



**MALAYSIA DAIRY INDUSTRIES PTE LTD.,**  
Opposer,

**-versus-**

**BETAGEN ASIA LIMITED,**  
Respondent-Applicant.

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**IPC No. 14-2010-00155**  
Opposition to:  
Appln. Serial No. 4-2008-011499  
Date Filed: 22 September 2008  
TM: **"BETAGEN AND  
BOTTLE DESIGN"**

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### NOTICE OF DECISION

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#### GREETINGS:

Please be informed that Decision No. 2015 - 79 dated May 11, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 11, 2015.

For the Director:

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



**MALAYSIA DAIRY INDUSTRIES PTE LTD.,**

Opposer,

-versus-

**BETAGEN ASIA LIMITED,**

Respondent-Applicant.

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IPC No. 14-2010-00155

Opposition to Trademark

Application No. 4-2008-011499

Date Filed: 22 September 2008

Trademark: **"BETAGEN AND  
BOTTLE DESIGN"**

Decision No. 2015- 79

### DECISION

Malaysia Dairy Industries Pte Ltd.<sup>1</sup> ("Opposer") an opposition to Trademark Application Serial No. 4-2008-011499. The contested application, filed by Betagen Asia Ltd.<sup>2</sup> ("Respondent-Applicant"), covers the mark "BETAGEN AND BOTTLE DESIGN" for use on "*dairy products; milk products; milk drinks; fermented milk products; fermented milk drinks; yoghurt; flavoured yoghurts; yoghurt drinks*" under Class 29 of the International Classification of Goods<sup>3</sup>.

According to the Opposer, it began in 1963 as a joint venture between the Thio Keng Poon family and Australian Dairy Produce Board. Five years later, it became a locally-owned entity when the Thio family bought over the Australian interest in the company. The company's first product is sweetened condensed milk but later on, it added more milk products. Malaysia Milk Sdn Bhd, its wholly-owned subsidiary, was established in 1969 to meet the growing demand for milk products in Malaysia. Its operations were started in 1977 with the introduction of its first innovative product, cultured milk called "VITAGEN". Over the past decades, the company experienced growth and has accepted awards and recognitions.

The Opposer maintains that its mark "VITAGEN" is already identified in the public mind as the mark of its well-known cultured milk drink. To preserve the goodwill and fame of its mark, it alleges to have advertised the same in numerous forms of media. It also claims to have been featured in various internet articles, publications, advertising and promotional materials. The Opposer moreover boasts of its trademark registrations and pending applications abroad and in the Philippines.

In support to its Opposition, the Opposer submitted the following as evidence:

<sup>1</sup> A corporation duly organized and existing under the laws of Singapore with principal office at 2 Davidson Road, Singapore, 36994.

<sup>2</sup> A corporation duly organized and existing under the laws of Hong Kong with principal office at 1702-05 Shun Tak Centre, West Tower 200 Connaught Road, Central, Hong Kong.

<sup>3</sup> 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.

**Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE**

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1. statement of Alfred Lim Jee Long;
2. copies of publications featuring the Opposer's mark "VITAGEN";
3. certified copies of international trademark applications and registration for the mark "VITAGEN";
4. affidavit of Amando Aumento, Jr.;
5. printed pages of the Opposer's website where its Vitagen products are found;
6. printed pages of internet websites featuring Vitagen products; and
7. printed data base copies of the Opposer's Philippine trademark applications and registrations of "VITAGEN".<sup>4</sup>

The Respondent-Applicant filed its Verified Answer alleging that it is engaged in the manufacture, distribution and sale of various milk and dairy products such as cultured milk, fermented milk and yogurt products in Thailand, Laos, Cambodia and Vietnam. It maintains that it launched its "BETAGEN" products in 1985 and has been using the mark "BETAGEN AND BOTTLE DESIGN" since 1991. It asserts that the Opposer's bottle design is not distinctive or arbitrary as a survey of dairy bottles in Asia shows that the latter is a common shape or configuration used by most dairy product manufacturers.

