



VITASOY INTERNATIONAL HOLDING, LTD.,  
Opposer,

-versus-

THE SUNRIDER CORPORATION d/b/a  
SUNRIDER INTERNATIONAL,  
Respondent-Applicant.

X-----X

IPC No. 14-2004-00130

Opposition to:

Appln. Serial No. 4-2001-001102

Date filed: 14 Feb. 2001

TM: "VITA SHAKE"

### NOTICE OF DECISION

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### GREETINGS:

Please be informed that Decision No. 2012 – 220 dated November 05, 2012 ( copy enclosed) was promulgated in the above entitled case.

Taguig City, November 05, 2012.

For the Director:

**Atty. PAUSI U. SAPAK**  
Hearing Officer  
Bureau of Legal Affairs

CERTIFIED TRUE COPY

MARILYN F. RETUTAL

IPRS IV, Bureau of Legal Affairs, IP Phils.



**VITASOY INTERNATIONAL HOLDINGS LIMITED,**  
*Opposer,*

- versus -

**THE SUNRIDER CORPORATION**  
**d/b/a SUNRIDER INTERNATIONAL,**  
*Respondent-Applicant.*

X-----X

**IPC No. 14-2004-00130**

Opposition to:

Appln. Serial No. 4-2001-01102

(Filing Date: 14 Feb. 2001)

Trademark: **VITA SHAKE**

Decision No. 2012 - 220

## DECISION

VITASOY INTERNATIONAL HOLDINGS LIMITED<sup>1</sup> ("Opposer") filed on 16 September 2004 an opposition to Trademark Application Serial No. 4-2001-01102. The application, filed by THE SUNRIDER CORPORATION d/b/a SUNRIDER INTERNATIONAL<sup>2</sup> ("Respondent-Applicant"), covers the mark "VITA SHAKE" for use on "*nutritional supplements; powdered and liquid food drink; and preparation for making beverage*" under Classes 05, 29 and 32 of the International Classification of goods<sup>3</sup>.

The Opposer alleges, among other things, that the approval of the Respondent-Applicant's application is contrary to Sec. 123.1, pars. (d) to (f) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") and will violate its right to its trademarks VITA (Block letters); VITA (Chinese Characters); VITASOY (Block letters); and VITASOY (Chinese characters) for the goods covered and the right to extend the use thereof to other goods. According to the Opposer, Respondent-Applicant intended to ride on the popularity and goodwill of the Opposer's marks as to cause confusion, deceit and/or mislead the public into believing that Respondent-Applicant's goods are the same or connected with the Opposer's. The Opposer avers:

"1. That the Opposer is the applicant for registration of the trademarks VITA (Block letters); VITASOY (Chinese characters); VITASOY (Block letters) and registered owner of the trademark VITA (Chinese characters) and prior user of said marks for:

(a) soy-based beverage used as a milk substitute; and soya bean milk in liquid and solid form, soya bean-based food products and all kinds of food products and the ingredients therefor (Class 29); and

<sup>1</sup> A corporation organized and existing, with principal office address at 1 Kin Wong Street, Tuen Mun, New Territories, Hong Kong.

<sup>2</sup> A foreign corporation existing under the laws of Utah, United States of America, with office address at 1625 Abalone Avenue, Torrance, California.

<sup>3</sup> 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.

(b) concentrates, syrups and powders used in the preparation of juices and soft drinks; and soya bean-based carbonated and non-carbonated non-alcoholic drinks and beverages, syrups, powders, extracts and concentrates for making carbonated and non-carbonated non-alcoholic beverages, fruit and vegetable juices of all kinds, soft drinks, soya bean-based extracts, drinks and beverages (Class 32);

under Application Serial No. 80836-PN, May 20, 1992 (VITA) (Block Letters); Application Serial No. 80837-PN, May 20, 1992 (VITASOY) (Block Letters); Application Serial No. 80835-PN, May 20, 1992 (VITASOY) (Chinese Characters); and Registration Certificate No. 61652, issued on September 26, 1995, which registration continues to be in full force and effect;

"2. That Opposer's trademarks VITA and VITASOY for the foregoing classes of goods have been in continuous use in the Philippines for a sufficiently long period of time while the Respondent-Applicant never claimed any period of prior use of its infringing mark;

"3. That Opposer's trademarks are well-known marks because of numerous registrations worldwide and the great volume of its worldwide sales. The said trademark is advertised extensively in Hong Kong, India, Malaysia and other countries throughout the world;

"4. That Opposer's trademarks have therefore become a very strong mark with a well-established goodwill and solid business reputation throughout the world, including the Philippines;

"5. That Opposer has filed several oppositions to Respondent-Applicant's VITA SHAKE applications in several countries; and

"6. That said trademarks have become firmly and widely identified with the products of Opposer and/or its distributors, dealers, licensees and agents."

