



OFFICE OF THE DIRECTOR GENERAL

ASSOCIATED BRITISH FOODS,
PLC,

Appellant,

-versus-

DIRECTOR OF BUREAU OF
TRADEMARKS,

Appellee.

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Appeal No. 04-2011-0019

Application No. 4-2008-008512

Date Filed: 16 July 2008

Trademark: ACTIV8 ICON HAS
IODINE, IRON, FOLIC ACID &
ZINC TO HELP SUPPORT MENTAL
PERFORMANCE AND DEVICE

DECISION

ASSOCIATED BRITISH FOODS, PLC (“Appellant”) appeals the decision of the Director of Bureau of Trademarks (“Director”) which sustained the final rejection of the Appellant’s application to register the mark “ACTIV8 ICON HAS IODINE, IRON, FOLIC ACID & ZINC TO HELP SUPPORT MENTAL PERFORMANCE AND DEVICE” (“ACTIV8 ICON AND DEVICE”).

Records show that the Appellant filed on 16 July 2008 Trademark Application No. 4-2008-008512 for ACTIVE8 ICON AND DEVICE for use on milk and milk products, cocoa and chocolate based beverages and preparations for making the same, and preparations for making beverages. Subsequently, the Examiner-in-Charge (“Examiner”) issued a “REGISTRABILITY REPORT”¹ stating that the mark may not be registered because it nearly resembles a registered mark belonging to a different proprietor and the resemblance is likely to deceive or cause confusion. The Examiner cited the marks “ACTIVE 8”² and “ACTIVATE”³.

The Appellant filed a response dated 03 July 2009 maintaining that its mark and the marks cited by the Examiner are different in over-all appearance. The

¹ Paper No. 02 issued by the Examiner on 27 April 2009.

² Registration No. 42005004607 issued on 11 June 2007 in favor of Alticor, Inc. for use on fruit drinks, fruit juices, fruit juice powder, and drink mixes.

³ Registration No. 42008014905 issued on 10 December 2008 in favor of Societe Des Produits Nestle S. A. for use on coffee, coffee extracts, coffee-based preparations and beverages; iced coffee; coffee substitutes, extracts of coffee substitutes, preparations and beverages based on coffee substitutes; chicory; tea, tea extracts, tea-based preparations and beverages; iced tea; malt-based preparations; cocoa and cocoa-based preparations and beverages; chocolate-based preparations and beverages; flavoured water; fruit-flavoured and fruit-based beverages, fruit and vegetable juices, nectars, lemonade, sodas and other non-alcoholic beverages specially tea or coffee based ready to drink beverages; syrups, extracts and essences and other preparations for making non-alcoholic beverages (except essential oils); lactic fermented beverages; soya-based beverages; malt-based beverages; and isotonic beverages.

Appellant stated that **ACTIV8 ICON AND DEVICE** is a composite mark while the marks cited by the Examiner are word marks printed in bold and upper-cased letterings. The Appellant averred that its mark is different from the marks cited by the Examiner in terms of sound, spelling, and syllables.

The Examiner issued another official action⁴ stating that the Appellant's mark cannot be registered because the goods covered by this mark are closely related to the class of goods covered by the cited marks. The Examiner asserted that the word "ACTIVE8" is the dominant feature of these marks. The Appellant filed another response dated 04 November 2009 maintaining that there is no similarity in style, spelling, and appearance of the trademarks and that the goods covered by them are different and under different classes.

On 21 January 2010, the Examiner issued a "FINAL REJECTION" stating that the Appellant's mark cannot be registered because it nearly resembles "ACTIVE 8" that belongs to a different proprietor with an earlier filing date and for the same and closely-related goods which is likely to deceive or cause confusion.

Consequently, the Appellant filed a "NOTICE OF APPEAL" and "APPELLANT'S BRIEF" on 29 March 2010 and 31 May 2010, respectively. The Appellant maintained its position that there is distinction in appearance between its mark and the mark "ACTIVE8" cited by the Examiner. The Appellant argued that its mark is only a secondary mark to support the mark "OVALTINE" and, hence, there can be no confusion or deception.

On 08 August 2011, the Director issued a decision denying the appeal and sustaining the final rejection of **ACTIVE8 ICON AND DEVICE**.

Not satisfied with the decision, the Appellant filed on 29 September 2011 an "APPEAL MEMORANDUM" contending that the Director erred in affirming the Examiner's ruling that **ACTIVE8 ICON AND DEVICE** cannot be registered because it is confusingly similar with **ACTIVE 8**. The Appellant reiterates its position that its mark is merely a secondary mark which is intended to be used in conjunction with its internationally well-known mark "OVALTINE". The Appellant maintains its position that **ACTIVE8 ICON AND DEVICE** is a composite mark with intricate details and stylized lettering indicating the evident distinctions between its mark and the mark cited by the Examiner.

