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**MAYO FOUNDATION FOR MEDICAL  
EDUCATION AND RESEARCH,**  
Opposers,

**IPC No. 14-2015-00391**  
Opposition to:  
Appln. Serial No. 4-2014-013223  
Date Filed: 23 October 2014  
TM: "MAAYO WOMEN'S HEALTH  
CLINIC"

-versus-

**MAAYO MEDICAL CLINIC CORPORATION,**  
Respondent- Applicant.

**NOTICE OF DECISION**

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**GREETINGS:**

Please be informed that Decision No. 2018 - 229 dated June 29, 2018 (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, June 29, 2018.

*Marilyn F. Retutal*  
**MARILYN F. RETUTAL**  
IPRS IV  
Bureau of Legal Affairs

**MAYO FOUNDATION FOR  
MEDICAL EDUCATION AND  
RESEARCH,**

Opposers,

- versus -

**MAAYO MEDICAL CLINIC  
CORPORATION,**

Respondent-Applicant.

**IPC NO. 14 – 2015 – 00391**

Opposition to:  
Trademark Application No.  
42014013223

**TM: “MAAYO WOMEN’S  
HEALTH CLINIC”**

x-----x

**DECISION NO. 2018 - 229**

## DECISION

MAYO FOUNDATION FOR MEDICAL EDUCATION AND RESEARCH (Opposers)<sup>1</sup> filed an Opposition to Trademark Application Serial No. 42014013223. The trademark application filed by MAAYO MEDICAL CLINIC CORPORATION (Respondent-Applicant)<sup>2</sup>, covers the mark “MAAYO WOMEN’S HEALTH CLINIC” for use on “*comprehensive, specialized care for women’s health issues or concerns*” under Class 44 of the International Classification of Goods<sup>3</sup>.

The Opposer based its Opposition on the following grounds:

1. The “MAAYO WOMEN’S HEALTH CLINIC” Trademark is confusingly similar to opposer’s internationally well-known “Mayo” Marks. Hence, its registration is proscribed under Section 123.1 (e) and (f) of the IP Code.
2. Respondent-Applicant’s use and adoption of MAAYO WOMEN’S HEALTH CLINIC for Services in Class 44 is likely to cause confusion, or mistake, or to deceive purchasers as to the source or sponsorship of said services.
3. The “MAAYO WOMEN’S HEALTH CLINIC” Mark comprises matter which disparages the opposer or brings opposer into contempt or disrepute and may not be registered under Sec. 123.1 (a) of the IP Code.

<sup>1</sup>A corporations organized under the laws of State of Minnesota, USA with office address at 200 First Street S.W. Rochester, Minnesota 55905.

<sup>2</sup> Formerly Caduceus Medella Prima Corporation, a domestic corporation with address at 6th Flr.. 2 Quad Bldg., Cebu Business Park, Cebu City

<sup>3</sup> *The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.*

4. "MAAYO WOMEN'S HEALTH CLINIC" is a descriptive trademark and may not be registered trademark under Sec 123.1(j) of the IP Code.
5. Opposer's Mayo Marks have acquired valuable goodwill as trademarks, which must be protected from acts of unfair competition under Article 10*bis* of the Paris Convention and Section 168 of the IP Code.
6. Registration of the "MAAYO WOMEN'S HEALTH CLINIC" Trademark in the name of Respondent-Applicant will cause incalculable and irreparable damage to Opposer as it will dilute the distinctiveness of Opposer's international well-known trademarks and misrepresent valuable business it has established through the years, resulting in the impairment of its goodwill and reputation.

The relevant portion of its Opposition are quoted as follows:

2.1 Opposer Mayo Foundation for Medical Education and Research is a wholly-owned subsidiary of Mayo Clinic, which is a world famous, non-profit integrated health care system focusing on medical education, research and patient care based in Rochester, Minnesota. x x x

2.2 Opposer is the Mayo Clinic subsidiary which owns all of its intellectual property, including its trademarks and service marks. Opposer owns an extensive trademark portfolio consisting of numerous "Mayo" -based marks that are highly-distinctive and imbued with tremendous goodwill and significant recognition in the marketplace. Among Opposer's trademark are (a) MAYO; (b) MAYO CLINIC; (c) MAYO & Design (d) MAYO CLINIC & Design (e) MAYO CLINIC HEALTH LETTER; (f) MAYO CLINIC HOSPITAL; (g) MAYO HEALTH SYSTEM; (h) MAYO CLINIC CARE NETWORK; (i) MAYO MEDICAL LABORATORIES; (j) MAYO CLINIC PHARMACY; and (k) CLINICA MAYO, among other marks (collectively, the "MAYO Marks")

2.3 Opposer has trademark registrations for MAYO in over 50 countries. The MAYO trademark is registered in Australia, Austria, Bahrain, Benelux, Bolivia, Brazil, Canada, Chile, China, Colombia, Costa Rica, Czech Republic, Ecuador, Egypt, European Union, Finland, France, Germany, Greece, Honduras, Hong Kong, Iceland, India, Indonesia, Israel, Italy, Japan, Liechtenstein, Malaysia, Mexico, Monaco, Morocco, Norway, Panama, Paraguay, Peru, Philippines, Poland, Portugal, Qatar, Russian Federation, Saudi Arabia, Singapore, South Africa, South Korea, Switzerland, Tangiers, United States of America, Uruguay and Venezuela. x x x

