

PEDIATRICA, INC.,
Opposer,

IPC No. 14-2009-00043
Case Filed: 05 February 2009

Opposition to:

- versus -

Appl'n Serial No.: 4-2008-010034
Date Filed: 19 August 2008
Trademark: "C-PLUS TO THE MAX"

PHILKRAFT MARKETING CORP.
Respondent-Registrant,
X-----X

Decision No. 2009-85

DECISION

This pertains to the opposition to the registration of the mark "C-PLUS TO THE MAX" bearing Application No. 4-2008-010034 filed on August 19, 2008 covering the goods "vitamin and minerals" falling under class 5 of the International Classification of goods which application was published for opposition on page three (3) of the Intellectual Property Philippines (IPP) E-Gazette, officially released on November 07, 2008.

The Opposer in this instant case is "PEDIATRICA, INC." a corporation duly organized and existing under the laws of the Philippines, with principal office located at 3rd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.

On the other hand, the Respondent-Applicant is "PHILKRAFT MARKETING CORP.," a domestic corporation with principal address at No. 82 J.P. Rizal Street, Makati City.

The grounds of the opposition are as follows:

"1. That the trademark "C-PLUS" so resembles "ZEEPLUS" trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark "C-PLUS". The trademark "C-PLUS", which is owned by Respondent-Applicant, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark "C-PLUS" is applied for the same class of goods as that of trademark "ZEEPLUS", i.e. Class 5; vitamin preparation.

"2. The registration of the trademark "C-PLUS" in the name of the Respondent-Applicant will violate Section 123 of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines", which provides, in part, that a mark cannot be registered if it:

"(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or
- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;" (Emphasis supplied)

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.

“3. Respondent-Applicant’s use and registration of the trademark “C- PLUS” will diminish the distinctiveness and dilute the goodwill of Opposer’s trademark “ZEEPLUS”.

Opposer relied on the following facts in support of its opposition:

“4. Opposer, the registered owner of the trademark “ZEEPLUS”, is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the mark “ZEEPLUS” was originally filed with the Intellectual Property Office on 11 May 2006 by Opposer and was approved for registration by this Honorable Office on 28 May 2007 and valid for a period of ten (10) years. Hence, Opposer’s registration of the “ZEEPLUS” trademark subsists and remains valid to date. Attached are copies of Certificate of Registration Number 42006004978 for the trademark “ZEEPLUS” marked as Annex “B”.

“5. The trademark “ZEEPLUS” has been extensively used in commerce in the Philippines.

5.1 Opposer dutifully filed Affidavits of Use pursuant to the requirement of law, to maintain the registration of “ZEEPLUS” in force and effect. A copy of the Declaration of Actual Use filed by Opposer is hereto attached as Annex “C”.

5.2 A sample of product label bearing the trademark “ZEEPLUS” actually used in commerce is hereto attached as Annex “D”.

5.3 In order to legally market, distribute and sell these pharmaceutical preparations in the Philippines, the products using the mark ZEEPLUS were registered with the Bureau of Food and Drugs (BFAD). A copy of the Certificate of Product Registration issued by the BFAD for the product “ZEEPLUS” is hereto attached as Annex “E”.

5.4 No less than the Intercontinental Marketing Services (IMS) itself, the world’s leading provider of business intelligence and strategic consulting services for the pharmaceutical and healthcare industries with operations in more than 100 countries, acknowledged and listed the brand “ZEEPLUS” as the leading brand in the Philippines in the category of “Vitamin C” in terms of market share and sales performance. (Attached is a copy of the certification and sales performance marked as Annex “F”)

“6. There is no doubt that by virtue of the above-mentioned Certificate of Registration, the uninterrupted use of the trademark “ZEEPLUS”, and the fact that they are known among consumers, as well as to internationally known pharmaceutical information provider, the Opposer has acquired an exclusive ownership over the “ZEEPLUS” marks to the exclusion of others.

“7. C-PLUS is confusingly similar to “ZEEPLUS”.

7.1 There is no set of rules that can be deduced in particularly ascertaining whether one trademark is confusingly similar to, or is a colorable imitation of another. Nonetheless, jurisprudence provides enough guidelines and tests to determine the same.

