



NATURAL ORGANICS, INC.,
Opposer,

-versus-

NATURALLY PLUS DIRECT MARKETING
PTE, LTD.,
Respondent- Applicant.

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}
} IPC No. 14-2011-00194
} Opposition to:
} Appln. Serial No. 4-2010-501508
} Date Filed: 07 October 2010
} TM: "NATURALLY PLUS SUPER
} LUTEIN & JAPANESE
} CHARACTERS LOGO"

NOTICE OF DECISION

**ROMULO MABANTA BUENAVENTURA
SAYOC & DE LOS ANGELES**
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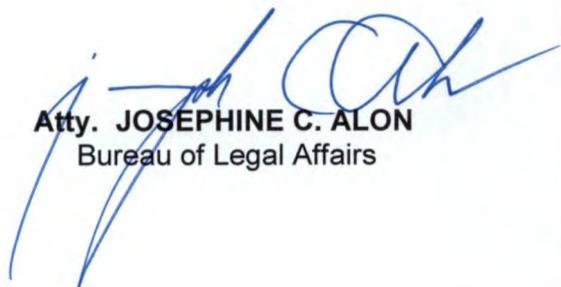
HECHANOVA BUGAY & VILCHEZ
Counsel for the Respondent-Applicant
G/F Chemphil Building
851 Antonio Arnaiz Avenue
Makati City

GREETINGS:

Please be informed that Decision No. 2014 - 169 dated June 25, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 25, 2014.

For the Director:


Atty. JOSEPHINE C. ALON
Bureau of Legal Affairs

"4. Respondent-Applicant's proposed NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS LOGO is confusingly similar to the mark NATURE'S PLUS of opposer and is intended to ride on the popularity and goodwill of the latter's mark and to deceive and/or confuse the purchasing public to believe that respondent-applicant's business and goods are the same or connected with the business and goods of oppose. Thus,

x x x

"5. The approval of the application in question will cause great and irreparable damage and injury to herein opposer. The opposer herein will rely on the following facts to support its opposition:

(a) Opposer Natural Organics, Inc., established in 1972, is a world leading manufacturer, distributor, advertiser and seller of dietary food supplements and vitamins. Its products are sold worldwide, including the Philippines.

(b) The opposer, has always been the owner of the mark NATURE'S PLUS since it was first used on dietary supplements and vitamins before the application date of the mark NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS LOGOA of respondent-applicant.

(c) The opposer has used its NATURE'S PLUS mark for its goods not only in the United States, its home country, but in most countries of the world, and the registration of the mark NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS LOGO will greatly damage and prejudice opposer in the use of its strong mark.

(d) The mark NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS LOGO are for goods in class 5, which are similar to the goods on which opposer uses its NATURE'S PLUS mark, so much so that it will confuse the public which may assume that the goods of respondent-applicant are those of or sponsored by opposer. It will also reduce or dilute the distinctiveness of opposer's strong mark.

(e) Opposer continues to use its NATURE'S PLUS mark on dietary supplements and vitamins under International Class 5.

(f) By virtue of opposer's prior and continued use, if not prior registration and application for, of the NATURE'S PLUS mark in its home country the United States and other parts of the world, this mark has become popular and goodwill has been established with the public, which identifies the opposer as the source of goods bearing the NATURE'S PLUS mark. The long use and promotion of the mark and the reputation have generated an immense goodwill for said mark in many other countries of the world, and has acquired general international consumer recognition as belonging to the one owner and source, i.e., the opposer herein, and opposer's goods have acquired the reputation of high quality products with the general public so that opposer's NATURE'S PLUS mark has become strong and distinctive and world famous.

(g) This strong and distinctive goodwill of the NATURE'S PLUS mark will now be diluted, whittled away, and diminished, if not tarnished by the mark NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS LOGO.

(h) Opposer's NATURE'S PLUS mark has been registered and applied for registration and used, in most countries of the world and, is therefore a strong mark, such that it is entitled to protection under the Intellectual Property Code, R.A. 8293 and Article 6bis of the Paris Convention for the Protection of Industrial Property.

