

VITASOY INTERNATIONAL	}	IPC NO. 14-2008-00182
HOLDINGS LIMITED,	}	Case Filed : 19 August 2008
<i>Opposer,</i>	}	Opposition to:
	}	
- <i>versus-</i>	}	Appl'n Serial No. : 4-2007-011507
	}	Date Filed : 16 October 2007
	}	Trademark : "VITALIFE"
UNIVERSAL ROBINA CORPORATION,	}	
<i>Respondent-Applicant.</i>	}	
x-----x	}	Decision No. 2009-60

DECISION

This pertains to the oppositions to the registration of the mark "VITALIFE" bearing application No. 4-2007-011507 filed on October 16, 2007 covering the goods "*beverages namely drinking water, mineral water, aerated water without flavor*" under Class 32 of the International Classification of goods, which trademark application was published in the E-Gazette which was released for circulation on April 18, 2008.

The Opposer in the instant case is "VITASOY INTERNATIONAL HOLDINGS LIMITED" a corporation organized and existing under the laws of Hong Kong, with principal address at 1 Kin Wong Street, Tuen Mun, New Territories, Hong Kong.

On the other hand, the Respondent-Applicant is "UNIVERSAL ROBINA CORPORATION" a corporation with given address at No. 110 E. Rodriguez Jr. Avenue, Libis, Quezon City.

The grounds of the opposition are as follows:

- "1. Opposer is the prior adopter, user and true owner of the trademarks "VITA" and "VITASOY" and their variants in the Philippines and around the world.
- "2. Respondent-Applicant's trademark "VITALIFE" is confusingly similar to Opposer's "VITA", "VITASOY" and their variants trademarks;
- "3. Opposer's trademarks "VITA", "VITASOY" and their variants are internationally well-known;
- "4. The registration of Respondent-Applicant's trademark "VITALIFE" will cause grave and irreparable injury and damage to the Opposer; and
- "5. Since Opposer's trademarks "VITA", "VITASOY" and their variants are internationally well-known, they are entitled to protection against confusingly similar marks covering or related goods.

Opposer relies on the following facts to support its Verified Notice of Opposition:

- "1. Opposer is the prior adopter, user and owner of the marks "VITA", "VITASOY" and their variants, having used the same in commerce in Hong Kong as early as 1940. To date, Opposer continues to sell its products bearing the aforementioned trademark, internationally and in the Philippines. Opposer has obtained and continues to obtain registrations for the trademarks "VITA", "VITASOY" and their variants from the intellectual property offices of various countries around the world;

- “2. The internationally well-known trademarks “VITA” and “VITASOY” have been registered in the name of herein Opposer in many countries all over the world;
- “3. Opposer’s “VITA”, “VITASOY” and their variants trademarks have acquired immense and valuable goodwill as a result of enormous sums of money spent in advertising and promotions worldwide, including the Philippines. Opposer’s internationally well-known marks “VITA”, “VITASOY” and their variants have long become distinctive of the business and/or the goods of the Opposer, through its long and exclusive use thereof in international commerce.
- “4. As internationally well-known marks, “VITA”, “VITASOY” and its variants are protected under the Paris Convention for the Protection of Industrial Property or better known as the Paris Convention, particularly Article 6*bis* thereof;
- “5. Opposer will be damaged by the registration of the mark “VITA”, “VITASOY” and its variants in the name of Respondent-Registrant, considering the fact that said Opposer’s marks have long been established and have obtained goodwill and consumer recognition in the Philippines and worldwide;
- “6. The mark in question is identical to and/or confusingly similar with the trademark/trade name of herein Opposer and its continued use by Respondent-Applicant is therefore, not only unfair but also has caused and will continue to cause substantial damage to Opposer’s business, because such use by Respondent-Applicant has tended, as it has in fact tended to deceive the general public as to the source and origin of the goods bearing such trademark. Confusion as to the origin or source of the goods is all the more made likely considering that the mark “VITA” is the dominant portion of Opposer’s business name, Vitasoy International Holdings Limited;
- “7. The registration of the mark “VITALIFE” for goods under Class 32 in the name of Respondent-Applicant will cause grave and irreparable injury and damage to the Opposer. The mark “VITALIFE” incorporates in its entirety Opposer’s internationally well-known trademark “VITA”. Thus, Respondent-Applicant mark, as used in connection with the identified goods, i.e. “*beverage, namely, drinking water, mineral water and aerated water with and without flavor*” is likely to cause confusion or mistake, in view of Opposer’s prior use of the mark “VITA”, “VITASOY” and its variants for similar goods in Class 32, including among others “*soya bean based carbonated and non-carbonated and non-alcoholic drinks and beverages.*”;
- “8. The Opposer is the owner of the internationally well-known trademarks “VITA”, “VITASOY” and its variants which are a dominant part of its trade name/corporate name Vitasoy International Holdings Limited, which under Section 37 of the Philippine Trade Name Law and the Paris Convention should be protected even without the obligation of registration; and
- “9. The registration of the “VITALIFE” mark in the name of Respondent-Applicant is an unfair competition with and an infringement of Opposer’s internationally well-known marks “VITA”, “VITASOY” and its variants, as

the use of the said mark on the goods described in its registration clearly violates the exclusive right of the Opposer to said marks.

Opposer submitted the following in support of its opposition:

Exhibit	Description
Exhibits "A" to "A-4"	Certified true copy of the pertinent original Special Power of Attorney.
Exhibit "B"	Certified true copy of Certificate of Registration No. 61652 for the mark "VITA (In Chinese Characters)"
Exhibits "C" to "C-3"	Copies of trademark application for the marks "VITA", "VITASOY" and "VITASOY & FIVE LEAF LOGO"
Exhibits "D" to "D-194"	Certified true copy of the duly authenticated and notarized Affidavit of Au-Hing Tong and sales of Opposer's VITA
Exhibit "E"	Certification issued by Christina S. Molino
Exhibit "E-1"	Official website of Vitasoy International Holdings Limited
Exhibit "E-2"	Official Hong Kong website of Vitasoy International Holdings Limited
Exhibit "E-3"	Official United States of America's website of Vitasoy International Holdings Limited
Exhibit "E-4"	Official Chinese website of Vitasoy International Holdings Limited
Exhibit "E-5"	Official Australian website of Vitasoy International Holdings Limited
Exhibits "E-6" to "E-46"	Others exhibits submitted as websites computer printouts of Vitasoy Holdings Limited
Exhibits "F" o "R-267"	duly authenticated and notarized Affidavit Direct Testimony executed by Au-Hing Tong and attached therewith the list of the worldwide trademark applications and registrations of Opposer for "VITASOY"

On January 21, 2009, Respondent-Applicant filed its verified Answer denying all the material allegations in the Verified Notice of Opposition and further alleged the following as its Affirmative Defenses:

- "1. Opposer has no cause of action against the Respondent-Applicant;
- "2. The mark "VITALIFE" is not confusingly similar to Opposer's marks, the same being entirely different in form, presentation, concept, image and font used;
- "3. The presentation of the marks are so distinct and different that there is no likelihood that the public will confuse subject mark "VITALIFE" with Opposer's marks "VITA", "VITASOY" and its variants;
- "4. That this Honorable Office has granted certificates of registration to the following marks: (a) "NESVITA" owned by Societe Des Produits Nestle S.A.; and (b) "QVITAL" owned by the Quaker Oats Company notwithstanding the existence of Opposer's marks and, presumably, after a determination that the Registered Marks should be taken in its entirety and should not be dichotomized as suggested by the Opposer in the instant case;

“5. That unless a particular mark has been used solely for the purpose of benefiting from the previously registered or well-known mark and evidence to that effect is ample. Clear and convincing, the rule is to regard the mark in its entirety and not to dichotomize the same.

The ultimate issue to be resolved in this particular case is:

WHETHER OR NOT THE RESPONDENT-APPLICANT IS ENTITLED TO THE REGISTRATION OF THE MARK “VITALIFE”.

The applicable provision of the law is Section 123.1 (g) and (h) of Republic Act No. 8293, which provides:

“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 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;

The contending trademarks are reproduced below for comparison and scrutiny:



Opposer's marks



Respondent-Applicant's Mark

Opposer's trademarks consists of the word “VITA” and the composite one “VITASOY” which is its trade name or corporate name.

On the other hand, the Respondent-Applicant's mark consists of the word “VITALIFE”.

The very reason why the Opposer filed the instant opposition is due to the inclusion of the word "VITA" in the Respondent-Applicant's mark, which it considers its dominant element/or features.

It cannot be denied that the Respondent-Applicant's mark "VITALIFE" is a composite mark composed of three (3) syllables. The first two (2) syllables "VITA" is exactly the same in *spelling, pronunciation* as well as in *meaning* of the Opposer's mark "VITA", and likewise the dominant feature of its trade name/or corporate name "VITASOY" which under the Paris Convention should be protected even without obligation of registration.

Article 8 of the Paris Convention provides:

"A trade name shall be protected in all countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark."

In "Philippine Exports B.V. vs. Court of Appeals et. al. (G.R. No. 96161 February 21, 1992)", the Supreme Court ruled:

"A corporation's right to use its corporate and trade name is a property right. A right *in rem* which it may assert and protect against the whole world in the same manner as it may protect its tangible property, real or personal against trespass or conversion. A corporation has the exclusive right to the use of its name which may be protected by injunction upon a principle similar to that upon which persons are protected in the use of trademarks and trade names. It is a fraud on the corporation which has acquired a right to that name and perhaps carried on its business thereunder that another should attempt to use the same, or the same name with a *slight* variations, in such a way to induce persons to deal with it in the belief that they are dealing with the corporation which has given reputation to the name."

Opposer introduced its vitasoy products to the Philippine market in August 1996 through Sunshine Trading Limited in 1999 (Exhibit "F-5"), Opposer appointed Fly Ace Corporation as its Philippine Distributor, which started selling Opposer's "VITA" goods in 1998. Representative samples of advertising and promotional materials circulated in the Philippines featuring Opposer's mark "VITA" (Exhibits "D-183" to "D-194" and Exhibits "F-95" to "F-124").

There is no doubt that the Opposer is the prior *adopter* and *user* of the mark "VITA" and "VITASOY" which is confusingly similar to Respondent-Applicant's mark "VITALIFE".

When one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark, this is not only to avoid confusion on the part of the public, but also to protect an already *used* and registered trademark and an established goodwill. (Chuanchow Soy & Canning Co., vs. Director of Patents and Rosario Villapania (G.R. No. L-13947, June 30, 1960)).

The Respondent-Applicant's mark is not overshadowed by the word "LIFE", its last syllable, as what catches the eyes and mind of the buying public is the word "VITA". The likelihood of confusion on the part of the consuming public is bound to occur, as well as confusion or source, affiliation or connection if the Respondent-Applicant's mark be registered. Compounding confusion and deception is the fact that the contending trademarks both cover the goods falling under Class 32 of the International Classification of goods.

In the instant case, confusing similarity could have been avoided had it not been for the word "VITA" included in the Respondent-Applicant's mark which has already been appropriated and registered by the Opposer and which registration is still valid and existing.

WHEREFORE, in the light of all the foregoing, the Opposition is, as it is hereby SUSTAINED. Consequently, Trademark Application No. 4-2007-011507 filed on October 16, 2007 for the mark "VITALIFE" filed by "UNIVERSAL ROBINA CORPORATION" is, as it is hereby REJECTED.

Let the filewrapper of the trademark "VITALIFE" subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 08 May 2009.

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