7.1.1 In fact, in *Societe Des Produits Nestle S.A. vs. Court of Appeals* [356 SCRA 207, 216] the Supreme Court, citing *Etepha vs. Director of Patents*, held “[i]n determining if colorable imitation exists, jurisprudence has developed two kinds of tests - Dominancy Test and the Holistic Test. The test of dominancy focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or

deception and thus constitute infringement. On the other side of the spectrum, the holistic test mandates that the entirety of the marks in question must be considered in determining confusing similarity.

7.1.2 It is worthy to note at this point that in *Societe Des Produits Nestle, S.A. vs. Court of Appeals* [Supra, p. 221] the Supreme Court held “[T]he totality or holistic test relies on visual comparison between two trademarks whereas the dominance test relies not only on the visual but also on the aural and connotative comparison and overall impressions between the two trademarks.”

7.1.3 Relative thereto, the Supreme Court in *McDonalds’ Corporation vs. L.C. Big Mak Burger, Inc.*, [147 SCRA 10] held:

“This Court, however, has relied on the dominance test rather than the holistic test. The dominance test considers the dominant features in the competing marks in determining whether they are confusingly similar. Under the dominance test, courts give greater weight to the similarity of the appearance of the product arising from the adoption of the dominant features of the mark, disregarding minor differences. Courts will consider more the aural and visual impressions created by the marks in the public mind, giving little weight to factors like prices, quality, sales outlets and market segments.”

Thus, in the 1954 case of *Co Tiong Sa vs. Director of Patents*, the Court ruled:

“...It has been consistently held that the question of infringement of a trademark is to be determined by the test of dominance. Similarity in size, form and color, while relevant, is not conclusive. If the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement take place. Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate. (*G. Heilman Brewing Co., vs. Independent Brewing Co.*, 191 F., 489, 495, citing *Eagle White Lead Co., vs. Pflugh* (CC) 180 Fed. 579). The question at issue in cases of infringement of trademarks is whether the use of the marks involved would be likely to cause confusion or mistakes in the mind of the public or deceive purchasers. (*Auburn Rubber Corporation vs. Honover Rubber Co.*, 107 F. 2d 588;) (Emphasis Supplied.)

xxx”

7.1.4 Applying the dominance test, it can be readily conclude that the trademark “C-PLUS”, owned by the Respondent-Applicant, so resembles the trademark “ZEEPLUS”, that it will likely cause confusion, mistake and deception on the part of the purchasing public.

7.1.4.1 First “C-PLUS sounds almost the same as ZEEPLUS”;

7.1.5 Clearly, the Respondent-Applicant adopted the dominant features of the Opposer’s mark “ZEEPLUS”;

7.1.6 As further ruled by the High Court in *McDonalds’ case* [p.33];

“In short, aurally the two marks are the same, with the first word of both marks phonetically the same, and the second word of both marks also phonetically the same. Visually, the two marks have both words and six letters, with the first word of both marks having the same letters and the second word having the same first two letters. In spelling, considering the Filipino language, even the last letters of both marks are the same.

x x x “

“The Court has taken into account the aural effects of the words and letters contained in the marks in determining the issue of confusing similarity.”

7.2 The trademark “ZEEPLUS” and Respondent’s trademark “C-PLUS” are practically identical marks in sound and appearance that they leave the same commercial impression upon the public.

7.2.1 Thus, the two marks can easily be confused for one over the other, most especially considering that the opposed trademark “C-PLUS” is applied for the same class and goods as that of trademark “ZEEPLUS”, i.e. Class (5), to the Opposer’s extreme damage and prejudice.

7.3 Yet, Respondent still filed a trademark application for “CPLUS” despite its knowledge of the existing trademark registration of “ZEEPLUS” which is confusingly similar thereto in both its sound and appearance.

“8. Moreover, Opposer’s intellectual property right over its trademark is protected under Section 147 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines (“IP Code”), which states:

“The owner of a registered mark shall have the exclusive right to prevent all parties not having the owner’s consent from using in the course of trade identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion.” (Emphasis supplied).

“9. To allow Respondent-Applicant to continue to market its products bearing the “C-PLUS” mark undermines Opposer’s right to its marks. As the lawful owner of the mark “ZEEPLUS”, Opposer is entitled to prevent Respondent-Applicant from using a confusingly similar mark in the course of trade where such would likely mislead the public.

