

UNITED HOME PRODUCTS, INC.,
Opposer,

-versus-

DIAMOND LABORATORIES, INC.,
Respondent- Applicant.

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IPC No. 14-2014-00362
Opposition to:
Appln. Serial No. 4-2013-008212
Date Filed: 12 July 2013
TM: "VITAMIN B1+ B6 +
+B12 MULTIBEE"

NOTICE OF DECISION

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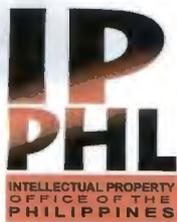
GREETINGS:

Please be informed that Decision No. 2016 - 484 dated December 23, 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, December 23, 2016.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



UNITED HOME PRODUCTS, INC.,
Opposer,

- versus -

DIAMOND LABORATORIES, INC.,
Respondent-Applicant.

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IPC No. 14-2014-00362
Opposition to:

Appln. No. 4-2013-008212
Date Filed: 12 July 2013
Trademark: "**VITAMIN B1+
B6+B12 MULTIBEE**"

Decision No. 2016 - 484

DECISION

UNITED HOME PRODUCTS, INC. ("Opposer")¹, filed an opposition to Trademark Application Serial No. 4-2013-008212. The application, filed by DIAMOND LABORATORIES, INC. ("Respondent-Applicant")², covers the mark "VITAMIN B1+B6+B12 MULTIBEE" for use on "*pharmaceuticals*" under class 05 of the International Classification of Goods.³

The Opposer alleges the following grounds for opposition:

"7. The mark 'VITAMIN B1+B6+B12 MULTIBEE' applied for by Respondent-Applicant so resembles the trademark 'MULTI-B' owned by Opposer which was applied for registration with this Honorable Bureau on 24 July 2012, or prior to the filing of the application of the mark 'VITAMIN B1+B6+B12 MULTIBEE' by Respondent-Applicant on 12 July 2013.

"8. The mark 'VITAMIN B1+B6+B12 MULTIBEE' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'VITAMIN B1+B6+B12 MULTIBEE' is applied for the same class and goods as that of Opposer's trademark 'MULTI-B', i.e., Class 05 of the International Classification of Goods for pharmaceuticals, specifically vitamin B.

"9. The registration of the mark 'VITAMIN B1+B6+B12 MULTIBEE' in the name of the Respondent-Applicant will violate Sec. 123.1(d) of the IP Code, which provides, in part, that a mark cannot be registered if it:

"x x x

(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:

¹ A domestic corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines, with office address at 4/F Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Metro Manila, Philippines.
² A domestic company, with office address at #8 FERIA Rd., Commonwealth Ave., Diliman, Quezon City, Philippines.
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.

- (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,

x x x (Emphasis supplied)

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

The Opposer's evidence consists of the following:

1. Copy of the pertinent page of the IPO E-Gazette on the subject mark;
2. Certified true copy of the Acknowledgment issued by the IPO on the application for trademark of Opposer's MULTI-B;
3. Certified true copy of Certificate of Listing of Identical Drug Product No. DRP-2586-03 for MULTI-B;
4. Sample product label bearing the trademark MULTI-B; and,
5. Certification and sales performance issued by the IMS.

On 18 November 2014, Respondent-Applicant filed its answer, alleging among others, the following:

"23. Respondent-Registrant (sic) denies the baseless claim that it is seeking to ride upon Opposer's goodwill. Respondent-Registrant, even though comparably small compared to Opposer, has already established its own name and goodwill on its own. There is simply no basis for Opposer to make such a malicious claim.

"24. Furthermore, to set the record straight, though the Trademark Registration for 'VITAMIN B1+B6+B12 MULTIBEE' may have only been filed on 12 July n2013, it bears emphasis that said product has been out in the market since 2009. In fact, it was already registered with the Food and Drug Administration ('FDA') as early as 17 November 2009.

