

ALLERGAN, INC.,  
Opposer,  
- versus -

IPC No. 14-2009-00074  
Opposition to:

App'l'n Serial No. 4-2008 004165  
Date Filed : 11 April 2008

IMAGE SENSE CORPORATION,  
Respondent-Applicant.

Trademark: "ARDEN B-TOX  
and DEVICE"

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## DECISION

ALLERGAN, INC. ("Opposer"), a corporation duly existing and registered under the laws of the United States of America, with business address at 2525 Dupont Drive, Irvin, California 92612, United States of America, filed on 06 March 2009 an opposition to Trademark Application No. 4-2008-004165. The application was filed by IMAGE SENSE CORPORATION ("Respondent-Applicant"), a Philippine corporation with principal address at No. 201 R & D Building, Guijo Street, San Antonio Village, Makati City, for use on "*skin care products, body rejuvenation products, beauty enhancement and maintenance products, namely; cream lotion, soap and cosmetics*" falling under class 3 of the NICE International Classification of goods.

The Opposer alleges the following:

3. The Opposer will be damage by the registration of the Application and respectfully submits that the Application should be denied for the reasons set forth below:
4. The Opposer is entitled to the benefits granted to foreign nationals under Section 3 Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines (IP Code):

'Section 3. *International Conventions and Reciprocity.* – Any person who is a national or who is domiciled or has a real and effective industrial establishment in a country which is a party to any convention, treaty of agreement relating to intellectual property right or the repression, to which the Philippines is also a party, or extends reciprocal rights to nationals of the Philippines by law, shall be entitled to benefits to the extent necessary to give effect to any provision of such convention, treaty or conventional law, in addition to the rights to which any owner of an intellectual property right is otherwise entitled by this Act.'

5. The registration of the Application violates Section 123.1 (d), (e) and (f) of the IP Code which expressly prohibit the registration of a mark if it is:
  - 5.1 Identical to 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 of cause confusion. [Section 123.1 (d) of the IP Code]
  - 5.2 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 use 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. [Section 123.1 (e) of the IP Code]

5.3 Identical with, or confusing 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 interest of the owner of the registered mark are likely to be damaged by such use. [Section 123.1 (f) of the IP Code]

6. In addition, both the Philippines and the United States of America where the Opposer is domiciled are members of the Paris Convention for the Protection of Industrial Property and the WTO TRIPS Agreement. The Paris Convention provides that:

*Article 6bis*

(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to well be known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. xxx

*Article 10bis*

(1) The countries of the Union are bound to assure nationals of such countries effective protection against unfair competition.

7. The WTO TRIPS Agreement widens the scope of protection of well-known marks by enjoining unauthorized use of these marks on dissimilar goods/services:

*Article 16 (3)*

(3) Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark are likely to be damaged by such use.

The Opposer's evidence consists of the following:

1. Exhibit "A" – Verified Notice of Opposition;
2. Exhibit "B" – Certified true copy of the oppose's (Philippines) Trademark Registration No. 4-2000-010286 for BOTOX in class 5;

