



MONAVIE, LLC,
Opposer,

-versus-

EXTRA EXCEL INTERNATIONAL
(PHILS.), INC.,
Respondent-Applicant.

}
} IPC No. 14-2011-00541
} Opposition to:
} Appln. Serial No. 4-2011-005663
} Date Filed: 18 May 2011
} TM: "MENOVIÉ"

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 73 dated May 07, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 07, 2015.

For the Director:


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



MONAVIE, LLC,
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-versus-

**EXTRA EXCEL INTERNATIONAL
(PHILS.), INC.,**

Respondent-Applicant.

X ----- X

IPC No. 14-2011-00541

Opposition to Trademark
Application No. 4-2011-005663
Date Issued: 18 May 2011

Trademark: **"MENOVIÉ"**

Decision No. 2015- 78

DECISION

Monavie, LLC¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-005663. The contested application, filed by John Allan Chan² ("Respondent-Applicant"), covers the mark "MENOVIÉ" for use on *"pharmaceutical as a food supplement capsule"* all under Class 05 of the International Classification of Goods.³

The Opposer claims to be the owner of the mark "MONAVIE", which it registered in the Philippines under Classes 05 and 32 on 23 September 2010. It avers that its mark is well-known and that the registration of the Respondent-Applicant's mark will constitute a violation of Article 6bis and 10bis of the Paris Convention in conjunction with Section 123.1 subparagraphs (e) and (f) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It adds that the "MONEVIÉ" mark is likewise confusingly similar to its trade name and domain name. It alleges to have extensively promoted its mark and has obtained significant exposure for its dietary and nutritional supplements and other health products in various media. It asserts that the Respondent-Applicant's use of the applied mark to goods and services similar or closely related to that of its own will take unfair advantage of, dilute and diminish the distinctive character or reputation of "MONAVIE".

In support of its Opposition, the Opposer submitted the following:⁴

1. affidavit of Graden P. Jackson, with attachments;
2. legalized notary public certification of the "MONAVIE: brochures of "Products with Purpose", "RVL Ob-X", "RVL Ob-X Plus", "The Premiere Acai Blend", Active and RVL;

¹ With address at 10855 South River Front Parkway, South Jordan, Utah 84095, United States of America.

² With address at 23F Rufino Pacific Tower, 6784 Ayala Avenue, Makati City 1226.

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 Exhibits "B" to "EE", inclusive.

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2. legalized notary public certification of the "MONAVIE: brochures of "Products with Purpose", "RVL Ob-X", "RVL Ob-X Plus", "The Premiere Acai Blend", Active and RVL;
3. legalized notary public certification of the "MONAVIE" product information page;
4. computer printouts of the trademark details report for "MONAVIE" under Registration Nos. 4-2010-004486 and 4-2010-004485 both registered on 23 September 2010 downloaded from the Office's website;
5. certified copies of Korean Trademark Registration No. 145306 and Japan Trademark Registration No. 984547 for "MONAVIE" and their English translation;
6. certified copies of Singapore Trademark Registration No. T0910510A, Canada Trademark Registration No, 760,573, New Zealand Trademark Registration No. 795063, Germany Trademark Registration No. 302011030571, Australia Trademark Registration No. 1321227 and United States of America (USA) Trademark Application No. 77/751,195;
7. original publications entitled "Total Wellness Journal", "Bienestar Total Publication" and "Health and Wealth Report";
8. original promotional booklet for "MONAVIE" and RVL;
9. original promotional ad for "Reveal Your Best Self", "MONAVIE" RVL, Premiere Weight Solution and Active Gel;
10. original promotional brochures for "MONAVIE" active gel; and
11. original magazine publication entitled "SUCCESS From Home" dated July 2011.

The Respondent-Applicant filed its Verified Answer alleging that the instant Opposition must be dismissed for the Opposer' failure to timely file a motion for extension to file the same and for the latter's failure to comply with Order No. 2012-208 requiring the Opposer to submit the original certificate showing Graden P. Jackson's authority to sign the verification an certificate of non-forum shopping. According to the Respondent-Applicant, this Bureau issued Order No 2011-1603 dated 16 December 2011 granting the Opposer' request for a thirty (30)-day extension from 02 December or until 01 January 2012 to file the Opposition. The Opposer, however, filed the Opposition only on 02 January 2012. It contends that a motion for extension of time to file a pleading must be filed before the expiration sought to be extended and that the Opposer did not even offer an explanation for its failure to timely file the motion.

The Respondent-Applicant also argues that instead of submitting the certificate showing the authority of Jackson to sign the verification and certificate of non-forum shopping, the Opposer submitted the by-laws of MonaVie, Inc., which provides the powers and duties of its General Counsel; and a letter from Mr. Dell Brown, President, stating that Graden is elected General Counsel effective December 2007. It asserts that according to the Assignment and Assumption Agreement

attached to the Opposer' Compliance dated 14 February 2012, the latter is merely a wholly owned subsidiary of Monavie, Inc. and therefore, separate and distinct from its parent company. It maintains that the letter of Brown should be expunged from the records for being self-serving, for failing to categorically show which company Jackson and Brown are officials, for lack of notarization by the notary and authentication by the appropriate diplomatic or consular office and for being executed only on 07 February 2012 or after the filing of the Opposition.