2.4 In the Philippines, Opposer is the registered owner of the MAYO mark in Class 16 for printed materials, namely medical journals, health care, newsletters, patient education brochures, and medical and health related books and information. x x x

2.5 Opposer likewise has trademark registrations for MAYO CLINIC in the following countries: Australia, Bahrain, Bolivia, Brazil, Canada, Chile, China, Colombia, Costa Rica, Czech Republic, Ecuador, European Union, Guatemala, Honduras, Iceland, India, Indonesia, Israel, Japan, Jordan, Liechtenstein, Malaysia, Mexico, Monaco, Morocco, New Zealand, Norway, Panama, Paraguay, Peru, Poland, Portugal, Puerto Rico, Republic of Korea, Russian Federation, Singapore, South Africa, Switzerland, Taiwan, Tangiers, Thailand, Turkey, Uganda, United Arab Emirates, United States of America, Uruguay and Venezuela.

2.6 Mayo Clinic was founded in 1914 and is named after its founders, William James Mayo and Charles Horace Mayo. Mayo Clinic is the first and largest integrated non-profit medical group practice in the world, employing more than 4,200 physicians and

2/11

scientists and 52,900 allied health staff. It is an iconic healthcare and medical research system that annually attracts over one million patients from all 50 states and from over 100 countries. In 2014, 1.3 Million people from all 50 states of USA and 143 countries came to Mayo Clinic for care. x x x

2.8 Mayo Clinic is dedicated to providing world class medical research education, patient care, and related services that support those core interests, including philanthropic and fundraising initiatives. It is a leading academic research and medical education institution, offering students access to expert faculty and world class resources, and the opportunity to work in a broad range of fields. The education program, known as the Mayo Clinic College of Medicine, operates through five schools: Mayo Medical School, Mayo Graduate School, Mayo School of Graduate Medical Education, Mayo School of Health Sciences, and Mayo School of Continuous Professional Development.

x x x

2.11 Mayo Clinic is widely regarded as one of the world's greatest hospitals and is the recipient of numerous industry awards and prestigious recognitions. It was ranked No. 1 in the 2014-2015 U.S. News & World Report List of "Best Hospitals in the Nation," maintaining a position near the top for more than 20 years. x x x

2.12 Mayo Clinic is routinely the subject of news stories covered by international and national print media organizations x x x Additionally, numerous national news and broadcast networks x x x have reported stories about Mayo Clinic and the services offered under the Mayo brand. x x x

2.13 Mayo Clinic also provides extensive healthcare-related information at its official website: [www.mayoclinic.org](http://www.mayoclinic.org). In addition, Mayo Clinic also owns and provides additional information through the following domain names:

- a.) Mayoclinic.com;
- b.) Mayo.edu;
- c.) Healthyliving.mayoclinic.org
- d.) Sportsmedicine.mayoclinic.org
- e.) 150years.mayoclinic.org
- f.) Gbs.mayoclinic.org
- g.) individualizingmedicineconference.mayo.edu
- h.) Mayoresearch.mayo.edu/center-for-individualized-medicine; and
- i.) Philanthropy.mayoclinic.org

2.13.1 From July 2014 through June 2015, these websites have received 800 million views from visitors in countries around the world. Each website prominently display the MAYO Marks.

x x x

2.16 Mayo clinic offers a variety of medical products for sale to patient, employees, and visitors, including among others, eyewear, podiatry products, surgical products, dressings and bandages, skin and hair care products, and heart monitors.

2.17. Mayo Clinic routinely engages in advertising and marketing endeavors throughout the United States and the world, and has done so for a sustained period of time. x x x

2.18. The Mayo Marks are used throughout the world in relation to its various services. For example, the Mayo School of Graduate Medical Education offers the International Health Program which supports Mayo Clinic residents and fellows performing clinical

rotations in underserved communities around the world, including the Philippines. x x x

2.21 Among the countries in which Opposer provides healthcare laboratory services directly to health care facilities under the MAYO trademark in at least the last three years are Argentina, Australia, Austria, Bahamas, Barbados, Belgium, Bermuda, Bolivia, Brazil, Canada, Cayman Islands, Chile, Colombia, Costa Rica, Cote D'Ivoire, Croatia, Cyprus, Czech Republic, Denmark, Dominica, Dominican Republic, Egypt, El Salvador, Finland, France, Germany, Greece, Guatemala, Honduras, Hong Kong, Hungary, Iceland, India, Ireland, Israel, Italy, Jamaica, Japan, Jordan, Kingdom of Bahrain, Lebanon, Malaysia, Malta, Mexico, New Zealand, Nicaragua, Nigeria, Norway, Oman, Pakistan, Paraguay, Peru, Philippines, Portugal, Qatar, Republic of Korea, Romania, Russian Federation, Saudi Arabia, Serbia, Singapore, Slovenia, South Africa, Sweden, Switzerland, Taiwan, Thailand, The Netherlands, Trinidad and Tobago, Turkey, United Arab Emirates, United Kingdom, United States, Uruguay, Venezuela and Vietnam.

