



ON OPTIMUM NUTRITION LTD.,
Opposer,

-versus-

BAYANI LOSTE,
Respondent-Applicant.

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IPC No. 14-2010-00081
Opposition to:
Application No. 4-2009-007908
Date filed: 07 August 2009
TM: **"SUSTAIN PRO
COMPLEX GOLD"**

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NOTICE OF DECISION

**VERA LAW
DEL ROSARIO RABOCA GONZALES & GRASPARIL**
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Makati City

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GREETINGS:

Please be informed that Decision No. 2015 - 110 dated May 28, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 28, 2015.

For the Director:


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



ON OPTIMUM NUTRITION LTD.,
Opposer,

-versus

BAYANI LOSTE,
Respondent-Applicant.

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}IPC NO. 14-2010-00081
}Opposition to:
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}Appln. No. 4-2009-007908
}Filing Date: 7 August 2009
} Trademark: SUSTAIN PRO
}COMPLEX GOLD
}
} Decision No. 2015- 110

DECISION

ON OPTIMUM NUTRITION LTD.. (Opposer)¹ filed an opposition to Trademark Application Serial No. Appln. No. 4-2009-007908. The application, filed by BAYANI LOSTE(Respondent-Applicant)², covers the mark “SUSTAIN PRO COMPLEX GOLD”, for use on “Food supplement” under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

“10. The registration of the mark ‘SUSTAIN PRO COMPLEX GOLD’ in the name of the Respondent will violate and contravene Section 123.1 (e) and (g) of the Intellectual Property Code because said mark is identical to or confusingly similar to the internationally well-known mark ‘PRO-COMPLEX’ owned, registered and unabandoned by the Opposer.

“11. Section 123.1 paragraphs (e) and (g) provides:

Section 123. Registrability.-123.1. A mark cannot be registered if it:

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark with which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the public at large,

¹ A corporation duly organized and existing under the laws of the State of Illinois with address at 700 N. Commerce Street, Aurora, IL 60504, USA

² Filipino with address at 16 Constellation St. Bel Air, Makati City

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

including knowledge in the Philippines which has been obtained as a result of the promotion of the mark; xxx

(g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods and services;"

According to the Opposer:

"12. Opposer is the owner and the prior user of the mark 'SUSTAIN PRO COMPLEX GOLD', having used the same in connection with food supplements in as early as 1995 or some 15 years ago.

"13. Since its first use in 1995, the popularity of the mark 'PRO COMPLEX' spread like a wildfire and quickly became a by-word in the food supplements industry.

"14. To supplement and further enhance the popularity of 'PRO-COMPLEX' products, Opposer has engaged in extensive advertising and marketing campaign to promote the 'PRO-COMPLEX' mark.

"16. During the period from 2006 to 2009, Opposer has spent at least 1.4 Million US Dollars or approximately 80 Million Pesos in advertising and marketing campaigns.

"17. Opposer likewise maintains the website www.optimumnutrition.com where information about Opposer and its 'PRO-COMPLEX' line of products can be seen. xxx

"24. It should be reiterated that, as shown by the invoices and shipping documents, Opposer has been selling and marketing 'PRO-COMPLEX' products in the Philippines as early as 2003 several years before the Respondent even attempted to apply for the registration of a similar mark.xxx"

To support its opposition, the Opposer submitted as evidence the following:

1. Special Power of Attorney dated 12 March 2010;
2. Verification and Certification dated 6 April 2010;
3. Copy of website print-out of status of "Sustain Pro Complex Gold" application;
4. Copy of USPTO Reg. No. 3,311,720 for the mark "PRO COMPLEX" dated 16 October 2007;
5. Copy of Korean registration for the mark "PRO COMPLEX";
6. Photocopies of advertising materials for "PRO COMPLEX";
7. Print-out of web pages of www.optimumnutrition.com with information about "PRO COMPLEX"; and

8. Copies of Sales invoices with the product description of "PRO COMPLEX"⁴

The Respondent-Applicant, in its Answer, alleged among other things, the following:

"11. Respondent-Applicant is the duly appointed Corporate Secretary of SLC LIFE SUPPLEMENTS, INC. (formerly HLC LIFE SUPPLEMENTS, INC.). He has been given authority to apply for the mark "SUSTAIN PRO-COMPLEX GOLD" as indicated in the Secretary's Certificate dated 5 August 2010.

"12. SLC LIFE SUPPLEMENTS, INC. is engaged in the business of selling and distributing, among others, food supplements.

"13. Among the products being sold by SLC LIFE SUPPLEMENTS, INC. is a supplement with the brand name 'Sustain Pro Complex.' SLC LIFE SUPPLEMENTS, INC. began marketing and distributing 'Sustain Pro Complex' sometime in June 2008.

"14. On 17 June 2009, SLC LIFE SUPPLEMENTS, INC. secured a Certificate of Product Registration (CPR) for the food supplement 'Sustain Pro Complex.'

"15. In order to protect its brand, SLC LIFE SUPPLEMENTS, INC. authorized its Corporate Secretary to apply the trademark 'SUSTAIN PRO COMPLEX' with the Bureau of Trademarks with the Intellectual Property Office (IPO). On 8 September 2008, the trademark 'SUSTAIN PRO COMPLEX' was issued Certificate of Registration with the Registration No. 4-2008-005986.

