



UNITED LABORATORIES, INC.,
Opposer,

- versus -

MEDHAUS PHARMA, INC.,
Respondent-Applicant.

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IPC No. 14-2009-00238
Opposition to:

Appln. Ser. No. 4-2007-010244
Date Filed: 17 September 2007

Trademark: **ENERVIT**
Decision No. 2012 - 48

DECISION

UNITED LABORATORIES, INC.¹ ("Opposer") filed on 12 October 2009 a Verified Opposition to Trademark Application No. 4-2007-010244. The application, filed by MEDHAUS PHARMA, INC.² ("Respondent-Applicant"), covers the mark ENERVIT for use on "vitamins" under Class 05 of the International Classification of Goods³.

The Opposer alleges the following:

"1. The trademark ENERVIT so resembles the trademark ENERVON-C (ENERVON) owned by Opposer. The trademark ENERVIT, which is owned by Respondent, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark ENERVIT is applied for the same class and good as that of trademark ENERVON, i.e. Class 5 vitamin preparation.

"2. The registration of the trademark ENERVIT in the name of the Respondent will violate Sec. 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:

x x x

"3. Respondent's use and registration of the trademark ENERVIT will diminish the distinctiveness and dilute the goodwill of Opposer's trademark ENERVON."

The Opposer's evidence consists of the following:

1. Exhibit "A" - Computer print-out showing Trademarks Published for

1 A corporation duly organized and existing under the laws of the Republic of the Philippines with principal office located at No. 66 United Street, Mandaluyong City.
2 A domestic corporation with principal address at 139 K. First St., Kamuning, Quezon City.
3 The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

Opposition released on 13 July 2009;

2. Exhibit "B" - Certified copy of Certificate of Registration No. 14854 for the trademark ENERVON-C;
3. Exhibit "C" - Certified copy of Assignment of Registered Trademark filed on 13 October 2005;
4. Exhibit "D" - Certified copy of Assignment of Registered Trademark filed on 26 March 2009;
5. Exhibit "E" - Certified copy of Affidavit of Use/Non-Use filed on 12 September 1979;
6. Exhibit "F" - Certified copy of Affidavit of Use/Non-Use filed on 15 June 1984;
7. Exhibit "G" - Certified copy of Affidavit of Use for Fifth Anniversary filed on 12 July 1994;
8. Exhibit "H" - Certified copy of Affidavit of Use for Tenth Anniversary filed on 08 July 1999;
9. Exhibit "I" - Certified copy of Affidavit of Use for 15th Anniversary filed on 16 July 2004;
10. Exhibit "J" - Sample product label bearing the trademark ENERVON;
11. Exhibit "K" - Copy of Certification issued by Intercontinental Marketing Services (IMS) dated 08 October 2008; and
12. Exhibit "L" - Certified copy of Certificate of Product Registration issued by the BFAD for the mark ENERVON.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 04 November 2009. The Respondent-Applicant, however, did not file an Answer despite receipt of the notice. Thus, this Bureau, pursuant to Section 11⁴ of Office Order No. 79, as amended, issued Order No. 2011-222 dated 10 February 2011 submitting the case for decision on the basis of the opposition, affidavits of witnesses and evidence presented by the Opposer.

Should the Respondent-Applicant's trademark application be allowed?

Sec. 123.1 (d) of the IP Code provides that a mark cannot be registered if it:

⁴ Section 11. *Effect of failure to file Answer* - In case the respondent 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 affidavits of the witnesses and the documentary evidence submitted by the petitioner or opposer.

(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.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application in 2007, the Opposer, specifically its predecessors-in-interest, already has an existing trademark registration for ENERVON-C used on *"high-potency therapeutic vitamin formula containing essential Vitamin B Complex plus Vitamin C"*. The goods on which the competing marks are used therefore are similar or closely related.

But are the competing marks identical or closely resemble each other that confusion or deception is likely to occur?

The first two syllables of the Respondent-Applicant's mark – forming the prefix "ENER" – are the same with the Opposer's. "ENER" is obviously derived from the word "energy" and thus, is not really unique if used as a trademark or as part of a trademark for food or pharmaceutical products. Indeed, "ENER" is clearly suggestive as to the kinds of goods a mark with "ENER" as a component is attached to. What would make such trademark distinctive are the suffixes or appendages to the prefix "ENER" and/or the devices, if any.

In this regard, the last syllable in the Opposer's mark "VON-C" is different from the last syllable in the Respondent-Applicant's mark "VIT". The dash and the letter "C" in the Opposer's mark, which is part and parcel of the registered trademark, makes a fine distinction with that of the Respondent-Applicant's mark as to sound and appearance such that confusion or deception is unlikely to occur. There is a remote possibility for a consumer to assume or conclude that there is a connection between the parties solely because both marks start with the syllable "ENER" since, as we discussed above, "ENER" is merely suggestive of the word energy.

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.⁵

Clearly, the Respondent-Applicant satisfied this function test.

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, November 19, 1999.



WHEREFORE, premises considered, the instant opposition is hereby **DENIED**. Let the filewrapper of Trademark Application No. 4-2007-010244 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 02 March 2012.


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

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