9.1 Being the lawful owner of “ZEEPLUS”, Opposer has the exclusive right to use and/or appropriate the said marks and prevent all third parties not having its consent from using in the course of trade identical or similar marks, where such would result in a likelihood of confusion.

9.2 By virtue of Opposer’s ownership of the trademark “ZEEPLUS”, it also has the right to prevent third parties, such as Respondent-Applicant, from claiming ownership over Opposer’s marks or any depiction similar thereto without its authority or consent.

9.3 Moreover, following the illustrative list of confusingly similar sounds in trademarks which the Supreme Court cited McDonald’s Corporation, McGeorge Food Industries, Inc. vs. L.C. Big Mak Burger, Inc., 437 SCRA 268 (2004), it is evident that the mark “C-PLUS” is aurally confusingly similar to Opposer’s mark “ZEEPLUS”.

9.4 To allow Respondent-Applicant to use its “C-PLUS” mark on its product would likely cause confusion or mistake in the mind of the public or deceive purchasers into believing that the “C-PLUS” products of Respondent-Applicant originate from or is being manufactured by Opposer, or at the very least, is connected or associated with the “ZEEPLUS” products of Opposer, when such connection does not exist.

9.5 In any event, as between the newcomer, Respondent-Applicant, which by the confusion loses nothing and gains patronage unjustly by the association of its products bearing the “C-PLUS” mark with the well-known “ZEEPLUS” mark, and the first user and actual owner of the well-known mark, Opposer, which by substantial investment of time

and resources and by honest dealing has already achieved favor with the public and already possesses goodwill, any doubt should be resolved against the newcomer, Respondent-Applicant, considering that Respondent-Applicant, as the latter entrant in the market had a vast range of marks to choose from which would sufficiently distinguished its products from those existing in the market.

“10. By virtue of Opposer’s prior and continued use of the trademark “ZEEPLUS”, the same have become well-known and established valuable goodwill to the consumers and general public as well. The registration and use of Respondent’s confusingly similar trademark on its goods will enable the latter to obtain benefit from Opposer’s reputation, goodwill and advertising and will tend to deceive and/or confuse the public into believing that Respondent is in any way connected with the Opposer.

“11. Likewise, the fact that Respondent seeks to have its mark “C-PLUS” registered in the same class (NICE Classification 5) as the trademark “ZEEPLUS” of Opposer will undoubtedly add to likelihood of confusion among the purchasers of these two goods.

“12. Thus, Opposer’s interests are likely to be damaged by the registration and use of the Respondent-Applicant of the trademark “C-PLUS”. In support of the foregoing, the instant Opposition is herein verified by Mr. Roberto Munoz which likewise serves as his affidavit (Nasser vs. Court of Appeals, 191 SCRA 786 [1990]).

Respondent-Applicant failed to file its answer despite having received the Notice to Answer issued by the Bureau of Legal Affairs (BLA) on February 11, 2009.

Section 11 of the Summary Rules (Office Order No. 79, Series of 2005), provides:

Section 11. *Effect of failure to file an Answer.* - In case the Respondent-Applicant fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the Petition or Opposition, the affidavit of the witnesses and documentary evidence submitted by the Petitioner or Opposer.

Opposer submitted the following in support of its opposition:

Annex	Description
Annex “A”	Trademark published for opposition, released November 11, 2008
Annex “B”	Certificate of Registration No. 4-2006-004978 for the mark “ZEEPLUS” issued on May 28, 2007 covering the goods “ <i>vitamin preparation</i> ” in Class 5 of the International Classification of goods.
Annex “C”	Declaration of Actual Use (DAU) for the mark “ZEEPLUS” filed on December 11, 2007.
Annex “D”	Actual labels of the mark “ZEEPLUS”
Annex “E”	Certificate of Product Registration for the mark “ZEEPLUS” issued by the Bureau of Food and Drugs (BFAD).
Annex “F”	Certification signed by Mr. Leo R. Yap Jr. country manager IMS Health Philippines, Inc.

The issue to be resolved in this particular case is:

WHETHER OR NOT RESPONDENT-APPLICANT IS ENTITLED TO THE REGISTRATION OF THE MARK “C-PLUS TO THE MAX”.