3. Exhibit "C" – Certified true copy of Opposer's Trademark Registration No. 4-2008-005229 for BOTOX in class 3;
4. Exhibit "D" – Certified true copy of the Opposer's (Philippines) Trademark Registration No. 056418 for BOTOX in class 5;
5. Exhibit "E" – Certified true copy of the Opposer's (Philippines) Trademark Registration No. 4-2000-008512 for BOTOX BOTULINUM TOXIN TYPE A & DESIGN in classes 5 and 16;
6. Exhibit "F" – Certified true copy of the opposer's (Philippines) Trademark Registration No. 4-2000-010285 for BOTOX AND DESIGN in class 5;
7. Exhibit "G" – Certified true copy of the Opposer's (Hong Kong) Trademark Registration No. 200308039 for BOTOX in class 3 issued on 09 January 2003;
8. Exhibit "H" – Certified true copy of the Opposer's (Hong Kong) Trademark Registration No. 199406140 for BOTOX in class 5 issued on 06 February 1991;
9. Exhibit "I" – Certified true copy of the Opposer's (United Kingdom) Trademark Registration No. 2255853 for BOTOX in class 5 issued on 18 May 2001;
10. Exhibit "J" – Certified true copy of the Opposer's (United Kingdom) Trademark Registration No. 2357789 for BOTOX in class 3 issued on 26 November 2004;
11. Exhibit "K" – Certified true copy of the Opposer's (OHIM) Trademark Registration No. 003700317 for BOTOX in class 3 issued on 14 August 2006;
12. Exhibit "L" – Certified true copy of the Opposer's (OHIM) Trademark Registration No. 001999481 for BOTOX in class 5 issued on 09 October 2002;
13. Exhibit "M" – Certified true copy of the Opposer's (China) Trademark Registration No. 1745458 for BOTOX in class 5 issued on 14 April 2002;
14. Exhibit "N" – Certified true copy of the Opposer's (Singapore) Trademark Registration No. T92/09342J for ALLERGAN BOTOX in class 10 issued on 05 December 2002;
15. Exhibit "O" – Certified true copy of the Opposer's (Singapore) Trademark Registration No. T92/09343I for ALLERGAN BOTOX in class 05 issued on 05 December 2002;
16. Exhibit "P" – Certified true copy of the Opposer's (Singapore) Trademark Registration No. T00/21365C for BOTOX in class 5 issued on 14 December 2000;
17. Exhibit "Q" – Certified true copy of the Opposer's (Singapore) Trademark Registration No. T93/01708F for BOTOX in class 05 issued on 09 March 2003;
18. Exhibit "R" – Certified true copy of the Opposer's (Singapore) Trademark Registration No. T91/02630D for BOTOX in class 05 issued on 06 March 2001;
19. Exhibit "S" – Certified true copy of the Opposer's (Singapore) Trademark Registration No. T00/21581H for BOTOX in class 05 issued on 18 December 2000;
20. Exhibit "T" – Certified true copy of the Opposer's (Singapore) Trademark Registration No. T00/17665J for BOTOX BOTULINUM TOXIN TYPE A PURIFIED NEUROTOXIN COMPLEX in class 05 issued on 07 October 2000;

21. Exhibit "U" – Certified true copy of the Opposer's (Singapore) Trademark Registration No. T00/17666I for BOTOX BOTULINUM TOXIN TYPE A PURIFIED NEUROTOXIN COMPLEX in class 16 issued on 07 October 2000;
22. Exhibit "V" – Certified true copy of the Opposer's (Singapore) Trademark Registration No. T06/16140Z for FROM THE CREATOR OF BOTOX in class 44 issued on 04 August 2006;
23. Exhibit "W" – Certified true copy of the Opposer's (Australia) Trademark Registration No. 551279 for BOTOX in class 05 issued on 28 February 1991;
24. Exhibit "X" – Certified true copy of the Opposer's (Australia) Trademark Registration No. 1008655 for BOTOX in class 3 issued on 12 March 2004;
25. Exhibit "Y" – Certified true copy of the Opposer's (Japan) Trademark Registration No. 5053263 for BOTOX in class 03 issued on 08 June 2007;
26. Exhibit "Z" – Certified true copy of the Opposer's (Japan) Trademark Registration No. 5065393 for BOTOX in class 05 issued on 27 July 2007;
27. Exhibit "AA" – Legalized Power of Attorney in favor of the undersigned firm;
28. Exhibit "BB" – Legalized Affidavit of Martin A. Voet, Assistant Secretary of the Opposer;
29. Exhibit "CC" – Opposer's 2007 Annual Report – Annex A of Voet Affidavit;
30. Exhibit "DD" – List of Various Reports and articles in relation to the Opposer's BOTOX brand of Botulinum Toxiun Type A products published in various medical or specialist journals and publications and from conferences, including from Hong Kong, USA, and Korea – Annex B of Voet Affidavit;
31. Exhibit "EE" – Schedule of Opposer's registrations and pending applications for BOTOX trademarks around the world and a sampling of the registrations obtained in key countries (Annex C of Vort Affidavit);
32. Exhibit "EE-1" – Vietnam – Registration No. 41185 for BOTOX in class 5 issued on 20 May 2002;
33. Exhibit "EE-2" – OHIM – Registration No. 1999481 for BOTOX in class 5 issued on 10 September 2002;
34. Exhibit "EE-3" – Britain and Northern Ireland-Registration No. 2357789 for BOTOX in class 3 issued on 08 March 2004;
35. Exhibit "EE-4" – Britain and Northern Ireland-Registration No. 1504721 for BOTOX in class 5 issued on 29 June 1992;
36. Exhibit "EE-5" – Britain and Northern Ireland-Registration No. 2255853 for BOTOX in class 3 issued on 14 December 2000;
37. Exhibit "EE-6" – India-Registration No. 556178 for BOTOX in class 3 issued on 08 March 2004;
38. Exhibit "EE-7" – Singapore-Registration No. T00/21365C for BOTOX in class 5 issued on 14 December 2000;