(i) The mark NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS LOGO subject of the application of respondent-applicant is confusingly similar to opposer's NATURE'S PLUS mark and when applied to or used with the goods of respondent-applicant will likely cause confusion or mistake or deceive the public in general as to the source of respondent-applicant's goods to such an extent that the goods covered by the mark NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS LOGO will be mistaken by the unwary public to be goods offered by opposer or will cause the general public to believe that herein respondent-applicant is affiliated or connected with opposer's business.

(j) The mark NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS LOGO subject of respondent-applicant's application is a flagrant and veritable imitation of opposer's NATURE'S PLUS mark so that its use on the goods of respondent-applicant will indicate that respondent-applicant's goods are the same or connected with the goods of herein opposer falsely suggesting a connection between the opposer's and the respondent-applicant's business, therefore, defrauding the opposer of its long-established business.

(k) The mark NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS LOGO of respondent-applicant is so confusingly similar to opposer's NATURE'S PLUS mark such that it may have been adopted and used by respondent-applicant with the intention of riding on the long established goodwill of the NATURE'S PLUS mark."

The Opposer's evidence consists of the affidavit of Opposer's President James P. Gibbons; schedule providing the details of worldwide registrations and applications; copies of sampling of the worldwide registrations and applications; certified copy of Philippine Reg. No. 4-2009-007952 for NATURE'S PLUS; samples of worldwide print brochures and advertisements showing products bearing the mark NATURE'S PLUS; copies of print-out of the website www.naturesplus.com, and advertising products bearing the mark NATURE'S PLUS.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 17 June 2011. The Respondent-Applicant filed their Answer on 17 October 2011 and avers, among other things, the following:

⁴ Marked as Exhibits "A" to "F", inclusive.

x x x

"II. SPECIFIC DENIALS

"Respondent-Applicant specifically denies, for the reasons and facts stated in the Affirmative Allegations and Special and Affirmative Defenses set forth hereunder, the allegations contained in the following paragraphs:

"2.1 Paragraph 01 of the Opposition, insofar as it is alleged and made to appear that the registration of the mark NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) will violate the rights and interests of Opposer over its trademark NATURE'S PLUS and will cause great and irreparable damage and injury to the latter.

"2.2 Paragraph 02 of the Opposition, insofar as it is alleged and made to appear that Respondent-Applicant's NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) so resembles the Opposer's trademark as to likely to deceive or cause confusion and dilute the distinctiveness of Opposer's trademark.

"2.3 Paragraph 04 of the Opposition, insofar as it is alleged and made to appear that Respondent-Applicant's NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) is confusingly similar to the mark NATURE'S PLUS of Opposer and is intended to ride on the popularity and goodwill of the latter's mark and to deceive and/or confuse the purchasing public to believe that Respondent-Applicant's business and goods are the same or connected with the business and goods of Opposer.

"2.4 Paragraph 05 of the Opposer, insofar as the following are alleged:

2.4.1 That the public may assume that the goods of Respondent-Applicant are those of or sponsored by Opposer;

2.4.2 That NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) will reduce or dilute the distinctiveness of Opposer's strong mark;

2.4.3 That the alleged strong and distinctive goodwill of the NATURE'S PLUS mark will be diluted, whittled away, and diminished, if not tarnished by the mark NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO);

2.4.4 That Opposer's NATURE'S PLUS mark is a strong mark;

2.4.5 That NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) is confusingly similar to Opposer's NATURE'S PLUS mark, and when applied to or used with the goods of Respondent-Applicant will likely cause confusion or mistake or deceive the public in general as to the source of Respondent-Applicant's goods to such extent that the goods covered by the mark NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) will be mistaken by the unwary public to be goods offered by Opposer or will

cause the general public to believe that herein Respondent-Applicant is affiliated or connected with Opposer's business;

2.4.6 That NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) is a flagrant and veritable imitation of Opposer's NATURE'S PLUS mark so that its use on the goods of Respondent-Applicant will indicate that Respondent-Applicant's goods are the same or connected with the goods of herein Opposer, falsely suggesting a connection between the Opposer's and the Respondent-Applicant's business, therefore, defrauding the Opposer of its long-established business; and

2.4.7 That NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) is so confusingly similar to Opposer's NATURE'S PLUS mark such that it may have been adopted and used by Respondent-Applicant with the intention of riding on the long established goodwill of the NATURE'S PLUS mark.