The Respondent-Applicant filed its Answer on 04 November 2004 alleging among other things the following:

"9. Respondent's mark VITA SHAKE is not identical or confusingly similar to Opposer's marks. In the case of *Etepha A.G. v. Director of Patents, et. al.*, enumerated the following factors that would constitute similarity between two trademarks:

1. Sound and pronunciation;
2. Appearance;
3. Form and ideas connoted by the marks;
4. Meaning and spelling of words used; and
5. Setting in which the words appear.

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"12. Mere similarity in the prefix 'VITA' is an insufficient basis for establishing confusing similarity in the cited marks. First, the prefix 'VITA' is a common Italian word meaning 'life'. It is unreasonable for any party to claim exclusive right over the said word or prefix. Second, under the totality test, there are ample differences in the sound, pronunciation, appearance, form, ideas connoted,

meaning, spelling and pronunciation of the subject marks. Third, under the dominance test, similarity in the prefix 'VITA' does not automatically mean that the dominant features of the two marks are the same. In fact, an actual comparison of Respondent's and Opposer's marks would show that there is no confusing similarity in their dominant features. Consequently, employing both the dominance test and the totality test, there may be very little basis for the claim that Respondent's mark is identical or very similar to Opposer's marks VITA and VITASOY;

"13. Respondent has spent considerable sums of money to advertise its trademark for the goods it covers and has, as result – and also because of the inherent excellent quality of its goods – developed tremendous goodwill for its trademark;

"14. This Honorable Office is aware that there are a number of marks registered with it, such as VITAFORT, VITA and VITA-PLUS, which are not in Opposer's name. In fact, this Honorable Office approved the publication and published Respondent's application for the registration of the mark; and

"15. In view of the foregoing, it is clear that the registration of Respondent's mark will not cause any damage to Opposer since the same cannot be categorized as being confusingly similar to Opposer's mark."

The pre-trial conference of the case was conducted and terminated on 25 April 2005. Then after, the trial on the merits proceeded in which the Opposer presented testimonial evidence and offered the following documentary exhibits:

1. Affidavit of Ah Hing Tong, Company Secretary of Opposer and his signature;
2. Notarized and authentication pages of the Affidavit, date and signature of Vice Consul, Victorio Mario M. Dimagiba, Jr.;
3. Copies of tetra-brick packaging for mango-flavored juice drink, blackcurrant-flavored juice drink, guava-flavored juice drink, apple-flavored juice drink, lemon tea drink, chrysanthemum tea drink, honey chrysanthemum tea drink, honey green tea drink, apple green tea drink, jasmine tea, oolong tea, sugar cane drink, soya bean extract drink, all indicating the VITA mark;
4. Opposer's publication called "Vision of Vitasoy";
5. Table index list which indicates the extent of Opposer's registrations throughout the world;
6. Original and duly authenticated Cert. of Reg. Nos. 820388 and 563060 for the marks VITASOY and FIVE LEAF LOGO and VITASOY in Chinese characters issued in of Australia;
7. Cert. of Reg. No. 137.459 issued in Austria for VITASOY;
8. Cert. of Reg. Nos. 17,824 and 18,675 issued in Brunei Darussalam for VITASOY and VITASOY in Chinese Characters, respectively;
9. Cert. of Reg. Nos. 175944 and 226616 issued in the Czech Republic for VITASOY and VITASOY in Chinese Characters, respectively;
10. Cert. of Reg. Nos. 80,407 and 80,380 issued in Costa Rica for VITASOY in Chinese Characters and VITASOY, respectively;
11. Cert. of Reg. No. VR 1993 01267 issued in Denmark for VITASOY together with its original translation and Cert. of Reg. No. VR 01.267 1993 issued in Denmark prior to the renewed certificate for VITASOY;



