

BIOFEMME, INC.,	}	IPC NO. 14-2008-00020
Opposer,	}	Opposition to:
	}	Application Serial No. 4-2006-012083
-versus-	}	Date filed: 7 November 2006
	}	Trademark: "ELLA"
LABORATOIRE HRA PHARMA,	}	
Respondent-Applicant.	}	
x-----x		Decision No. 2009-68

DECISION

For decision is the Notice of Opposition filed by BIOFEMME, INC., opposer herein, a corporation organized and existing under the Philippine laws with address at 2nd Floor Bonaventure Plaza, Greenhills, San Juan City against Application Serial No. 42006012083 for the trademark "ELLA" for goods under class 5 – "pharmaceutical preparations, namely occasional, postcoital or emergency contraceptives" filed on 7 November 2006 by Laboratoire HRA Pharma, respondent-applicant herein, a corporation organized in France with address at 15 Rew Beranger Paris 75003 France.

The grounds for the opposition are as follows:

1. The trademark "ELLA" so resembles "ELA" trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark "ELLA". The trademark "ELLA", which is owned by Respondent, will likely cause confusion, mistake and deception on the part of the purchasing, public, most especially considering that the opposed trademark "ELLA" is applied for the same class of goods as that of trademark "ELA", i.e. Class (5).

2. The registration of the trademark "ELLA" in the name of the Respondent will violate Sec. 123 of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines", which provides, in part, that a mark cannot be registered if it:

"(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; (Emphasis supplied)

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

3. Respondent's use and registration of the trademark "ELLA" will diminish the distinctiveness and dilute the goodwill of Opposer's trademark "ELA".

In support of the opposition, opposer submitted the following evidences:

ANNEX	DESCRIPTION
"A"	copy of page 2 IPO E-Gazette
"B"	photocopy of Notice of Allowance

A Notice to Answer was received on 27 February 2008 but no Answer was filed. The issue is whether the mark "ELLA" can be registered as a mark for goods under class 5.

The Intellectual Property Code states:

"Section 123. *Registrability*. – 123.1 A mark cannot be registered if it:
xxx

"(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; (Emphasis supplied)

Opposer relies on the above-quoted provision of law and asserts that it is the lawful owner of the mark ELA. It argues that ELLA is confusingly similar to ELA. Aside from a page from the IPO-E Gazette where respondent-applicant's ELLA mark was published, opposer presented a photocopy of the Notice of Allowance issued by the Bureau of Trademarks which was notarized by a notary public. The Notice of Allowance stated the applicant as BIOFEMME, Inc. and the mark ELA with a filing date of August 23, 2006.

Jurisprudence has developed two tests in determining the issue of confusing similarity. However, the Supreme Court in *McDonald's Corporation v. L.C. Big Mak Burger, Inc.*, G.R. No. 143993, dated 18 August 2004 held:



"In determining likelihood of confusion, jurisprudence has developed two tests, the dominance test and the holistic test. The dominance test focuses on the similarity of the prevalent features of the competing trademarks that might cause confusion. In contrast, the holistic test requires the court to consider the entirety of the marks as applied to the products, including the labels and packaging, in determining confusing similarity. xxx

The test of dominance is now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code which defines infringement as the "colorable imitation of a registered mark xxx or a dominant feature thereof."

Applying the dominance test, the Court finds that respondents' use of the "Big Mak" mark results in likelihood of confusion. First, "Big Mak" sounds exactly the same as "Big Mac". Second, the first word in "Big Mak" is exactly the same as the first word in "Big Mac". Third, the first two letters in "Mak" are the same as the first two letters in "Mac". Fourth, the last letter in "Mak" while a "K" sounds the same as "C" in spelling, thus "Caloocan" is spelled "Kaloocan". (Underscoring supplied)

The Supreme Court in *American Wire & Cable Co. vs. Director of Patents*, 31 SCRA 544 held:

"The similarity between the competing marks, DURAFLEX and DYNAFLEX, is apparent. Not only are the initial letters and the last half of the appellations identical, but the difference exists only in two out of the eight literal elements of the designations. Coupled with the fact that both marks covered insulated flexible wires under class 20; that both marks covered insulated flexible wires under class 20; that both products are contained in boxes of the same material, color, shape and size; xxx"

Opposer's mark	Respondent-Applicant's mark
	

Applying the dominancy test in scrutinizing the contending marks, it is plain that except for an additional letter "L", the mark ELA is the same as the mark ELLA, previously allowed for registration with an earlier filing date, as seen in the Notice of Allowance. (Annex "B"). Moreover, both trademarks are used on the same class of goods i.e. Class 5, pharmaceutical preparations.

WHEREFORE, premises considered the OPPOSITION filed by Biofemme, Inc., opposer is hereby SUSTAINED. Accordingly, Application Serial No. 4-2006-012083 filed by Respondent-Applicant, Laboratoire HRA Pharma, respondent-applicant on 7 November 2006 for registration of the mark "ELLA" used on goods under Classes 5, is, as it is, hereby REJECTED.

Let the filewrapper of "ELLA ", subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 9 June 2009.

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