



KRAFT FOODS GLOBAL
BRANDS LLC,
Opposer,

- versus -

BENEVELLE CORPORATION
Respondent-Applicant.

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IPC No. 14-2009-00263
Opposition to:
Appln. Serial No. 4-2008-014570
Date Filed: 02 Dec. 2008
TM: "BENEVITA AND DEVICE"

Decision No. 2012- 50

DECISION

Kraft Foods Global Brands LLC. ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2008-014570. The application, filed by Benevelle Corporation ("Respondent-Applicant")², covers the mark "BENEVITA AND DEVICE" for use on "cocosugar, coco nectar" under Class 30 of the International Classification of Goods³.

The Opposer alleges, among other things, that the registration of BENEVITA AND DEVICE is proscribed by Sec. 123.1 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), because it is confusingly similar to its mark "BELVITA" which is protected by trademark registrations it secured in 2006 and 2007 and used on similar or related goods. According to the Opposer, the public may likely associate the Respondent-Applicant's products as related to, sponsored by, or originating from the Opposer. Also, the use of BENEVITA AND DEVICE diminishes the distinctiveness, dilutes the goodwill of the mark BELVITA, and hinders the natural expansion of the Opposer's business and the use of its mark for goods in Class 30. The Opposer also points out that BELVITA is known in numerous countries to be owned by it and is registered in countries worldwide.

The Opposer's evidence consists of the following:

1. Exh. "A": Affidavit of the Opposer's Chief Trademark Counsel Susan H. Frohling executed on 18 October 2009;
2. Exhs. "B" and "C": certificates of registration of the BELVITA word mark in the Philippines;

¹ A corporation duly organized under the laws of the United States of America, with principal office at Three Lakes Drive, Northfield, Illinois, 0093, U.S.A.

² A corporation organized and existing under the laws of the Philippines with principal place of business at #84-F Kitanlad Street, Quezon City, Philippines.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a multilateral treaty administered by the World Intellectual Property Organization (WIPO), called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

3. Exh. "D": authenticated certificate, issued 24 Sept. 2009, of trademark registration of BELVITA in Singapore (No. T05011741) for a period of ten years from 03 Feb. 2005;
4. Exh. "D-1": authenticated certificate, issued 24 Sept. 2009, of the registration of BELVITA in Singapore (No. T0501173J) for a period of ten years from 03 Feb. 2005;
5. Exh. "D-2" - copy of the entry of the trademark BELVITA in the United Kingdom register of trademarks;
6. Exh. "D-3" - authenticated certificates of trademark registration of BELVITA in Colombia, Hong Kong, Panama Mexico, and Australia;
7. Exh. "E" - copy of the document "*Report 8-TM File- Listing by Reg. Owner with Goods*" showing registrations or applications for the registration of the mark BELVITA in many countries;
8. Exhs. "F" to "F-35" and "G" to "G-2" - different BELVITA trademark designs for different products in different countries;
9. Exh. "H" and "H-1" - Declaration of Actual Use of BELVITA trademark executed on 13 Dec. 2007 and certification of the filing thereof in the Bureau of Trademarks on 03 Jan. 2008.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 14 January 2010. The Respondent-Applicant filed a request for extension to file answer which was granted via Order No. 2010-265, dated 17 February 2010, giving the said party until 15 March 2010 within which to file the answer. The Respondent-Applicant, however, failed to file the Answer within the period. Instead, it filed on 29 April 2010 a "motion for reconsideration" of Order No. 2010-265, and subsequently, its "Answer" through "Compliance and Manifestation on 11 May 2010. The motion was denied by the Hearing Officer in an Order dated 10 March 2011.

But even if the Answer was filed on time, this Bureau finds merit in the Opposition.

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 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 product.⁴ Thus, Sec. 123.1(d) of the IP Code provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services of if it nearly resembles such mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its trademark application on 02 December 2008, the Opposer has existing registrations for the mark "BELVITA" under Reg. No. 4-2004-011844 for use on "*nutrition food*

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

supplements, including energy bars, low-carb bars and diet bars" under Class 05, "cheese, dairy based products, nut bars, protein bars, fruit bars and yogurt bars" under Class 29, "coffee, tea, cookies, cookie bars, crackers, chocolate, confectionery and snack bars, including cereal bars, breakfast bars, granola bars and candy bars" under Class 30, and "juices and water" under Class 32; and Reg. No. 4-2005-001107 for "meat, fish, poultry, and game; meat extracts, preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, edible oil and fats" under Class 29, and "coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice" under Class 30. Comparing the parties' respective goods, this Bureau finds the Respondent-Applicant's "cocosugar" similar to the Opposer's "sugar", and along with "coconectar", closely related to the other goods, e.g. "honey", "jams", "confectionery", "candies", etc.

The resemblance therefore between the competing marks, as shown below:



Respondent-Applicant's mark

BELVITA

Opposer's mark

will likely cause confusion or even deception. The competing marks both start with the syllable "BE" and ends with "VITA", features which immediately draw the eyes and ears. The prominence of these features renders inconsequential the differences between the competing marks. In this regard, confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists 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 other⁵. The conclusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term⁶.

The replacement of the letter "L" in the Opposer's mark with the letters "N" and "E" failed to give the Respondent-Applicant's mark a character that is sufficiently and clearly distinct from the Opposer's. BELVITA is a unique mark, in the category of a fanciful mark, such that it is highly improbable for another person to come up with an identical or nearly identical mark for use on the same or related goods purely by coincidence. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the answered riddle is why, of the millions of terms and combination of letters and available, the Respondent-Applicant had come up with a mark identical or so clearly similar to

⁵ *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 April 2001, 356 SCRA 207, 217.

⁶ *Continental Connector Corp., vs. Continental Specialties Corp.* 207 USPQ 60.

another's mark if there was no intent to take advantage of the goodwill generated by the other mark⁷.

Hence, considering that the competing marks are used on similar or closely related goods, confusion, mistake, or even deception, as to the goods or products or with respect to the origin or manufacturers thereof are likely. Consumers may even assume that one mark is just a variation of the other or that the Respondent-Applicant's goods originate from or sponsored by the Opposer or believe that there is a connection between them, as in a trademark licensing agreement. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:⁸


Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

It is stressed that the laws on Trademarks and Tradenames is based on the principle of business integrity and common justice. This law, both in letter and spirit is laid upon the premise that, while it encourages fair trade in every way and aims to foster, and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing others business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another.⁹

WHEREFORE, premises considered, the instant opposition is hereby SUSTAINED. Let the filer wrapper of Trademark Application Serial No. 4-2008-014570 be returned, together with a copy of this Decision, to the Bureau of Trademarks, for information and appropriate action.

SO ORDERED.

Taguig City, 12 March 2012.


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

⁷ *American Wire and Cable Co. v. Director of Patents et. al* (SCRA 544), G.R. No. L-26557, 18 Feb. 1970.

⁸ See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al*, G.R. No. L-27906, 08 Jan. 1987.

⁹ See *Baltimore Bedding Corp. v. Moses*, 182 and 229, 34A (2d) 338.