12. Cert. of Reg. No. 213036 issued in Finland for VITASOY in Chinese Characters;
13. Cert. of Reg. No. 98 721584 issued in France for VITASOY in Chinese Characters;
14. Original and duly authenticated Cert. of Reg. No. 1,738,222 issued in France for VITASOY together with its original translation and the certificate of renewal thereof;
15. Original and duly authenticated Cert. of Reg. No. 2,090,379 issued in Germany for VITASOY together with its original translation;
16. Cert. of Reg. Nos. 131303 and 131302 issued in Greece for VITASOY in Chinese Characters and VITASOY, respectively;
17. Cert. of Reg. No. 138 071 issued in Hungary for VITASOY together with its original translation and the renewal thereof and Cert. of Reg. No. 160222 issued in Hungary for VITASOY in Chinese Characters;
18. Cert. of Reg. No. 551909 issued in India for VITASOY in Chinese characters;
19. Cert. of Reg. No. 303182 issued in Indonesia for VITASOY in English and Chinese characters;
20. Cert. of Reg. Nos. 212089 and 213969 issued in Ireland for VITASOY and VITASOY in Chinese characters, respectively;
21. Cert. of Reg. No. 4421104 issued in Japan for VITASOY in Chinese characters together with its original translation;
22. Original and duly authenticated Cert. of Reg. No. 4457124 issued in Japan for VITASOY together with its original translation;
23. Cert. of Reg. No. 29833 issued in Jordan for VITASOY and the renewal thereof;
24. Cert. of Reg. Nos. 1952 and 29853 issued in Jordan for VITASOY and VITASOY in Chinese characters, respectively;
25. Cert. of Renewal No. 38971 issued in Kenya for VITASOY in Chinese characters;
26. Cert. of Reg. No. 173660 issued in South Korea for VITASOY and VITASOY in Korean characters;
27. Original and duly authenticated Cert. of Reg. No. 10930-M issued in Macao for VITASOY together with its original translation;
28. Cert. of Reg. Nos. M/26791 and M/26792 issued in Malaysia for VITASOY in fanciful form and VITASOY in Chinese characters, respectively, together with their original translations;
29. Cert. of Reg. Nos. 3903/2000 and 3570/92 issued in Myanmar for VITASOY in Chinese and English characters, respectively, and the cautionary notice equivalent to renewal of certificates of registration;
30. Cert. of Reg. Nos. 257238, 209799 and 293593 issued in New Zealand for VITASOY CALCI-PLUS, VITASOY and VITASOY in Chinese characters, respectively, and the renewal certificates thereof;
31. Cert. of Reg. No. 152947 for VITASOY in Chinese characters and Renewal of Cert. No. 161047 for VITASOY issued in Norway;
32. Cert. of Reg. No. 44455 (renewal) issued in Pakistan for VITASOY;
33. Cert. of Reg. No. 13311801 issued in Panama for VITASOY;
34. Cert. of Reg. No. A52500 (renewal) issued in Papua New Guinea for VITASOY;
35. Cert. of Reg. No. 73194 (renewal) issued in Poland for VITASOY;
36. Cert. of Reg. Nos. 275394 (renewal) and 336933 issued in Portugal for