"Respondent-Applicant, for lack of knowledge or information sufficient to form a belief as to the truth or falsity thereof, specifically denies the allegations in the Opposition contained in the following paragraphs:

"2.5 Paragraph 05 of the Opposition, insofar as the following are alleged:

2.5.1 That Opposer was established in 1972 and is a world leading manufacturer, distributor, advertiser, and seller of dietary food supplements and vitamins;

2.5.2 That Opposer's products are sold worldwide;

2.5.3 That Opposer has always been the owner of the mark NATURE'S PLUS;

2.5.4 That NATURE'S PLUS was first used on dietary supplements and vitamins before the application date of the mark NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO);

2.5.5 That Opposer has used the mark NATURE'S PLUS for its goods in most countries of the world;

2.5.6 That the mark NATURE'S PLUS has become popular and has established goodwill with the public, which identifies the Opposer as the source of goods bearing the NATURE'S PLUS mark;

2.5.7 That the alleged long use and promotion of the mark have generated goodwill in many countries, and has acquired international consumer recognition;

2.5.8 That Opposer's NATURE'S PLUS mark has been registered and applied for registration and used in most countries of the world; and

2.5.9 That Opposer has acquired the reputation of high quality products with the general public so that Opposer's NATURE'S PLUS mark has become strong and distinctive and world famous.

"III. SPECIAL AND AFFIRMATIVE DEFENSES

"In support of the foregoing Specific Denials, Respondent-Applicant respectfully pleads the following defenses:

x x x

"3.1 Opposer made the general allegation that Respondent-Applicant's NATURALLY PLUS LOGO 'so resembles the Opposer's trademark' so to likely to deceive or cause confusion, and yet fails to allege and specify *how* said marks are similar, what test was used to determine this so-called similarity, or where their alleged similarities lies.

"3.2 To help illustrate that Respondent-Applicant's NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) is not confusingly similar with Opposer's NATURE'S PLUS, below is a side-by-side comparison of both marks:

x x x

"3.3 Even a causal perusal of both marks, as replicated above, shows that Respondent-Applicant's mark is distinctively different from Opposer's. Indeed, they are dissimilar visually, aurally, and in meaning. Respondent-Applicant has observed the following, among others:

- a. "Opposer's mark is composed of only the words 'nature's' and 'plus', whereas Respondent-Applicant's NATURALLY PLUS SUPERL LUTEIN & JAPANESE CHARACTERS (LOGO) is a distinct combination of words, shapes and devices. In fact, Respondent-Applicant's mark is described in its application as follows:
 - i. It is composed of the terms 'super' and 'lutein' in bold upper case font in two lines;
 - ii. Above the term 'super' are the words 'naturally' and 'plus' in much smaller bold upper case font;
 - iii. Below the term lutein is a lightly shaded elongated oval device inside which are several Japanese characters;
 - iv. Below such device is the word 'supplement' in light-shaded bold upper-case font;
 - v. A small lightly shaded leaf-like device above the words 'naturally plus';
 - vi. All the aforementioned elements inside a darkly-shaded diamond-like device.
 - vii. Below the term 'lutein' is a lightly shaded 'composed of the words 'naturally' and 'plus' in two lines, all the letters in bold upper case font inside a darkly shaded diamond-like device, a small lightly shaded leaf-like device above the word 'naturally'.