2.22 In the Philippines, Opposer renders services to the following health care facilities:  
a.) Saint Luke's Medical Center at 32<sup>nd</sup> Street Bonifacio Global City, Taguig City;  
b.) Saint Luke's Medical Center at E. Rodriguez Avenue, Quezon City  
c.) University of the East Ramon Magsaysay Memorial Medical Center at Aurora Blvd., Quezon City; and  
d.) University of the Philippines – Philippine General Hospital at 547 Pedro Gil St. Manila

2.23 The MAYO Marks are also used in connection with variety of different services beside healthcare services. For instance, Mayo Clinic sponsors a professional women's basketball team, the Minnesota Lynx, which prominently display the MAYO trademark in connection with the Lynx brand. Mayo Clinic has also recently licensed its name for use on a sports medicine and retail facility, Mayo Clinic Square, to accommodate this sponsorship. x x x

2.24 In 2014 and 2013, Mayo Clinic generated in excess of 9 Billion US Dollars (\$9,000,000,000) in gross revenue for healthcare related services delivered by 59,000 medical professionals. It spent over 8.8 Billion US Dollars (\$8,800,000,000) in 2014 and over 8.7 Billion US Dollars (\$8,700,000,000) in 2013 for salaries and benefits, supplies and services, and facilities. x x x

2.25 Opposer has a history of successful prosecution of its rights to MAYO marks. Among the registration which were cancelled or applications which were refused registration are MAYA CLINIC for distribution of herbal remedies in Benelux and MAYOLAX for pharmaceutical products in India. x x x

2.26. The MAYO mark has become so famous and well-known that it has found its way into the Encyclopedia Britannica.  
x x x

4.1 As shown in the Statement of Facts and supported by the Exhibits attached to this Opposition, Opposer's MAYO Marks are without question internationally well-known.  
x x x

4.3 The MAYO Marks are among the most famous marks in the world. They are registered in more than 50 countries. Mayo Clinic is regarded as one of the world's greatest hospitals, with more than one million people from over 100 countries coming to Mayo Clinic yearly for care. It is recipient of numerous industry awards and prestigious recognitions, and has been routinely featured in numerous publications

and broadcasting network worldwide. It provides healthcare related information in the various websites it maintains., which annually receives over 800 million views from visitors in countries around the world. It generates revenue in excess of Nine Billion Dollars (US\$ 9,000,000,000) and spends in excess Eight Billion US Dollars (US\$ 8,000,000,000) for salaries and benefits, supplies and services and facilities. Opposer has a history of successful prosecution of its trademarks and the MAYO Marks are so famous and well-known that it has found its way into the Encyclopedia Britannica. Opposer has thus sufficiently proven the status of its MAYO Marks as internationally well-known.

4.4 Respondent-Applicant's MAAYO WOMEN'S HEALTH CLINIC mark nearly resembles Opposer's MAYO Marks that it is likely to deceive or to cause confusion. The dominant term in Opposer's MAYO Marks is the term "MAYO" while the dominant term in Respondent-Applicant's mark is the term "MAAYO." Only one letter differentiates the marks from each other and Respondent-Applicant's mark contains the main, essential and dominant feature of Opposer's MAYO Marks.

x x x

4.7 A simple visual examination of Opposer's MAYO Marks and Respondent-Applicant's mark will readily show that the mark of respondent applicant contains the main, essential and dominant feature of Opposer's MAYO Marks. The use by respondent-applicant of the term "MAAYO" creates confusion in the minds of the public who are familiar with or accustomed to the services of Opposer, specially considering the fact that respondent-applicant intends to use its mark on services which are similar or closely related to Opposer's services.

x x x

4.11 Opposer's MAYO Marks are arbitrary marks, unique and very distinctive and are in fact derived from the surname of its founders. It is thus almost impossible for Respondent-Applicant, who intends to offer the same services as Opposer, to coin a mark closely resembling Opposer's MAYO Marks for identical or similar services by pure coincidence.

x x x

4.12 Section 123.1(e) of the IP Code proscribes the registration of a mark which is identical with or confusingly similar to an internationally well-known mark, whether or not it is registered in the Philippines, and used for identical or similar goods or services. x x x

4.13 Opposer's internationally well-known marks are registered world-wide in several classes covering its healthcare, research and education products and services, including Class 5 for pharmaceutical, veterinary and sanitary preparations; Class 10 for medical devices; Class 16 for medical journals, health care newsletters and patient education pamphlets; Class 41 for educational services, providing courses of instruction through a graduate medical school, medical school and school of health-related sciences and providing continuing medical education; Class 42 for medical and health care services; and Class 44 for all kinds of healthcare services, namely medical clinics, dentistry, healthcare for face and skin, hospitals, medical nursing, physical therapy, sanatorium, plastic surgery services, veterinary assistance and agriculture. On the other hand, respondent-applicant seeks to register its mark in Class 44 for comprehensive, specialized care for women's health issues or concerns. Clearly, respondent-applicant's mark is applied for registration for identical or similar services as Opposer's internationally well-known MAYO Marks.