39. Exhibit "EE-8" – Singapore-Registration No. T91/02630D for BOTOX in class 5 issued on 06 March 1991;
40. Exhibit "EE-9" – United States of America-Registration No. 1692384 for BOTOX in class 5 issued on 05 June 1991;
41. Exhibit "EE-10" – United States of America-Registration No. 1709160 for BOTOX in class 5 issued on 18 August 1992;
42. Exhibit "EE-11" – United States of America-Registration No. 2510675 for BOTOX in class 5 issued on 20 November 2001;
43. Exhibit "EE-12" – Hong Kong-Registration No. 199406140 for BOTOX in class 5 issued on 06 February 1991;
44. Exhibit "EE-13" – Hong Kong-Registration No. 200308039 for BOTOX in class 3 issued on 09 January 2003;
45. Exhibit "EE-14" – Indonesia-Registration No. 493035 for BOTOX in class 5 issued on 21 December 2000;
46. Exhibit "EE-15" – China-Registration No. 1745458 for BOTOX in class 5 issued on 14 April 2002;
47. Exhibit "EE-16" –United Kingdom - Registration No. 2357789 for BOTOX in class 3 issued on 26 November 2004;
48. Exhibit "EE-17" –United Kingdom - Registration No. 2255853 for BOTOX in class 5 issued on 18 May 2001;
49. Exhibit "FF" – A copy of the American Society of Aesthetic Plastic Surgery 2004 statistics report – Annex D of Voet Affidavit;
50. Exhibit "GG" – A list of outlets or clinics in the Philippines that have been selling the Opposer's products under or by reference to the Opposer's BOTOX trademark – Annex E of Voet Affidavit;
51. Exhibit "HH" – A slide showing the covers of some of the magazines the Opposer advertised in 2006 – Annex F of Voet Affidavit;
52. Exhibit "II" – The Opposer's 2006 magazine print media schedule and budget-Annex G of Voet Affidavit;
53. Exhibit "JJ" – Historical copies of extracts from various publications, advertisements, newspapers and magazine cutting published and distributed around the world featuring the Opposer's BOTOX trademarks – Annex H of Voet Affidavit;
54. Exhibit "KK" – A copy of a brochure used by the Opposer in the Philippines to explain BOTOX treatments – Annex I of Voet Affidavit;
55. Exhibit "LL" – Encyclopedia Britannica entry for BOTOX which states that the trademark for botulinum toxin type A – Annex J of Voet Affidavit;
56. Exhibit "MM" – The online encyclopedia Wikipedia's entry for Botulinum toxin which refers to Allergan's development of and ownership of trademark – Annex K of Voet Affidavit;

