

PEDIATRICA, INC.
Opposer,

IPC. No. 14-2009-00123
Opposition to:

- versus -

Application Serial No. 4-2008-010704
Filing Date : 4 September 2008
TM : "SEL-C-PLUS"

JOSE CHING
Respondent-Applicant.
x-----x

Decision No. 2010-40

DECISION

Pediatrica, Inc. ("Opposer"), a corporation organized and existing under the laws of the Philippines with office located at 3rd Floor Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City filed an Opposition to Trademark Application Serial No. 4-2008010704. The application, filed by Jose Ching, ("Respondent-Applicant") Filipino, with address at 518 Silensio Street, Sta. Mesa, Manila, covers the mark "SEL-C-PLUS", used on goods under Class 5¹ particularly: "health supplements namely selenium, vitamin C, zinc and minerals".

The Opposer alleges the following:

"1. The trademark 'SEL-C-PLUS' so resembles 'ZEEPLUS' trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark 'SEL-C-PLUS'. The trademark 'ZEEPLUS', which is owned by Respondent, will likely cause confusion, mistake, deception on the part of the purchasing public, most especially considering, that the opposed trademark 'SEL-CPLUS' is applied for the same class of goods as that of trademark 'ZEEPLUS', i.e., Class (5); vitamin preparation.

"2. The registration of the trademark 'SEL-C-PLUS' in the name of the Respondent will violate Sec. 123 of Republic Act. No. 8293, otherwise known as the 'Intellectual Property Code of the Philippines', which provides, in part, that a mark cannot be registered if it:

'(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 ;'

Under the above-quoted provision, any mark which is similar to a registered mark shall be denied registration in respect of similar or related goods or if the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

"3. Respondent's use and registration of the trademark 'SEL-C-PLUS' will diminish the distinctiveness and dilute the goodwill of Opposer's trademark 'ZEEPLUS'.

The Opposers' evidence consists of the following:

1. Annex "A"- Print-out of IPO -E-Gazette;
2. Annex "B"- Certificate of Registration;

¹ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the purposes of the Registration of Marks concluded in 1957.

3. Annex "C"- Declaration of Actual Use;
4. Annex "D"- Sample Product label of "ZEEPLUS";
5. Annex "E"- Certificate of Product Registration issued by BFAD; and
6. Annex "F"-Certification and Sales Performance issued by Intercontinental Marketing Services.

This Bureau issued and served a copy of a Notice to Answer to the Respondent-Applicant. The Respondent-Applicant, however, did not file an Answer within the prescribed period. Thus, Rule 2, Section 11 the Regulations on Inter Partes Proceedings provides:

Section 11. Effect of failure to file Answer -In case the respondent fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the petition or opposition, the affidavits of the witnesses and the documentary evidence submitted by the petitioner or opposer.

Should the Opposer's Opposition be sustained?

It is emphasized that the function of a trademark is to pinpoint distinctly the origin of ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his produce.²

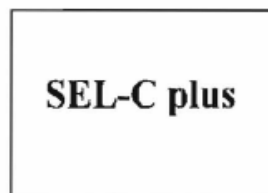
Thus, Sec.123.1.(d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines (IP Code), provides that a mark cannot be registered if it:

(d) is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing date 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.

Records and evidence show that at the time the Respondent-Applicant filed his trademark Application on 04 September 2008, the Opposer has an existing registration for the mark ZEEPLUS. The Opposer's registered mark is used on goods under Class 05, specifically "vitamin preparation", and therefore, similar and/or closely related to the goods on which the Respondent-Applicant uses the mark SEL-C-PLUS.

The question is: Are the competing marks, as shown below, resemble each other that confusion, deception or mistake is likely to occur?



Respondent-applicant's Mark



Opposer's Mark

² Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999

The last word in the Respondent-Applicants' mark, that is, "plus", is the same as the second syllable in the Opposer's mark. Thus, "C-plus" in the Respondent-Applicants' mark sounds exactly the same as the Opposer's "ZEEPLUS".

