



UNITED HOME PRODUCTS, INC.,
Opposer,

-versus-

ST. BARACHIEL THE ARCHANGEL
FOOD INDUSTRIES, INC.,
Respondent- Applicant.

X-----X

}
} IPC No. 14-2013-00477
} Opposition to:
} Appln. Serial No. 4-2013-00501190
} Date Filed: 22 May 2013
} TM: "ELSIVIT"

NOTICE OF DECISION

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**ST. BARACHIEL THE ARCHANGEL
FOOD INDUSTRIES INC.**
Respondent-Applicant
Blk.2, Lot 7-A Sterling Industrial Park
Phase I, Meycauayan, Bulacan

GREETINGS:

Please be informed that Decision No. 2014 - 121 dated April 29, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 29, 2014.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



UNITED HOME PRODUCTS, INC.,	}	IPC No. 14-2013-00477
Opposer,	}	Opposition to:
	}	
- versus -	}	Application No. 4-2013-00501190
	}	Date Filed: 22 May 2013
ST. BARACHIEL THE ARCHANGEL	}	
FOOD INDUSTRIES, INC.,	}	Trademark: ELSIVIT
Respondent-Applicant.	}	
x-----x		Decision No. 2014 - <u>121</u>

DECISION

UNITED HOME PRODUCTS, INC.¹ ("Opposer") filed on 04 December 2013 a Verified Notice of Opposition to Trademark Application No. 4-2013-00501190. The contested application, filed on 22 May 2013 by ST. BARACHIEL THE ARCHANGEL FOOD INDUSTRIES, INC.² ("Respondent-Applicant"), covers the mark ELSIVIT for use on "*pharmaceutical (food supplement)*" under Class 5 of the International Classification of goods.³

The Opposer anchors its opposition on the following grounds:

"7. The mark ELSIVIT applied for by Respondent-Applicant so resembles the trademark LYSIVIT owned by Opposer and duly registered with this Honorable Bureau prior to the publication of the application for the mark ELSIVIT.

"8. The mark ELSIVIT will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark ELSIVIT is applied for the same class and goods as that of Opposer's trademark LYSIVIT, i.e. Class 05 of the International Classification of Goods for pharmaceutical preparation, appetite enhancer, vitamins, food supplements.

"9. The registration of the mark ELSIVIT in the name of the Respondent-Applicant will violate Section 123.1 (d) of the IP Code, which provides, in part, that a mark cannot be registered if it: x x x

Under the above-quoted provision, any mark, which is similar to a registered mark, shall be denied registration in respect of similar or related goods or if the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

- 1 A domestic corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines, with office address at Bonaventure Plaza, Ortigas Avenue, San Juan, Metro Manila, Philippines.
- 2 Appears to be a domestic corporation with office address at Blk. 2, Lot 7-A Sterling Industrial Park, Phase I Meycauayan, Bulacan, Philippines.
- 3 Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

"10. Respondent-Applicant's use and registration of the mark ELSIVIT will diminish the distinctiveness of Opposer's trademark LYSIVIT."

As part of its evidence, the Opposer submitted a copy of the pertinent page of the IPO e-Gazette bearing publication date of 04 November 2013 (Exhibit "A") and a certified true copy of Certificate of Registration No. 4-2012-001638 for the trademark LYSIVIT (Exhibit "B").

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 13 January 2014. The Respondent-Applicant, however, did not file its Verified Answer. Thus, this Bureau issued Order No. 2014-369 dated 20 March 2014 declaring the Respondent-Applicant in default and submitting the case for decision on the basis of the opposition, affidavit of witness and documentary or object evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the trademark ELSIVIT?

The essence of trademark registration is to give protection to the owners of 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 product.⁴ Thus, Section 123.1 (d) of R. A. No. 8293, also known as the Intellectual Property Code of the Philippines ("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, the records and evidence show that at the time the Respondent-Applicant filed its trademark application on 22 May 2013, the Opposer already has an existing registration (No. 4-2012-001638) for the trademark LYSIVIT issued on 24 May 2012. The Respondent-Applicant's trademark application indicates that the mark is for use on goods "*pharmaceutical (food supplement)*" under Class 05 while the Opposer's registration covers goods also under Class 5, namely, "*pharmaceutical preparations, appetite enhancer, vitamins, food supplements*". The goods, therefore, being both pharmaceutical products intended as food supplement falling under Class 5 are related to each other.

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

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

LYSIVIT

Opposer's Mark

ELSIVIT

Respondent-Applicant's Mark

The marks are confusingly similar both in the visual and aural aspects. They both consist of seven (7) letters and three (3) syllables. The last five (5) letters of the Respondent-Applicant's mark "S-I-V-I-T" are exactly the same as that of the Opposer's. The difference in the spellings, however, in the first syllable of the contending marks is inconsequential to the effect on the eyes and ears. As ruled by the Supreme Court, confusion cannot be avoided by merely dropping, adding or changing some of the 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.⁵

Aurally, the marks produced the same sound effect when pronounced. This happens because they have the same number of syllables and the last five letters are phonetically the same. The changes in the spelling in the first syllable, therefore, did not retract from the finding of aural similarity in the marks. Time and again, the court has taken into account the aural effects of the words and letters contained in the marks in determining the issue of confusing similarity.⁶ Thus, in *Marvex Commercial Co., Inc. v. Petra Hawpia & Co., et al.*,⁷ the Court held:

"Two letters of SALONPAS are missing in LIONPAS: the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance (*Co Tiong Sa v. Director of Patents*, 95 Phil. 1, citing *Nims, The Law of Unfair Competition and Trademarks*, 4th ed. Vol. 2, pp. 678-679). The importance of this rule is emphasized by the increase of radio advertising in which we are deprived of the help of our eyes and must depend entirely on the ear (*Operators, Inc. v. Director of Patents*, supra).

The following random list of confusingly similar sounds in the matter of trademarks, culled from *Nims, Unfair Competition and Trade Marks*, 1947, Vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jass-Sea"; "Silver Flash" and "Supper Flash"; "Cascarete" and "Celborite"; "Celluloid" and "Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo". Leon Amdur, in his book "Trade-Mark Law and Practice", pp. 419-421, cities, as coming within the purview of the

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

6 *Prosource International Inc. v. Horphag Research Management S. A.*, G. R. No. 180073, 25 November 2009.

7 G. R. No. L-19297, 22 December 1966.

idem sonans rule, "Yusea" and "U-C-A", "Steinway Pianos" and "Steinberg Pianos", and "Seven-Up" and "Lemon-Up". In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Cordura" are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin", as the sound of the two names is almost the same.

In the case at bar, "SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (see *Celanese Corporation of America vs. E. I. Du Pont*, 154 F. 2d. 146, 148)."

Succinctly, because the Opposer's and Respondent-Applicant's marks both deal with pharmaceutical products specifically for food supplements, the changes in the spelling therefore did not diminish the likelihood of the occurrence of mistake, confusion or even deception. As trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark.

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.⁸ 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.⁹

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.

⁸ *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

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



Accordingly, this 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 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-00501190 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 29 April 2014.



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