x x x

- b. "In Opposer's mark, the word 'nature' is the same size as the word 'plus'. However, in Respondent-Applicant's mark, the words 'SUPER LUTEIN' are more dominant than the words 'NATURALLY PLUS', as they appear in larger size font;
- c. "While Respondent-Applicant's mark also contains the word 'plus', Opposer cannot claim exclusive ownership over the word 'plus' itself, as the word 'plus' is an ordinary word meaning 'added to' or 'extra'. Opposer's trademark consists of the word combination NATURE'S PLUS in its entirety, and is thus entitled to protection over the mark as a whole or as a combination of the words 'NATURE' and 'PLUS', and not over any one or single component of said mark. As such, Opposer cannot claim exclusive ownership over the word PLUS, and has no right to prevent Respondent-Applicant from using the same;
- d. "Opposer's NATURE'S PLUS has only two (2) words with a total of three (3) syllables, whereas the word component in Respondent-Applicant's SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) has seven (7) words;
- e. Not only is the word 'NATURE'S' spelled differently, but it also holds an entirely different meaning and connotation from the word 'NATURALLY'. According to the Merriam-Webster dictionary, the word 'NATURE', as it is used in Opposer's mark, is a noun referring to a 'controlling and creative force in the universe', or 'the external world in its entirety'. On the other hand, the word 'NATURALLY', as used in Respondent-Applicant's mark, is an adverb meaning 'according to the usual course of things' or 'without artificial aid'.

"3.4 It has been held that in determining whether two marks or trade names are confusingly similar, the test is not simply to take their words and compare their spelling and pronunciation. Rather, it is to consider the two marks or trade names in their entirety, as they appear in the respective labels in relation to the goods to which they are attached. [*Bristol Meyers Co. v. Director of Patents*, 17 SCRA 128]

"3.5 A visual presentation of the labels or hang tags is the best argument for one or the other. Competing labels must be compared. Inspection should be undertaken from the viewpoint of the prospective buyer. The mark complained of should be compared and contrasted with the purchaser's memory, not juxtaposition, of the marks said to be infringed. Some factors such as sound appearance, form, style, shape, size or format, color, ideas connoted by the mark and lettering in which the words appear may be considered.

"3.6 Replicated below, for this Honorable Office's reference, are the competing trademarks as they appear on some of the parties' respective goods:

x x x

"3.7 As seen from the above, not only is the appearance of the packaging of the respective parties' products remarkably different, but Opposer's mark NATURE'S PLUS and Respondent-Applicant's mark NATURALLY PLUS SUPER LUTEIN &

JAPANESE CHARACTERS (LOGO), as they appear on the goods' labels and/or packaging, could not be any more divergent from each other. Respondent-Applicant's NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) appears so prominently on its labels and in a manner and style so diverse from the Opposer, that it precludes any confusion or mistake in the minds of the purchasing public.

"3.8 Indeed, in the case of Philip Morris, Inc. et al vs. Fortune Tobacco Corporation (G.R. No. 158589, June 27, 2006), where the Supreme Court ruled against the likelihood of confusion arising from the respondent's use of the mark "MARK" for its cigarette product, the Court had this to say:

x x x

"3.9 Opposer's allegation that Respondent-Applicant's use of the mark NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) on its goods in Class 05 will confuse the public which may assume that the goods of respondent-applicant are those of or sponsored by Opposer' is false and misleading.

"3.10 The Supreme Court has emphasized that in ascertaining whether one trademark is confusingly similar to or is a 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, the Supreme Court ruled that the likelihood of confusion is a relative concept; to be determined only according to the particular, and sometimes peculiar, circumstances of each case. In trademark cases, even more than in any other litigation, precedent must be studied in light of the facts of the particular case. The wisdom of the likelihood of confusion test lies in its recognition that each trademark infringement case presents its own unique set of facts. Indeed, the complexities attendant to an accurate assessment of likelihood of confusion require that the entire panoply of elements constituting the relevant factual landscape be comprehensively examined. (Societe Des Produits Nestle, S.A. and Nestle Philippines, Inc. vs. Court of Appeals, G.R. No. 112012, April 4, 2001).

"3.11 In the case at bar, the goods covered by Respondent-Applicant's NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) and Opposer's NATURE'S PLUS are as follows:

x x x

Since both parties' products are for nutritional or medicinal use, or for health benefits and purposes, the buyer will, needless to say, be more wary of the nature of the product he is buying.

