



UNITED LABORATORIES, INC.,

Opposer,

-versus-

VITAL C HEALTH PRODUCTS, INC.,

Respondent-Applicant.

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IPC No. 14-2013-00141

Opposition to:

Application No.4-2012-710189

Date filed: 11 July 2012

TM: "VITAWHITE"

NOTICE OF DECISION

OCHAVE & ESCALONA

Counsel for Opposer
No. 66 United Street
Mandaluyong City

VITAL C HEALTH PRODUCTS, INC.


Respondent-Applicant
Suite 1902 The Centerpoint Building
Julia Vargas Avenue corner Garnet Road
Ortigas Center, Pasig City

GREETINGS:

Please be informed that Decision No. 2015 - 220 dated October 20, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 20, 2015.

For the Director:


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



UNITED LABORATORIES, INC.,
Opposer,

- versus -

VITAL C HEALTH PRODUCTS, INC.,
Respondent-Applicant.

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IPC No. 14-2013-00141
Opposition to:

Appln. No. 4-2012-710189
Date Filed: 11 July 2012
Trademark : "VITALWHITE"

Decision No. 2015 - 220

DECISION

UNITED LABORATORIES, INC. ("Opposer"),¹ filed a verified opposition to Trademark Application Serial No. 4-2012-710189. The application, filed by VITAL C HEALTH PRODUCTS, INC. ("Respondent-Applicant"),² covers the mark "VITALWHITE" for use on "*glutasoap*" under class 03; and, "*vitamins preparations (the glutathione booster)*" under class 05 of the International Classification of Goods.³

The Opposer alleges the following grounds for the opposition:

"7. The mark 'VITALWHITE' owned by Respondent-Applicant so resembles the trademark 'VITAWHITE' owned by Opposer and duly registered with the IPO prior to the publication for opposition of the mark 'VITALWHITE' and thus, will likely cause confusion, mistake and deception on the part of the purchasing public.

"8. The mark 'VITALWHITE' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'VITALWHITE' is applied for the same class and goods (Classes 3 and 5) as that of Opposer's trademark 'VITAWHITE' (Class 3) as beauty products.

"9. The registration of the mark 'VITALWHITE' in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code.

Under the above-quoted provision, any mark, which is similar to a registered mark shall be denied registration in respect of similar or related goods or if the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

The Opposer's evidence inclusive of annexes consists of the following:

1. Pertinent page of the IPO E-Gazette;
2. Certified true copy of Registration No. 4-2005-011137 for VITAWHITE;
3. Certified true copy of Deed of Assignment of the trademark VITAWHITE;

¹ A corporation duly organized and existing under the laws of the Philippines, with office address at 66 United Street, Mandaluyong City.

² A domestic corporation with address at Suite 1902, The Centerpoint Bldg., Julia Vargas Ave., corner Garnet Road, Ortigas Center, Pasig City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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. Certified true copies of Declarations of Actual Use;
5. Sample product label of the trademark VITAWHITE;
6. Certification reflecting the sales performance of VITAWHITE; and,
7. Certified true copy of Certificate of Product Registration of products bearing the trademark VITAWHITE.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 22 April 2013. However, this Bureau did not receive an answer and thus, Respondent-Applicant is declared in default and this case is deemed submitted for decision.⁴

Should the Respondent-Applicant be allowed to register the trademark VITAL WHITE?

Section 123.1 paragraph (d) of R.A. No. 8293, also known as the Intellectual Property Code ("IP Code") provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services if it nearly resembles such mark as to be likely to deceive or cause confusion.

Records show that the Opposer⁵ has registration falling under Class 03 for the trademark VITAWHITE dated 19 February 2007 for skincare products namely: facial moisturizer; lotion; facial wash; and body wash.⁶ It has also shown attached documents showing use in the market through the Declarations of Actual Use within three (3) years from filing⁷, and within one year from the fifth anniversary of the registration of the mark.⁸

But, are the contending marks, depicted below, resemble each other such that confusion, even deception, is likely to occur?



Opposer's Trademark



Respondent-Applicant's Trademark

The foregoing marks appear almost visually identical except for the letter "L" in VITAL WHITE of Respondent-Applicant's mark, as against VITAWHITE of Opposer's mark. Moreover, the subject trademark consists of two word "VITAL" and "WHITE", compared to the single word mark "VITAWHITE" of that of Opposer's. As to the sound produced, there is no doubt that the competing

⁴ Order No. 2012-1424 dated 03 September 2013.
⁵ Exhibit "C" of Opposer.
⁶ Exhibit "B" of Opposer.
⁷ Exhibit "D" of Opposer.
⁸ Exhibit "D-1" of Opposer.

marks have roughly identical aural character and when spoken, create an apparent aural similarity creating the likelihood of confusion of one mark as against the other.

Further, a scrutiny of the goods covered by the mentioned marks show the relatedness of the products covered by the competing marks. Opposer's VITAWITE is a skincare product particularly for facial moisturizer, lotion, facial wash and body wash. The actual packaging indicates the words "Whitening Face Lotion" below the mark VITA WHITE.⁹ Respondent-Applicant VITAL WHITE is a vitamins preparation or glutathione booster. In ordinary parlance, a glutathione booster is also known as an oral skin whitening booster. Products of this kind is common in the market.¹⁰ While they do not belong to the same classification of goods, the objective of both product is to whiten skin complexion. Thus, they are intended for the same purpose and use, cater to the same group of purchasers, and available in the same channels of trade.

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 purchaser as to cause him to purchase the one supposing it to be the other.¹¹ Colorable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.¹²

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.¹³ The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court.¹⁴

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 on 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 of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Hence, 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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

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

⁹ Exhibit "E" of Opposer.

¹⁰ Relumins, available at <http://www.relumins.com/products/relumins-glutathione-booster>; Active White Max Glutathione Booster yellow gels, available at <http://www.lazada.com.ph/active-white-max-glutathione-booster-yellow-softgels-200935.html>.

¹¹ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

¹² Emerald Garment Manufacturing Corp. v. Court of Appeals, G.R. No. 100098, 29 December 1995.


¹³ American Wire and Cable Co. v. Director of Patents, et al., 31 SCRA 544, G.R. No. L-26557, 18 February 1970.

¹⁴ Converse Rubber Corporations v. Universal Rubber Products, Inc. et al., G.R. No. L-27906, 08 January 1987.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-710189 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 20 October 2015.



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