4.14 Opposer's MAYO Marks are being used and are widely-known in the Philippines. Patients from the Philippines are among those who avail of MAYO CLINIC's

healthcare services and Filipinos, including many healthcare practitioners, are among those who regularly refer to Opposer's official website: [www.mayoclinic.org](http://www.mayoclinic.org), and its other related sites, for health care-related information resulting in over 800 million views from all over the world on an annual basis. The Philippines is also among the countries served by the Mayo International Health Program and Mayo Clinic has an exchange program with the Philippines which is offered through the Mayo Clinic's Infectious Diseases Fellowship.

4.15 Opposer's Mayo Laboratories' practice likewise renders healthcare laboratory services directly to the following health care facilities in the Philippines under the MAYO trademark:

- a.) Saint Luke's Medical Center at 32<sup>nd</sup> Street, Bonifacio Global City, Taguig City;
- b.) Saint Luke's Medical Center at E. Rodriguez Avenue, Quezon City;
- c.) University of the East- Ramon Magsaysay Memorial Medical Center at Aurora Blvd., Quezon City; and
- d.) University of the Philippines – Philippine General Hospital at 547 Pedro Gil St., Manila

x x x

4.17 Section 123.1 (f) of the IP Code proscribes the registration of a mark which is confusingly similar to an internationally well-known mark which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for where use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered mark and the interests of the owner of the registered mark are likely to be damaged by such use.

x x x

4.21 While Opposer's trademark registration in the Philippines covers printed materials namely medical journals, health care, newsletters, patient education brochures, medical and health related books and information in Class 16 and respondent-applicant's application cover comprehensive, specialized care for women's health issues or concerns in Class 44, said goods and services are health-care related, as a result of which confusion as to source or origin is likely to arise. x x x

4.24 The apparent confusing similarity between Respondent-Applicant's MAAYO WOMEN'S HEALTH CLINIC mark and Opposer's MAYO Marks is likely to cause confusion, mistake or deception as regards its affiliation, connection or association with the Opposer, or as to the origin, sponsorship or approval of its services by the Opposer. x x x

4.30 Respondent-Applicant's use of the term MAAYO, together with the WOMEN'S HEALTH CLINIC, for comprehensive, specialized care for women's health issues or concerns, disparages Opposer as one of the world's leading medical institutions. The use of respondent-applicants mark on services in which Opposer also deals in will result in the tarnishment of the positive association Opposer's Mark have come to convey.

4.31 Sec 123.1 (a) of the IP Code proscribes the registration of marks which consist of deceptive matter or other matter which may disparage institutions or bring them into contempt or disrepute. x x x

4.35 Secs 123.1 (j) of the IP Code proscribes the registration of descriptive marks or those that consist exclusively or signs or indications that designate the kind, quality, intended purpose or other characteristics of the goods or services. x x x

x x x

4.37 Respondent-Applicant's address is in Cebu where Cebuano or Visayan is the primary language. MAAYO is an adjective in the Cebuano or Visayan language that translate to "GOOD" in English. x x x

4.42 As "MAAYO WOMEN'S HEALTH CLINIC" translate to "GOOD WOMEN'S HEALTH CLINIC" which consists of purely descriptive terms, it is a descriptive trademark in its entirety and may not be registered under Sec. 123.1(j) of the IP Code. x x x

4.50 In this case, to allow Respondent-Applicant to use MAAYO WOMEN'S HEALTH CLINIC as a trademark for comprehensive, specialized care for women's health issues or concerns under Class 44 would be to condone the unlawful appropriation of the reputation and goodwill of Opposer's Mayo Marks and the products and services covered therein. To prevent Respondent-Applicant's deceptive acts which amount to unfair competition, Respondent-Applicant's trademark application should be refused registration. x x x

4.58 To protect Opposer from incalculable and irreparable damage resulting from the dilution of the distinctiveness of its MAYO, the disparagement or suggestion of a false connection between Opposer and Respondent-Applicant or the tarnishment of the positive association its mark have come to convey, as well as the impairment of the established goodwill and reputation of its products and services, Respondent-Applicant's application should be refused registration

To support its Opposition, the Opposers submitted the following exhibits:

Exhibit "A" – Officer's Certificate and Special Power of Attorney;

Exhibit "B" – By laws of Mayo Foundation For Medical Education and Research;

Exhibit "C" – Mayo Foundation Trademark Portfolio;

Exhibit "D" – US Trademark Registration for Mayo mark;

Exhibit "D-1" – Australian Trademark Registration for Mayo mark;

Exhibit "D-2" – Japan Patent Office Trademark Registration;

Exhibit "D-3" – Singapore Trademark Registration for Mayo Mark ;

Exhibit "D-4" – OHIM Trademark Registration;

Exhibit "E" – IPOPHL Trademark Registration with Reg No. 63817 for Mayo Mark;