The Respondent-Applicant's mark is obviously a colorable imitation of the Opposer's, letters "S", "E" and "L", in the Respondent-Applicant's mark notwithstanding. Confusion cannot be avoided by merely dropping or changing one of the letters of registered mark. Confusing similarity exists when there is such a close or ingenious imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchasers as to cause him to purchase the one supposing it to be the other.³ Corollarily, infringement of trade-mark does not depend on the use of identical words, nor on the question whether they are so similar that a person looking at one would be deceived into the belief that it was the other, it being sufficient if one mark is so like another in form, spelling, or sound that one with not a very definite or clear recollection as to the real mark is likely to be confused or misled.⁴

In this regard, similarity in sound can be the basis of a finding of confusing similarity. The Supreme Court held:

"In fact, even their similarity in sound is taken into consideration, where the marks refer to merchandise of the same descriptive properties, for the reason that trade *idem sonans* constitutes violation of trade mark patents.⁵

Also, in *Marvex Commercial Co., Inc. vs. Petra Hawpia & Co.*⁶, the Supreme Court ruled:

"The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, *Unfair Competition and Trade Marks*, 1947, vol. 1, will reinforce our view that 'SALONPAS' and 'UONPAS' are confusingly similar in sound: 'Gold Dust' and 'Gold Drop'; 'Jantzen' and 'Jazz-Sea'; 'Silver-splash, and 'Supper-Flash"; 'Cascarete' and 'Celborite'; 'Celluloid' and 'Cellonite'; 'Charteuse' and 'Charseurs'; 'Cutes' and 'Cuticlean'; 'Hebe' and 'Meje'; 'Kotex' and 'Femetex'; 'Zuso' and 'Hoo-hoo'. Leon Amdur, in his book 'Trademark law and Practice', pp. 419-421, cites, as coming within the purview of the *idem sonans* rule. 'Yusea' and 'U-C-A', 'Steinway Pianos' and 'Stienberg Pianos' and 'Seven-Up' and 'Lemon-Up'. In *Co Tiong vs. Director of Patents*, this Court unequivocally said that 'Celdura' and 'Condura' are confusingly similar in sound ; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name 'Lusolin' is an infringement of the trademark 'Sapolin', as the sound of the two names is almost the same.

"In the case at bar, 'SALON PAS' and 'LI0NPAS' when spoken sound very much alike. Similarity of sound is sufficient ground for this court to rule that the two are confusingly similar when applied to merchandise of the same descriptive properties. (See *Celanese Corporation of America vs. E.I. Du Pont*, 154 F. 2d. 146, 148).

x x x"

In this instance, consumers can easily be confused or commit mistake in buying the product they intend to purchase. Somebody who is requested or instructed to buy ZEEPLUS may actually end up buying SEL-C-PLUS or vice-versa, because they sound practically the same and the product being similar and/or closely related.

That the Respondent-Applicant's use of his mark was "inspired" by the Opposer's mark and/or motivated by an intent to ride in on the goodwill of the ZEEPLUS mark, is obvious. The

3 *Societe Des Produits Nestle, SA vs. Court of Appeals*, G.R. No. 112012, 04 April 2001

4 *Northam Warren Corporation v. Universal Cosmetic Co.*, C.CAIII, 18F.2d714,775; *Philippine Nut Industry, Inc. v. Standard Brands Incorporated*, 65 SCRA 575

5 *American Wire & Cable Co. v. Director of Patents*, 31 SCRA 544, G.R. No. L-26557 (February 18, 1970).

6 18 SCRA 1178

Respondent-Applicant will use his product on goods or products that are similar or closely related to the Opposer's. The Respondent-Applicant, by appropriating a mark which is confusingly similar to the Opposer's will compete in the market on an uneven ground, to the prejudice of the Opposer. In *American Wire & Cable Co. vs. Director of Patents*⁷, the Supreme Court held:

“Of course, as in all other cases of colorable imitations, the unanswered riddle is why, of the millions of terms and combinations of letters and designs available, the appellee had to choose those closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark.”

WHEREFORE, premises considered the instant OPPOSITION to Trademark Application Ser. No. 4-2008-010704 is hereby SUSTAINED.

Let the filewrapper of Trademark Application No. 4-2008-010704 returned, together with a copy of this Decision, to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 16 July 2010.

NATHANIEL S. AREVALO
Director, Bureau of Legal Affairs
Intellectual Property Office

⁷ supra