"3.12 In the case of American Cyanamid Company vs. The Director of Patents, where it was decided that there was no confusing or deceptive similarity between 'SULMET' and 'SULMETINE', the Supreme Court pointed out that a prospective buyer of products such as medicinal preparation for veterinary use will be more cautious and prudent enough to examine the contents of the printed matter on the label, unlike in situations where the products is for ordinary personal or household use, to wit:

x x x

"3.13 Although a consumer may be able to buy either the Opposer's or Respondent-Applicant's products without a doctor's prescription, the Supreme Court has ruled that 'when this happens, then the buyer must be one thoroughly familiar with what he intends to get, else he would not have the temerity to ask for a medicine - specifically needed to cure a given ailment. In which case, the more improbable it will be to palm off one for the other. For a person who purchases with open eyes is hardly the man to be deceived.' [Etepha v. Director of Patents, 16 SCRA 495, 501-502 [1966]]

x x x

"3.14 Contrary to Opposer's allegations, Respondent-Applicant's goods that bear the NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) mark do not move in the same trade channel as those of Opposer's that bear the NATURE'S PLUS mark.

"3.15 In resolving whether goods are related, several factors come into play, among which are the following:

- a. The conditions under which the article is usually purchased; and
- b. The channels of trade through which the goods flow, how they are distributed, marketed, displayed and sold.

"3.16 According to Opposer's exhibits, its products bearing the NATURE'S PLUS mark are sold in health food stores, from which anyone and everyone may purchase. In fact, herewith attached as Exhibit 4 with sub-markings is the Affidavit of Atty. Editha R. Hechanova, wherein she attests to having purchased a bottle of Opposer's Nature's Plus Ultra Chewable Cranberry Dietary Supplement from a 'Healthy Options' store in Makati City. As proof of the foregoing, herewith attached as Exhibit 4-A is the receipt issued for said purchase, while herewith attached as Exhibit 4-B is a photograph of the aforementioned Nature's Plus product.

"3.17 In clear contrast, only members of Naturally Plus are able to purchase Opposer's NATURALLY PLUS SUPER LUTEIN product. An interested purchaser must be sponsored by a member of the Naturally Plus program, as well as complete the membership registration. This membership-based system is put in place in accordance with Respondent-Applicant's corporate philosophy that the consumer's affection towards their products is derived from an experience-based understanding of their products and benefits.

"3.18 Respondent-Applicant's website, at <http://www.naturally-plus.com>, provides clear and detailed instructions as to how one can become a NATURALLY PLUS LOGO member, and consequently be able to purchase one of their products. Herewith attached as Exhibit 1 is an Affidavit -Direct Testimony executed by Atty. Clarisse Ann L. Barredo, wherein she identifies printouts and downloads she obtained from the aforementioned website, among others.

"3.19 New applicants are required to be introduced by an existing member of Naturally Plus. Only those above the age of 18 years old are eligible to join. On its

website, Respondent-Applicant requires an interested applicant to make sure that he/she has a thorough understanding of Respondent-Applicant's NATURALLY PLUS products and business nature. Furthermore, a new applicant is required to be introduced by an existing member to apply for membership. Only after an applicant's online registration has been processed will Respondent-Applicant proceed with its product-delivery service to the new member. Attached herewith as Exhibit 2-ab is a printout of a "Membership Application Form", which one may download from the Opposer's website, among other downloadable application forms.

"3.20 Unlike Opposer, which distributes its NATURE'S PLUS to the public through retail selling, Respondent-Applicant distributes Naturally Plus's products by word-of-mouth and direct selling. 'Direct selling' means that the company sells its products directly to customers who become members of Naturally Plus, and that a member's experience is used to invite others to purchase products from the company directly.

"3.21 In view of the foregoing requirements and procedures one must fulfill and undergo before being able to purchase Respondent-Applicant's NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS product, a consumer who has successfully bought one has done so through some effort and only after a careful study of Respondent-Applicant's products and as a result of his clear intention and desire to buy a NATURALLY PLUS SUPER LUTEIN product in particular, and not under any mistaken impression that what he is buying is a NATURE'S PLUS product or is a product that has originated from the Opposer.

