



**UNITED AMERICAN
PHARMACEUTICALS INC.,**
Opposer,

-versus-

EDISON LIN,
Respondent- Applicant.

IPC No. 14-2010-00321

Opposition to:
Appln. Serial No. 4-2010-005135
Date Filed: 17 May 2010
TM: "VIGORKEY"

X-----X

NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for Opposer
66 United Street
Mandaluyong City

EDISON LIN
Respondent-Applicant
Rm. 728 No. 516 Quintin Paredes Street
Binondo, Manila

GREETINGS:

Please be informed that Decision No. 2014 - 231 dated September 25, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 25, 2014.

For the Director:


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



**UNITED AMERICAN
PHARMACEUTICALS INC.,**

Opposer,

-versus-

EDISON LIN,

Respondent-Applicant.

x ----- x

IPC No. 14-2010-00321

Opposition to Trademark

Application No. 4-2010-005135

Date Filed: 17 May 2010

Trademark: **"VIGORKEY"**

Decision No. 2014- 231

DECISION

United American Pharmaceuticals Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2010-0005135. The contested application, filed by Edison Lin² ("Respondent-Applicant"), covers the mark "VIGORKEY" for use on "food supplement" under Class 05 of the International Classification of Goods³.

The Opposer maintains that its registered mark "VIGOR-ACE" so resembles Respondent-Applicant's mark "VIGORKEY" as to likely cause confusion, mistake and deception on the part of the purchasing public especially that the opposed mark is applied for the same class and goods as that of its own mark. According to the Opposer, it is engaged in the marketing and sale of a wide range of pharmaceutical products. It filed a trademark application for "VIGOR-ACE" with the Bureau of Patents, Trademarks and Technology Transfer (BPTTT) on 25 January 1989 and was approved for registration on 03 August 1990. On 30 July 2010, it timely filed for renewal of registration of the said mark.

The Opposer asserts that the trademark "VIGOR-ACE" has been extensively used in commerce in the Philippines. It avers that the Intercontinental Marketing Services (IMS) acknowledged and listed the said brand as one of the leading brands in the Philippines in the category of "A11A – Multivitamins + Minerals" in terms of market share and sales performance. It claims to have also registered its product with the Bureau of Food and Drugs (BFAD) in order to legally market, distribute and sell the same in the country.

In support of its Opposition, the Opposer submitted the following:

¹ A domestic corporation organized and existing under the laws of the Philippines, with office address at 132 Pioneer Street, Mandaluyong City, Philippines.

² An individual with office address at Room 728 #516 Quintin Paredes Street, Binondo, Manila.

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.

1. copy of the Respondent-Applicant's trademark application as published in the IPO E-Gazette;
2. certified true copy of Certificate of Registration No. 48755 for the trademark "VIGOR-ACE";
3. copy of the its Petition for Renewal of Registration;
4. certified true copies of its Affidavits of Use;
5. sample product label bearing the trademark "VIGOR-ACE";
6. certification and sales performance from IMS; and
7. copy of the Certificate of Product Registration issued by the BFAD⁴.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 01 July 2011. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued on 02 April 2014 Order No. 2014-450 declaring the Respondent-Applicant in default and the case submitted for decision.

The issue to be resolved in this case is whether the Respondent-Applicant's trademark "VIGORKEY" should be allowed.

Section 123.1 (d) of the IP Code provides that:

"123.1. 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; xxx."

Records reveal that the Opposer filed an application for the mark "VIGOR-ACE" as early as 25 January 1989. The mark was eventually allowed registration on 03 August 1990 under Certificate of Registration No. 048755. On the other hand, the Respondent-Applicant sought application of its mark "VIGORKEY" only on 17 May 2010.

But are competing marks, as reproduced hereafter, confusingly similar?

⁴ Marked as Exhibit "A" to "G".

VIGOR-ACE

Opposer's Mark

Vigorkey

Respondent-Applicant's mark

The contending marks are similar in the sense that they both appropriate the word "vigor". This term, however, is a common English word which anyone can use in conjunction with another word or device. In fact, the Trademark Registry of this Office, which this Bureau may take judicial notice, has registered various marks appropriating the term "vigor" also for goods under Class 05. In particular, the trademarks "VIGOR GREEN & DEVICE" and "VIGOR-SX WITH CHINESE CHARACTERS MEANING VIGOR-SX", both pertaining to products under the same class, are covered by Certificate of Registration Nos. 4-2007-005625 and 4-2007-006767, respectively. These aforementioned registered "VIGOR" marks are issued in favor of different proprietors other than the Opposer herein. The Opposer therefore is not adopting and using "vigor" to the exclusion of others; thus, it is a weak mark. What will then determine whether the competing marks are confusingly similar are the words that precede or succeed the said word.

In this case, the word "vigor" is followed by the word "ace" in the Opposer's mark and "key" in the Respondent-Applicant's. The words "ace" and "key" are clearly and obviously distinguishable in spelling, pronunciation, meaning and impression. Visually and aurally, the subject marks are individualized by their second words such that the term "vigor" pale in significance. Thus, to allow this opposition will only create a dangerous precedent as it will pave way to future cancellation cases of long registered marks that uses the term "vigor". In effect, it will give undue favor to Opposer over the use of the word.

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.⁵ Based on the above discussion, Respondent-Applicant's trademark substantially met this requirement.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-005135 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 25 September 2014.


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

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