Exhibit "F" – Print out of Mayo Foundation website;

Exhibit "G" – Print out from CNN.com regarding US News & World Report's Best Hospitals for 2014;

Exhibit "G-1" -Copy of Mayo Clinic in Fortune Magazin's list of 100 Best Companies to Work For;

Exhibit "H" to "H-11" – Print out of some of the news stories on Mayo Clinic's researches and activities;



Exhibit "I" to "I-4" – Print out of Mayo Clinic website showing health care-related information;

Exhibit "J" to "J-2" – Print out of the Mayo Clinic homepage of its electronic publication;

Exhibit "J-3" – Mayo Clinic Magazines sample;

Exhibit "K" to "K-4" – Copies of some of Mayo Clinic advertisement;

Exhibit "L" – Print out of Mayo Clinic website indicating the different countries it provides services;

Exhibit "M" – Print-out of the Mayo Clinic website regarding its School of Graduate Medical Education;

Exhibit "N" – Print out of Mayo Clinic's Mayo Medical Laboratories website;

Exhibit "O" to "O-1" – Print out of articles on Mayo Clinic sponsored Minnesota Lynx;

Exhibit "P" – Copies of parts of Mayo Clinic Consolidated Financial Report;

Exhibit "Q" – Summary of Mayo Clinic Trademark Enforcement Proceedings ;

Exhibit "Q-1" to "Q-4" – Copies of documents related to Trademark Enforcement cases;

Exhibit "R" to "R-2" –Print out of Encyclopedia Britannica website on Mayo Family;

Exhibit "S" to "S-1"– Print out of Online translation and meaning of Maayo;

Exhibit "T" – Copy of the Reply to Registrability report;

Exhibit "U" to "U-9" – Print out from USPTO database;

Exhibit "V" to "V-9" – Print out from IPO database of Maayo Trademarks; and

Exhibit "W" – Affidavit of Atty. Rhoda Regina Reyes-Rara;

This Bureau issued a Notice to Answer on 13 October 2015 and received by Respondent-Applicant on 16 October 2015. On 3 November 2015, the Respondent-Applicant filed its Verified Answer denying all the material allegations in the Opposition. The Respondent-Applicant based its Answer on the following grounds:

1. "MAAYO WOMEN'S HEALTH CLINIC" is not confusingly-similar to "MAYO";
2. "MAAYO WOMEN'S HEALTH CLINIC" is not likely to cause confusion, mistake or deception on the public;
3. "MAAYO WOMEN'S HEALTH CLINIC" does not disparage or bring "MAYO" into contempt or disrepute; and
4. "MAAYO WOMEN'S HEALTH CLINIC" will not cause any damage to or dilute the Opposer's mark.

The pertinent portion of the Answer are as follows:

1. There is a world of difference between the pronunciation of "MAYO" and "MAAYO."

- a.) "MAYO" is composed of two syllables and pronounced as May·Yo while "MAAYO" is composed of three syllables and pronounced as Mah·Ah·Yoo;
- b.) The first syllable of "MAYO" is pronounced with a long "A" and sounds like the first syllable of the word "mayonnaise" while the first syllable of "MAAYO" is pronounced with a short "A" and sounds like the syllables in "Mama;"
- c.) The second syllable of "MAYO" is pronounced as the greeting "Yo!" while the second syllable of "MAAYO" is pronounced as "Ah" and the third syllable is pronounced as "Yoo;"
- d.) "MAAYO" has two short "A"s which are pronounced as two syllables whereas "MAYO" has only one long "A;"
- e.) "MAYO" is a surname and is thus, a proper noun while "MAAYO" is a common noun with multiple meanings (as will be discussed herein). "MAAYO" has absolutely no relation to Mayo the person or the medical facility; and
- f.) "MAYO" and "MAAYO" do not sound alike at all and the public will never be confused by the two.

*The accompanying triple shield logo*

2. The Opposer uses its triple shield logo together with its MAYO word marks. x x x
3. This accompanying logo further differentiates the MAYO marks from MAAYO. Hence, there is no likelihood of confusion and the public would never be confused.  
x x x
5. In this case, the differences between the word marks "MAAYO" and "MAYO" are not minimal at all and are more than sufficient to distinguish one brand from the other. In the KOLIN Case, two word marks are exactly the same yet the Supreme Court ruled them to be non-confusing. In this case, the marks are not same and are pronounced differently. Moreover, the Opposer's mark is coupled with the triple shield logo. Hence, there could never be any confusion.  
x x x
7. In the present case, the "unsubtle" differences are more than enough to avoid confusion.
8. The Respondent's mark is applied for comprehensive, specialized care for women's health issues or concerns. The foregoing proves that when someone seeks comprehensive, specialized care for women's health issues or concerns, she would never think that the Respondent's services are the same as those of the Opposer's. Someone seeking the Respondent's services would never think that they (the Respondent's services) are the same or come from the entity behind "MAYO."
9. The parties' respective marks possess distinctive qualities that negate the possibility of confusion by those who seek medical services. Their appearance, sound, connotation, and the commercial impression created are so distinct from each other that the possibility of confusion is inconceivable. When the public is confronted with the two marks, they will never think that these are owned by the same entity.