"3.22 A consumer who has gone through the trouble of: (a) familiarizing himself/herself with Opposer's product and business, (b) finding an existing NATURALLY PLUS member to sponsor him/her, and (c) becoming a registered NATURALLY PLUS member himself/herself so that he may be able to purchase a NATURALLY PLUS product cannot possibly be mistaken as to said product's nature and origin.

"3.23 In view of the visual and aural dissimilarity between Respondent-Applicant's NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) mark and Opposer's NATURE'S PLUS mark, the nature of the products to which these competing marks are to be applied to, and the differing channels of trade through which the respective parties' products flow, there can be no likelihood of confusion or mistake in the minds of the public.

x x x

"3.24 Opposer claims that 'the registration of the mark NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) will greatly damage and prejudice opposer in the use of its strong mark'. However, Respondent-Applicant denies and contests Opposer's claim that NATURE'S PLUS is, at all, a strong or well-known mark.

"3.25 A 'strong mark' is a trademark or service mark that is distinctive, and is used in a fictitious, arbitrary, or fanciful manner in connection with a product. Presumably, Opposer's mark NATURE'S PLUS is obviously an allusion to its 'natural nutritional and dietary products, as advertised on Opposer's website.

Ergo, its use is not arbitrary or fanciful, as it is actually descriptive of the nature of the products to which said mark is attached.

"3.26 Furthermore, one need only make a simple search through the IPOPHIL's trademark database search engine to find out that there is an abundance of registered marks which contain the word component 'NATURE'S' much like Opposer's NATURE'S PLUS mark, some even covering goods under Class 05, such as:

x x x

"3.27 The existence of the aforementioned marks prove that the registration of the mark NATURE'S PLUS does not entitle Opposer to exclusive ownership over the individual components of its mark, specifically the words 'NATURE'S' or 'PLUS', separate from the mark NATURE'S PLUS in its entirety.

"3.28 Furthermore, and more importantly, Respondent-Applicant discovered that there are several existing products bearing marks confusingly similar to Opposer's NATURE'S PLUS which are sold in the very same channels of trade as Opposer's goods.

"3.29 As earlier mentioned, Atty. Hechanova was able to purchase a bottle of Opposer's NATURE'S PLUS Ultra Chewable Cranberry diet supplement from a 'Healthy Options' branch in Makati. During the very same visit, Atty. Hechanova also found and purchased the following products, which brands or marks bear a striking similarity to Opposer's NATURE'S PLUS mark:

x x x

As proof of the foregoing, herewith attached as Exhibit 4-A is the pertinent receipt issued by 'Healthy Options'. Also attached herewith, as Exhibits 4-B to 4-F, are photographs taken of the actual aforementioned products.

"3.30 The existence of products like these, which are of the same nature as Opposer's goods, and which are being sold in exactly the same store where Opposer's goods are being sold is a strong indication that, if anything, the supposed distinctiveness of Opposer's NATURE'S PLUS has already been diluted and diminished, rendering it a weak mark. Opposer cannot, therefore, claim that its mark NATURE'S PLUS has 'acquired general international consumer recognition' or 'has become strong and distinctive and world famous', when in all likelihood, consumers are unable to differentiate Opposer's products from other products bearing marks such as NATURE'S ANSWER, NATURE'S WAY or NATURE'S GATE.

"3.31 Neither is Opposer's NATURE'S PLUS mark is a well-known mark, as Opposer has failed to allege or prove which of the criteria in Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Tradenames, and Marked or Stamped Containers, or any combination thereof it has met, if any.

x x x

"3.1 It must be pointed out that the word component 'NATURALLY PLUS' in the mark 'SUPER LUTEIN & JAPANESE CHARACTERS (LOGO)' is the dominant part of Respondent-Applicant's corporate name, NATURALLY PLUS DIRECT MARKETING PTE., LTD, which is protected under the Paris Convention and the Philippines Trade Name Law without need of registration.

x x x

"3.30 A tradename is a descriptive of the manufacturer or dealer himself as much as his own name is, and frequently includes the name of the place where the business is located; it involves the individuality of the maker or dealer for protection in trade, and to avoid confusion in business, and to secure the advantages of a good reputation; it is more popularly applied to the good will of a business, and need not be affixed to the goods sold. (Arce & Sons v. Selecta Biscuit Co., L-14761, January 28, 1961, 1 SCRA 245).

