

ALLERGAN, INC.,  
Opposer,  
-versus-

IMAGE SENSE CORPORATION,  
Respondent-Applicant

x-----x  
ALLERGEN, INC.,

-versus-

IMAGE SENSE CORPORATION,  
Respondent-Applicant

x-----x

IPC NO. 14-2009-00115  
Opposition to:

Appln. No. 4-2007-013068  
Date filed: 23 November 2007  
TM: "BOT-C WORKS BETTER  
THAN BOTOX"

IPC NO. 14-2009-00116  
Opposition to:

Appln. No. 4-2007-013069  
Date filed: 23 November 2007  
TM: "BOT-C WORKS LIKE  
BOTOX WITH VIT. C"

Decision No. 2011-55

## DECISION

ALLERGAN, INC. ("Opposer") filed on 17 April 2009 separate oppositions to Trademark Application serial Nos. 4-2007-013068 and 4-2007-013069. The applications, filed by IMAGE SENSE CORPORATION ("Respondent-Applicant") on November 2007, cover the marks "BOT-C WORKS BETTER THAN BOTOX" and "BOT-C WORKS LIKE BOTOX WITH VIT.C" for use on goods under class 03 of the International Classification of goods."

The Opposer anchors its cases on common grounds. It alleges that as the registered owner of the BOTOX trademark in the Philippines for goods under classes 3, 5 and 16, it is entitled to the exclusive use thereof in connection with said goods and those that area related thereto. It argues that allowing the Respondent-Applicant's application will violate Sec.1.23.1 (d), (e), and (f) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), the Paris Convention for the Protection of Industrial Property, and the WTO-Trade Related Aspects of Intellectual Property ("TRIPS") Agreement which widened the scope of protection of well known marks by enjoining unauthorized use of these marks on dissimilar goods/services.

The Opposer also claims that it has global marketing and sales capabilities in more than 100 countries, with BOTOX as its leading product and that the mark is a coined term it originally adopted in the 1980s for its "botulinum toxin" to treat eyelid spasms and crossed eyes and which eventually, through its substantial investment and efforts, other applications therefore were discovered. According to the Opposer, BOTOX is currently most popularly associated with the field of medical aesthetics, involving a simple non-surgical procedure for temporarily smoothing moderate to severe wrinkles. Since its approval in 2002, BOTOX Cosmetics has been number one physician administered aesthetic procedure in the U.S. and enjoys a popular following worldwide. BOTOX branded products are currently available in 75 countries including the Philippines, enjoying consistently growing sales. The success of the BOTOX brand, the Opposer says, due in large part to the significant promotional efforts it undertaken worldwide, not only through publications (newspapers and magazines) but also via education awareness programs to broaden public knowledge about BOTOX. The Opposer has its own website and maintains another which is dedicated for BOTOX products. It points out that the mark is even mentioned in popular television shows such as "CSI Miami" and "Desperate Housewives", it has registered and applied for registration the mark in various countries throughout the world, and has successfully defended its rights over the mark in various jurisdictions. BOTOX, the Opposer contends, has been recognized as a well-known mark in other countries. In the Philippines, it has several applications and registrations for the mark since 2000. The Opposer cites the Respondent-

Applicant's obvious pattern copying the BOTOX mark, filing several applications that incorporate "BOTOX", "BOTO", "BOT", "BOT-X" and/or "B-TOX" betraying the intent to acquire rights over marks identical or similar to Opposer's.

