



UNITED LABORATORIES, INC.,
Opposer,

-versus-

ALDRTZ CORPORATION,
Respondent-Applicant.

X-----X

} IPC No. 14-2009-00211
} Opposition to:
} Appln. Serial No. 4-2008-014849
} Date filed: 09 December 2008
} **TM: "EnergO Extreme**
} **(Stylized)"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 - 67 dated April 17, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 17, 2012.

For the Director:


Atty. **MARLITA V. DAGOSA**
Hearing Officer, BLA



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 Date Filed: 09 December 2008
 Trademark: **Energo Extreme**
(Stylized)
 Decision No. 2012 - 67

DECISION

UNITED LABORATORIES, INC.¹ (“Opposer”) filed on 26 August 2009 a Verified Notice of Opposition to Trademark Application No. 4-2008-014849. The application, filed by ALDRTZ CORPORATION² (“Respondent-Applicant”), covers the mark ENERGO EXTREME (STYLIZED) for use on “*food supplement – capsule, syrup; energy drink and powder*” under Classes 5 and 32, respectively, of the International Classification of Goods³.

The Opposer alleges, among other things, the following:

“1. The trademark ENERGO so resembles the trademark ENERVON-C (ENERVON for brevity), owned by Opposer duly registered with this Honorable Bureau on 16 June 1969. The trademark ENERGO, which is owned by Respondent-Applicant, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark ENERGO is applied for the same class and goods as that of trademark ENERVON, i.e. Class 5.

“2. The registration of the trademark ENERGO in the name of the Respondent-Applicant will violate Sec. 123 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines (R. A. No. 8293), 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 as to the goods or its origin.

1 A domestic corporation duly organized and existing under the laws of the Philippines, with principal business address at No. 66 United Street, Mandaluyong City, Philippines.
 2 A domestic corporation duly organized and existing under the laws of the Philippines, with principal business address at No. 23 Alijis-Murcia Road, Bacolod City, Negros Occidental, Philippines.
 3 The 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.

"3. Respondent-Applicant's use and registration of the trademark ENERGO will diminish the distinctiveness and dilute the goodwill of Opposer's trademark ENERVON.

The Opposer's evidence consists of the following:

1. Exhibits "A" and "A-1" - Copies of the pertinent pages of the IPO E-Gazette;
2. Exhibit "B" - Copy of the Certificate of Registration for the trademark ENERVON;
3. Exhibits "C" and "D" - Copies of the Deed of Assignment duly recorded with the IPO;
4. Exhibit "E" - Copy of the Petition for Renewal of Registration;
5. Exhibits "F", "G", "H", "I" and "J" - Copies of the Affidavits of Use;
6. Exhibit "K" - Sample product label bearing the trademark ENERVON actually used in commerce;
7. Exhibit "L" - Copy of the Certification and sales performance; and
8. Exhibit "M" - Copy of the Certificate of Product Registration issued by the BFAD for the trademark ENERVON.

The Respondent-Applicant filed its Verified Answer on 18 January 2010, specifically denying the material allegations in the Notice of Opposition and sets forth, among other things, the following affirmative allegations and defenses:

"x x x

"32. Respondent-Applicant is the exclusive owner, by prior trademark registration and widespread prior adoption and use of the ENERGO trademark. ENERGO is an original coined mark created and first used by Respondent-Applicant for its energy drink product. The component syllables of the mark "E-NER-" came from the word "energy", which was added to the word "GO", in order to form a coined word which captures the thrust of Respondent-Applicant's ENERGO energy drink product - energy, strength and vitality for people with an active lifestyle, or more commonly known as "people-on-the-go".

"x x x

"35. The ENERGO energy drink is widely distributed nationwide, particularly in the National Capital Region, Regions 1, 2, 3, 4, 5, 6, 12, Eastern and Central Visayas Region, Davao, CARAGA/CDO, and Zamboanga Regions.



"36. Respondent-Applicant aggressively promotes and advertises its ENERGO energy drink product in both print and broadcast media to increase sales and public awareness of the product. The ENERGO energy drink receives extensive nationwide television promotion in the popular daily noontime show "Wowowee". Respondent-Applicant further commissioned the composer Mr. Lito Camo to compose a jingle for ENERGO, which jingle is also played everyday in the daily noontime show "Wowowee". Respondent-Applicant also engaged famous celebrities, particularly, television host and actress, Ms. Valerie Concepcion, to endorse its ENERGO energy drink and in promotional campaigns published in various newspapers and magazines.

"37. Respondent-Applicant's prior adoption and continuous use for at least seven (7) years of the ENERGO mark in the Philippine market has gained it a significant amount of fame and goodwill for the ENERGO brand.

