

NICHOLS PLC.,	}	IPC NO. 14-2008-00183
Opposer,	}	Opposition to:
	}	
-versus-	}	Serial No. 4-2007-011504
	}	Date Filed: 10-16-07
	}	Trademark: "VIMO AND Animme
	}	Cartoon Character"
UNIVERSAL ROBINA	}	
CORPORATION,	}	
Respondent-Applicant.	}	
x-----x	}	Decision No. 2009-21

## DECISION

This pertains to a Verified Opposition filed on 19 August 2008 by herein opposer, Nichols PLC, a corporation duly organized and existing under the laws of England, with principal office at Laurel House, 3 Woodlanes Park, Ashton Road, Newton Le Willows, WA 12 OHH, England, against the application filed on 16 October 2007 bearing Serial No. 4-2007-01154 for the registration of the trademark "VIMO AND Animme/Cartoon Character" used for goods in Class 32 fro chocolate drinks with cereals/beverages with cocoa or chocolate based drinks and powder, and cereals prepared for human consumption, which application was published in the Intellectual Property Office Official Gazette, officially released for circulation on 18 April 2008.

The respondent-applicant in this instant opposition is Universal Robina Corporation with business address at 110 E. Rodriguez Jr. Avenue, Libis Quezon City.

The grounds for the opposition are as follows:

1. The registration of the mark "VIMO & Animme/Cartoon Character" in the name of respondent-applicant will violate and contravene the provisions of Section 123 (d), (e), and (g) of the IP Code because said mark is almost identical and confusingly similar to the mark "VIMTO" owned and unabandoned by the opposer.
2. The trademark "VIMTO" is known all over the world to be exclusively owned by the opposer, hence, the registration of an almost identical and confusingly similar trademark in the name of respondent-applicant will be breach of the clear provision of Article 6bis of the Paris Convention for the Protection of Industrial Property.
3. The registration of the trademark "VIMO & Animme/Cartoon Character" will cause grave and irreparable injury and damage to the Opposer within the meaning of Section 134 of the IP Code.

The allegation of facts are as follows:

"The mark "VIMTO" was first used in England, in 1908; and registered in the United Kingdom as early as 1912. The Affidavit-direct testimony of Brendan Michael Hynes, Chief Executive Office of Opposer, Nichols PLX, attesting to this fact, is attached herewith as Exhibit C.

In the United Kingdom, the mark "VIMTO" is currently registered under Registration No. 644427. A duly authenticated copy of the aforementioned United Kingdom Certificate of Trademark Registration is attached to the Affidavit as Annex A thereof.

The trademark "VIMTO" is likewise registered in various countries around the world including Afghanistan, Andora, Argentina, Australia, Bahrain, Canada, Egypt, European Union, Hong Kong, Jamaica, Japan, New Zealand, Panama, Saudi Arabia, South Korea, Thailand, Trinidad and Tobago, Turkey, Ukraine, United Kingdom and the United States. Attached to Mr. Hynes' affidavit as Annexes B to V are the duly authenticated trademark registration certificates for the aforementioned countries.

In the Philippines, it is registered under Certificate of Registration number 052593, issued on April 29, 1992 for goods in class 32, particularly, non-alcoholic drinks, non-alcoholic fruit-flavored drinks, either carbonated or non-carbonated. Said registration remains active, valid and unabandoned. Attached herewith as Exhibit D is Philippine Trademark Registration Certificate for the mark "VIMTO".

To date, Nichols PLC holds One Hundred and Seventy Three (173) applications and/or registration to the mark "VIMTO". A detailed list of these applications and registration is attached to Mr. Hynes' affidavit as Annex W.

x        x        x

From the above listing of VIMTO's worldwide trademark registrations and applications, there is no doubt that Opposer, Nichols PLC, is the owner of the internationally well-known and registered trademark "VIMTO". Thus, Respondent-Applicant's application for the registration of the mark "VIMO & ANIMME/CARTOON CHARACTER" is in clear contravention of the IP Code, for being almost identical and confusingly similar to Opposer's registered trademark "VIMTO". In particular, Section 123.1 (d) of the IP Code provides:

x        x        x

As will be demonstrated below, the above elements concur:

1. Opposer's Philippine trademark registration for VIMTO was issued in 1992- said registration remains valid, subsisting and unabandoned up to this day. On the other hand, Respondent-Applicant, which is totally unrelated to Opposer, filed its application for a similar mark, VIMO with device, only on October 16, 2007;
2. Opposer's registration, like Respondent's application, covers goods under class 32; the goods are similar, if not, closely related, because both deal in non-alcoholic beverages;
3. The contending marks are almost visually and aurally identical.