The evidence for the Opposer consist of the

1. Exh. "A"- Verified Notice of Opposition;
2. Exh. "B" to "F"- Trademark Reg. Nos. 42000-010286, 4-2008-005229, 056418' 4-2000-008512 and 4-2000-010285;
3. Exh. "G" to "Z"- Various certified true copies of trademark registration in Hong Kong, United Kingdom, OHIM (European community), China, Singapore, Australia and Japan;
4. Exh. "AA"- Legalized Power of Attorney in favor of Taw & Associates;
5. Exh. "BB"- Legalized Affidavit of Martin A. Voet, Assistant Secretary of the Opposer Corporation;
6. Exh. "CC"- The Opposer's 2007 Annual Report;
7. Exh. "DD"- List of various reports and articles in relation to the BOTOX products published in various medical or specialist journals and publications and from conferences, including from Hong Kong, U.S. and Korea;
8. Exh. "EE" (inclusive) - Schedule of Opposer's registrations and pending applications for BOTOX around the world sampling of the registrations in key countries;
9. Exh. "FF"- A copy of the American Society for Aesthetic Plastic Surgery 2004 statistics report;
10. Exh. "GG"- A slide showing the covers of some the magazines the Opposer advertised in 2006;
11. Exh. "HH"- The Opposer's 2006 magazine print media schedule and budget;
12. Exh. "II"- Historical copies of extracts from various publications, advertisements, newspapers and magazines cuttings published and distributed around the world featuring BOTOX;
13. Exh. "JJ"- A copy of the brochure used by the Opposer in the Philippines to explain BOTOX treatments;
14. Exh. "KK"- Encyclopedia Britannica entry for BOTOX which states that BOTOX is the trademark for botulinum toxin type A;
15. Exh. "LL"- The online encyclopedia Wikipedia's entry for Botulinum toxin which refers to Allergen's development of and ownership of trademark;
16. Exh. "MM"- Entry from Concise Oxford Dictionary tenth (revised) edition 2001 which states that BOTOX is a trademark for a drug prepared from botulin, used medically to treat certain muscular conditions and cosmetically to remove wrinkles by temporarily paralyzing facial muscles;
17. Exh. "NN" to "WW" copies of decisions of foreign courts upholding the Opposer's right over the BOTOX mark;
18. Exh. "XX"- Affidavit of Felipe P. Jalla, Jr., line Manager (Philippines/Indonesia) of Allergan Facial Aesthetics, division of Zuellig Pharma Corporation which is the Opposer's exclusive distributor;
19. Exh. "YY"- The Opposer's 2006 Calendar featuring BOTOX mark treatments;
20. Exh. "ZZ"- Compact discs containing information about BOTOX treatments; and
21. Exh. "AAA" to "WWW"- various articles, publications and promotional materials in the Philippines on or for BOTOX.

The Respondent-Applicant filed on 09 September 2009 its Verified Answer, alleging, among other things, that after it filed its application, a "Registrability Report" wherein the "Intellectual Property Right Specialist" concerned cited, among other things, that the mark may not be registered because "it nearly resembles a mark with an earlier filing or priority date and the resemblance is likely to deceive or cause confusion". According to the Respondent-Applicant, report cited the marks of "Venus Cosmetic Corporation" and ordered that the phrase "works better than botox" be disclaimed. The Respondent-Applicant contends that in response to the report, it filed its "reply" citing various Supreme Court decisions and arguing that its marks are not confusingly similar to the marks cited in the report, and also agreeing to the disclaimer order.

Subsequently, the Respondent-Applicant points out, the “Notice of Allowance” was issued and the application was published, and on 19 January 2009, a Certificate of Registration was issued.

The Respondent-Applicant submitted as evidence in IPC No. 14-2009-00115 Cert. of Reg. No. 4-2007-013068 issued in its favor by the Bureau of Trademarks on 19 January 2009, covering the mark BOT-C “Works Better than Botox”.

The Opposer filed on 16 November 2009 a “REPLY” for both cases alleging, among other things, that the certificate of registration issued to the Respondent-Applicant is contrary to law and regulations since there is still an opposition to the trademark application. Also, the Opposer claims that the disclaimer is contrary to law and regulations because even with the disclaimer, the fact remains that the Respondent-Applicant’s mark still contains the BOTOX mark, which because it is a registered mark is not even a proper subject of a disclaimer. According to the Opposer, disclaimers apply only to unregistrable matters as provided under Sec. 126 of IP Code states. The Opposer asserts that the Respondent-Applicant’s marks are confusingly similar to BOTOX. The Respondent-Applicant’s allegation in par. 20 of the Answer—that it is only in the Philippines where the Opposer has a registration for the BOTOX trademark in class 3 – is untrue as the evidence it submitted proves otherwise. Moreover, the Opposer says, it also has registered in class 5 which covers goods that are applied for beauty enhancement, cosmetic or aesthetic-related purposes. Since the goods covered by the assailed applications serve the same purpose, regular consumers could easily assume that the Respondent-Applicant’s goods are connected with, endorsed by, or related to the Opposer.