57. Exhibit "NN" – Entry from Concise Oxford Dictionary Tenth (Revised) Edition 2001, that "Botox" is a trademark for a drug prepared from botulin, used to treat certain muscular conditions and cosmetically to remove wrinkles by temporarily paralyzing facial muscles – Annex L of Voet Affidavit;
58. Exhibit "OO" – Translation of the decision 28 October 2005 by the Court of Milan, Italy where the Opposer successfully prevented the defendants in that case from using, amongst others, the BOTOSKIN mark – Annex M of the Voet Affidavit;
59. Exhibit "PP" – A copy of a similar decision (with translation), issued in Panama which prevents defendants from using BOTOSKIN trademark – Annex N of Voet Affidavit;
60. Exhibit "QQ" – Translation of decision in Murcia, Spain against Conception Domingo Martin and Laboratories Indermo S.L. against use of marks BOTODESS, BOTODERMIC, BOTOSKIN, CORONA DE ORO BOTODERMIC AND BOTOSKIN PHARMA – Annex O of Voet Affidavit;
61. Exhibit "RR" – A copy of judgment against Helen Suarez- Sanchez M.D. & Company ABC d/b/a Clinica Adelgazamiento y Estetica Medica in the United States jurisdiction in Puerto Rico in relation to the mark BOTOXINED – Annex P of Voet Affidavit;
62. Exhibit "SS" – Translation of a decision on 07 March 2006 by a regional Trial Court in Warsaw prohibiting a company called MCR Corporation Mona Lisa Cosmetic France from using the mark BOTOX and other designations on the basis that it amounted to infringement of Opposer's BOTOX mark – Annex Q of Voet Affidavit;
63. Exhibit "TT" – Translation of a decision dated 10 November 2005 by a regional trial court of Paris, France finding that defendant Sari Juvenage had infringed the BOTOX trademark by use of similar marks incorporating the BOTO prefix – Annex R of Voet Affidavit;
64. Exhibit "UU" – A copy of a decision rendered in US – Puerto Rico, in the case of *Allergan Inc., vs. Helen Suarez-Sanchez*, that BOTOX is a famous mark property of Allergan" – Annex S of Voet Affidavit;
65. Exhibit "VV" – Translation of the Spanish decision in the case of *Allergan Inc., vs. Conception Domingo Martin and Laboratories Indermo S.L.*, where the court said "...there is no doubt that the trade mark BOTOX can indeed be considered well known" – Annex T of Voet Affidavit;
66. Exhibit "WW" - Translation of the decision in Brazil, in the cases of *Allergan Inc., vs. Klein Becker*, which contains numerous references to the notoriety of BOTOX – Annex U of Voet Affidavit;
67. Exhibit "XX" – Translation of decision dated 08 September 2008 rendered by the Barcelona Mercantile Court stating that BOTOX is a well-known mark and that the trademark BOTONIA, which was used in class 3, infringes the Opposer's BOTOX trademark – Annex V of Voet Affidavit;
68. Exhibit "YY" – Affidavit of Felipe P. Jalla Jr., Line Manager (Philippine/Indonesia) of Allergan Facial Aesthetics, a division of Zuellig Pharma Corporation, the Opposer's exclusive local distributor (Jalla Affidavit);
69. Exhibit "ZZ" – Opposer's 2006 calendar featuring BOTOX treatments and trademark- Annex A of Jalla Affidavit;
70. Exhibit "AAA" – 3 compact disc containing information about BOTOX treatments – Annex B of Jalla Affidavit;

71. Exhibit "BBB" – Publication in Practical Procedural Dermatology for preconvention workshop for DERMATOLOGIC (20-21 November 2008 – Annex C of Jalla Affidavit;
72. Exhibit "CCC" – Article in Belo News (6 March 2007) regarding new uses for BOTOX treatments – Annex D of Jalla Affidavit;
73. Exhibit "DDD" – Article in People Magazine (December 2005) entitled "Yes, I've had...." – Annex E of Jalla Affidavit Article in People Magazine (December 2005);
74. Exhibit "EEE" – Article in "HEALTH.CARE" (March- April 2006) entitled "Oplan Alis-Kulubot" – Annex of Jalla Affidavit;
75. Exhibit "FFF" – Article in Health Today featuring Zsa-Zsa Padilla – Annex G of Jalla Affidavit;
76. Exhibit "GGG" – Article in Preview Magazine (November 2001) – Annex H of Jalla Affidavit;
77. Exhibit "HHH" – Article in OK! Magazine (September 2006) entitled "Nips, Tucks and Honesty" – Annex I of Jalla Affidavit;
78. Exhibit "III" – Article in Skin Body Health & Beauty magazine entitled "The Wonders of BOTOX" featuring Albert Martinez – Annex J of Jalla affidavit;
79. Exhibit "JJJ" – Article in Time Magazine (18 February 2002) entitled "Smile you're on BOTOX!" – Annex K of Jalla Affidavit;
80. Exhibit "KKK" – Article in Newsweek Magazine (20 May 2002) entitled "Lining Up for a Pinch of Poison" – Annex L of Jalla Affidavit;
81. Exhibit "LLL" – Article in Business Mirror (25 May 2002) entitled "A lift for faces and moods?" – Annex M of Jalla Affidavit;
82. Exhibit "MMM" – Cover article in Newsweek Magazine (13 May 2002) entitled "The Business of BOTOX" – Annex N of Jalla Affidavit;
83. Exhibit "NNN" – Article in Dermatology News (July – September 2006) entitled "The Whole Stretch on BOTOX " – Annex O of Jalla Affidavit;
84. Exhibit "OOO" – Slide printouts for presentation on BOTOX Introductory Course – Annex P of Jalla Affidavit;
85. Exhibit "PPP" – Master list of Doctors authorized to perform BOTOX treatments in Philippines – Annex Q of Jalla Affidavit;
86. Exhibit "QQQ" – Journal Articles on BOTOX treatments entitled – Annex R of Jalla Affidavit;
87. Exhibit "QQQ-1" – Cosmetic Uses of Botulinum Toxins for Lower Aspects of the Face and Neck;
88. Exhibit "QQQ-2" – Using translational medicine to understand clinical differences between botulinum toxins formulations;
89. Exhibit "QQQ-3" – Botulinum Toxin Type A Treatment of Multiple Upper Facial Sites: Patient-Reported Outcome;