*People seeking comprehensive specialized care for women's health issues or concerns will never be confused*

10. The case of ETHEPA A.G. vs. Director of Patents, G.R. No. L-20635, is instructive and applies by analogy. x x x
11. By analogy, comprehensive, specialized care for women's health issues or concerns is not articles of everyday use which may be freely obtained by anyone, anytime, anywhere. One seeking comprehensive, specialized care for women's health issues or concerns asks for referrals and inquiries who the best medical practitioners are. She is not of the incautious, unwary, unobservant or unsuspecting type. She researches if the service provider has an excellent reputation and renders proficient service. Her first question is: which service provider would I consult? A

person seeking comprehensive, specialized care for women's health issues or concerns is hardly the man to be deceived.

12. Thus, someone seeking comprehensive, specialized care for women's health issues or concerns would never be deceived into thinking that "MAAYO" is the same as "MAYO." Again, the first question in her mind is: which service provider should I consult? After deciding on whom to consult, the next question is: where is his clinic located so I could visit him? If the chosen service provider has his clinic in a "MAAYO" facility, only then will he learn of that fact. Whether the chosen service provider has his clinic at a "MAAYO" facility or at another place, someone seeking to consult him will go to his clinic regardless of its location. Hence, whether a service provider is at a "MAAYO" facility is not the decisive factor in choosing a service provider. The crucial factor are the qualifications of the service provider – location of his clinic is of no importance.

x x x

14. Comprehensive, specialized care for women's health issues or concerns is not ordinary consumable household items which are of minimal cost. The service is not easily affordable. Accordingly, one seeking comprehensive, specialized care for women's health issues or concerns is predisposed to be more cautious and discriminating in and would prefer to mull over his choice of a service provider. Choosing a service provider is done only after deliberate, comparative, and analytical investigation as to his credentials. Confusion and deception, then is less likely between "MAAYO" and MAYO."

*The claim that the Opposer's mark is well-known*

20. The Opposer has not proven that its mark is well-known in the Philippines. It may be known in the U.S. but popularity in the U.S. does not translate to worldwide popularity. The Opposer's mark is likewise not popular in the Philippines. Maybe it is only Americans who are currently in the country who are familiar with this brand.
21. The Opposer also failed to prove that its mark is both locally and internationally well-known. It is the recognition of the mark that lies at the core of establishing whether a mark is famous or well-known. It is the Opposer's burden to prove that it is both internationally and locally well-known.
22. International registrations and advertisements are merely additional factors that only assist in assessing the degree of recognition acquired by a mark. It is consumer-recognition and not registration that makes a mark well-known. Besides, there is no substantial proof showing a logical relationship that an increase in trademark registration equates to an increase in consumer recognition of the mark. Thus, a registration of a mark becomes a valid indicator of the expansion of a mark's reputation when applied in conjunction with the evidence of enforcement, use, and advertising – and the most important of which is enforcement and use. (as discussed in Famous and Well-Known Marks, Second Edition, 2004, Frederick W. Mostert)

x x x

24. RA 8293 is very clear and unambiguous, needs no interpretation, and should prevail over any other law or treaty. RA 8293 requires that a well-known mark should be well-known BOTH internationally AND in the Philippines as a result of the promotion of the mark.
25. The Opposer's mark is not known and is not promoted in the Philippines. Under Rule 103 of Implementing Rules and Regulation on Trademarks, a criterion in determining whether a mark is well-known is the market share in the Philippines of the goods or services to which the mark applies. There is absolutely no evidence of such market in the Philippines of the Opposer's mark. Thus it does not meet the requirement of being an internationally well-known mark.

x x x

27. The Opposer avers that it renders healthcare laboratory services under the MAYO trademark in Saint Luke's Medical Center, University of the East-Ramon Magsaysay Memorial Medical Center, and University of the Philippines – Philippine General Hospital. However aside from these allegations in paragraphs 2.22 and 4.15 of the Opposition, no proof is presented regarding this claim. The Opposer's Exhibit "N", cited in paragraph 4.15, merely states that it benefits customers around the world but demonstrates no proof of these services in the Philippines. x x x

*The Opposer's goods are not related to the Respondent's services*

28. Since the Opposer's mark does not meet the requirement of being internationally well-known, its protection in the Philippines is limited only to its Class 16 registration which only covers printed materials pertaining to health. It is obvious that comprehensive, specialized care for women's health issues or concerns is not related to printed materials. Printed materials are merely products – even if they pertain to health.
29. In the Kolin Case, it was held that it is not sufficient to state that the goods involved are electronic products in order to establish relatedness between the goods. By analogy, it is also not sufficient that the Opposer's printed materials pertain to health to claim that they are related to the Respondent's comprehensive, specialized care for women's health issues or concerns.  
x x x
33. Hence, assuming arguendo that the contending marks are similar, they may be registered since they cover different goods and services. Printed materials, even if related to health, are not the same or are not related to comprehensive, specialized care for women's health issues or concerns.  
x x x
35. Assuming arguendo that "MAYO" is internationally well-known, there is also no way for the public to relate the Respondent's services with it. x x x
36. In the same vein, if MAYO is a well-known brand, those who have been availing of its services certainly know its services too well to confuse the Respondent's services with them.