To expound on the issue of identity and/confusing similarity between the contending marks, it is worthy to note that the dominant element of the contending marks are the word marks "VIMO", for Respondent-Applicant, and "VIMTO" for Opposer. Whatever, design Respondent-Applicant may have added to the mark "VIMO", it cannot be denied that "VIMO" is the distinctive element of the mark and also the element that the public will notice and remember.

The Honorable Supreme Court has already settled the issue of confusing similarity in a multitude of cases.

In the leading case of Operators Incorporated vs. The Director of Patents et al., The Honorable Supreme Court ruled that the marks "AMBISCO" and "NABISCO" are confusingly similar x x x.

The afore-quoted jurisprudence is further augmented and clarified in another leading case, that of Marvex Commercial Co. Inc. vs. Petra Hawpia & Co. In this case, the Honorable Supreme Court declared that the marks "SALONPAS" and "LIONPAS" are confusingly similar x x x.

Hence, the use of the mark "VIMO" which is almost identical to Opposer's mark "VIMTO" will result in public confusion, with Respondent-Applicant's goods being associated with Opposer.

While Respondent-Applicant cleverly tried to distinguish its mark from that of opposer by the use of a collateral device, the fact remains that because of the prominent use of the mark "VIMO", an instant connection will be made between that of Respondent-Applicant's and Opposer's goods which are both under class 32, and are, most likely, found on the same shelves of the supermarket.

In this instant Opposition, it cannot be denied that Respondent-Applicant's mark "VIMO and ANIMME/CARTOON CHARACTER" is confusingly similar to the previously registered mark "VIMTO" belonging to Opposer and that both marks cover the same class of goods (Class 32). x x x

Further, Respondent's application for registration of the trademark "VIMO and ANIMME/CARTOON CHARACTER" likewise contravenes Section 123.1 (e) of the IP Code x x x

As clearly established, the dominant element of Respondent-Applicant's mark "VIMO" is almost visually and aurally identical and/or confusingly similar to Opposer's internationally well-known mark "VIMTO".

As to the issue of well knownness, it cannot be gainsaid that Opposer mark "VIMTO" is internationally well known, having such an extensive worldwide registration and a long and prosperous history.

Opposer, Nichols PLC also maintains a website, readily accessible to the public, further bolstering "VIMTO'S" global presence. Printouts of said website are appended to Mr. Hynes' affidavit.

VIMTO products are likewise widely sold in the Philippines. Its presence and popularity in the local market has been duly verified by Mr. Allan Mucho, a Paralegal, who, after conducting a market research, concluded that "VIMTO" is popularly and extensively sold in the Philippines. Attached hereto as Exhibit E is the affidavit of Mr. Allan Mucho attesting to the aforementioned fact.

In the international scenario, and in view of the above worldwide registrations, international promotion and publicity, herein Opposer is undoubtedly the true and actual owner of the internationally well-known "VIMTO" mark. Hence, it would be inconsistent and unjust to have a confusingly similar trademark in the Philippines in the name of Respondent-Applicant, which is unrelated to and unauthorized by Opposer.

Respondent-applicant's use of the "VIMO & ANIMME/CARTOON CHARACTER" mark constitutes clothing the formers business, goods and

services with the general appearance of the Opposer's trademark, since the marks are confusingly similar.

Respondent-Applicant's business, goods and services are likely to confuse or deceive the purchasing public into believing that the business, goods and services of said Respondent-Applicant are under the sponsorship of the Opposer. Respondent-Applicant has obviously clear intentions to have a free-ride and to trade upon the popularity of Opposer's products and the goodwill associated therewith. Because of the international popularity of Opposer's mark "VIMTO", it is evident that Respondent-Applicant seeks to gain immense benefits therefrom, by making it appear that it is associated with Opposer.

Further, the use and registration of the mark "VIMO & ANIMME/CARTOON CHARACTER" in the name of Respondent-Applicant will cause grave and irreparable injury to the Opposer within the meaning of the IP Code."