90. Exhibit "QQQ-4" – Dilution Volume of Botulinum Toxin A for the Treatment of Glabellar Rhytides: Does it Matter?;
91. Exhibit "QQQ-5" – Improving Patient retention after Botulinum Toxin Type A Treatment ;
92. Exhibit "QQQ-6" – Eyebrow height after Botulinum Toxin Type A to the Glabella Pilot Study Comparing the Diffusion of Two Formulations of Botulinum Toxin Type A in Patient with Forehead Hyperhidrosis ;
93. Exhibit "RRR" – Varoious handouts and presentations for BOTOX treatments – Annex S of Jalla Affidavit; and
94. Exhibit "SSS" – Various posters for BOTOX treatments – Annex T of Jalla's Affidavit.

The Respondent-Applicant, through its authorized representative, filed on 27 July 2009 its verified answer alleging the following, among their things:

1. Does the presence of the word B-TOX in the Mark would make the mark confusingly similar with the BOTOX trademark of the Opposer?
2. Respondent- Applicant firmly believes that the mark is not confusingly similar with the trademark of the Opposer.
3. Opposer does not have the franchise to the letters in the BOTOX trademarks and just because some of the letters appear in the mark, this does not make it confusingly similar to any trademarks with an earlier filing or priority dates.
4. While the Opposer was correct in defoning the word Ardent, the device however, came from Ardent World, Inc., sister Corporation of the Respondent-Applicant and distributor of the Products that carry the "Hype" and "Ardent" Logo. When this instant application was filed, "Ardent" was still a separate brand. However, today, the Hype and Ardent Logos are carried under one logo.
5. The Trademark Registration of the Opposer for the mark "BOTOX" in the United States of America, Hong Kong, Europe and other countries all state that they are being registered under Class 5 for 'pharmaceutical preparations for treatment of neurological disorder, muscle dytonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhydrosis, sports injuries, cerebral palsy, spasm, tremors and pain. Only in the Philippines where a registration was filed under Class 3 and it was curiously filed after all the trademark applications of the Respondent-Applicant, has been filed with this Honorable Office."

The Respondent-Applicant's evidence consists of the following:

1. Exhibit "1" – Packaging samples of products carrying the Hyper- Ardent Logo; and
2. Exhibit "2" – Packaging samples of products carrying the Hyper- Ardent Logo.

The issues to be resolved in this case are:

1. Whether the Opposer's marks are well-known internationally;



2. Whether the competing marks are confusingly similar; and
3. Whether the Respondent-Applicant should be allowed to register the mark ARDENT B-TOX AND DEVICE.

On the first issue, Rule 102 of the Trademark Regulations, provides:

Rule 102. *Criteria for determining whether a mark is well-known.* In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- (l) the presence of absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.