- VITASOY and VITASOY in Chinese Characters, respectively, together with original translation;
37. Cert. of Reg. Nos. 245/9 and 245/10 issued in Saudi Arabia for VITASOY and VITASOY in Chinese Characters, respectively;
  38. Original and duly authenticated Cert. of Reg. Nos. T55/19815Z (renewal) and T02/04004G issued in Singapore for VITASOY in special script and VITASOY and FIVE LEAF LOGO DESIGN, respectively;
  39. Cert. of Reg. Nos. 2232400, M1639498 (renewal) and 1639499 issued in Spain for VITASOY in Chinese Characters and VITASOY, respectively, together with their original translations;
  40. Cert. of Reg. Nos. 27547 (renewal for 2000), 61845 (renewal for 2001) and 61845 issued in Sri Lanka for VITASOY;
  41. Cert. of Reg. Nos. 246742 (renewal) and 337 363 issued in Sweden for VITASOY and VITASOY in Chinese Characters, respectively, together with original translation of Reg. No. 246742;
  42. Cert. of Reg. Nos. 391786 and 396348 issued in Switzerland for VITASOY in Chinese Characters and VITASOY, respectively, together with their original translations;
  43. Original and duly authenticated Cert. of Reg. No. 1073627 issued in Taiwan for VITASOY;
  44. Cert. of Reg. No. 30885 issued in Trinidad and Tobago for VITASOY mark;
  45. Cert. of Reg. Nos. 1465316 and 1465317 issued in the United Kingdom for VITASOY and VITASOY in Chinese Characters, respectively;
  46. Cert. of Reg. No. 38314 issued in Vietnam for VITASOY in Chinese Characters together with its original translation;
  47. Cert. of Reg. No. 45192 issued in Serbia and Montenegro for VITASOY in Chinese Characters (new version) together with its original translation;
  48. Cert. of Reg. No. 42138 issued in the Federal Republic of Yugoslavia for VITASOY in Chinese characters together with its original translation;
  49. Original and duly authenticated Cert. of Reg. Nos. 247,464, 254,100 and 644,866 issued in Canada for VITASOY and VITA, respectively;
  50. Cert. of Reg. Nos. 271386, 271388, 271389, 749344, 773883, 773884, 815256, 815318, 817644, 819518, 823526, 832881, 834799, 1077573, 1120884, 1404094, 1153564 and 1199498 issued in Hong Kong for VITA and VITASOY, together with their original translations;
  51. Original and duly authenticated Cert. of Reg. Nos. 0173660 and 0173661 issued in Korea for VITASOY and VITASOY in Chinese characters, respectively;
  52. Certified true copy of Cert. of Reg. No. 61652 issued in the Philippines for VITA in Chinese characters;
  53. Original and duly authenticated Cert. of Reg. No. 172,847 for VITASOY issued in the Slovak Republic, together with its original translation;
  54. Original and duly authenticated Cert. of Reg. No. T93102941F for VITA issued in Singapore;
  55. Original and duly authenticated Cert. of Reg. No. 1465316 for the VITASOY mark issued in the U.K.;
  56. Original and duly authenticated Cert. of Reg. Nos. 1,968,713, 1,868,942, 2,765,529, 1,893,224, 1,833,973 and 2,574,498 for VITASOY and VITA issued in the United States of America;
  57. Colombian opposition filed by the Opposer to Fabio Botero Amaya's

- application for VITASOY (in Class 30) and the English translation for Res. No. 02042 by the Rep. of Colombia;
58. Colombian cancellation action filed by the Opposer against Laboratories Klinos C.A.'s Reg. No. 153044 for VITASOY in Class 29 and the English translation which contains a resolution with respect to VITASOY;
  59. Costa Rican opposition filed by Compania Numar S. A. to the Opposer's Application No. 8402-00 for VITA in Class 30 and summary of trademark for VITA Class 13 in Costa Rica;
  60. Israeli opposition filed by Pri Hagalil Ltd. and Pri-Vita Ltd. to the Opposer's Application Nos. 145122 for VITASOY in Class 29, 145123 for VITASOY in Class 32, 145128 for VITA in Class 30, 145129 for VITA in Class 32, 15552 for VITASOY and FIVE LEAF LOGO in Class 29 and 1553 for VITASOY and FIVE LEAF LOGO in Class 32;
  61. Israeli oppositions filed by the Opposer to owned by Pre-Hagalil Ltd.'s Application Nos. 162077 for VITA in Class 29 and 162080 in Class 29;;
  62. Panamanian oppositions filed by Opposer to Advanced Total Marketing System, Inc.'s Application Nos. 129384 for DE VITA in Class 29, 129385 for DE VITA in Class 30 and 129386 for DE VITA in Class 32;
  63. Letter from Arosemena Noriega & Contreras Law Firm dated 04 July 2005 and the confirmation copy of the letter between the Taiwanese Respondent's counsel;
  64. Taiwanese cancellation actions against Reg. Nos. 947183 for VITA-12 in Class 29 and 947184 for VITA-7 in Class 29 and oppositions by the Opposer to Application Nos. 89031203 for VITA-12 in Class 32 and 89021200 for VITA-7, both owned by Jinche Company;
  65. U.K. cancellation actions filed by the Opposer against Vitalon Foods Co. Limited's Reg. No. 2002977 for VITALON and against Elizabeth Bellhouse's Reg. Nos. 1340626 for VITA FLORUM in Class 5 and 1340627 in Class 32;
  66. Confirmation copy of the letter dated 11 July 2005;
  67. Letter from Field Fisher Waterhouse dated 13 July 2005 between Marcia Woodall and Baker Botts dealing with cancellation actions involving VITASOY;
  68. U.K. oppositions filed separately by Elizabeth Bellhouse, Bryggerigruppen A/S and Seton Healthcare Group PLC to the Opposer's Application No. 1465275 for VITA in Class 32;
  69. Ireland opposition filed by the Opposer to Glaabsbrau F. Glaab & Co.'s Application No. 001033190 for VITA-MALTZ in Class 32 and opposition to the Opposer's Application No. 98/0963 for VITA in Classes 29, 30 and 32;
  70. U.K. cancellation action filed by the Opposer against Unigate Dairies Limited's Reg. No. 1277707 for CALCIA PLUS in Class 29;
  71. Calcia Plus TM No. 1277707 downloaded on 06 July 2005;
  72. U.K. opposition filed by Unigate Dairies Limited to Opposer's Application No. 2175981B for CALCI-PLUS in Class 32;
  73. Original copy of document for the trademark case 21759 81-B downloaded on 06 July 2005;
  74. U.K. opposition filed by the Opposer to Sojaprotein Akeionarsko drustvo za preradu soje's Application No. 800408 for SOJA VITA in Class 30;
  75. Original copy of a downloaded document covering details for International Madrid UK case 8000408 involving SOJA VITA;
  76. Venezuelan opposition filed by Harinera Del Valle S.A. to the Opposer's



