

UNITED LABORATORIES INC.,
Opposer,

IPC No. 14-2010-00327
Opposition to:

-versus -

Appln. No. 4-2010-006328

SEL. J. PHARMA CORPORATION,
Respondent.
X-----X

Decision No. 2012-02

DECISION

United Laboratories, Inc. ("Opposer") on 22 December 2010, filed an opposition to Trademark Application Serial No. 4-2010-006328. The application, filed by SEL-J PHARMA CORPORATION, ("Respondent-Applicant") covers the mark "ENERSEL" for use on "multivitamins" under Class 5 of the International Classification of goods.

The Opposer alleges among others, the following:

- "1. The mark 'ENERSEL' owned by Respondent-Applicant so resembles the trademark 'ENERVON-C' ('ENERVON', for brevity) owned by Opposer and duly registered with this Honorable Bureau prior to the publication for opposition of the mark 'ENERSEL'.
- "2. The mark 'ENERSEL' will likely cause confusion, mistake and deception of the part of the purchasing public, most especially considering that the opposed mark 'ENERSEL' is applied for the same class and goods as that of Opposer's trademark 'ENERVON', i.e. Class 05 of the International Classification of Goods as vitamins.
- "3. The registration of the mark 'ENERSEL' in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code, which provides. x x x

The Opposer's evidence consists of the following:

- "1. Exh. "A" to "A-I" – printouts of the pertinent pages of the "IPO E-Gazette" indicating applications published for opposition with releasing date of 04 Oct. 2010;
- "2. Exh. "B" – copy of the Cert. of Registration in the Principal Register of the mark "ENERVON-C" issued by the Philippine Patent Office on 16 June 1969 in favor of United American Pharmaceuticals, Inc.;
- "3. Exh. "C" – copy of the Deed of Assignment executed by and between United American Pharmaceuticals, Inc. and Unam Brands (BVI) Ltd. on 21 Sept. 2005 covering the mark ENERVON-C;
- "4. Exhibit "D" – copy of the Deed of Assignment executed by and between Unam Brands (BVI) Ltd. and the Opposer on 23 Feb. 2009 covering the mark ENERVON-C;
- "5. Exh. "E" – copy of the Opposer's petition, dated 12 May 2009, for the renewal of the registration of the mark ENERVON-C;
- "6. Exhs. "F", "G", "H", "I" and "J" – copies of the affidavits of use of the mark ENERVON-C executed by executives of United American Pharmaceuticals Inc., the for the mark;

- “7. Exh. “K” – sample product label bearing the mark “ENERVON”, as actually used in commerce;
- “8. Exh. “L” – copy of a certification signed by Bienvenido C. Lazaro of IMS Health Philippines, Inc. on 11 Oct. 2010 covering sales data of “AuE-Vitamins B. Complex Market in values, share, and growth” for the period Sept. 2009 to Aug. 2010; and
- “9. Exh. “M” – Cert. of Product Reg. (“CPR”) issued by the Bureau of Food and Drugs (“BFAD”) on 04 Jan. 2010 for “MULTIVITAMINS Syrup under the brand name “Enervon”.

The Respondent-Applicant filed its answer on 27 May 2011, refuting the material allegations of the Opposer and contending that the mark “ENERSEL” is not confusingly similar to “ENERVON”. It submitted the following as evidence:

1. Exh. “1” – copy of Affidavit of Jonnahlyn Antenero, executed on 13 May 2011;
2. Exhs. “2” and “3” – sample packaging materials of the Respondent-Applicant’s products.
3. Exh. “4” – copy of CPR by the BFAD on 13 Oct. 2009 for the products of the Respondent-Applicant under the brand name “Energel”;
4. Exh. “5” – copy of the printout of web pages of the website www.ihealthdirectory.com on the subject “Benefits of lysine”;
5. Exh. “6” – copy of the printout of web pages of the website www.mayoclinic.com on the subject “Nutrition and healthy eating”; and
6. Exh. “7” – copy of the printout of web pages of the website www.candida-cure-recipes.com on the subject health benefit of coconut oil.

Should the Respondent-Applicant’s trademark application be allowed?

The Opposer anchors its case on Sec. 123.1 (d) of the IP Code which provides that a mark cannot be registered if is identical with a registered mark belonging to a different proprietors or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

In this regard, records show that at the time the Respondent-Applicant filed its trademark application in 2010, the Opposer has existing trademark registration for the mark ENERVON-C used on “high-potency therapeutic vitamin formula containing essential Vitamin B Complex plus Vitamin C”. The goods on which the competing marks are used therefore are similar or closely related.

But, are the competing marks identical or closely resemble each other that confusion or deception is likely to occur?

The only similarity between the competing marks is the first four letters comprising the first two syllables “ENER”. Considering that the marks are used on vitamins, “ENER” is obviously derived from the word “energy”. In fact, the Opposer, in connection to the mark “ENERVON-C”, has adopted the tagline “*more energy, more happy*”. Thus, “ENER” alone is not unique as a mark or as a component of a mark for the subject goods. “ENER” is clearly suggestive as to the kinds of goods a mark with “ENER” as a component is attached to. What

would make a composite mark with “ENER” distinctive would be the prefixes, suffixes or appendages to it, such as “VON” in “ENERVON”.

Succinctly, the last syllable in the Respondent-Applicant’s mark – “SEL” – rendered the mark a character that is clearly and glaringly distinct from the Opposer’s mark such that product confusion, mistake or deception is unlikely to occur. Neither is confusion of business likely. It is a remote possibility for a consumer to assume or conclude that there is a connection between the parties solely because the Respondent-Applicant’s mark starts with the letters or syllables “ENER”. As discussed above, “ENER” is not unique as a mark or as a component of a mark used for goods that connotes “energy”. Because of the nature of the goods involved, consumers tend to be more prudent in their purchases.

The function of a trademark is to point out distinctly the origin or 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 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 product. The Respondent-Applicant’s mark is consistent with this function.

WHEREOF, premises considered, the instant opposition is hereby DISMISSED. Let the file wrapper of Trademark Application No. 4-2010-006328 be returned, together with a copy of this DECISION, to the Bureau of Trademarks (BOT) to information and appropriate action.

SO ORDERED.

Taguig City, 16 January 2012.

ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs