

VITASOY INTERNATIONAL
HOLDINGS LIMITED,
Opposer,
- versus -

IPC 14-2006-00072

Opposition to:
TM Application No. 4-5005-001063
Date Filed: February 3, 2005)

GREEN SPOT (THAILAND)
LIMITED,
Respondent-Applicant.

Trademark "VITAMILK"

x-----x

Decision No. 2007 – 115

DECISION

This RESOLVES THE Notice of Opposition filed by Vitasoy International Holdings Limited, a corporation organized and existing under the laws of Hong Kong, with address at 1 Kin Wong Street, Tuen Mun, New territories, Hong Kong, against Application Serial No. 4-2005-001063 for the mark "VITAMILK" for goods under Class 32, namely "soya-bean based non-carbonated non-alcoholic beverages filed by Green Spot (Thailand) Limited, with address at No. 244 Snnagandra Road, Hua Mak Nang Kapi, Bangkok 10240, Thailand.

The grounds for the opposition are as follows:

1. Opposer's is the owner of internationally well-known trademark "VITA", "VITASOY" and their variants. In the Philippines, Opposer is the registered owner for the trademarks "VITA (CHINESE CHARACTERS)" under certificate of Registered No. 06152 issued on 26 September 1995, and "VITASOY & FIVE LEAF LOGO" under Certificate of Registration No. 42002001769 issued on 08 July 2004, for goods under Classes 29 and 32, both of which are in active condition. Opposer is also the owner of a pending trademark application (Application Serial No. 4-1992-80836 filed on May 1992) for the mark "VITA" for soy-based beverage used as milk substitute "in Class 29; "coffee and tea drinks" in Class 30; and fruit juices, vegetable juices and soft drinks; concentrates, syrups and powders issued in the preparation of juices and soft drinks" in Class 32.

2. The registration of the mark "VITAMILK" in the name of the Respondent-applicant will violate and contravene the provision of Section 123.1 (d), (e), and (f), of Republic Act 8293 (The "IP Code"), as amended, because the dominant element of said Mark, which is "VITA" is confusingly similar to Opposer's internationally well-known Trademarks "VITA", "VITASOY" and their variants (covering goods including those in International Classes 29 and 32), owned, used and not abandoned by the Opposer as to Be likely when applied to or used in connection with the goods of the Respondent-Applicant to cause confusion or mistake, or deceive the purchasers thereof as to the origins of the goods.

3. "VITA" is the dominant portion of Respondent-applicant mark "VITAMILK" and the world MILK is the generic or descriptive portion with references to Respondent-Applicant goods. However, the word "MILK" is mis-descriptive or misleading. Consumers commonly understand the plain word milk to refer to cow's milk. The use of the plain word "milk" as a mark for soya-bean based products, is likely to mislead consumers into believing that Respondent-applicants products are made of Cow's milk. Moreover, the goods "milk" is classified under Class 29 under the Nice Classification adopted by the Intellectual Property Office (IPO), and not under Class 29 as indicated by the subject classification, which would add to confusion of the public under Section 123.1(g) of the Intellectual Property Code, a mark cannot registered if its likely to mislead the public, particularly as to the nature, quality and characteristic of the goods.

4. The registration of the mark "VITAMIK" for goods under Class 32 in the name of respondent-applicant will cause grave and irreparable injury and damage to the Opposer. The mark "VITAMILK" incorporates in its entirety Opposer's internationally well-known mark "VITA" to form the dominant part of said mark "VITA" is also the dominant portion of Opposer's "VITASOY" mark and the word SOY is the generic name or is descriptive of Opposer's goods, which are soya-bean based products, thus Respondent-applicant mark. If use in connection with the identified goods. Soya Bean based non-carbonated non-alcoholic beverage would be likely to cause confusion or mistake, in view of Opposer's prior use and registration of the marks "VITA" and "VITASOY" for similar goods for Classes 29 and 32 including among others "soya bean based carbonated and non-carbonated and non-alcoholic drinks and beverages."

5. Opposer's is the prior adopter, user and true owner of the mark "VITA" "VITASOY" and their variants, having used said marks in commerce in Hong Kong as early as 1940 and in the Philippines prior 1992. To date, Opposer's continues to sell its products bearing the aforementioned trademarks, internationally and the Philippines.

6. Opposer's has obtained and continues to obtain registration for the trademarks "VITA" "VITASOY" and their variants from the intellectual Property Office of various countries and the world.

7. Opposer's mark "VITA", "VITASOY" and their variants have acquired immense and valuable goodwill as a result of enormous sums of money spent in advertising and promotions worldwide, including the Philippines.

8. Opposer's internationally well-known marks "VITA" "VITASOY" and their variants have long become distinctive of the business and/or goods of the Opposer through Opposer's long and exclusive use thereof international commerce. As internationally well-known mark "VITA", "VITASOY" and their variants are protected under Article of the Paris Convention.

9. The confusing similarity between Respondent-applicant's "VITASOY" mark and Opposer's internationally well-known trademarks "VITA", "VITASOY" and their variants is very likely to deceive the purchaser's of goods on which the mark is being used to the origin or source of said goods and as to nature character quality and Characteristics of the goods to which it is affixed.

10. Confusion as to the origin or source of goods is all the more made likely, considering that the mark "VITA" IS DOMINANT PORTION OF Opposer's business name Vitasoy International Holdings Limited. Under section 165.2(a) of the Intellectual Property Code trade names or business names shall be protected, even prior to or without registration, against any unlawful act committed by third parties, In particular any subsequent use of the trade name by a third party whether as a trade name of a mark or collective mark, or any such use of a similar trade name of a mark, likely to mislead the public, shall be deemed unlawful.

11. Opposer will be damage by the registration of the mark "VITAMILK" in The name of Respondent-applicant, considering the fact that Opposer's mark "VITA", "VITASOY" and their variants have long been established and has obtained goodwill and consumers recognition in the Philippines and worldwide.

12. the Respondent-applicant application to register the "VITAMILK" mark is in unfair competition with an infringement of Opposer's well-known marks "VITA", "VITASOY" and their variants as the use of the mark on the goods described in its application clearly violets the exclusive right of the Opposer to said marks.

13. The registration of the mark "VITAMILK" in the name of the Respondent-applicant will violet the proprietary right/interest, business reputation and goodwill of the Opposer over its own marks "VITA" "VITASOY" and their variants, considering that the distinctiveness of said mark will be diluted, thereby, causing irreparable injury to the Opposer.

14. It is also apparent that the registration of the mark "VITASOY" in the name of Respondent-applicant which mark is confusingly, similar to Opposer's well-known mark "VITA" "VITASOY" and their variants will not only, prejudice the Opposer but will allow the Respondent-applicant to unfairly, benefit from and get a free ride on the goodwill of Opposer's well-known marks.

For failure of the respondent-applicant to file its Answer within the time granted For it to file Answer, the case was submitted for decision.

The Opposer submitted the following evidence in support of the its opposition

EXHIBIT	DESCRIPTION
"A"	Special Power of attorney
"B"	Certified true copy of certificate of Registration No. 06152 of the mark "VITA" (Chinese Characters)
"C"	Certified true copy of Certificate of Registration No.42002001769 of the mark "VITASOY"
"D"	Certified of Registration 10934-M for the Mark "VITA" issued in Portugal in 1998 (Class 32)
"E"	Certificate of Registration of the mark "VITA" Issued in Italy in 1998 (Class 29, 30 and 32)
"F"	Certificate of Registration No. 27539 of the Mark "VITA" in Portugal in 1993 (Class 29)
"G"	Certificate of Registration No. 174391
"H"	Certificate of Registration No. 138,068 of the Mark "VITA" in Hungary in 1996 (Class 29,32)
"I"	Certificate of Registration No.1938,071 of the Mark "VITASOY" in 1996 (Class 29)
"K"	Certificate of Registration No. 10930M of the Mark "VITASOY" in 1997 (Class 32)
"L"	Certificate of Registration No. 275393 of the Mark "VITASOY" in Portugal in 1993 (Class 29)
"M"	Certificate of Registration No. 275394 of the Mark "VITASOY" in Portugal in 1993 (Class 32)
"N"	Certificate of Registration No.172847 of the Mark "VITASOY" in Slovak Republic in 1994
"O"	Affidavit-direct testimony of AH HING TONG
"P"	Print-outs form Vitasoy website

“Q” Print-outs of this pages websites

“R” Affidavit of Brenda Rivera

The issue in this case is whether “VITASOY” is a well-known mark and whether “VITASOY” is confusingly similar to the respondent-applicant’s mark, “VITASOY”, its marks.

In this regard, Republic Act 8293 provides:

“SEC. 123. *Registrability*

123.1 A mark cannot be registered if it: xxx

“(e) Is identical with or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

“(f) Is identical with, or confusingly similar to, or constitutes a translation or a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided; the use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registration mark: provide further, that the interest of the owner of the registered mark are likely to be damage by such use.

Further, Rule 102 of the Rules and Regulations on trademarks set the following Criteria or any combination to be taken in account in determining well-knownness:

- a. The duration, extent and geographical area of 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 exhibition, of the goods and/or services to which the mark applies;
- b. The market share in the Philippines and in other countries of the goods and/or services to which the mark applies;
- c. The degree of the inherent or required distinction of the mark
- d. the quality image of reputation of the acquired mark;
- e. The extent to which the mark has been used in the world;
- f. The exclusivity of the use attained by the mark in the world;
- g. The commercial value attributed to the mark in the world;
- h. The record of successful protection of the rights in the world;
- i. The outcome of litigations dealing with the issue of whether the mark is well-known mark and

- j. The presence or absence of identical or similar goods or services owned by persons other than the person claiming that his marks a well-known mark.

Opposer's also cites as basis it s relief, the protective mantle of article is of The Paris Convention for the Protection of Industrial Property, which provides;

ARTICLE 6 bis

" (1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well-known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any well-known mark or an imitation liable to create confusion therewith xxx"

The Bureau cannot accede to opposer's supposition that its mark is well-known under the law, to be considered well-known a mark must not only be well-known internationally but also in the Philippines apart from securing registration for the mark "VITASOY" (Exhibit "C") and the mark "VITA" (Exhibit "B") which we note is in Chinese characters. Its witness testified that it sold its products in the Philippines through a distributors, Fly, Ace Corporation. (Annex "B" of Exhibit "O") the advertising and promotional activities were evidenced by photographs and print advertising and Connection with sample tasting, sponsorships, participation in trade fairs etc. as testified by its witness, Brenda Rivera, the products bearing "VITASOY are sold in supermarkets as evidenced by photographs of its products displayed on shelves. (Exhibits "R") Abroad the mark "VITASOY" was registered in only five countries, Macao, Italy, Hungary, Portugal and Slovak Republic. These evidence is insufficient to sustain a finding that the mark is well-known by our standards simply because goods are traded and registration are obtained for a mark does not merit an automatic finding that it is well-known. Distinction, immense reputation and goodwill must be shown through a relatively exclusive use of such mark.

Now turning to the contending marks to determine whether or not confusingly similarity exists between the two marks. It must be emphasized that in infringement or trademark cases in the Philippines particularly in ascertaining whether one trademark is confusingly similar to or is colorable imitation of another no set rules can be deduced. Each case must be decided on its own merits. In *Esso Standard, Inc. v. Court of Appeals*, 116 SCRA 336, the Supreme Court ruled that the likelihood of confusion is a relative concept, to be determined only according to the particular and something peculiar, circumstances of a each case.

In cases involving infringement of trademark, it has been consistently held that that there is infringement of trademark when the use of mark involved would be likely to cause confusion or mistake in the mind of the public or to deceive purchasers as to the origin or source of the commodity that whether or not a trademark causes confusion and is likely to deceive the public is question of fact which is to be resolved by applying the "test of dominancy" meaning if the competing trademark contains the main or essential or dominant features of another by Reason of which confusion and deception are likely to result then infringement takes place that duplication or imitation is not necessary a similarity on the dominant features of the trademarks would be sufficient. (*Phil Nut Industry, Inc. vs. Standards Brands, Inc. and Tiburcio Evalle, G.R. No. L-23035, July 31, 1975*)

In McDonald's Corporation vs. L.C. Big Mak Burger, Inc, G.R. No. 143993, dated 18 August 2004, the Supreme Court further enunciated that:

"To establish trademark infringement the following elements must be shown 1) the validity of the plaintiff's mark 2) the plaintiff's ownership of the mark and 3) the use of the mark or its colorable imitation by the alleged infringer results in the "likelihood of confusion" of these it is the element of likelihood of confusing that is the gravamen of the trademark infringement xxx

In determining likelihood of confusion jurisprudence has developed two tests the dominance test and the holistic test. The dominance test focuses on the similarity of the prevalent features of the competing trademarks that might cause confusion. In contrast, the Holistic test requires the court to consider the entirety of the marks as applied to the products including the labels and packaging is determining confusing similarity xxx

The test of dominance is now explicitly incorporated into Law in Section 155.1 of the Intellectual Property Code, which defines infringement as colorable imitation of a registered mark xxx or a dominant feature thereof."