The Director filed on 25 October 2011 her "COMMENT" maintaining her decision that **ACTIVE8 ICON AND DEVICE** is confusingly similar with **ACTIVE 8**. According to her, these marks have striking phonetic similarities and meaning and that any dissimilarity between these marks is so slight and insignificant that the likelihood of confusion is evident. The Director asserts that the goods of these marks fall under the same classification, are closely-related, and traded in similar channel. The Director avers that there is a great possibility that either of the proprietors of these marks may choose to expand its business to cover the goods of the other.

⁴ Paper No. 04 with mailing date of 04 September 2009.

The main issue in this case is whether the Director was correct in sustaining the final rejection of the Appellant's application to register ACTIVE8 ICON AND DEVICE. Moreover the relevant question to answer in this case is whether ACTIVE8 ICON AND DEVICE is confusingly similar with ACTIVE 8 as to likely to deceive or cause confusion.

Below are the illustrations of the Appellant's mark and the mark cited by the Examiner.



Appellant's mark

ACTIVE 8

Mark cited by the Examiner

In trademark cases, particularly in ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, no set of rules can be deduced. Each case is decided on its own merits.⁵ As the likelihood of confusion of goods or business is a relative concept, to be determined only according to the particular, and sometimes peculiar, circumstances of each case,⁶ the complexities attendant to an accurate assessment of likelihood of such confusion requires that the entire panoply of elements constituting the relevant factual landscape be comprehensively examined.⁷

In this case, while the Appellant's mark has a term "Activ8" that appears to be similar to the mark cited by the Examiner, this similarity is not sufficient to arrive at a conclusion that the registration of the Appellant's mark will likely cause confusion or deception. The Appellant's mark has distinctive features that negate any likelihood of confusion or deception that will be caused by the registration of ACTIVE8 ICON AND DEVICE. As correctly pointed out by the Appellant:

As a matter of fact, applicant-appellant's mark is specifically described as "A design feature composed of the illustrations of a boy, illuminating light bulb and two smiling faces, all individually enclosed in circles, with the word "ACTIV8" printed below the circles and an illustration of a star on the upper right portion of the number '8', and the words 'has Iodine, Iron, Folic Acid & Zinc To Help Support

⁵ Emerald Garment Manufacturing Corporation v. Court of Appeals, 251 SCRA 600 (1995).

⁶ Esso Standard Eastern, Inc. v. Court of Appeals, 116 SCRA 336 (1982).

⁷ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001.

Mental Performance’ printed below the word ‘ACTIV8’, with all the words enclosed in a ray of light.” Said main features are all absent in the cited mark ACTIVE 8 which is merely a word mark.⁸

In this regard, the attention of the purchasing public would easily be directed to these distinctive features of the Appellant’s mark. Significantly, the term “ACTIV8” forms part of prior certificates of registration issued in favor of the Appellant. The Appellant filed on 12 January 2004 a trademark application for “ACTIV8” which was subsequently registered on 18 June 2007.⁹ Thereafter, the Appellant filed another application on 29 June 2004 to register the mark “OVALTINE ACTIV8POWER LABEL MARK” as shown below



This mark was registered on 04 May 2009.¹⁰ Accordingly, the Appellant’s ownership of “ACTIV8” has been recognized by this Office through these prior certificates of registration.

In this regard, it is emphasized that 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.¹¹

The Appellant has registered marks containing “ACTIV8” which it has been using in its business, thus, negating any likelihood that the registration of ACTIVE8 ICON AND DEVICE may cause confusion as to the true owner of this mark. Neither would the allowance for registration of this mark cause confusion as to the source or

⁸ APPEAL MEMORANDUM dated 07 September 2010, pages 8-9.

⁹ Certificate of Registration No. 42004000256 for use on dietetic substances for food for babies and children; vitamins and minerals; milk and milk products; food preparations in powder or tablet form composed principally of malt, milk and eggs, the malt predominating.

¹⁰ Certificate of Registration No. 42004005736 for use on dietetic substances for food for babies and children; vitamins and minerals; milk and milk products; food preparations in powder or tablet form composed principally of malt, milk and eggs, the malt predominating.

¹¹ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

origin of the goods covered by ACTIVE8 ICON AND DEVICE. The Appellant also correctly pointed out in its appeal that:

2. With all due respect, it must be stressed that the subject mark "ACTIVE8 ICON" is merely a **secondary mark** which is intended to be used by the appellant-applicant in conjunction with its internationally well-known mark "OVALTINE" trademark (Reg. No. 42003007944). As shown in the actual "OVALTINE" product label, the subject mark is used only as secondary trademark which presents the OVALTINE product's ACTIV8 formula. Thus, it is only by a stretch of the imagination that the present application may be considered likely to deceive or cause confusion.¹²

Wherefore, premises considered, the appeal is hereby GRANTED. Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Trademarks for appropriate action. Let a copy of this Decision be furnished also the library of the Documentation, Information and Technology Transfer Bureau for its information and records purposes.

SO ORDERED.

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RICARDO R. BLANCAFLOR
Director General

¹² APPEAL MEMORANDUM dated 07 September 2010, page 8.