



OFFICE OF THE DIRECTOR GENERAL

WOODLANDS SUNNY FOODS
PTE LTD.,

Appellant,

-versus-

DIRECTOR OF THE BUREAU OF
TRADEMARKS

Appellee.

X-----X

Appeal No. 04-2013-0003

Application No. 4-2010-008598
Date Filed: 06 August 2010

Trademark: "VIVO & Device"

NOTICE

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Director, Bureau of Trademarks
Intellectual Property Office
Taguig City

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Transfer Bureau
Intellectual Property Office Taguig City

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DATE: 09/10/14
BY: [Signature]

GREETINGS:

Please be informed that on 09 September 2014, the Office of the Director General issued a Decision in this case (copy attached).

Taguig City, 10 September 2014.

Very truly yours,

[Signature]

ROBERT NEREO B. SAMSON
Attorney V

IPOPHL
CERTIFIED TRUE COPY
DATE: 09/10/14
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DECISION

WOODLANDS SUNNY FOODS PTE LTD. (“Appellant”) appeals the decision of the Director of the Bureau of Trademarks (“Appellee”) sustaining the final rejection of the Appellant’s Trademark Application No. 4-2010-008598 for “VIVO & Device”.

Records show that the Appellant filed on 06 August 2010 an application to register the mark VIVO & Device for use on goods¹ falling under Class Nos. 29 and 30 of the Nice Classification.² On 27 October 2010, the Examiner-in-Charge (“Examiner”) issued a finding³ 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 Appellant filed on 22 December 2010 a response that it is deleting the goods “jellies” and “tea”, and added “whipped cream” and “shortening” to further specify the goods “milk products” and “edible oils”. The Appellant maintained that its goods have different physical properties, characteristics, and purposes and cannot be considered closely similar and competing with those products covered by the registered mark cited by the Examiner. The Examiner issued another official action⁴ stating that the Appellant’s mark nearly resembles a registered mark issued to Jolan Alexander C. Licauco for use on coconut oil, jellies and powdered tea. According to

¹ Class No. 29 – meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jams, compotes, eggs, milk and milk products; whipped cream; edible oils and fats including shortening; margarine, milk substitutes, soups, preparations for making soup.

Class No. 30 – coffee, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; cookies, biscuits, pies, meat pies, salad dressings.

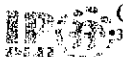
² The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

³ REGISTRABILITY REPORT Paper No. 03 with mailing date of 03 November 2010.

⁴ Paper No. 05 with mailing date of 11 February 2011.

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ATTORNEY AT LAW

the Examiner, even if the Appellant deleted the goods jellies and tea, still, the remaining goods of the Appellant are closely related to the goods covered by the cited mark registered to a different proprietor.

The Appellant filed on 08 June 2011 a response to the Examiner's official action and maintained that its mark is well-known not only in the Philippines but also in Asia, United States, and Europe. The Appellant claimed that its goods are not related and do not share the same class or descriptive characteristics or physical attributes or channel of trade with the goods covered by the mark cited by the Examiner.

On 23 August 2011, the Examiner issued a "FINAL REJECTION"⁵ of the Appellant's application to register VIVO & Device. The Appellant appealed the final rejection to the Director who sustained the Examiner and denied the appeal.⁶

Not satisfied, the Appellant filed on 07 February 2013 an "APPEAL MEMORANDUM" contending that the Director erred in sustaining the final rejection of its trademark application. The Appellant reiterates its arguments that confusion is unlikely given the unrelated, non-competitive nature, type, and characteristics of its goods and those covered by the mark cited by the Examiner. The Appellant asserts that its mark is well-known and has acquired a secondary meaning.

The Appellee filed her "COMMENT" on 04 April 2013 maintaining that the Appellant's mark and the mark cited by the Examiner are identical and cover related goods. Regarding the Appellant's claim that its mark is well-known, the Appellee posits that this is proper in an adversarial proceeding. On the assertion that the Appellant's mark has acquired a secondary meaning, the Appellee maintains that the Appellant's mark is not geographically or otherwise descriptive, thus, no reference to or discussion of secondary meaning could be made in this case.

Subsequently, the Appellant filed on 29 April 2013 a "MEMORANDUM and MANIFESTATION" stating that upon verification of the status of the mark cited by the Examiner, it appears that the applicant for this mark failed to submit a declaration of actual use and proof of commercial use of the mark on the 5th year anniversary of the registration of the mark and/or within the grace period of one year. The Appellant, thus, maintains that there is no more an obstacle to the registration of its mark.

In this regard, this Office requested information and certification from the Bureau of Trademarks (BOT) on the status of the mark that was cited by the Examiner in rejecting the Appellant's trademark application. On 11 February 2014, the BOT issued a "MEMORANDUM" stating that the status of the mark "VIVO AND DEVICE" Trademark Application No. 4-2006-003799 is "Abandoned with Finality".

Paper No. 09 with mailing date of 26 August 2011.
DECISION dated 04 January 2013.

DATE: *ll*

This MEMORANDUM issued by the Director is relevant in the resolution of this appeal. Significantly, the Appellant's application to register VIVO & Device was rejected because of the prior Trademark Application No. 4-2006-003799 for VIVO AND DEVICE. As stated in the "FINAL REJECTION" by the Examiner:

After an examination of the application, the undersigned IPRS has determined that the mark subject of the application cannot be registered because it nearly resembles the mark "VIVO AND DEVICE" under Reg. No. 4-2006-003799 issued on April 23, 2007 to Jolan Alexander C. Licauco for virgin coconut oil, jellies and powdered tea, hence registration is proscribed under Sec. 123.1 (d) of the IP CODE.

In view, however, of the information given by the BOT that the mark VIVO AND DEVICE, which was cited by the Examiner in rejecting the Appellant's trademark application, is abandoned with finality, this Office can now allow the publication of the Appellant's trademark application.

Sec. 133 of Rep. Act No. 8293 known as the Intellectual Property Code of the Philippines ("IP Code") provides in part that:

SEC. 133. Examination and Publication.- 133.1. Once the application meets the filing requirements of Section 127, the Office shall examine whether the application meets the requirements of Section 124 and the mark as defined in Section 121 is registrable under Section 123.

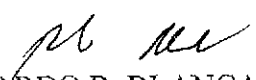
133.2. Where the Office finds the conditions referred to in Subsection 133.1 are fulfilled, it shall, upon payment of the prescribed fee, forthwith cause the application, as filed, to be published in the prescribed manner.

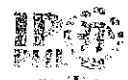
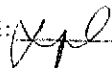
The Appellant's trademark application was not given due course because the subject mark resembles a mark covered by Trademark Application No. 4-2006-003799. However, as this trademark application was abandoned with finality, the Appellant's Trademark Application No. 4-2010-008598 may now be published in accordance with the provisions of the IP Code and the Trademark Regulations.

Wherefore, premises considered, the appeal is hereby GRANTED and the Appellant's Trademark Application No. 4-2010-008598 for VIVO & Device is allowed for publication. 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.

09 SEP 2014 Taguig City


RICARDO R. BLANCAFLOR
Director General


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DATE: 
ROBERT HEREO B. SAMSON
ATTORNEY V
Office of the Director General