*Alleged prosecution*

37. The Opposer claims that it has successfully prosecuted its rights to the MAYO marks. However, all that it attaches to the Opposition is a self-serving summary of alleged cases that it won. x x x
38. Moreover, the alleged cases involve marks like "MAYA" "MAIO" and "MAYO." These are dissimilar to the instant case which involves a mark which has three syllables and is pronounced differently from "MAAYO."

*"MAAYO" is not descriptive*

39. It is not true that "MAAYO" is descriptive.  
x x x

*Multiple meanings of "MAAYO"*

43. "MAAYO" is a Cebuano word which means good, not damaged, undamaged, or unimpaired.  
x x x
45. When a Cebuano-speaking person hears "MAAYO", he associates it with greetings like: MAAYONG BUNTAG" ("Good Morning") "MAAYONG HAPON," ("Good Afternoon") "MAAYONG GABII" ("Good Evening"). In this sense, "MAAYO" is a word used for greeting and as a sign of respect.  
x x x
47. The bottom line is that "MAAYO" has different meanings and connotations to the Cebuano-speaking populace. When a Cebuano-speaking person hears the word

- "MAAYO," he does not associate it with medical services. This makes "MAAYO" registrable as the Respondent is using it fancifully.
48. As to the word "GOOD," a look at the IPO Trademarks Database reveals 149 trademark registrations and 100 pending applications with the word "GOOD" in them. x x x
  49. Hence assuming Arguendo that "MAAYO" only means "good," "MAAYO WOMEN'S HEALTH CLINIC" should also be registered in the same way that the above enumerated "GOOD" marks were registered.

*Alleged goodwill and alleged trademark dilution*

50. The Opposer alleges that the opposed mark will take advantage of its goodwill and will cause it damage. This is farthest from the truth.
51. It bears repeating that the Opposer has not proved that its mark is famous in the Philippines. Assuming that it is, there is no riding on its goodwill simply because of the differences between the contending marks. Hence, the averred taking advantage of goodwill and causing of damage is merely imaginary.
52. There is also no trademark dilution. Trademark dilution only comes into play when the contending marks are confusingly similar – however, they are not in this case. Even granting that "MAYO" is famous, the opposed mark is not confusingly similar to it. Thus, there is no application of the trademark dilution concept at all.  
x x x

On 30 May 2016, a preliminary conference was conducted. Upon termination of the preliminary conference, the parties are then directed to file their respective Position Papers. Consequently, this case was submitted for decision.

The basic issue to resolve in this case is whether Respondent-Applicant's trademark "MAAYO WOMEN'S HEALTH CLINIC" should be allowed to be registered.

The Opposition is anchored on Section 123.1 (d), (e), (f), (g), and Section 168 of the IP Code, to wit:

Section 123.1. 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:

- (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:

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the

Philippines which has been obtained as a result of the promotion of the mark;

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use;

(g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;

(j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services;

Section 168. Unfair Competition, Rights, Regulation and Remedies. –

168.1. A person who has identified in the mind of the public the goods he manufactures or deals in, his business or services from those of others, whether or not a registered mark is employed, has a property right in the goodwill of the said goods, business or services so identified, which will be protected in the same manner as other property rights.

168.2 Any person who shall employ deception or any other means contrary to good faith by which he shall pass off the goods manufactured by him or in which he deals, or his business, or services for those of the one having established such goodwill, or who shall commit any acts calculated to produce said result, shall be guilty of unfair competition, and shall be subject to an action therefor.

The relevant trademarks are reproduced below for comparison:



After a careful perusal of the records and the evidence submitted by the parties, this Bureau finds the Opposition meritorious.

An examination of the Respondent-Applicant's trademark shows that the most prevalent and dominant feature is the word "MAAYO." It is the word that will catch the eyes and ears of the public and is the one that would identify the

Respondent-Applicant's products or services. The accompanying words "WOMEN'S HEALTH CLINIC" serve merely as a descriptive terms, since they relate to the type of services subject of the trademark. These words do not give a separate identity to the mark. In fact, on the trademark application documents the words "WOMEN'S HEALTH CLINIC" is expressly disclaimed by Respondent-Applicant.<sup>4</sup> Moreover, the Respondent-Applicant will be using the word "MAAYO" as a housemark as can be gleaned from the different trademark variations applied by Respondent-Applicant.<sup>5</sup>

Thus, in determining the existence of confusing similarity that will bar registration of the applied trademark, this Bureau will focus on the wordmarks "MAYO" vis a vis "MAAYO."

At the outset, it is apparent that four (4) of the five (5) letters of the dominant wordmark being applied by the Respondent-Applicant are identical with the registered mark of the Opposer, particularly "M," "A," "Y" and "O." Notably, the similar letters comprise the whole of the Opposer's "MAYO" wordmark.