"16. To optimize its food supplements product line. SLC LIFE SUPPLEMENTS, INC. created 'SUSTAIN PRO COMPLEX GOLD' label for distribution to health clubs and clinics. SLC LIFE SUPPLEMENTS, INC. is the owner and prior user of the mark 'SUSTAIN PRO COMPLEX GOLD', contrary to the allegation of the opposer.

"17. Likewise, SLC LIFE SUPPLEMENTS, INC. then instructed its Corporate Secretary to secure a trademark registration for the label 'SUSTAIN PRO COMPLEX GOLD'.

The Respondent-Applicant submitted as evidence, the following:

1. Copy of Secretary's Certificate dated 5 August 2010;
2. Copy of Certificate of Product Registration dated 17 June 2011 for "SLC SUSTAIN PRO COMPLEX with N-Acetylcysteine";

⁴ Exhibits "A" to "J"

3. Photocopies of pictures of "SUSTAIN PRO COMPLEX GOLD" products;
4. Print-out of relevant pages of USPTO websites on trademarks "PRO-EPIL COMPLEX" and "PRO-CARBO COMPLEX";
5. Copy of relevant pages of website of Klaire, Labs, Inc./Pro Thera, Inc;
6. Copy of Bureau of Food and Drugs (BFAD), Bureau Order No. 163, series of 1997 dated 16 August 1999;
7. Copy of BFAD Bureau Circular No. 18, series of 1999 dated 16 August 1999;
8. Copy of BFAD Circular 2007-006-A dated 24 March 2008;
9. Copy of BFAD Circular 2007-006 dated 12 July 2007; and
10. Copies of affidavits of users "SUSTAIN PRO COMPLEX" namely: Glenn del Rosario, Edith Zabala and Normita F. Demandante; and
11. Affidavit of Bayani B. Loste dated 6 August 2010.⁵

On 05 August 2011, the Preliminary Conference was held wherein only the Respondent-Applicant appeared. Thus, the Preliminary Conference was terminated and the Respondent-Applicant was directed to file his position paper and the Opposer was considered to have waived his right to file the same. The Respondent-Applicant filed his position paper 15 August 2011.

Should the Respondent-Applicant be allowed to register the trademark SUSTAIN PRO COMPLEX GOLD?

Records show that at the time Respondent-Applicant applied for registration of the mark "SUSTAIN PRO COMPLEX GOLD", it had obtained Registration No. 42008005986 for the mark "SUSTAIN PRO COMPLEX" on 8 September 2008 in the name of SLC Life Supplements, Inc. The Opposer on the other hand, registered the mark "PRO COMPLEX" in the United States of America under United States Patent and Trademark Office (USPTO) Registration No. 3-311-720⁶ on 16 October 2007 and in the Korean Intellectual Property Office under Registration No. 723188⁷ on 4 September 2007. The goods covered by the Opposer's trademark registration are also under Class 5 namely "dietary supplements", same as indicated in the Respondent-Applicant's trademark application for "food supplements".

The competing marks are similar in so far as the Respondent-Applicant's mark contain the words "PRO COMPLEX" which comprises the Opposer's mark, to wit:

PRO COMPLEX

Opposer's mark

**SUSTAIN PRO
COMPLEX
GOLD**

Respondent-Registrant's mark

⁵ Exhibits "1" to "11" with submarkings

⁶ Exhibit "D"

⁷ Exhibit "E"

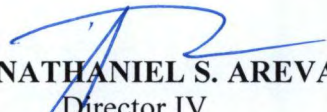
The Respondent-Applicant's mark, however, also includes the words "SUSTAIN" and "GOLD". In this regard, this Bureau cannot rule in favor of the Opposer on the basis of the words "PRO COMPLEX" alone. To sustain the opposition on the ground of the commonality between the marks as to the words "PRO COMPLEX" would have the effect of giving the Opposer exclusive use of these words as a mark and/or as part thereof for use on dietary supplements and related products. The Trademarks Registry, the contents of which this Bureau can take cognizance of via judicial notice, shows registered marks, similarly containing the words "PRO COMPLEX", belonging to different proprietors.

Thus, the words "PRO COMPLEX" as a mark or as parts thereof, are not unique to the Opposer nor to its goods. To emphasize, the trademark registry⁸ is replete with trademarks under class 5, with the words "PRO COMPLEX" belonging to different proprietors, including "PRO MULTIPLE WHITE COMPLEX"; "AMINO PRO-V COMPLEX"; "MARY KAY PANTHENOL-PRO COMPLEX"; "INTELLIGENT PRO-CELL COMPLEX". This Bureau agrees with the Respondent-Applicant's observation that even in the jurisdiction of the Opposer's principal office, there are other trademark owners whose trademark features the words "PRO" and "COMPLEX" are used, namely "PRO-EPIL COMPLEX"; "PRO-CARBO COMPLEX" and "PRO BIOTIC COMPLEX".⁹ Succinctly, the prevalent use by different proprietors of the words "PRO COMPLEX" as part of trademarks only shows that confusion or mistake is unlikely in this instances. The words "SUSTAIN" and "GOLD" accompanying the words "PRO COMPLEX" are sufficient to distinguish the Respondent-Applicant's mark and goods from other proprietors, including the Opposer to describe its food supplement product.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2009-007908 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 28 May 2015.


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

⁸ <http://www.wipo.int/branddb/ph/en/>

⁹ Exhibits "4"- "5"