



ALLERGAN, INC.,
Opposer,

-versus-

HERBANEXT, INC.,
Respondent- Applicant.

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IPC No. 14-2012-00014
Opposition to:
Appln. Serial No. 4-2011-008404
Date Filed: 19 July 2011
TM: "OPTIVIM"

NOTICE OF DECISION

TAW & ASSOCIATES
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HERBANEXT, INC.,
Respondent-Applicant
D.C. Cruz Building, Magsaysay Avenue
Singcang, Bacolod City

GREETINGS:

Please be informed that Decision No. 2013 - 1162 dated August 06, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 06, 2013.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



ALLERGAN, INC.,
Opposer,

IPC No. 14-2012-00014
Case Filed: 12 March 2012

-versus-

Opposition to:
Appln. Serial No.: 4-2011-008404
Date Filed: 19 July 2011

HERBANEXT, INC.,
Respondent-Applicant.

TM: "OPTIVIM"

x-----x

Decision No. 2013- 160

DECISION

ALLERGAN, INC. ("Opposer")¹ filed on 12 March 2012 an opposition to Trademark Application Serial No. 4-2011-008404. The application, filed by HERBANEXT, INC. ("Respondent-Applicant")², covers the mark "OPTIVIM" for use on herbal supplement under Class 5 of the International Classification of Goods and Services³.

The Opposer alleges among other things the following:

1. The Opposer will be damaged by the registration of the mark OPTIVIM and respectfully submits that the Application should be denied for the reasons set forth below.
2. The Opposer is the registered owner of the OPTIVE trademark in the Philippines, and is therefore entitled to the exclusive use of the mark. Section 138 of the IP Code states:

"Section 138. *Certificate of Registration.* – A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate."

¹ A corporation duly existing and registered under the laws of U.S.A. with address at 2525 Dupont Drive, Irvine, California 92612, U.S.A.

² A company incorporated under the laws of the Philippines with address at D.C. Cruz Bldg., Magsaysay Avenue, Singang, Bacolod City.

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

3. The registration of the Application violates Sections 123.1 (d), (e) and (f) of the IP Code which expressly prohibit the registration of a mark if it is:
 - 7.1. Identical to a registered mark belonging to a different proprietor or a 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. [Section 123.1 (d) of the IP Code].

In support of its opposition, Opposer submitted in evidence the following:

1. Annex "A" – Power of Attorney;
2. Annex "B" – Affidavit of Opposer's authorized representative Claire B. Corral;
3. Annex "C" – Website printout of a write-up ;
4. Annex "D" – Opposer's overview and fast facts printout;
5. Annex "E" – Images of Optive eye drops and artificial tears;
6. Annex "F" – Website printout showing the different variants of Optive products;
7. Annexes "G" and "H" – Website printout showing various consumer and medical opinions as well as journals;
8. Annex "I" – Website printout showing the study of Optive products;
9. Annexes "J", "K" and "L" – Pictures showing promotional materials to promote Optive;
10. Annex "M" – List of Opposer's worldwide registrations for the mark Optive;
11. Annexes "N" and "U" – Website printout of the worldwide registrations for the mark Optive; and
12. Annex "V" – Copy of Certificate of Registration No. 4-2009-003892 for the mark OPTIVE.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 25 April 2012. However, the Respondent-Applicant did not file the required verified answer, hence Order No. 2012-1588 dated 10 December 2012 was issued declaring Respondent-Applicant in default and the instant opposition is deemed submitted for Decision based on the opposition and evidence submitted by the Opposer.

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

It is emphasized that the essence of trademark registration is to give protection to the owner of the trademarks. 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 products.⁴

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999

Thus, Section 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, or if it is nearly resembles such a mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application on 19 July 2011, the Opposer has already an existing Trademark Reg. No. 4-2009-003892 issued on 12 November 2009 for the mark OPTIVE for eye drops under Class 5 of the International Classification of Goods and Services⁵. Further, Opposer holds fifty-four (54) registrations for the mark OPTIVE worldwide⁶.

Jurisprudence says that a practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of the prospective buyer. The trademark complained should be compared and contrasted with the purchaser's memory of the trademark said to be infringed. Some factors such as sound; appearance; form, style, shape, size or format; color, idea connoted by the mark; the meaning, spelling and pronunciation of the words used; and the setting in which the words used; may be considered for indeed, trademark infringement is a form of unfair competition.⁷

In this regard, the question is: are the competing marks, depicted below, resemble each other such that confusion or mistake, or even deception, is likely to occur?

OPTIVE

OPTIVIM

Opposer's Mark

Respondent-Applicant's Mark

Both marks start with the prefix "OPTI". As word marks, the prefix, which connotes such terms as "optical" or "optimum", is the part that catches the eyes and the ears. While it may be fairly inferred that "OPTI" is used in this sense to suggest "optical" in respect of the Opposer and "optimum" as to the Respondent-Applicant's the letters appended to the prefix still render the competing marks imbued with distinctive property. However, in both marks, the prefix "OPTI" is immediately followed by the letter "V" and this is where the likelihood of confusion arises.

This Bureau notices that the Respondent-Applicant's trademark application covers "herbal supplements". The term "herbal supplement", however, is a broad concept. Herbal supplements are non-pharmaceutical,⁸ non-food substances marketed to improve health. Herbalism (herbal medicine, botanical medicine) is the use of plant-derived substances, and sometimes other environmental substances, to treat or cure medical conditions. Without qualifying or specifying in the trademark application the type or "herbal supplement", it follows therefore that the Respondent-Applicant could use its mark on various types of herbal supplements, even one that could claim to deal with eye-related diseases or medical conditions.

⁵ Annex "C".

⁶ Please refer to Annex "M" of the Ms. Claire Corral Affidavit.

⁷ Clarke v. Manila Candy Co. 36 Phil. 100, 106; Co Tiong SA v. Director of Patents 95 Phil. 1, 4.

⁸ [Http://rationalwiki.org/wiki/Herbal_supplement](http://rationalwiki.org/wiki/Herbal_supplement).

Succinctly, this Bureau finds that the close resemblance between the marks could result in the likelihood of confusion, or even deception.

Consumers will likely assume that the Respondent-Applicant's mark is just a variation of the Opposer's and/or the goods and services originate or provided by one party alone, or the parties are connected or associated with one another which in fact there is none. The likelihood of confusion would subsist not only on the purchaser's perception of the goods but on the origin thereof as held by the Supreme Court⁹.

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 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.

The determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake, it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it¹⁰.


Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

It is stressed that the Respondent-Applicant was given the opportunity to explain its side and defend its trademark application. However, it failed and/or chose not to do so.

WHEREFORE, premises considered that the instant opposition is hereby **SUSTAINED**. Let the filer wrapper of Trademark Application Serial No. 4-2011-008404 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 06 August 2013.


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

⁹ Converse Rubber Corp. v. Universal Rubber Products, Inc. et.al. G.R. No. L-27906, 08 Jan. 1987.

¹⁰ See American and Cable Co. v. Director of Patents et.al. (SCRA 544) G.R. No. L-26557, 08 Jan. 1987.