While it is true that the Respondent-Applicant's dominant wordmark is composed of three (3) syllables (MA – A – YO) and the Opposer's mark only has two syllables (MA – YO), the additional syllable at the middle which constitute a single letter "A", does not give sufficient distinguishing feature to the mark, both visually and aurally.

Respondent-Applicant asserts that in addition to the number of syllables, the two marks are also pronounced differently. It adds that the first two syllables of Respondent-Applicant mark have a short "A" sound, while the Opposer has the long "A" on its first syllable. It further contends that the last syllable in the Opposer is pronounced as "Yo!" while it is "Yu" or "Yoo" for the Respondent-Applicant.

However, the hair-splitting differentiation being espoused by the Respondent-Applicant is untenable. Considering that the consonants ("M" and "Y") accompanying the vowels in both trademarks are the same, the difference in the length of the vowel sounds on the marks would be trivial at best. On the contrary, comparing them aurally, the contending marks are practically the same. The added single vowel sound in the second syllable of the Respondent-Applicant's mark could easily be pronounced by the consuming public as joint or blended with the preceding similar vowel sound of the first syllable. As argued by the Opposer, this is especially apparent when the said wordmark is pronounced quickly or in a hurry. It may be true that MAAYO was taken by Respondent-Applicant from the Cebuano or Visayan dialect with its own diction and enunciation, but the Respondent-Applicant's medical services would nonetheless still be available to non-Cebuanos that could pronounced the mark differently. Hence, the evil sought to be prevented would still subsist.

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<sup>4</sup> Exhibit "T" of the Opposer

<sup>5</sup> Exhibit "W" of the Opposer and Paragraph 41 of the Answer of the Respondent-Applicant

Verily, under our jurisdiction, Intellectual Property 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>6</sup> Our law also does not require actual confusion, it being sufficient that confusion is likely to occur.<sup>7</sup>

The Respondent-Applicant also contends that the Opposer's mark is usually accompanied by triple shield logo and further differentiates the MAYO marks from MAAYO. This Bureau does not agree. The inclusion of a triple shield logo in the Opposer's mark would not affect the existence of confusing similarity because "MAYO" and "MAAYO" wordmarks will still be the dominant feature of the respective marks.

The possible occurrence of confusion or mistake on the part of the consuming public is heightened by the fact that the goods or services subject of the Respondent-Applicant's trademark is closely related to the goods or services being offered by the Opposer. The mark of the Opposer is registered for medical and health related printed materials or publications, while the Respondent-Applicant trademark is being applied for health clinic. The Respondent-Applicant claims that since the registered Opposer's products refer to goods while the Respondent products refers to services, they are not related. Again, this Bureau is not persuaded. Undeniably, the products subject of the competing trademarks both pertain to health or medical care. It is not farfetched that the patient-customers who will avail of the medical procedures or services of Respondent-Applicant would come across the medical research and articles published by the Opposer. Moreover, the Opposer has sufficiently shown that as an indispensable part of the researches for its medical publications, Opposer also operates similar hospital care<sup>8</sup> and laboratory services<sup>9</sup> on its Mayo Clinic Health System facilities based in the U. S.

The reliance of Respondent-Applicant on the Kolin case<sup>10</sup> is equally misplaced. In the said case, the Court adjudged that the consumer goods of the competing parties are not part of the same diversified categories of electronic goods and therefore not related. The condition is different in health care industry, where customer-patients would generally read medical articles and publications related to their illness which affect their decision making in choosing the proper medical services and their providers. Thus, in view of the confusing similarity of MAYO and MAAYO wordmarks, even an ordinary intelligent customer could make a mistake to assume that the Respondent-Applicant's medical services

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<sup>6</sup> American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

<sup>7</sup> Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992

<sup>8</sup> Exhibit "G" and "G-1" of the Opposition

<sup>9</sup> Exhibit "N" of the Opposer

<sup>10</sup> Taiwan Kolin Corporation, Ltd vs. Kolin Electronics Co. Inc., G.R. No. 209843, March 25, 2015.




originate from or sponsored by the Opposer, or at the very least, a connection exist between them as in a partnership or a trademark licensing agreement.

Succinctly, the protection of trademarks as intellectual property is intended not only to preserve the goodwill and reputation of the business established on the goods or services bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods or services.<sup>11</sup>

**WHEREFORE**, premises considered the Opposition to the Trademark Application with Serial No. 42014013223 is hereby **SUSTAINED**. Let the filewrapper of Trademark Registration with Serial No. 42014013223 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

**SO ORDERED.**

Taguig City, 29 JUN 2018

  
**Atty. Leonardo Oliver Limbo**  
Adjudication Officer  
Bureau of Legal Affairs

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<sup>11</sup> Berris Agricultural Co., Inc. vs. Norvy Abyadang, G.R. No. 183404, 13 October 2010; Skechers, U.S.A. vs. Inter Pacific Industrial Trading Corp.; Trendworks International Corporation vs. Inter Pacific Industrial Trading Corp., G.R. No. 164321, 28 March 2011.