BIOFEMME, INC., Opposer, **-versus-** **AMBROSIO V. PADILLA III,** Respondent-Applicant.	}	**IPC No. 14-2012-00020** Opposition to: Appln. Serial No. 4-2011-010867 Date Filed: 12 September 2011 **TM: "OBIVIT"**

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NOTICE OF DECISION

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ATTY. AMBROSIO V. PADILLA III
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Unit 1001, 88 Corporate Center
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GREETINGS:

Please be informed that Decision No. 2013 - 198 dated October 14, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 14, 2013.

For the Director:

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

BIOFEMME, INC.,
Opposer,

-versus-

AMBROSIO V. PADILLA, III
Respondent-Applicant.
x----------x

IPC No. 14-2012-00020

Opposition to:
Appln. Serial No. 4-2011-010867
Date Filed: 12 September 2011

TM: "OBIVIT"

Decision No. 2013- 198

DECISION

BIOFEMME, INC. ("Opposer")[1] filed on 19 January 2012 an opposition to Trademark Application Serial No. 4-2011-010867. The application, filed by AMBROSIO V. PADILLA, III ("Respondent-Applicant")[2], covers the mark "OBIVIT" for use on "*pharmaceutical product – comprehensive vitamin – mineral support during pregnancy*" under Class 5 of the International Classification of Goods and Services[3]. The Opposer alleges, among other things the following:

1. The mark OBIVIT owned by Respondent-Applicant so resembles the trademark "OBIMIN" owned by Opposer and duly registered with this Honorable Bureau prior to the publication for opposition of the mark "OBIVIT".

2. The mark OBIVIT will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark OBIVIT is applied for the same class and goods as that of Opposer's trademark OBIMIN, *i.e.* of the International Classification of Goods as pharmaceutical product – vitamins during pregnancy.

3. The registration of the mark OBIVIT in the name of the Respondent-Applicant will violate Sec. 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code").

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

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1 A domestic corporation duly organized and existing under the laws of the Philippines, with office address at 2nd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines.
2 With office address at Unit 1001, 88 Corporate Center, Sedeño corner Valero Street, Salcedo Village, Makati 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.

1. Exhibit "A" – copy of the page of the "TM E-Gazette" containing the list of trademarks published for opposition ("Release Date: 12/13/2011") including Trademark Application Serial No. 4-2011-010867 ;
2. Exhibit "B" – certified true copy of the Certificate of Reg. No. 4-2008-002781 for the mark OBIMIN;
3. Exhibit "C" – certified true copy of the Declaration of Actual Use for the trademark OBIMIN;
4. Exhibit "D" – sample product label bearing the trademark OBIMIN actually used in commerce; and
5. Exhibit "E" – certified true copy of the Certificate of Product Registration issued by the Food and Drug Administration for OBIMIN.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 29 October 2012. The Respondent-Applicant, however, did not file an answer. Accordingly, the Hearing Officer issued on 31 January 2013 Order No. 2013-187 declaring the Respondent-Applicant in default.

Should the Respondent-Applicant 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]. 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, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

In this regard, records show that at the time the Respondent-Applicant filed his trademark application on 12 September 2011, the Opposer has an existing trademark registration for the mark OBIMIN (No. 4-2008-002781) issued on 01 September 2008. The registration covers "*multivitamins and minerals for pre-natal care*" under Class 5, and which are similar to the goods indicated in the Respondent-Applicant's trademark application.

But, are the competing marks, as depicted below, resemble each other such that confusion, even deception, is likely to occur?

OBIMIN	Obivit
Opposer's Mark	Respondent-Applicant's Mark

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

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 contracted with purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some factors such as sound; color; idea connoted by the mark; the meaning; spelling and pronunciation of the words used; and the setting in which the words appear may be considered for indeed, trademark infringement is a form of unfair competition[5].

The mark OBIMIN is an invented word. It is not derived from the generic name of the pharmaceutical products to which the mark is attached. While it may be inferred that OBIMIN is inspired by the words "*obstetrics*"[6] and "vitamins", the mark's configuration is creative, fanciful, if not totally unique.

Now, the Respondent-Applicant did not only decide to deal with pharmaceutical products that are similar to those covered by the mark OBIMIN, he also chose to adopt a mark that also starts with "OBI". That the mark applied for registration by the Respondent-Applicant ends with the letters/syllables "VIT" is of no moment. Because of its preeminent position, and the outward-curves or bulges of the letters "O" and "B", "OBI" is the part that immediately draws the eyes. When one utters the mark, the sound produced from "OBI" easily rings to the ears.

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 other[7]. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article[8].

Moreover, like the letters/syllable "MIN" in the Opposer's mark, it is also reasonable to infer that "VIT" also came from the word "vitamins". Thus, there is the likelihood that a consumer encountering the parties' pharmaceutical products bearing the marks OBIMIN and OBIVIT, would assume that these goods originate from the same source, or the manufacturers are connected or associated with one another. The likelihood of confusion subsists not only on the public's perception of goods on the origin thereof. There is therefore the likelihood that information, assessment, perception or impression about Respondent-Applicant's products may be unfairly cast upon or attributed to the Opposer, and *vice-versa*.

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5 Clarke v. Manila Candy Co. Phil. 100, Tiong S.A. v. Director of Patents, 95 Phil. 1, 4.

6 The branch of medicine that deals with the care of women during pregnancy, childbirth, and the recuperative period following delivery. (Source/reference http://www.thefreedictionary.com/obstetrics citing The American Heritage® Dictionary of the English Language, Fourth Edition copyright ©2000 by Houghton Mifflin Company, updated in 2009).

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

8 Emerald Garment Manufacturing Corp. v. Court of Appeals. G.R. No. 100098, 29 Dec. 1995.

It is stressed that 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 for registration, 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 it.[9] 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:[10]

> 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.

WHEREFORE, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-010867 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 14 October 2013.

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

9 American Wire and Cable Co. v. Director of Patents et al., (31 SCRA 544) G.R. No. L-26557, 18 Feb. 1970.
10 Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 Jan. 1987.