"3.31 The law recognizes and protects the ownership or possession of a mark or trade name in the same manner and to the same extent as other property rights known to the law. (La Chemiste Lacoste, S.A. v. Fernandez, 129 SCRA 373 [1984]) In Philips Export B.V. vs. Court of Appeals, the Supreme Court enunciated the right of a corporation to use its corporate and trade name. The Court held:

xxx

"3.32 Opposer claims that NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) 'may have been adopted and used by respondent-applicant with the intention of riding on the long-established goodwill of the NATURE'S PLUS mark'. Nothing could be further from the truth.

"3.33 Respondent-Applicant traces its origin to Naturally Plus Co., Ltd, which was established in Ariake, Tokyo in March 1999. Attached herewith as Exhibit 6 with sub-markings is the Affidavit-Direct Testimony of Mr. Masao Naito, the General Manager of Respondent-Applicant, which contains a brief history of the Respondent-Applicant.

"3.34 Respondent-Applicant has taken great pains to protect its rights over the mark NATURALLY PLUS by causing said mark's registration with various countries worldwide. Attached to the Affidavit of Mr. Naito as Annex 'A' is a list of active registrations and pending applications of the mark NATURALLY PLUS and its variations in the name of Respondent-Applicant worldwide. Also attached to Mr. Naito's Affidavit, marked as Annex 'B', are certificates of registrations issued in favor of Respondent-Applicant over the aforementioned trademarks. Herewith attached as Exhibit 3 with sub-markings are search results obtained from the Australian Trade Mark On-Line System (ATMOSS) and the USPTO Trademark Electronic Search System (TESS), which show that Respondent-Applicant's NATURALLY PLUS LOGO trademark and its variations are also registered with the Australian Intellectual Property Office and with the USPTO.

"3.35. Respondent-Applicant has spent considerable amounts in advertising and in the promotion of its products bearing the SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) mark. Attached as Annex 'C' to Mr. Naito's Affidavit are advertising materials featuring goods bearing Respondent-Applicant's

NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) mark, which are distributed to the members of the NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) direct selling system.

"3.36 The fact is that Respondent-Applicant's NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO) has earned its own goodwill and established its own reputation, through Respondent-Applicant's long and continued use thereof. Respondent-Applicant has no desire or need to ride on the supposed goodwill of Opposer's NATURE'S PLUS mark, or any other entity's, for that matter.

The Respondent-Applicant's evidence consists of the Affidavit-Direct Testimony executed by Atty. Chrissie Ann L. Barredo; Affidavit of Atty. Editha R. Hechanova attesting to having purchased a bottle of Opposer's Nature's Plus Ultra Chewable Cranberry Dietary Supplement; receipt issued for said purchase; photograph of the Nature's Plus product; printout of a "Membership Application Form" for Naturally Plus new applicants; photographs of brands or marks allegedly bearing a striking similarity to Opposer's NATURE'S PLUS mark; Affidavit-Direct Testimony of Masao Naito, General Manager of Naturally Plus Direct Marketing PTE, Ltd.⁵

Should the Respondent-Applicant be allowed to register the trademark NATURALLY PLUS SUPER LUTEIN & JAPANESE CHARACTERS (LOGO)?

It is emphasized that 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.⁶

Thus, Sec. 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides:

- (d) Is identical with 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;"

Records show that the Opposer's filing of its trademark application on 10 August 2009 preceded the Respondent-Applicant's (07 October 2010). Also, the Respondent-

⁵ Marked as Exhibits "1" to "6", inclusive.

⁶ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Eihepa v. Director of Patents, supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

Applicant's application covers goods that are similar and/or closely related to the Opposer's, particularly, nutritional supplements.

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

NATURE'S PLUS



Opposer's trademark

Respondent-Applicant's mark

The mark applied for registration by the Respondent-Applicant features the words NATURALLY PLUS which are almost identical to the Opposer's mark NATURE'S PLUS. Succinctly, this Bureau has already passed upon the issue of whether NATURALLY PLUS is confusingly similar to NATURE'S PLUS in two opposition cases involving the same parties.