On 26 November 2009, the Respondent-Applicant filed a “REJOINDER” for both cases.

The Preliminary Conference was conducted and terminated on 14 January 2010. Thereafter, the Opposer moved for the consolidation of the cases on 18 January 2010 arguing that it would facilitate the efficient resolution thereof because of the identity of the parties and issues. On 27 January 2010, this Bureau issued Order No. 2010-184 granting the motion.

The issues to be resolved in this case are the following:

1. Whether Cert. of Reg. No. 4-2007-013068 issued to the Respondent-Applicant is valid or not;
2. Whether BOTOX is a well-known mark; and
3. Whether the Respondent-Applicant should be allowed to register the marks “BOT-C WORKS BETTER THAN BOTOX” and “BOT-C WORKS LIKE BOTOX WITH VIT. C”

On the first issue, Sec. 134 of the IP Code provides:

SEC. 134. Opposition- Any person who believes that he would be damage by the registration of a mark may upon payment of the required fee and within thirty days after the publication referred to in Subsection 133.2, file with the Office an opposition to the application. Such opposition shall be in writing and verified by the oppositor or by any person on his behalf who knows the facts, and shall specify the grounds on which it is based and include a statement of the facts relied upon. Copies of the certificates of registration of marks registered in the countries or other supporting documents mentioned in the opposition shall be filed therewith, together with the translation in English, if not in the English language. For good cause shown upon payment of the required surcharge, the time for filling an opposition may be extended by the Director of Legal Affairs, who shall notify the applicant of such extension. The Regulations shall fix the maximum period of time within which to file the opposition. (Sec. 8, R.A. No. 165a)

In this regard, records show the following:

1. Appln. Serial No. 4-2007-013068 was published on 19 December 2008;

2. on 16 January 2009, or within the so-day period for filing the opposition, the Opposer which this Bureau granted under Order No. '2009-250, filed a request for extension dated 27 January 2009;
3. the Opposer's subsequent requests for extension were granted by this Bureau under Order Nos. 2009-369 and 2009-544, giving the Opposer up to 18 April 2009, to file the verified notice of opposition.

Thus, the Opposer's filing of its opposition to Trademark Appln. Serial No. 4-2007-013068 was on time. Corollarily. Sec. 136 of the IP Code provides:

SEC 136 Issuance and Publication of Certificate — When the period for filing the opposition has expired, or when the Director of Legal Affairs shall have denied the opposition, the Office upon payment of the required fee, shall issue the certificate of registration. Upon issuance of a certificate of registration, notice thereof making reference to the publication of the application shall be published in the IPO Gazette.

In this instance, when Cert. of Reg. No. 4—2007-013068 was issued, the period to file an opposition to Trademark Appln. Serial No. 4-2007-013068 has not yet expired. The issuance of the certificate, therefore, was premature and not in accord with the afore-quoted provisions of law.

Going now to the second issue, the Opposer's claim that its mark BOTOX is a well-known mark is substantiated by the evidence the said party submitted, including various certified true copy of trademark registration in Hong Kong, United Kingdom, China, Singapore, Australia, Japan, copies of decision of foreign Courts upholding its right over the marks, publications and promotional materials. These pieces of evidence show at least a combination of the criteria set forth in Rule 102 of the Trademark Regulations.

Significantly, this Bureau has previously declared the mark BOTOX a well-known mark in IPC Nos. 14-2009-00052 and 14-2009-00053 and therefore, is entitled to protection under Sec. 123.1, paragraphs (e) and (f), of the IP Code. This case involved the same parties.

Resolving now the third issue, it is emphasized that 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>4</sup>

Thus. Sec. 123.1 (d) of RA. No. 8293, also known as the Intellectual Property Code of the Philippines ("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 filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such mark as to be likely to deceive or cause confusion. Paragraphs (e) and (f) of the same section also prohibits the registration of a mark if it:

(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;

Records show that at the time the Respondent-Applicant filed its trademark applications for use on “cosmetics, perfumes, cologne, hair care products, skin care products, lotions nail care products, body enhancement products, beauty enhancement and maintenance products”, the Opposer already had existing trademark applications or registrations, specifically: Nos. 4-2000-010286<sup>5</sup>, 0564186<sup>6</sup>, 4-2000-008512<sup>7</sup> and 4-2000-010285<sup>8</sup>.

