

“6. Applicant’s unauthorized appropriation of the mark O’ THALIA is an infringement of Opposer’s intellectual and industrial property rights and of her right of publicity to the singer and actress THALIA (sic) by which she is well-known among Philippine consumers long before the Applicant’s filing of the present application in 1996, by reason of the sale and distribution of her phonograph recordings and videos and the commercial television broadcast and use of such mark in Opposer’s television programs long before applicant appropriated and used it as a mark without Opposer’s consent or authority.

“7. The registration of the trademark O’ THALIA in the name of the Applicant is contrary to other provisions of the Intellectual Property Code.”

To support the opposition, Opposer relied upon the following facts, among others:

“1. Opposer is a licensor of wide variety of goods in Class 9, including eyeglasses, glass frames, eyeglass cases, sunglasses, prescription sunglasses, audio and audiovisual recordings, including phonograph records, motion picture films, electronic books and publications, among others. Opposer has adopted and used the trademark THALIA for goods in Class 9, clothing including shirts and lingerie in Class 25 and other items such as perfumery in Class 3, which Opposer has been actively promoting and selling for many years. Opposer has been commercially using the trademark THALIA long before the appropriation and use of O’ THALIA by the Applicant.

“2. Opposer is the owner of the trademark THALIA, and has applied for its registration in her name with the Intellectual Property Office for goods in Class 9. Opposer has also used and registered or applied for the registration of the trademark THALIA for the same products in other countries. Indeed, Opposer has sold her own line of lingerie, panties and brasseries under the THALIA trademark in Mexico and elsewhere.

“3. Opposer’s trademark THALIA is an internationally well-known trademark and is now part of her commercial identity as a well-known singer and actress in the Philippines and elsewhere. Opposer’s trademark and professional name THALIA is protected against appropriation and use by other parties without Opposer’s consent.

“4. Opposer’s trademark THALIA is an arbitrary trademark when used on goods in Class 9 and is entitled to broad legal protection against unauthorized users like the Applicant who has appropriated it for an identical and/or related class of goods.

“5. Opposer is the first user of the trademark THALIA, which Applicant has appropriated for the obvious purpose of misleading the public into believing that his goods originate from, or are licensed or sponsored by Opposer.

“6. Applicant has misrepresented that he is the first user of the trademark O’THALIA, which he derived from Opposer’s trademark and professional name THALIA.

“7. Applicant’s infringing use of the trademark O’ THALIA for his goods, which rightfully belongs to Opposer, is not lawful use of the trademark in commerce, and cannot be the basis of trademark ownership.

“8. The registration and use of a confusingly similar trademark by the Applicant will tend to deceive and/or confuse purchasers into believing that

Applicant's products emanate from or are under the sponsorship of the Opposer, for the following reasons:

- i) the trademarks are identical and/or confusingly similar;
- ii) the trademarks are applied on identical/related goods;
- iii) the parties are engaged in competitive business; and
- iv) the goods on which the trademarks are used are bought by the same class of purchasers and flow through the same channels of trade.

Applicant obviously intends to trade, and is trading on, Opposer's goodwill.

"9. The registration and use of a confusingly similar trademark by the Applicant will diminish the distinctiveness and dilute the goodwill of Opposer's trademark and professional name THALIA."

The Notice to Answer, dated 25 September 2002, was served upon and received by Respondent-Applicant. For failure of the Applicant to file the required Answer, Applicant was declared in default by this Office as per Order No. 2003-39 and the Opposer was allowed to present its evidence ex-parte.

Admitted as evidence for the Opposer are Exhibits "A" to "C", inclusive of sub-markings, consisting of: the notarized and legalized Affidavit of the Opposer; legalized copies of the Certificates of Registration of the trademark THALIA in the name of the Opposer such as Certificates of Registration No. 519962 and 539828 dated 29 March 1996 and 27 January 1997 respectively (Mexico), Certificate of Registration No. 2, 163,352 dated 09 June 1998 (USA), Certificate of Registration No. 819630985 dated 30 May 2000 (Brazil), and Certificate of Registration No. DNPI-469-98-MCIP dated 26 January 1998 (Ecuador); notarized affidavits of Opposer's fans in the Philippines; and certified copy of the Philippine trademark application for the mark THALIA with Serial No. 4-2002-004212.

The issues to be resolved in this particular case are: (a) whether or not there exists a confusing similarity between the Opposer's trademark THALIA and Respondent-Applicant's trademark O' THALIA; and (b) who between the Opposer and the Respondent-Applicant is the prior user entitled to protection under the Trademark Law.

Considering that the Application subject of the instant opposition was filed under the old Trademark Law (R.A. 166, as amended), this Office shall resolve the case under said law so as not to adversely affect rights already acquired prior to the effectivity of the new Intellectual Property Code (R.A. 8293).

The applicable provisions of the Trademark Law, Sections 4(c) and 4(d) provide:

"Sec. 4. *Registration of trademarks, trade-names and service-marks on the principal register.* – xxx The owner of a trademark, trade-name or service-mark used to distinguish his goods, business or services from he goods, business or service of others shall have a right to register the same on the Principal Register, unless it: xxx

[(c) Consists of or comprises a name, portrait or signature identifying a particular living individual except by his written consent, or the name, signature or portrait of a deceased President of the Philippines, during the life of his widow, if any, except by written consent of the widow.]

(d) Consists of or comprises a mark or trade-name which so resembles a mark or trade-name registered in the Philippines or a mark or trade-name

previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or service of the applicant, to cause confusion or mistake or to deceive purchasers.”