"25. On the other hand, the Trademark 'MULTI-B' may have been registered earlier with the Honorable Office, but the product for which it is being used was only registered with the FDA on 11 October 2012, or almost three years after the existence of Opposer's goods in the market.

x x x

"28. In this case, 'VITAMIN B1+B6+B12 MULTIBEE' has been registered with FDA and sold in the market since 2009, way earlier than the existence of Opposer's 'MULTI-B' as a trademark. For this reason, the prima facie validity of registration of the latter has been overcome. Hence, Respondent-Registrant is entitled to registration.

x x x

"32. Certainly, when taken as a whole, the visual presentation of both marks are substantially different: x x x

"33. In addition, even though they may have similar letters, they are completely different since the word 'BEE' has a markedly different sound than the letter 'B'. Even simple elementary



students would know the difference. Thus, not only are the trademarks different visually, their aural characteristics are different as well.

x x x

"38. Unlike Respondent-Registrant's trademark, Opposer's trademark is descriptive. The first syllable 'multi' is generic, especially in vitamins as people generally refer to them as multivitamins. Even appending the letter 'B' to such term will not help its cause especially considering that the vitamins involved is B-complex.

x x x

"40. In this case, it is quite clear that 'MULTI-B' is a descriptive term for a Multivitamin B-complex product as the consumers need not even exercise any form of imagination to come up with such a determination. It is but a logical conclusion that any person can arrive at."

The Respondent-Applicant submitted a lone evidence of a Certificate of Product Registration of MULTIBEE Capsule issued by the Bureau of Food and Drugs.

Thereafter, the Preliminary Conference was held and terminated. Parties submitted their respective position papers on 10 August 2015. Hence, this decision.

Should the Respondent-Applicant be allowed to register the trademark VITAMIN B1+B6+B12 MULTIBEE?

The instant opposition is anchored on Section 123.1 paragraph (d) of R.A. No. 8293, also known as the Intellectual Property Code which 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 at the time Respondent-Applicant filed its trademark application on 12 July 2013 for the subject mark "VITAMIN B1+B6+B12 MULTIBEE"⁴, the Opposer has an application for the registration of the mark "MULTI-B" on 24 July 2012⁵. It appears that the Opposer's application was filed prior to that of Respondent-Applicant. The competing marks cover the same class 05 for pharmaceutical preparations and/or vitamins.

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

MULTI-B

Opposer's Trademark

**VITAMIN B₁+B₆+B₁₂
MULTIBEE**

Respondent-Applicant's Trademark

⁴ With disclaimer on "Vitamin B1+B6+B12". Filewrapper records.

⁵ Exhibit "B" of Opposer.

What appears common in the foregoing marks is the word MULTI. Regardless of this similarity, Opposer's mark is visually and aurally different from Respondent-Applicant's mark. The presence of hyphen (-) and the letter B distinguishes it from the competing mark which has the word "BEE" added to MULTI. Obviously, the word MULTI refers to multivitamin which are the goods covered by both marks. It is a descriptive word and therefore, cannot be registered under the law.⁶ What is left with the subject mark is the word BEE which is appended to the word MULTI, and which makes Respondent-Applicant's mark MULTIBEE different in its entire composition and appearance.

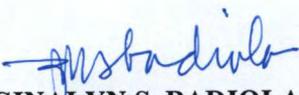
Moreover, this Bureau cannot sustain the instant opposition on the basis of the similarity of the word MULTI. To do so would have the effect of giving the Opposer the exclusive right to use the word MULTI. In fact, a perusal of the trademark database of this Office⁷ shows registered trademarks belonging to different owners which contains the word MULTI in its trademark and covers goods under class 5, particularly vitamins, food supplements and pharmaceutical preparations. Among which are the following: MULTI-FIVE (Reg. No. 4-2015-0140041); MULTI-MORE (Reg. No. 4-2014-008846); DEX-MULTI (Reg. No. 4-2015-507193); MULTI-KINE (Reg. No. 061685); MULTI-SANOSTOL (Reg. No. 048419); and, MULTI-GYN (Reg. No. 4-2014-010303).

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.⁸ This Bureau finds the Respondent-Applicant's mark consistent with this function.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2013-008212 is hereby **DISMISSED**. Let the file wrapper of subject trademark application be returned, together with a copy of the Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. **23 DEC 2016**


Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs

⁶ Sec. 123, R.A. 8293 (IP Code).

"A term is descriptive and therefore invalid as a trademark if, as understood in its normal and natural sense, it 'forthwith conveys the characteristics, functions, qualities or ingredients of a product to one who has never see it and does not know what it is,' or 'if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods' or if it clearly denotes what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination." (Societe Des Produits Nestle, S.A. vs. Court of Appeals, G.R. No. 112012, 4 April 2001)

⁷ IPPhl Philippine Trademark Database, available at <http://www.wipo.int/branddb/ph/en/> (last accessed (19 December 2016).

⁸ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.