



## OFFICE OF THE DIRECTOR GENERAL

**SOCIETE DES PRODUCTS NESTLE, S.A.,**  
*Appellant,*

**Appeal No. 14-2010-0017**  
**IPC No. 3980**

**-versus-**

**VITASOY INTERNATIONAL HOLDINGS**  
**LIMITED.,**

**Petition for Cancellation:**  
**Registration No. 31168**  
**Date Issued: October 01, 1982**

*Appellee.*

**Trademark: "VITA"**

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## DECISION

**SOCIETE DES PRODUCTS NESTLE, S.A.** ("Appellant"), appeals Decision No. 2008-150, dated 12 August 2008, and the corresponding Resolution No. 2012-02 (D), dated 08 February 2012, issued by the Director of the Bureau of Legal Affairs ("Director"), which granted the Petition for Cancellation filed by **VITASOY INTERNATIONAL HOLDINGS, LIMITED** ("Appellee") against the Appellant's Certificate of Registration No. 31168.

Records show that the Appellant was issued on 01 October 1982, Certificate of Registration No. 31168 for the mark "VITA" for use on goods under Classes 29 and 32, specifically for *vegetable based meat extenders, and soy based food products, specifically beverage soya drinks.*

Petition for Cancellation, thereby constituting abandonment, and meriting the cancellation of such registration.

In its Answer dated 22 June 1994, the Appellant countered that the Appellee has no standing to sue nor cause of action against the Appellant, as the Appellee has neither registered nor actually used in commerce the subject mark in the Philippines. Appellant further claims that it first used its trademark "VITA" in the Philippines on 25 October 1979, and was issued Certificate of Registration No. 31168 as early as 01 October 1982 under Republic Act No. 166, as amended, and pursuant to the Rules of Practice in Trademark Cases. The Appellant also argues that the Appellee's failure to immediately challenge the Appellant's use of the "VITA" mark in commerce on 25 October 1979 constitutes laches for which the Appellee can no longer claim relief.

After the appropriate proceedings, the Director rendered the subject Decision and Resolution, granting the Appellee's Petition for Cancellation. Ruling that the Appellant's trademark registration should be cancelled and stricken off from the registry of the Bureau of Trademarks, the Director noted the Appellant's failure to show that it has actually used the mark "VITA" in the Philippines. The Director cited the requirement of actual use in commerce in the Philippines, which is an essential pre-requisite for the acquisition of ownership over a trademark under Sections 2 and 2-A of Republic Act No. 166, the law in effect when the subject mark was applied for registration by the Appellant. According to the Director, based on the evidence adduced by the Appellee which substantially rebutted the evidence submitted by the Appellant to prove its prior use of the subject mark, there was a clear showing that the Appellant's products were not sold in supermarkets and establishments identified in its Affidavit of Use. In fact, the Appellant has not submitted a single receipt, sales invoice, bill of lading, or any document of a similar import that would establish sale of its products purportedly bearing the

products itself being sold in the Philippines during the hearings of the case, but it did not.

On the issue of the Appellee's standing to file the present cancellation case, Section 17 of the Old Trademark Law, as cited above, states that any person who believes that he is or will be damaged by the registration of mark or trade-name may apply to cancel the said registration. Under Section 20 of the Old Trademark Law, when the Appellant was issued a Certificate of Registration for its "VITA", it obtained the exclusive right to use the same in connection with the goods, business or services in such certificate. Section 20 states that:

#### CHAPTER V - Rights and Remedies

**Section 20. Certificate of registration prima facie evidence of validity.** - A certificate of registration of a mark or trade-name shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark or trade-name, and of the registrant's exclusive right to use the same in connection with the goods, business or services specified in the certificate, subject to any conditions and limitations stated therein.

In this case, the Appellee alleged that it is the exclusive owner and prior adopter of the "VITA" trademark and its variations, having allegedly used the same prior to the Appellant. Therefore, with the subsistence of the Appellant's registration for "VITA", the Appellee would have been likely to suffer damage as it would have not been able to use the same mark in connection with its goods, business or services. Thus, the Appellee had standing to file the present cancellation case.

Proceeding to the main issue of the present appeal, the question to be resolved is whether the Director was correct in granting the Petition for



Correspondingly, Section 12 of the Old Trademark Law likewise states that:

**Section 12. Duration.** - Each certificate of registration shall remain in force for twenty years: Provided, That registrations under the provisions of this Act shall be cancelled by the Director, unless within one year following the fifth, tenth and fifteenth anniversaries of the date of issue of the certificate of registration, the registrant shall file in the Patent Office an affidavit showing that the mark or trade-name is still in use or showing that its non-use is due to special circumstances which excuse such non-use and is not due to any intention to abandon the same, and pay the required fee.

The Director shall notify the registrant who files the above-prescribed affidavits of his acceptance or refusal thereof and, if a refusal, the reasons therefor.

In this regard, there is no dispute that the Appellant has a registration for the trademark "VITA", however, as correctly pointed out by the Appellee, an abandoned mark may be subject to cancellation proceedings. Rule 192 (b) of the Rules of Practice in Trademark Cases, which was applicable in this case, provides that:

x x x if a mark of tradename has not been substantially used for five (5) years next preceding the filing of the petition for cancellation, it shall be presumed to have been abandoned.

Applying the foregoing to the present case, this Office notes that the Appellant failed to produce evidence to show its exclusive and continuous adoption and use of the trademark "VITA". In fact, as correctly held by the

With the foregoing pronouncements, this Office finds no cogent reason to disturb the Decision and Resolution of the Director, as the same are fully supported by the evidence on record in the present case.

**WHEREFORE**, premises considered, the appeal is hereby DISMISSED. Let a copy of this Decision and the records of this case be furnished and returned to the Director of the Bureau of Legal Affairs for appropriate action. Further, let also the Director of the Bureau of Trademarks and the library of the Documentation, Information and Technology Transfer Bureau be furnished a copy of this Decision for information, guidance, and records purposes.

SO ORDERED.

**SEP 02 2013** Taguig City.

  
**RICARDO R. BLANCAFLOR**  
Director General 