Respondent's VITAMILK is confusingly similar to opposer's VITASOY. The Dominant features in opposer's trademark itself, the prefix "VITA" in opposer's trademark, is identical literal elements of the respondent's mark "VITAMILK". Concededly, the suffixes of both marks are dissimilar words one is "soy" and the other is "milk". Likelihood of confusion, however, cannot be avoided by adding the word milk in respondent's trademark. Oft repeated is the true that the confusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term. (In Continental Connector Corporation vs. Continental Specialties Corporation, 207 USPQ 60) Moreover, there are indeed some variations or additional features mark which are absent or distinct from respondent's mark as the registered "VITASOY" mark appears with other slogans in the packaging (Annex A-5 of Exhibit "R"). The container where the mark appears is a range of yellow. The mark is in written in red letters with white borders in a distinct font in a circular slant. This is encases in a yellow green odd rectangular shape. Annex A-5 are photographs of the VITASOY mark appearing in the carton packages in block style and it's written in blue and red. The letter "O" in the word VITASOY is designed in a way that it contains a pictorial representation of five arranges leaves. Nonetheless the competing marks creates an impression that they are similar to each other considering that the goods to which the parties use their marks belong to the same class. i.e., Class 32 and related to each other, hence the likelihood of confusion of goods in likely to occur. It must be noted that the products bearing the competing trademark are considered common household items bought off the shelf in supermarkets and convenient stores by an ordinary sometimes unsuspecting Purchasers. At times when such ordinary purchaser is unsuspectingly impetuous in buying, he would not have the time nor the inclination to make a keen and meticulous examination of the physical discrepancies in the trademarks of the products. Instead, he will just ignore them and believe that respondent's VITAMILK is just the same as Opposer's product. As stated in Co Tiong SA vs. Director of Patents (95 Phil 1) when a person sees an object, a central or dominant idea or picture thereof is formed in his mind. This dominant picture or idea is retained in the mind, and the decorations or details are forgotten, x x x He retains in his mind the dominant characteristics or features or central idea in the label, and does not retain or forgets the attendant decorations, flourishes, or variations. The ordinary customer does not scrutinize the details of the label; he forgets or overlooks these but retains a general impression, or a central figure, or a dominant characteristic.

The marks are reproduced hereunder for reference.



Opposer's mark appearing on label
(Annex "A" S of Exhibit "R")

Opposer's "VITASOY" mark
(Exhibit "C")

Respondent-applicant's mark

Opposer's "VITA" mark
(Exhibit "B")

Opposer's further argues that the mark "VITAMILK" is misdescriptive and misleading because "milk" refers to cow's milk and soy-bean based beverages must be particularly referred to as "soymilk" not simply "milk" Opposer's reasoning is proper. This Bureau agrees to opposer's statement that commonly understand the plain word "milk" to refer to cow's milk. Admittedly the word "milk" is also used to describe the beverage obtaining from soy, however, said description is particularly referred to as *Soy milk or soybean milk* and not plainly milk, (See *Webster's Third New International Dictionary of the English language, Merriam, Webster, Inc. Publishers, Massachusetts, U.S.A. 1986*); Thus the use of the plain word milk as a mark for soya bean based products without distinguishing the same as soymilk is misdescriptive of the product and is likely to mislead the consumers into believing that respondent's products are made of cow's milk. The registration of a misdescriptive mark is therefore proscribed by law, specifically Section 123.1 (g) of R.A. 8293 which provides that milk cannot be registered if it is likely to mislead the public particularly as to the nature quality and characteristics of the goods.

WHEREFORE premises considered the NOTICE OF OPPOSITION filed by Vitasoy International Holdings Limited is hereby SUSTAINED. Accordingly, Application Serial No. 4-2005-001063 filed by Respondent-Applicant, Green Spot (Thailand) Limited on 3 February 2005 for the mark "VITASOY" used on soya-bean based non-carbonated non-alcoholic beverage 'under class 32, is as it is hereby REJECTED.

Let the filewrapper of "VITAMILK" subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademark (BOT) for appropriate action.

SO ORDERED

Makati City, 10 August 2007

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