The Respondent-Applicant further denies that there is likelihood of confusion arguing that its mark "MENOVIÉ" is presented as one word and in uppercase while the Opposer's "MONAVIE" mark contains a period between "MONA" and "VIE" and also presented as "MonaVie". It also posits that the aural similarity is only with respect to the last syllable and that the pronunciations do not sound similar in such a way that consumers might be wrongly led to believe that they refer to the same brand. It explains that "MENOVIÉ" is derived from "MENO", from the word "menopause" and which in medical dictionary means a combining form used with reference to menstruation in the formation of compound words such as "menopause" or "menorrhagia", and "VIE", which is a French word for life.

The Respondent-Applicant submitted the following as evidence the affidavit of Sandra Leh, with attachments.⁵

The issues to be resolved are as follows:

(a) Whether this Opposition should be dismissed for (1) being filed out of time and/or (2) failure to present Graden P. Jackson's authority to sign the verification and certificate of non-forum shopping; and

(b) Whether Respondent-Applicant's applied mark "MENOVIÉ" should be allowed registration.

Firstly, this Bureau will dwell on the procedural issues. Records show that the Opposer filed its motion for extension to file Opposition on 02 January 2012 or a day after its deadline for submission of its Opposition. However, 01 January 2012 was an official holiday. The Director General of the Intellectual Property Office of the Philippines Ricardo R. Blancaflor issued on 19 December 2011 a memorandum stating:

"All papers and documents due on December 26, 2011 may thus still be received on December 27, 2011 while papers and documents due on December 29 and 30, 2011 may thus still be received on the first working day of January 2012 and shall be considered as having been filed on their due dates."

⁵ Exhibit "1".

Thus, the Opposer's filing of a motion for extension on 02 January 2012 is timely. This is likewise in accordance with the provisions of the Rules and Regulations on Inter Partes Proceedings (Office Order No. 99, Series of 2011), which states that "if the last day of filing of the answer or motion for extension falls on a Saturday, Sunday, holiday, non-working day or on a day when the Office of the Bureau is closed for business as may be declared by the Director General, the filing must be done on the next succeeding working day." Also, this Bureau in the interest of justice has approved the said motion for extension in Order No. 2012-51 giving the Opposer additional thirty (30) days from 01 January 2012 or until 31 January 2012 to file the Opposition.

Anent the alleged lack of authority of Graden P. Jackson to sign the verification and the certificate of non-forum shopping, this Bureau finds the certified copy of the Amended Articles of Incorporation and By-Laws of MonaVie, Inc., Assignment and Assumption Agreement, Partial Assignment and Assumption Agreement and the letter of Dell Brown, President of the Opposer, as having sufficiently complied with the Rules as it is able to show that Jackson has been given by the Opposer the authority to as General Counsel to represent the latter in the instant case. Article XI, Section 11.1 of the By-Laws provides that the General Counsel has the authority to sign and execute pleadings, powers of attorney pertaining to legal matters and any other documents in the regular course of his duties. Brown stated in his letter that Jackson was appointed General Counsel since December 2007 thereby confirming the latter's authority to sign the verification and certificate of non-forum shopping.

Going now to the substantial issues, records reveal that at the time Respondent-Applicant filed its application for registration of the contested mark on 18 May 2011, the Opposer already has existing registrations for the mark "MONAVIE" under Certificates of Registration No. 4-201-004485 and 4-2010-004486 both issued on 23 September 2010.

But are the contending marks, as hereafter reproduced, confusingly similar?

MONAVIE

Opposer's marks

MENOVIE

Respondent-Applicant's mark

The competing marks are almost identical in sound and appearance as both consists of seven letters and three syllables and they are spelled almost the same. The differences in their second and fourth letters are insufficient to eradicate the

possibility of confusion, mistake and/or deception. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchased as to cause him to purchase the one supposing it to be the other.⁶

Moreover, the competing marks pertain to similar goods, i.e. supplements under Class 05. Thus, it is highly probable that the purchasers would be led to believe that Respondent-Applicant's mark is a mere variation of Opposer's mark. Withal, the protection of trademarks as intellectual property is intended not only to preserve the goodwill and reputation of the business established on the goods bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods.⁷

Succinctly, the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."⁸

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.⁹ Based on the above discussion, the Respondent-Applicant's trademark fell short in meeting this function. The latter was given ample opportunity to defend his trademark application but Respondent-Applicant failed to do so.

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code, which provides

⁶ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁷ Skechers, USA, Inc. vs. Inter Pacific Industrial Trading Corp., G.R. No. 164321, 23 March 2011.

⁸ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 1772276, 08 August 2010.

⁹ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

or closely related goods or services, or has a near resemblance to such mark as to likely deceive or cause confusion.¹⁰

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-005663 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 07 May 2015.


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

¹⁰ Great White Shark Enterprises vs. Danilo M. Caralde, Jr., G.R. No. 192294, 21 November 2012.