- Application No. 04988-97 for VITASOY in Class 29;
77. Acknowledgment Receipt dated 26 May 2005 from the Bureau of Patents, Trademarks and Technology Transfer;
  78. Certified true copy of the Opposer's Philippine Application No. 80837 for VITASOY in Class 29 and 32;
  79. Paper No. 3 in relation to the Opposer's Philippine Application No. 4-2002-01769 for VITASOY AND FIVE LEAF LOGO;
  80. Acknowledgment Receipt dated 26 May 1992 issued by the BPTTT in relation to Philippine Application No. 80836;
  81. Certified true copy of Philippine application serial No. 80835 VITASOY (Chinese characters); Serial No. – 80835 in Classes 29 and 32;
  82. Purchase Order, Invoices, Bill of Lading and Packing lists issued by Opposer;
  83. Copies of packaging of VITASOY WITH FIVE LEAF LOGO for Premium Organic Soya Drink, Premium Organic Soya Drink Creamy Original flavor, Premium Organic Soya Drink Vanilla Delight flavor;
  84. Several promotional posters, pamphlet, leaflets, advertising materials and photos featuring the Opposer's marks;
  85. Copies of packaging materials of the Opposer's products and several articles featuring Opposer's mark;
  86. Schedule of worldwide annual shipment sales for 1996-2004 for VITA and VITASOY;
  87. Notarized Affidavit of Ellen Conchanco, her signature and notarization by Atty. Randy P. Gareng;
  88. List of VITA and VITASOY products distributed by Fly Ace Corporation for the Philippine market;
  89. Summaries of VITASOY Sales>Returns, Good Stock Returns and Bad Stock Returns from January to July, 2006;
  90. Several Certificates of Product Registrations issued to Opposer;
  91. Deposition Upon Written Cross-Interrogatories of Tong Ah Hing; Transmittal by the Department of Foreign Affairs dated 20 Feb. 2008; Receiving stamp of the Intellectual Property Office, BLA, on 27 Feb. 2008; Brown envelope containing the transcript of deposition; Certification dated 13 Feb. 2008 issued by Consul Dimagiba, Jr.; Oath of Witness in Deposition; Signature of Tong Ah Hing; Oath of Stenographer; Certificate of Deponent and date thereof; Errata on Deposition and date thereof and Authentication by the Consulate General of the Republic of the Philippines;
  92. Certificate of Incorporation on Change of Name of "The Hong Kong Soya Bean Products Company, Ltd." to "Vitasoy International Holdings Ltd." and the date thereof bearing 21 Sept. 1999;
  93. Certificate of Incorporation of The Hong Kong Soya Bean Products Company, Ltd. dated 23 Dec. 1997;
  94. Certification of Employment of Tong Ah Hing dated 09 Jan. 2008;
  95. Export Market Summary of Opposer updated on 04 Jan. 2008; and
  96. Several Invoices and Bills of Lading issued by Opposer dated Feb. 1997 and Nov. 1996.<sup>4</sup>

For its part, the Respondent-Applicant presented the oral testimonies of its witnesses and offered the following documentary evidence:

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<sup>4</sup> Marked as Exhibits "A" to "O" inclusive of submarkings.