These applications /registrations cover goods or services that are similar or closely related to the Respondent-Applicant’s:

1. No. 056418 – “pharmaceutical preparations, namely, ophthalmic muscle relaxants”; and
2. No. 4200010286, 42000010285 and 42000008512 — “pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhydrosis, sports injuries, cerebral palsy, spasms, tremors and pains”;

This Bureau also noticed that in the Trademark Registry, the Opposer also filed and registered the mark ‘FROM THE CREATORS OF BOTOX” (Cert. of Reg. No. 42006008742). The Opposer’s filing of the trademark application on 09 August 2006 and the subsequent registration of the mark on 10 September 2007 were also prior to the Respondent-Applicant’s filing of the trademark applications. Moreover, the Opposer’s application/registration covers services that are similar or closely related to the Respondent-Applicant’s particularly, “providing information to physicians, medical practitioners and their patients relating to facial aesthetics”. This Bureau takes cognizance of this fact via judicial notice:

But are the Respondent-Applicant’s applied marks resemble the Opposer’s such that confusion, mistake or deception is likely to occur? The marks are shown below:

Opposer’s marks

Respondent-Applicant’s marks



**BOT-C**  
*“Works like Botox with Vit. C”*

**BOTOX**

**BOT-C**  
*“Works better than Botox”*



The feature that immediately draws ones’ attention with respect to the marks the Respondent-Applicant applied for registration is “BOT”. Printed in the upper case, “BOT” is exactly the first three letters of the Opposer’s mark BOTOX. After that initial contact, one definitely proceeds to encounter or read the tag lines below “BOT-C” - “Works like Botox with Vit. C” and “Works better than Botox”.

In this regard, this Bureau finds that BOTOX is a coined or invented word and therefore is unique and highly distinctive with respect to the goods to which the mark is applied to or used.

Considering, therefore, that the Respondent-Applicant will use the marks it applied for registration on goods and services that are similar and/or closely related to the Opposer's, it is very likely that consumers will commit mistake or be confused or deceived as to the origin of the goods and services. The taglines will lead consumers to believe or assume that the BOT-C products and services are just variations or enhancements to BOTOX products and services and thus, originate from, or associated or connected with, or licensed by the Opposer. The disclaimer is of no consequence as the tag lines are still part of the trademarks sought to be registered.

It is well-settled in jurisprudence that a practical approach to the problem of similarity or dissimilarity is to go into the whole of the competing trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some factors such as sound, appearance, form, style, shape, size or format; color, idea connotated by the mark; the meaning, spelling, and pronunciation of the words used and the setting in which the words appear may be considered, for indeed, trademark infringement is a form of unfair competition.

Corollarily, it is stressed that the conclusion (of similarity) created by the use of the same word as the primary element in a trademark is not counteracted by the addition of another term. By analogy, confusion cannot also be avoided by merely dropping, adding or changing one of the letters of a registered mark. ° Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other<sup>11</sup>. The copycat need not copy the entire mark, but it is enough that he takes one feature which the average buyer is likely to remember. In *American Wire & Cable Co. v. Director of Patents et.al.*”, the Supreme Court held:

“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 such mark would likely cause confusion or mistake on the part of the buying public. In short, 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.”

Aptly, the ultimate ratio in cases of grave doubt is the ride that as between new corner who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favour with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.”

As in all other cases of colorable imitations, the unanswered riddle is why, of the millions of terms and combinations of letters and designs available, the Respondent-Applicant had to come up with marks that by overall presentation, not only show resemblance to, but as a matter of fact, feature the Opposer's mark, if there was no intent to take advantage of the goodwill generated by the latter.<sup>14</sup>

To conclude, this Bureau finds that the registration of the trademarks applied by the Respondent-Applicant for registration is proscribed by Sec. 123.1, paragraphs (d) to (f), of the IP Code.

WHEREFORE, premises considered, the instant oppositions to Trademark Serial Nos.

4-2007-013068 and 4-2007-013069, are hereby SUSTAINED. Also, Cert. of Reg. No. 4-2007-013068 issued to the Respondent-Applicant is hereby CANCELLED for the reasons stated above. Let the filewrappers of the subject trademark applications be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.  
Taguig City. 27 June 2011.