In the Decision No. 2014-152⁷ in Inter Partes Case No. 14-2011-00193, this Bureau ruled:

"The Respondent-Applicant's mark NATURALLY PLUS is nearly identical to Opposer's trademark NATURE'S PLUS. Both marks bear words that are almost similar. Their meanings are the same. NATURALLY, although an adverb, means by nature or through nature, thus, NATURALLY PLUS is confusingly similar to Opposer's NATURE'S PLUS. Respondent-Applicant's mark NATURALLY PLUS covers "nutritional supplements" under Class 05, goods (supplements) which the Opposer deals in under the mark NATURE'S PLUS. It is likely therefore, that a consumer who wishes to buy food/nutritional supplements and is confronted with the mark NATURALLY PLUS, will think or assume that the mark or brand is just a variation of or is affiliated with the Opposer's."

Likewise, in its Decision No. 2014-153 in Inter Partes Case No. 14-2011-00187, this Bureau held:

"The Respondent-Applicant's mark NATURALLY PLUS LOGO is nearly identical to Opposer's trademark NATURE'S PLUS. Even with the presence of the leaf and diamond shaped LOGO, to the Bureau's mind, the dominant feature of the trademark is the word component NATURALLY PLUS. Both marks bear words that are

⁷ Promulgated on 04 June 2014.

almost similar. Their meanings are the same. NATURALLY, although an adverb, means by nature or through nature, thus, NATURALLY PLUS is confusingly similar to Opposer's NATURE'S PLUS. Respondent-Applicant's mark NATURALLY PLUS covers "nutritional supplements" under Class 05, goods (supplements) which the Opposer deals in under the mark NATURE'S PLUS. It is likely therefore, that a consumer who wishes to buy food/nutritional supplements and is confronted with the mark NATURALLY PLUS, will think or assume that the mark or brand is just a variation of or is affiliated with the Opposer's."

In this instant, the mark applied for registration by the Respondent-Applicant consists of the words "NATURALLY PLUS" and logo accompanied by the words "SUPER LUTEIN" and figures that are supposedly "Japanese characters". In this regard, the Supreme Court held that whether a trademark causes confusion and is likely to deceive the public hinges on "colorable imitation" which has been defined as "such similarity in form, content, words, sound, meaning, special arrangement or general appearance of the trademark or trade name in their overall presentation or in their essential and substantive and distinctive parts as would likely mislead or confuse persons in the ordinary course of purchasing the genuine article."⁸

The word components in the mark applied for registration by the Respondent-Applicant render the accessories merely as ornamental. In this jurisdiction, consumers would not know or care about the meaning of the "Japanese characters". The more pressing issue to be resolved is whether the presence of the words "SUPER LUTEIN" in the mark applied for registration by the Respondent-Applicant eliminated the likelihood of confusion.

It must be emphasized that what the Respondent-Applicant applied for registration is not "SUPER LUTEIN". The main or principal feature of the mark is still "NATURALLY PLUS". The fact that "SUPER LUTEIN" is printed in bigger font-size than the words "NATURALLY PLUS" is of no moment. "NATURALLY PLUS" is conspicuously located above "SUPER LUTEIN", such that the eyes are drawn towards it. This pre-eminent position of the words "NATURALLY PLUS" gives the impression that "SUPER LUTEIN" is a special or a merely a variation of the goods or products under the mark or brand "NATURALLY PLUS".

Succinctly, 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

⁸ Mighty Corporation v.E.J. Gallo Winery ,G.R. No.154342,4July 2004)

mistaking the newer brand for it⁹. The likelihood of confusion or mistake would subsist not only in respect of the purchaser's perception of goods but on the origin thereof as held by the Supreme Court.¹⁰

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

WHEREFORE, premises considered, the instant Opposition to Trademark Application Serial No. 4-2010-501508 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 25 June 2014.


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

⁹ See *American Wire and Cable Co. v. Director of Patents et. al.* (SCRA 544) G.R. No. L-26557, 08 Jan. 1987.

¹⁰ *Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.