The applicable provision of law is Section 123.1 (d) of Republic Act No. 8293, which provides:

Section 123.1. A mark cannot be registered if it:

“(d) Is identical with a registered mark belonging to a different proprietor or mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or
- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;”

The contending trademarks are reproduced below for comparison and scrutiny.



Opposer's mark



Respondent-Applicant's mark

The Opposer's mark consists of the word "ZEEPLUS" and the Respondent-Applicant's mark consists of the words or phrases "C-PLUS TO THE MAX".

The very reason why the Opposer opposed the registration of the Respondent-Applicant's trademark is due to the presence or inclusion of the word "C-PLUS" which according to the Opposer, is confusingly similar to its trademark "ZEEPLUS".

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. (87 C.J.S. pp 288-291) Some such factors as sound; appearance; form, style shape, size or format; color, idea connoted by the mark; the meaning, spelling and pronunciation of the words used; and the setting in which the words appear may be considered, (87 C.J.S. pp. 291-292) for indeed, trademark infringement is a form of unfair competition (Clark vs. Manila Candy Co., 36 Phil. 100, 106; Co Tiong Sa vs. Director of Patents, 95 Phil. 1, 4).

Confusion is likely between trademarks only if their over-all presentation in any of the particulars of *sound*, appearance or meaning are such as would lead the purchasing public into believing that the products to which the marks are applied emanated from the same source.

In the case at bar, the contending trademarks although they differ in their entire composition, yet the inclusion of the phrase "C-PLUS" in the Respondent-Applicant's mark would rise to the existence of confusing similarity to Opposer's mark "ZEEPLUS" because they have the same pronunciation/or their sounds are almost identical.

It cannot be denied that the Respondent-Applicant's mark is a composite one simply because it consists of more than one component, and one of which is the phrase "C-PLUS" the part that comes first which is the most pronounced and which had the same sound with Opposer's "ZEEPLUS". Where goods are advertised over the radio, similarity of sound is of special significance. Similarity of sound is a sufficient ground for holding that the two trademarks are confusingly similar when applied to merchandise of the same descriptive properties.

In this particular case, the competing trademarks cover exactly the same goods “*vitamin*” under Class 5 of the international classification of goods.

Records will show that the Opposer’s trademark “ZEEPLUS” has been registered with the Intellectual Property Philippines (IPP) under Registration No. 4-2008-004978, with date of registration May 28, 2007 covering the goods “vitamin preparation” in Class 5 (Annex “B”). The use and adoption by the Respondent-Applicant of substantially the same mark as subsequent user can only mean the applicant wishes to reap the goodwill benefit from the advertising value and reputation of Opposer’s mark.

When one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark, this not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill. (Chuanchow Soy & Canning Co., vs. The Director of Patents and Rosario Villapanta [G.R. No. L-13947, June 30, 1960]).

The Respondent-Applicant’s mark cannot avoid or escape confusing similarity by the fact that it disclaimed the exclusive use of the word “C-PLUS” because it is still a part of its trademark.

In “American Wire & Cable Co., vs. Director of Patents et.al., 31 SCRA 544 [G.R. No. L-26557, February 18, 1970], the Supreme Court ruled:

“The determinative factor in a contest involving registration of trade mark is not whether the challenged mark would *actually* cause confusion or deception of the purchasers but whether the use of such mark would *likely* cause confusion or mistake on the part of the buying public. In short, to constitute an infringement of an existing trademark patent and warrant a denial of an application for registration, 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.”

In trademark registration cases, the Certificate of Registration is a prima facie evidence of the validity of the registration, the registrant’s ownership of the mark and of the exclusive right to use the same in connection with the goods or services and those that are related thereto (Levi Strauss & Co., vs. Clinton Apparelle, Inc., 470 SCRA, 253-254 (2005)).

WHEREFORE, in light of all the foregoing, the opposition is, as it is hereby SUSTAINED. Consequently, Application No. 4-2008-010034 filed on August 19, 2008 by Respondent-Applicant “PHILKRAFT MARKETING CORP.” for the registration of the mark “C-PLUS TO THE MAX” is, as it is hereby REJECTED.

Let the filewrapper of the trademark “C-PLUS TO THE MAX” subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 06 July 2009.

ESTRELLITA BELTRAN ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property of Office