Records show that the Opposer's mark has been registered in the Philippines and in many countries. Likewise, the Opposer submitted evidence of sales of its goods under the mark BOTOX, extensive promotion of the BOTOX treatment and trademarks throughout the world via the Opposer's website ([www.allergan.com](http://www.allergan.com)), ([www.botox.com](http://www.botox.com)), newspaper, magazines and educational awareness programs, local and international promotional materials and other publications. The evidence submitted by the Opposer, therefore, constitutes at least a combination of the criteria under Rule 102 of the Trademark Regulations to be considered well-known. As a matter of fact, the mark BOTOX was already declared well-known by this Office in a previous decision rendered in IPC No. 14-2009-00052 involving the same parties.

With respect to the second issue, this Bureau finds and holds that the competing trademarks are as shown below, confusingly similar.

Opposer's Trademark

Respondent-Applicant's Trademark

The Opposer's mark consists of the word BOTOX while the Respondent- Applicant's mark consists of two components, namely, ARDENT and B-TOX.

In this regard, 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 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 connoted 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.

The Supreme Court explained in *American Wire and Cable Co., vs. Director of Patents, et. Al.*

"The determinative factor in a contest involving registration of trademark is not whether the challenge 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 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 law, 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"

It cannot be denied that the mark "BOTOX" of the Opposer is almost identical to the element or component of the Respondent-Applicant's mark "B-TOX". The slight difference between the two is inconsequential since when pronounced, they sound practically the same.

While it is true that the Respondent-Applicant's mark consists of two words of features, what strikes the eyes and rings to the ear is "B-TOX". "B-TOX" is the "catchy" part or feature of the Respondent-Applicant's mark, because it is unusual like the Opposer's mark BOTOX which is an invented word and therefore, unique. Hence, the consumer is likely to commit the mistake of associating the Respondent-Applicant's mark with the Opposer's mark BOTOX.

This Bureau noticed that the trademark registry, the contents of which this Bureau can take cognizance of via judicial notice, reveals that the Respondent-Applicant's marks particularly the element or component "ARDENT" with design, have already been registered or applied for registration with the Intellectual Property Office of the Philippines (IPO), covering the goods falling under class 3 of the international classification of goods such as the following:

- |                 |   |                              |
|-----------------|---|------------------------------|
| 1. Mark         | : | ARDENT GLUTA-C               |
| Registration No | : | 42008003197                  |
| Registered Date | : | August 27, 2009              |
| 2. Mark         | : | ARDENT G-THIONE AND DEVICE   |
| Registration No | : | 42008004163                  |
| Registered Date | : | September 22, 2008           |
| 3. Mark         | : | ARDENT BODY SERUM AND DEVICE |
| Registration No | : | 42008006741                  |
| Registered Date | : | June 10, 2008                |

4. Mark : ARDENT G-THIONE PLUS AND DEVICE  
Registration No : 42008004162  
Registered Date : December 8, 2008

Resolving therefore, the third issue, the records show that at the time the Respondent-Applicant filed its trademark application on 11 April 2008, the Opposer had already a pending trademark application for the mark "BOTOX" in the Philippines. The Opposer was issued subsequently Registration No. 4-2008-005229 on 5 May 2008, covering the goods falling under class 3 of the international classification of goods. Also the Opposer had already registered and/or applied for registration of the mark in many countries.

In this regard Sec. 123.1, (d) and (e) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), provides:

Section 123. *Registrability* – 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 diffusion;

(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 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 that of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

Considering therefore, that the Respondent-Applicant's mark is identical or at the very least, confusingly similar to the Opposer's registered trademark, the approval of the Respondent-Applicant application is prescribed by Section 123.1, paragraphs (d) and (e) of the IP Code.

The parties are hereby reminded that the right to register trademarks, trade names And service marks are based on ownership. Only the owner of a mark may apply for its registration.

Thus, it is very difficult to understand why the Respondent-Applicant included or added in its registered mark the element "B-TOX" which is the same or almost exactly identical to the Opposer's registered mark "BOTOX".

The Supreme Court in *Chuanchow Soy & Canning Co., vs. Director of Patents and Rosario Villapania* stated:

"When one applies for the registration of a trademark of label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark, this not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill."

WHEREFORE, premises considered, the instant opposition is hereby SUSTAINED. Let the file wrapper of Trademark Application No. 4-2008-004165 together with a copy of this DECISION, to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 09 March 2011

NATHANIEL S. AREVALO  
Director, Bureau of Legal Affairs  
Intellectual Property Office