"38. The subject ENERGO EXTREME (STYLIZED) mark is intended for use in a new ENERGO energy drink product variant that is currently being developed by Respondent-Applicant and would be introduced in the market in the market. The subject mark consists of Respondent-Applicant's ENERGO brand name and the word "Extreme" with a large letter "X" in a stylized design, as shown below:

x x x

"x x x

"41. Opposer claims that Respondent-Applicant's ENERGO EXTREME (STYLIZED) mark resembles Opposer's ENERVON-C mark, which will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark ENERGO is applied for the same class and goods as that of trademark ENERVON, i.e. Class 5. This is untenable.

"42. Contrary to Opposer's assertions, there are significant and very obvious differences between Respondent-Applicant's ENERGO EXTREME (STYLIZED) mark and Opposer's ENERVON-C mark that negate the existence of confusing similarity.

"x x x

"45. While there may be similarity in the spelling of the two marks in that they both use the letters E-N-E-R, still, the manner of display, the style and design of the words, their pronunciation and their over-all appearances show that Respondent-Applicant's ENERGO EXTREME (STYLIZED) mark and Opposer's ENERVON-C mark are in no way identical.

"45.1. First, the illustrations of the two marks are displayed in a distinct manner glaring and striking to the eye. Opposer's ENERVON-C mark consists of a simple and plain word mark. On the other hand, Respondent-Applicant's ENERGO EXTREME (STYLIZED) mark consists



of various components, i.e., the coined word ENERGO and the English word Extreme, with a stylized letter "X" drawn in a large font. x x x

"45.2. Second, the style of the words used is also unique for each mark. Respondent-Applicant's ENERGO EXTREME (STYLIZED) mark displays the coined word ENERGO with a slight diagonal slant towards the right. The English word Extreme is also displayed with a slight diagonal slant towards the right but with the letter "X" drawn larger and more dominantly than the other letters. Overall, the words used are presented in a fanciful manner that is visually distinctive and appealing to the eye. Opposer's ENERVON-C mark, on the other hand, consists of the plain and bare word ENERVON, to which a dash (-) and a letter "C" are added.

"45.3. Third, the aural impressions of both marks are also distinct. Opposer's ENERVON-C mark is plainly pronounced as /e/-/ner/-/von/-/si/, while Respondent-Applicant's ENERGO EXTREME (STYLIZED) is pronounced as /e/-/ner/-/go/-/ik/-/stream/.

"45.4. Fourth, the illustrations of the two marks, particularly the use of illustrations or visual representations, are also different. Opposer's ENERVON-C mark is a plain word mark, without any logo or pictorial representation of any character. Respondent-Applicant's ENERGO EXTREME (STYLIZED) mark, on the other hand, presents the component words of the mark in a distinctive and visually appealing design.

"46. The use of the syllables "ENER" as component of both trademarks cannot be considered as a factor for declaring the two marks confusingly similar, because "ENER" is descriptive and generic and is open for appropriation by anyone.

"47. In fact, a number of trademarks which used the syllables "ENER" has been allowed registration for class 5 goods, or those goods involving pharmaceutical preparations and energy drink products, to wit:

x x x

Notably, the above marks also adopted the syllables "ENER" precisely to suggest the purpose or use of their respective goods, i.e., energy drink products and other pharmaceutical preparations, which is to give energy and vigour to their consumers.

"48. That the syllables "ENER" have been allowed use, as a component feature of other registered marks for goods in Classes 5 and 32, or those similar to the goods of Opposer and Respondent-Applicant, is proof that the same is generic and is incapable of exclusive appropriation.

"x x x

"51. Applying the foregoing doctrines to the case at bar, the obvious conclusion is that the mere fact that both marks use the common component "ENER" does not make Opposer's ENERVON-C mark confusingly similar to Respondent-Applicant's ENERGO EXTREME (STYLIZED) MARK. Notably, the syllable "ENER" was derived from the word "energy" which implies the benefit of using the parties' respective products.

"x x x

"52. By itself, "ENER" cannot be appropriated as a component of a trademark to the exclusion of others. As ruled in *Etepha* however, it may properly become the subject of a trademark by combining it with another word or phrase. Precisely, this is what Opposer and Respondent-Applicant did with their respective ENERVON-C and ENERGO EXTREME (STYLIZED) marks. Opposer added the suffix "VON" and the letter "C" to "ENER". On the other hand, Respondent-Applicant added the suffix "GO" to "ENER" then combined it with another word, Extreme. With the addition of different suffixes, Opposer's and Respondent-Applicant's marks have become distinct from each other and are, therefore, entitled to co-exist in the market and be both registrable as trademarks.