As per the evidence presented, Opposer was able to show that THALIA is the screen name by which she is well known as an actress and singer in the Philippines and elsewhere. As THALIA, Opposer played the lead character in several telenovelas, including “Marimar” and “Maria Mercedes”, which have been shown on Philippine television since 1996. Opposer also recorded several music albums, including the album THALIA 1990, under said screen name.

Capitalizing on the popularity of the name THALIA, Opposer has manufactured and marketed a variety of goods under said name. Opposer adopted and used the trademark THALIA for goods such as perfume (Class 3); eyeglass cases, sunglasses, etc (Class 9); shirts, jackets, sweaters, etc. (Class 25); and toys (Class 28), among others.

As THALIA, Opposer gained such popularity among Filipinos such that when she had a concert in the Philippines, then President Fidel V. Ramos even invited her to Malacañang Palace for a courtesy call. In the minds of the Filipino public, the name THALIA identifies a particular living individual; the Opposer.

Under Section 4(c) of the Trademark Law, a trademark cannot be registered if it consists of a name of a particular living individual, except with his written consent. And to identify a particular living individual, a name does not have to be a person’s full name. (*Ross vs. Analytical Technology, Inc.*, 51 USPQ2d 1269 [TTAB 1999]). “Name” refers to any name regardless of whether it is a full name or a surname or given name, or even a nickname, which identifies a particular living individual. (*Societe Civile des Domaines Dourthe Freres vs. S.A. Consortium Vinicole de Bordeaux Et de la Gironde*, 6USPQ2d 1205 [TTAB1988]). In the instant case, the screen name THALIA is the name by which Opposer is well known in the Philippines. The public would reasonably assume Opposer’s connection with Respondent-Applicant’s goods, considering that the only difference between Opposer’s name and Respondent-Applicant’s mark is the addition of the prefix “O”.

With regard to the issue of confusing similarity, the determinative factor in a contest involving registration of trademark is not whether the challenged mark would *actually* cause confusion or deception of the purchasers but whether the use of the mark would *likely* cause confusion or mistake on the part of the buying public. The law does not require that the competing trademarks must be so identical as to produce actual error or mistake. It would be sufficient that the similarity between the two trademarks is such that there is a possibility or likelihood of the older brand mistaking the newer brand for it.

In the case of *Etepha vs. Director of Patents* (16 SCRA 502), the Supreme Court stated that:

“The essential element of infringement is colorable imitation. This term has been defined as “such a close or ingenious imitation as to be calculated to deceive ordinary purchasers, or such resemblance of the infringing mark to the original as to deceive an ordinary purchaser giving such attention as a purchaser usually gives, and to cause him to purchase the one, supposing it to be the other.”

The Supreme Court, in determining whether or not there is confusing similarity between trademarks, has relied on the dominancy test or the assessment of the essential or dominant features in the competing trademarks. Even the spelling and the similarity in sounds and pronunciation are taken into consideration. Thus, in the case of *Co Tiong Sa vs. Director of Patents* (95 Phil 1) the application for the registration of the trademark “FREEDOM” was rejected due to the existing registration of the mark “FREEMAN” over the same class of goods.

In the case of *Marvex Commercial Co. vs. Hawpia & Co. (18 SCRA 1178)*, THE Supreme Court found that:

“The tradename ‘LIONPAS’ for medicated plaster cannot be registered because it is confusingly similar to ‘SALONPAS’, a registered trademark also for medicated plaster. xxx Although the two letters of ‘SALONPAS’ are missing in ‘LIONPAS’ the first letter *a* and the letter *s*. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. xxx”

In the case of *American Wire and Cable Co. vs. Director of Patents (31 SCRA 544)*, the Supreme Court observed that:

“xxx The similarity between the two competing trademarks, DURAFLEX and DYNAFLEX is apparent. Not only are the initial letters and the last half of the appellations identical but the difference exists in only two out of the eight literal elements of the designations. Coupled with the fact that both marks cover insulated flexible wires under Class 20; xxx no difficulty is experienced in reaching the conclusion that there is a deceptive similarity that would lead the purchaser to confuse one product with the other.”

In the instant case, the only difference between the two trademarks is in the addition of the letters “O” in Respondent-Applicant’s trademark. Both trademarks also cover similar goods, i.e., goods under Class 25. As such, both products flow through the same channels of trade such that confusion between the two trademarks is likely to result in the mind of the prospective buyers.

The purpose of the law in protecting a trademark cannot be over-emphasized. They are to point out distinctly the origin or ownership of the article to which it is affixed, to secure to him, who has been instrumental in bringing into a market a superior article of merchandise, the fruit of his industry and skill, and to prevent fraud and imposition (*Etepha vs. Director of Patents, ibid.*). Today, the trademark is not only a symbol of origin and goodwill --- it is often the most effective agent for the actual creation and protection of goodwill. In other words, the mark actually sells the goods. The mark has become the “silent salesman”. It has become a more convincing selling point than even the quality of the articles to which it refers. (*Mirpuri vs. Court of Appeals, 318 SCRA 516*)

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Consequently, application bearing Serial No. 114255 for the registration of the mark “O’THALIA” filed in the name of TE BI, on 26 September 1996 is hereby REJECTED.

Let the file wrapper of O’THALIA subject matter of this case be forwarded to the Administrative, Financial Human Resource Development Service Bureau for appropriate action in accordance with this Decision and a copy hereof be furnished to the Bureau of Trademarks for information and update of its records.

SO ORDERED.

Makati City, June 30, 2003.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office