1. Judicial Affidavit notarized 18 July 2008 of Mr. Josefino J. Sarmiento;
2. Special Power of Attorney dated 14 December 2006;
3. Articles of Incorporation of Sunrider Philippines, Inc. (SPI);
4. Certificate of Distributorship;
5. International publications, brochures and promotional materials of Sunrider Corporation d/b/a Sunrider International;
6. Print-out of Sunrider's website;
7. Print-outs of Sunrider's worldwide offices;
8. Sample box/packaging/sachet of VITASHAKE;
9. Summary of VITASHAKE trademark registrations and applications worldwide;
10. Legalized certificates of registration of VITASHAKE in the name of Sunrider for goods under Classes 5, 29, 30 and 32 in Canada, Colombia, Hong Kong, Hungary, India, Indonesia, Japan, Kazakhstan, Korea, Latvia, Malaysia, Mexico, New Zealand, Poland, Singapore, USA, China, Taiwan and Nigeria; and pending applications for VITASHAKE in Brazil, Canada, Community Trademark, Philippines and South Africa;
11. Legalized Affidavit of Mr. Owen Smigelski and annexes;
12. Articles of Incorporation of Sunrider;
13. Summary of VITASHAKE registration and applications and legalized copies;
14. Letter dated 23 June 2008 from the Nigerian Federal Ministry of Commerce and Industry on Opposer's abandonment of its opposition against VITASHAKE;
15. Legalized Affidavit of Ms. Wendy Teng and annexes;
16. Print-out of company website showing detailed list of products;
17. A map and list of Sunrider's worldwide offices, from which Sunrider products are being sold directly;
18. Sales summary worldwide; and
19. Marketing material used in the US, Europe, Israel, Korea, Malaysia and Singapore.<sup>5</sup>

The Opposer filed its position paper on 26 October 2009 while the Respondent-Applicant did so on 29 October 2009.

Should the Respondent-Applicant be allowed to register the mark VITASHAKE?

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.<sup>6</sup> Thus, Sec. 123.1(d) of the 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

<sup>5</sup> Marked as Exhibits "1" to "38" inclusive of sub-markings.

<sup>6</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its trademark application in 2001, the Opposer already has existing applications for the registration of the marks VITA (Application No. 4-1992-080836) and VITASOY (Application No. 4-1992-080837) both filed on 20 May 1992 for use on *"soya bean milk in liquid and solid form, soya bean based food products and all kinds of food products and the ingredients therefor"* under Class 29 and *"soya bean based carbonated and non-carbonated non-alcoholic drinks and beverages, syrups, powders, extracts and concentrates for making carbonated and non-carbonated non-alcoholic beverages, juices of all kinds, soft drinks"* under Class 32, respectively. The goods indicated in the Respondent-Applicant's trademark application are similar and/or closely related to those covered by the Opposer's aforementioned trademark applications. But is VITA SHAKE identical to or resembles the Opposer's marks such that confusion or deception is likely to occur?

The Opposer's mark VITASOY under Application Serial No. 4-1992-080837 is a word mark consisting of block letters, while VITA under Application No. 4-1992-080836 is in Chinese characters, as shown below:

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In this regard, confusion between VITA SHAKE and VITA is unlikely. The Chinese characters' appearance is vastly different from VITA SHAKE. There is no showing that the Chinese characters represent the exact translation of VITA. And, even if they do, the purported commonality of idea or meaning of these with the word or mark VITA is not apparent in the Philippine market. No evidence is presented to establish that the ordinary consumers under this jurisdiction are familiar with Chinese characters such that when confronted with a product bearing the mark VITA, the consumers would likely assume that it reads or means VITA, much less assume that it is associated or connected with the Opposer and/or the mark VITA SHAKE.

However, this Bureau finds that VITA SHAKE is confusingly similar to the Opposer's mark VITASOY (Application Serial No. 4-1992-080837). The distinctive feature of these marks is the same, the word VITA. It is the feature that draws the eyes and ears and the one that would be remembered by the consumers.

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, 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.<sup>7</sup>

When two marks are confusingly similar, the consumers will have the impression that the goods or services covered by these marks originated from a single source or origin, or assume that one mark is just a variation of the other and there is a connection or association between the two marks and/or between the contending parties themselves, when in fact there is none. The likelihood of confusion therefore, would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court.<sup>8</sup>

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 one 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 former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, 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 and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code. With this finding, this Bureau deems that there is no need to dwell on the issue of whether or not the Opposer's mark is a well-known mark.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2001-01102, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 05 November 2012.

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

<sup>7</sup> *American Wire and Cable Co. v. Director of Patents et al.*, (31 SCRA 544) G.R. No. L-26557, 18 Feb. 1970.

<sup>8</sup> *Converse Rubber Corporation v. Universal Rubber Products, Inc. et al.*, G.R. No. L-27906, 08 Jan. 1987.