The Respondent-Applicant argues that the Opposer's "VITAGEN" and its own mark are completely different in appearance, spelling and sound. It asserts that taking into consideration how both products are sold, marketed and presented in the market with their respective labels and distinct packaging, the two are not identical or confusingly similar. It avers that it is uncommon for consumers to rely on a potentially distinctive configuration to identify the source of the product but instead looks at the word marks used as indicators of their source. In addition, the Respondent-Applicant alleges that the Opposer's marks has either been already abandoned, opposed by another party and/or still pending application.

The Respondent-Applicant's evidence consists of the affidavit of Thanadej Attaskulchai and copies of the trademark search results that pertains to "VITAGEN AND BOTTLE DESIGN".<sup>5</sup>

The Preliminary Conference was conducted and terminated on 11 August 2011. The parties were directed to file their respective position papers within ten days thereafter. After which, the case is deemed submitted for resolution.

The issue to be resolved is whether Respondent-Applicant's mark "BETAGEN AND BOTTLE DESIGN" should be allowed registration.

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<sup>4</sup> Marked as Exhibits "B" to "H", inclusive.

<sup>5</sup> Marked as Exhibits "2" to "3", inclusive.

Prefatorily, 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.<sup>6</sup>

Records reveal that at the time the Respondent-Applicant filed its application on 22 September 2008, the Opposer has pending applications for "VITAGEN & BOTTLE DESIGN" under Trademark Application Serial Nos. 4-2005-012376 and 4-1998-009367 filed on 16 December 2005 and 24 December 1998, respectively, as well as for the mark "VITAGEN (SERIES)" under Trademark Application Serial Nos. 4-2005-012377 and 4-2002-004995 filed on 26 March 2005 and 19 June 2002, respectively.

The Trademark Registry of this Office, however, shows that Application No. 4-2005-012376 has been "finally refused" while 4-1998-009376 has been abandoned. Thus, as the Opposer has no pending application and/or registration for its "VITAGEN AND BOTTLE DESIGN" its allegation that the configurations of the bottles of its products and that of the Respondent-Applicant's are identical has no leg to stand on.

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the competing marks are shown below for comparison:

<b>VITAGEN</b>	<b>VITAGEN</b>
<b><i>Vitagen</i></b>	<b><i>Vitagen</i></b>

*Opposer's marks*

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<sup>6</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.



*Respondent-Applicant's mark*

A perusal of the marks will readily show that they differ only with respect to their first two letters. Be that as it may, the same is insufficient to draw a conclusion that the marks are confusingly similar. The Trademark Registry of this Office shows that there are other registered marks pertaining to milk products also ending with the syllable "GEN" such as "SUSTAGEN" and "SUPLIGEN". The Opposer, therefore cannot claim exclusive use thereto as the suffix "GEN" cannot be considered distinctive to goods covered by its mark.

What will then determine whether the competing marks are confusingly similar are the syllables, words and/or device that precede and/or accompany the common syllable "GEN". In this case, the Opposer's mark begins with the word "VITA" while that of the Respondent-Applicant's with "BETA". The marks are easily differentiated by the configurations of their first two letters. The inverted triangular shape of the letter "V" is easily distinguishable with the straight line and curves forming the letter "B". Likewise in pronunciation, the marks are easily distinguishable. Particularly in the Philippine setting, the Opposer's mark is pronounced as /vay-ta-jen/ while that of the Respondent-Applicant's as /be-ta-gen/. This is apart from the fact that the words "VITA" and "BETA" each have their own connotation. The word "VITA" connotes "vitamins" while "BETA" pertains to the second Greek alphabet.

Finally, 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.<sup>7</sup> Based on the above discussion, the Respondent-Applicant's trademark substantially met this function.

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<sup>7</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2008-011499 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 11 May 2015.

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