



UNITED LABORATORIES, INC.,
Opposer,

-versus-

NUGENTEC LIFESCIENCES CO., LTD.,
Respondent-Applicant.

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}
} IPC No. 14-2009-00125
} Opposition to:
} Appln. Serial No. 4-2008-012503
} Date filed: 14 Oct. 2008
} TM: "HAVITAL"
}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 – 201 dated October 17, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 17, 2012.

For the Director:


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



UNITED LABORATORIES, INC.,
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IPC No. 14-2009-00125
Opposition to:
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(Filing Date: 14 Oct. 2008)
TM: "HAVITAL"

Decision No. 2012- 201

DECISION

UNITED LABORATORIES, INC. ("Opposer")¹ filed on 29 April 2009 an opposition to Trademark Application Serial No. 4-2008-012503. The application, filed by NUGENTEC LIFESCIENCES CO., LTD. ("Respondent-Applicant")², covers the mark "HAVITAL" for use on "anti-aging cream, anti-wrinkle cream, astringents for cosmetic purposes, body and beauty care cosmetics, cleansing creams (cosmetic), cosmetic creams, cosmetic creams for skin care, cosmetic oils for the epidermis, cosmetic preparations for skin renewal, cosmetic, eye compresses for cosmetic purposes, face creams, facial cleansers, facial masks, hair cleaning preparations, liquid bath soaps, lotions for indicate specific type (e.g. skin, hair, face, body, hair, waving), lotion for face and body care, skin solution, skin moisturizer and sun block" under Class 3 of the International Classification of goods³.

The Opposer alleges that HAVITAL so resembles its registered mark "HAVITALL" such that it will likely cause confusion, mistake and deception on the purchasing public. According to the Opposer, the registration of HAVITAL in favor of the Respondent-Applicant violates Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines. To support its opposition, the Opposer submitted as evidence⁴ copies of documents pertaining to the mark HAVITALL, specifically, list of trademarks published for opposition with "releasing date" of 30 January 2009, Cert. of Reg. No. 4-2007-001046, Deed of Assignment, Declaration of Actual Use, and Cert. of Product Registration issued by the Bureau of Food and Drugs. It also submitted a sample of the product label bearing the mark.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 27 May 2009. The Respondent-Applicant, however, did not file the Answer.

Should the Respondent-Applicant be allowed to register the mark HAVITAL?

The essence of trademark registration is to give protection to the owners of

¹ A corporation organized and existing under the laws of the Philippines with address at No. 66 United Street, Mandaluyong City.

² A corporation organized and existing under the laws of Taiwan R.O.C. with address at 8F-1 NO. 54, SEC. 3, Jhongshan N. Rd., Taipei City, Taiwan

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.

⁴ Marked as Annexes "A" to "F".

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.⁵ Thus, Sec. 123.1 (d) of the IP Code provides that a mark cannot be registered if its 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.

Records show that when the Respondent-Applicant filed its trademark application on 14 October 2008, the Opposer already has an existing trademark registration for HAVITALL. The parties' respective marks are depicted below:

The image shows the trademark 'HAVITALL' in a bold, black, sans-serif font. The letters 'H', 'A', 'V', and 'I' are stacked vertically on top of each other, while 'T', 'A', 'L', and 'L' are stacked vertically on top of each other. The overall appearance is a dense, blocky arrangement of characters.

Opposer's mark

The image shows the trademark 'HAVITAL' in a bold, black, sans-serif font. The letters 'H', 'A', 'V', 'I', 'T', 'A', and 'L' are arranged in a single horizontal line, with consistent spacing between each letter.

Respondent-Applicant's mark

The marks differ in respect of the fonts used, the manner of presentation, and the extra letter "L" in the Opposer's mark. These differences notwithstanding, the marks still look and sound alike. When used by the parties on their respective goods, the likelihood of confusion persists.

Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose.⁶ In this regard, the Opposer's trademark registration covers "food supplements comprised of vitamins and minerals" under Class 5, while the Respondent-Applicant's application indicates "anti-aging cream, anti-wrinkle cream, astringents for cosmetic purposes, body and beauty care cosmetics, cleansing creams (cosmetic), cosmetic creams, cosmetic creams for skin care, cosmetic oils for the epidermis, cosmetic preparations for skin renewal, cosmetic, eye compresses for cosmetic purposes, face creams, facial cleansers, facial masks, hair cleaning preparations, liquid bath soaps, lotions for indicate specific type (e.g. skin, hair, face, body, hair, waving), lotion for face and body care, skin solution, skin moisturizer and sun block under Class 3. Related as to purpose. The Respondent-Applicant's goods may not be similar to the Opposer's in terms of composition, form and other physical attributes or characteristics. However, the Respondent-Applicant's goods are not totally unrelated to the Opposer's. The parties' respective goods find commonality as to purpose, that is maintaining a person's physical well-being. The usage of the Opposer's goods complements that of the Respondent-Applicant's. In commercial establishments, food supplements (vitamins and minerals) are

⁵ *Pribhdas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

⁶ *Canon Kabushiki Kaisha vs. Court of Appeals et al.*, G.R. 120900, July 20, 2000, citing the case of *Esso Standard Eastern, Inc. vs. Court of Appeals*, 116 SCRA 336 (1982) p. 342.

often seen placed on shelves that are side-by-side or near body and beauty care products.

Thus, HAVITALL being a very distinctive mark, it is likely that a consumer will assume that the goods bearing the mark HAVITAL is connected to or associated with the HAVITALL products, thinking that one mark is just a variation of the other. There is the likelihood therefore, that information, assessment, perception or impression, whether good or positive, on the goods sold by the Respondent-Applicant may unfairly be cast upon or attributed to the Opposer, and *vice-versa*.

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.⁷ Succinctly, 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.⁸

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.

Accordingly, this Bureau finds and concludes that Trademark Application Serial No. 4-2008-012503 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. 4-2008-012503 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 17 October 2012.


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

⁷ *American Wire and Cable Co. v. Director of Patents et al.*, (31 SCRA 544) G.R. No. L-26557, 18 Feb. 1970.

⁸ *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.