



VITASOY INTERNATIONAL HOLDINGS
LIMITED,

Opposer,

-versus-

SAN MIGUEL CORPORATION,
Respondent-Applicant.

X-----X

IPC No. 14-2010-00068

Opposition to:

Appln. Serial No. 4-2009-500287

Filing Date: 20 May 2009

Trademark: "Activsoy"

NOTICE OF DECISION

HECHANOVA BUGAY & VILCHEZ

Counsel for Opposer

G/F Chemphil Building

851 Antonio Arnaiz Avenue

Makati City

BENGZON NEGRE UNTALAN

Intellectual Property Attorneys

Counsel for Respondent-Applicant

Second Floor, SEDCCO Building

Rada corner Legaspi Streets, Legaspi Village

Makati City

GREETINGS:

Please be informed that Decision No. 2012 - 155 dated August 17, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 17, 2012.

For the Director:


Any. PAUST U. SAPAK

Hearing Officer

Bureau of Legal Affairs

CERTIFIED TRUE COPY



VITASOY INTERNATIONAL HOLDINGS
LIMITED,

Opposer,

- versus -

SAN MIGUEL CORPORATION,
Respondent-Applicant.

x-----x

IPC No.14-2010-00068

Opposition to:

TM Appln. Serial No. 4-2009-500287
(Filing Date: 20 May 2009)

TM: "Activsoy"

Decision No. 2012- 155

DECISION

VITASOY INTERNATIONAL HOLDINGS, LTD. ("Opposer")¹ filed on 16 March 2010 an opposition to Trademark Application Serial No. 4-2009-500287. The application, filed by SAN MIGUEL CORPORATION ("Respondent-Applicant")² covers the mark "Activsoy" for use on "Ready-to-Drink Soy-Based Drinks" under Class 29 of the International Classification of goods³.

The Opposer anchors its opposition on the ground that it is the prior user of and applicant for the marks "VITA", "VITASOY" and its variants. According to the Opposer, Activsoy is confusingly similar to its trademarks, and thus, the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). The Opposer's evidence consists of the following:⁴

1. Special Power of Attorney ("SPA") it issued in favour of its counsel of record;
2. Cert. of Reg. No. 4-2005-008310 for VITASOY & FIVE LEAF LOGO;
3. certified copy of Cert. of Reg. No. 4-1992-080837 for VITASOY;
4. Cert. of Reg. No. 4-1992-08035 for VITASOY CHINESE CHARACTER;
5. Cert. of Reg. No. 4-2002-001769 for VITASOY & FIVE LEAF LOGO;
6. Trademark Application No. 4-1992-080836 for VITA;
7. affidavits-direct testimonies of Ellen Conchanco, Julie T. Ang, Ah-Hing Tong, Janessa Calugay, and John Shek Hung Lau;
8. certification of Princess Luren Aguas;
9. Decision No. 2008-33, dated 12 Feb. 2008, in IPC No. 14-2007-00127 (opposition to Trademark Application Serial No. 4-2005-008742 for the mark VITA-C;

¹ With address at 1 Kin Wong Street, Tuen Mun, New Territories, Hong Kong.

² With address at 40 San Miguel Avenue, Mandaluyong 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 Marked as Exhibits "A" to "K", inclusive.

10. Decision No. 2009-45, dated 24 March 2009, in IPC No. 3938, 3939, 3951 and 3952 (opposition to Trademark Application Serial Nos. 80835, 80837 for the marks VITASOY and VITASOY IN CHINESE CHARACTERS); and
11. Answer of Ah Hing Tong to the Written Interrogatories, dated 16 January 2008 (IPC Nos. 3938, 3939, 3951 and 3952).

The Respondent-Applicant filed its Verified Answer on 23 August 2010 refuting the material allegations in the opposition, particularly, that Activsoy is confusingly similar to the Opposer's mark. The Respondent-Applicant's evidence consists of a copy of list of its subsidiaries as appearing in its 2008 Annual Report, certified copy of the subject trademark application, and the SPA it issued in favour of its counsel of record⁵.

Should the Respondent-Applicant be allowed to register in its favour the mark Activsoy?

Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("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 earlier filing or priority date in respect of the same goods or services or closely related goods or services, or if it nearly resembles such, mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its application for the registration of the mark Activsoy, the Opposer has existing trademark registrations and/or applications for its VITASOY marks. These trademark registrations or applications cover goods that are similar and/or closely related to the goods indicated in the Respondent-Applicant's trademark application.

However, this Bureau finds that Activsoy does not resemble the Opposer's marks and would not likely deceive or cause confusion.

In looks and sound, the only similarity between the competing marks is the word "soy". In this regard, this Bureau agrees with the Respondent-Applicant that the Opposer should have no monopoly or exclusive right over the word "soy". The competing marks are for use on "soy" and "soy-based products". "Soy" indicates the kind of the product itself or the main ingredient thereof, and therefore the generic term for the subject goods. In *Societe des Produits Nestle SA v. Court of Appeals*⁶, the Supreme Court held,

"Generic terms are those which constitute the common descriptive name of an article or substance, or are commonly used as the name or description of a kind of goods and are not legally protectible."

The reason as to why generic terms is incapable of exclusive use as a trademark or part thereof was laid down by the Supreme Court in *Asia Brewery, Inc. v. Court of Appeals*⁷, to wit:

"No one may appropriate generic or descriptive words. They belong to the public domain.

x x x

⁵ Marked as Annexes "A" to "C".

⁶ 356 SCRA 207, citing Federal Unfair Competition: Lanham Act S. 43(a).

⁷ G.R. No. 103543, 05 July 1993.

“(Generic and descriptive words) cannot be appropriated and protected as a trademark to the exclusion of its use by others.....inasmuch as all persons have an equal right to produce and vend similar articles, they also have the right to describe them properly and to use any appropriate language or words for that purpose, and no person can appropriate to himself exclusively any word or expression, properly descriptive of the article, its qualities, ingredients or characteristics, and thus limit other persons in the use of language appropriate for the description of their manufactures, the right to the use of such language being common to all.”

In fact, the Respondent-Applicant in its trademark application disclaimed the word “soy”. There are several registered marks in the Trademark Registry a part or a feature of which is the word “soy”, i.e. “SOY YUMMY”, “HER SOY PLUS”, “V-SOY”, “NUTRISOY”, “LACTASOY”, “ASIA SOY SAUCE” and “TEASOY”.⁸ These registrations only show that “soy” is a generic term such that no single entity should have exclusive right over its use on soy and soy-based products or goods.

This Bureau finds untenable the argument that since the Respondent-Applicant’s mark contains all the letters in the Opposer’s mark, the marks are now confusingly similar. As discussed above, “soy” is a generic term. Also, the letters “V”, “I”, “T”, and “A” are arranged differently in the Respondent-Applicant’s mark. With the additional letter “C”, the letters formed the syllables “ACTIV”. “ACTIV” is obviously a play on the word “active” and which has different visual and aural properties from “VITA”.

Neither is there merit in the Opposer’s contention that the competing marks are confusingly similar because these have similar meaning. The Respondent-Applicant is correct in pointing out that:

“x x x. As Opposer admitted in the opposition, ‘the word “VITA...” is the latin word for “life”’. Thus, ‘vita’ means ‘life’. On the other hand, an online source defines the word ‘active’ as ‘engaged in action’ characterized by energetic work (and) participation...’ Even though the word ‘active’ can be an adjective for the word ‘life’ (as in ‘active life’), it cannot be assumed that both words are similar in meaning, inasmuch as ‘active’ and ‘stock market’(as in ‘active stock market’) do not have similar meanings. In vain, Opposer undertook to link the words ‘active’ and ‘life’ in the Opposition. The meanings of the two (2) words are simply dissimilar; it is a stretch to correlate the two (2) meanings. x x x”⁹

Aptly, the conclusion that the subject marks are not confusingly similar rendered moot the issue of whether the or not the Opposer’s mark is a well-known mark.

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.¹⁰ This Bureau finds that the Respondent-Applicant’s mark satisfies this function test.

⁸ Trademark Reg. Nos. 4-2003-007620, 4-2004-006904, 4-2005-001064, 4-2005-012699, 4-2000-006945, 042928, and 4-2006-012993.

⁹ Respondent-Applicant’s Verified Answer, par. 52.

¹⁰ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

WHEREFORE, premises considered, the instant opposition case is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2009-500287 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 17 August 2012.



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