Subsequently, this Bureau issued a Notice to Answer dated 02 September 2008 to herein respondent-applicant's counsel, directing the filing of an Answer within thirty (30) days from receipt. Said Notice was duly received by the latter on 30 September 2008. To this date however, no motion, answer nor any pleading related thereto was filed by respondent-applicant. Thus, pursuant to Section 11 of Office Order No. 79, series of 2005, this instant opposition case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses and the documentary evidence submitted by herein opposer and admitted hereupon consisting of Exhibits "A", "B", "C" (including Annex "A", "B", "E", "F", "G", "H", "I", "J", "K", "M", "O", "P", "Q", "R", "T", "U", "V", and "W"), "D", "E" (including Annex "A" and "B"). On the other hand, Annex "C", "D", "L", "N" and "S" of Exhibit "C" are not admitted as these are documents in foreign language without English translation. Officer Order No. 79, series of 2005, this instant opposition case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses and the documentary evidence submitted by herein opposer and admitted hereupon consisting of Exhibit "A", "B", "C", (including Annex "A", "B", "E", "F", "G", "H", "I", "J", "K", "M", "O", "P", "Q", "R", "T", "U", "V" and "W"), "D", "E" (including Annex "A" and "B"). On the other hand, Annex "C", "D", "L", "N" and "S" of Exhibit "C" are not admitted as these are documents in foreign language without English translation. (Section 134, Intellectual Property Code)

The issues –

- I. Whether or not there is confusing similarity Between opposer's registered trademark "VIMTO" and respondent-applicant's applied mark "VIMO & Animme Cartoon Character", both covering class 32 goods.
- II. Whether or not opposer's registered trademark "VIMTO" is a well-known mark.

On the first issue, this Bureau after careful perusal of the arguments and evidence presented by herein opposer, finds merit in the opposition case under the pertinent provision enunciated in Section 123.1 (d), supra. Which reads:

"Sec. 123. Registrability. – 123.1. A mark cannot be registered if it:  
x x x

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or

- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;  
(Emphasis Supplied)

In a contest involving registration of trademark, the determinative factor is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would likely cause confusion or mistake on the part of the buying public.

The existence of confusion of trademark or the possibility of deception to the public hinges on “colorable imitation”, which has been defined as “such similarity in form, content, words, sound, meaning, special arrangement or general appearance of the trademark or trade name in their overall presentation or in their essential and substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.” (Emerald Garment Mfg. Corp. vs Court of Appeals, 251 SCRA 600)

Thus, in determining confusion of goods or origin, it does not require that the competing trademarks must be so identical as to produce actual error or mistake. It is rather that the similarity between the two trademarks is such that there is a possibility or likelihood of the older brand mistaking the newer brand for it:

In resolving the issue of confusing similarity, the law and jurisprudence has developed two kinds of tests – the Dominancy Test as applied in a litany of Supreme Court decisions including Asia Brewery, Inc. vs Court of Appeals, 224 SCRA 437; Co Tiong vs Director of Patents, 95 Phil. 1; Lim Hoa vs Director of Patents, 100 Phil. 214; American Wire & Cable Co. vs Director of Patents, 31 SCRA 544; Philippine Nut Industry, Inc. vs Standard Brands Inc., 65 SCRA 575; Converse Rubber Corp. vs Universal Rubber Products, Inc., 147 SCRA 154; and the Holistic Test developed in Del Monte Corporation vs Court of Appeals, 181 SCRA 410; Mead Johnson 7 Co. vs Van Dorp, Ltd., 7 SCRA 771; Fruit of the Loom, Inc. vs Court of Appeals, 133 SCRA 405.

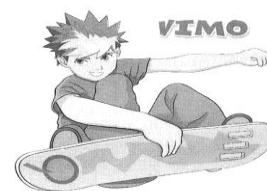
The Test of Dominancy has been consistently relied upon by the Honorable Supreme Court in cases relating to infringement of marks. It is in fact incorporated in Section 155 of R.A. 8293 which focuses on the similarity of the prevalent features, or the main, essential and dominant features of the competing trademarks which might cause confusion or deception. As to what constitutes a dominant feature of a label, no set of rules can be deduced. Usually, these are sign, color, design, peculiar shape or name, or some special, easily remembered earmarks of the brand that easily attracts and catches the eye of the ordinary consumer.

The Holistic Test, in the case of “Mighty Corporation vs E & J Gallo Winery, 434 SCRA 473, so holds that, “the discerning eye of the observer must focus only on the predominant words but also on the features appearing in both labels in order that he may draw his confusion whether one is confusingly similar to the other.

A side by side illustration of the contending marks are reproduced hereunder for examination:



Opposer's Registered Trademark



Respondent-Applicant's Trademark

The contending marks albeit not identical, appears confusingly similar. The word mark "VIMTO" is the dominant feature in the contending marks. The deletion of the media letter "T" in respondent-applicant's "VIMO" mark device cannot dispel the fact that similarity is perceivable both visually and aurally.