"x x x

"54. Opposer's allegation that Respondent-Applicant's use of the ENERGO EXTREME (STYLIZED) mark would result in confusion as to the source or origin of the latter's goods is untenable. As stated above, Respondent-Applicant's ENERGO energy drink product has been commercially sold and marketed in the Philippines for more than seven (7) years. Through Respondent-Applicant's extensive promotion and advertising, consumer awareness for the ENERGO energy drink product has been steadily increasing throughout the years and Respondent-Applicant's ENERGO-ALWAYS ON THE GO! OSTRICH LOGO has become an easily recognizable and well-known brand. On the other hand, Opposer's ENERVON-C mark, although also well-known among the consuming public, is only associated with Opposer's multivitamins products. To date, there is no energy drink product bearing the ENERVON-C mark. Simply stated, Respondent-Applicant's ENERGO product and Opposer's ENERVON-C product have been successfully co-existing in the market for several years already, and the consuming public is well-aware that these two products are produced by unrelated companies. Respondent-Applicant's use and registration of the ENERGO EXTREME (STYLIZED) mark, therefore, would not likely result in a confusion as to origin or business. A product bearing the ENERGO EXTREME (STYLIZED) mark would be readily recognizable as a product variant of Respondent-Applicant's already established ENERGO energy drink product and will not be confused with Opposer's ENERVON-C product.

"55. Finally, through Respondent-Applicant's ENERGO brand has already gained its own reputation and goodwill as an energy drink product. Certainly, it is not riding on the goodwill of any other

trademark, particularly, that of Opposer's ENERVON-C mark.

"56. All told, Respondent-Applicant's ENERGO EXTREME (STYLIZED) mark is neither identical nor confusingly similar to Opposer's ENERVON-C mark. Their over-all impression, as appearing in their respective labels, and their dominant features, make the subject marks distinct and distinguishable from each other. Respondent-Applicant's ENERGO EXTREME (STYLIZED) in, on itself, sufficiently distinctive and should be allowed for registration."

The Respondent-Applicant submitted the following exhibits:

1. Exhibit "1" - Affidavit of Jerome M. Mongcal;
2. Exhibit "2" - Certified copy of Philippine Certificate of Registration No. 4-2002-004205;
3. Exhibit "3" - Copy of the trademark application details of Application No. 4-2008-002870 printed from the official website of the Intellectual Property Office;
4. Exhibit "4" - Copy of the trademark application details for the LOW BAT KA NA BA? MAG ENERGO KA! mark as published in the IPO's official website;
5. Exhibit "5" - List of places of distribution of the ENERGO energy drink product, as well as its authorized distributors;
6. Exhibit "6" - A CD-ROM containing excerpts from the daily noontime show "Wowowee" where the ENERGO ALWAYS ON THE GO! Energy drink product is being promoted;
7. Exhibits "7" to "7-b" - Copies of the published endorsements of the ENERGO Energy Drink product by Ms. Valerie Concepcion and other newspaper articles;
8. Exhibit "8" - Copy of the trademark details of the mark KUKU BIMA ENER-G printed from the IPO website;
9. Exhibit "9" - Copy of the trademark details of the mark ENER-Z printed from the IPO website;
10. Exhibit "10" - Copy of the trademark details of the mark ENER-C printed from the IPO website; and
11. Exhibit "11" - Print out from the Respondent-Applicant's www.aldrtz.com website.

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



The Opposer anchors its case on Sec. 123.1 (d) of the IP Code which provides that a mark cannot be registered if it:

(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.

In this regard, records and evidence show that at the time the Respondent-Applicant filed its trademark application in 2008, the Opposer, specifically its predecessors-in-interest, already has an existing trademark registration for ENERVON-C used on "*high-potency therapeutic vitamin formula containing essential Vitamin B Complex plus Vitamin C*". The goods on which the competing marks are used therefore are similar or closely related.

But are the competing marks identical or closely resemble each other that confusion or deception is likely to occur?

The only similarity between the competing marks is the first four letters comprising the first two syllables "ENER". Considering that the marks are used on vitamins and food supplement, "ENER" is obviously derived from the word "energy". Thus, "ENER" alone is not unique as a mark or as a component of a mark for the subject goods. "ENER" is clearly suggestive as to the kind of goods a mark with "ENER" as a component is attached to. What would make such trademark distinctive are the suffixes or appendages to the prefix "ENER" and/or the devices, if any.

Succinctly, the last syllable in the Opposer's mark "VON-C" is different from the last syllable in the Respondent-Applicant's mark "GO". The dash (-) and the letter "C" in the Opposer's mark and the word EXTREME with the letter "X" displayed in a slanting position and larger than the other letters in the Respondent-Applicant's make a fine distinction between the contending marks as to sound and appearance such that confusion or deception is unlikely to occur. There is a remote possibility for a consumer to assume or conclude that there is a connection between the parties solely because both marks start with the syllable "ENER" since, as we discussed above, "ENER" is merely suggestive of the word energy.

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

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

Clearly, the Respondent-Applicant satisfied this function test.

WHEREFORE, premises considered, the instant opposition is hereby **DENIED**. Let the filewrapper of Trademark Application No. 4-2008-014849 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 17 April 2012.


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