In the case of *Continental Connector Corp. vs. Continental Specialties Corp.*, 207 USPQ 60, the rule applied was that, the conclusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term. By analogy, confusion cannot also be avoided by merely dropping or changing one of the letters of a registered mark. Confusing similarity exist when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other. (*Societe Des Produits Nestle., S.A. vs. Court of Appeals, G.R. N o. 112012, April 4 2001*) An unfair competitor need not copy the entire mark to accomplish its fraudulent purposes. It is enough of he takes the one feature which are average buyer is likely to remember. (Nims, *The Law of Unfair Competition and Trademarks*, 4<sup>th</sup> Vol. 2, 678-679) Indeed, measured against the dominant-feature standard, respondent-applicant's mark must be disallowed. For, undeniably, the dominant and essential feature of the article is the trademark itself.

Anent respondent-applicant's presentation of a boy riding in a skateboard (file wrapper records), this cannot dispel the confusion created by the word mark. While it was produced in a bigger picture than the word mark "VIMO", indiscriminate consumers of non-alcoholic beverages, in most cases would refer to the products by its word mark, than the device. Moreover, the representation of a boy in skateboard does not create product distinction. At most, it is suggestive of the benefit of healthy and active body in drinking "VIMO" beverage.

Confusion in this instant case is aggravated by the fact that the contending marks cover related goods. Opposer's "VIMTO" covers non-alcoholic drinks referring to non-alcoholic fruit flavor drinks either carbonated or non-carbonated (Exhibit "D"); whereas respondent-applicant's "VIMO & Animme/Cartoon Character" covers chocolate drinks with cereals/beverages with cocoa or chocolate based drinks and powder, and cereals prepared for human consumption (file wrapper records). The foregoing set of beverages fall under class 32 of the Nice Classification of Goods. As such, both products flow through the same channels of trade.

The above enumeration shows the relatedness of the goods. "Goods are related when they belong to the same class or have the same class or descriptive properties; when they possess the same physical attributes or essential characters with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or sold in grocery store. Thus biscuits were held related to milk because they are both food products." (*American Foundries vs Robertson*, 269 USPO 372, 381)

This legal assemblage affirms the superior right of opposer in accordance to the above-quoted provision of the IP Code, otherwise known as the "prior registrant rule" or "prior filer rule", in relation to Section 147.1 supra, which provides for the exclusive right of a registrant mark's owner to prevent all third parties without consent of the owner from using the same which are identical or similar, resulting in a likelihood of confusion. Records show that opposer's aforementioned registered trademarks were issued registration for "VIMTO" mark and which were filed prior to the filing date of respondent-applicant's subject mark.

On the second issue posed, opposer seeks the declaration of well-known over its mark "VIMTO". This Bureau cannot agree. Opposer failed to submit sufficient and eloquent proof to prove that its mark has actually gained and enjoyed a worldwide reputation internationally and in the Philippines, in accordance to The Rules and Regulations on Trademark, Service Mark, Trade Names and Marked or Stamped Containers, particularly Rule 102, which enshrines the criteria of a well-known mark, to wit:

“Rule 102. Criteria for determining whether a mark is well known. – In determining whether a mark is well-known the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the records of successful protection of the rights in the mark;
- (k) the outcome of the litigations dealing with the issue of whether the mark is a well-known; and
- (l) the presence or absence of identical or similar marks validly registered for or on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.”

In the instant case, opposer did not meet the enumerated criteria or any majority combination thereof a well-known mark. It failed to proffer evidence to show the duration, extent and geographical area of the use of the mark, including its promotion or advertisement in relation to the relevant sector of the consumers in foreign countries and in the Philippines. The fact of being well-known has to be established in the United States and other places as well as in the Philippines. The Certificates of Registration (Exhibit “C”, including its Annexes) issued in numerous jurisdictions cannot sufficiently declare opposer’s “VIMTO” mark as well-known. Thus, in the light of the foregoing and under the language of the applicable rules, this Bureau does not find opposer’s mark “VIMTO” well-known for failure to meet the standards of a well-known mark, as above-enumerated.

IN VIEW of all the foregoing, the instant Verified Opposition is, as it is hereby SUSTAINED, without however declaring opposer’s mark “VIMTO” as well-known. Consequently, trademark application bearing Serial No. 4-2007-11204 for the “VIMO & Animme Cartoon Character” for Universal Robina Corporation, filed on 16 October 2007 covering class 32 goods fro chocolate drinks with cereals/beverage with cocoa or chocolate based drinks and powder, and cereals prepared for human consumption, is hereby REJECTED.

Let the file wrapper of “VIMO & Animme Cartoon Character”, subject matter of this case together with copy of this Decision be forwarded to the Bureau of Trademarks (BTO) for appropriate action.

SO ORDERED.

Makati City, 19 February 2009.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs  
Intellectual Property Office