

CLINIQUE LABORATORIES,)	INTER PARTES CASE NO. 3517
INC.,)	
Opposer,)	OPPOSITION TO:
)	
)	Application Serial No. 66665
)	Filed : January 12, 1989
- versus -)	Applicant : Queenie Chua
)	Trademark : CLINICA
)	Used on : Pressed powder/
)	facial powder
)	
)	<u>DECISION NO. 92-32 (TM)</u>
)	
QUEENIE CHUA.)	November 17, 1992
Respondent-Applicant.)	
x-----x	

DECISION

On January 12, 1989, Queenie Chua, herein Respondent-Applicant filed an application for the registration of the trademark "CLINICA" for use on pressed powder/facial powder which was assigned Application Serial No. 66665 and was subsequently allowed and published in the Volume II of the Bureau of Patents, Trademark and Technology Transfer Official Gazette which was circulated on December 21, 1989 for purposes of Opposition.

Believing that they will be damaged by the registration of said trademark in favor of the Respondent-Applicant. Clinique Laboratories, a corporation organized and existing under the laws of Delaware, located and doing business at 767 Fifth Avenue, New York, filed a Verified Notice of Opposition on February 13, 1990.

The grounds for Opposition are as follows:

"1. The registration of the captioned trademark is contrary to the provisions of Sec. 4(d), Chapter II of Republic Act No. 166, as amended, which prohibits the registration of:

xxx

"A mark of tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename 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 services of the applicant, to cause confusion or mistake or to deceive purchasers"; (Emphasis supplied)

2. Opposer is the owner of the trademark "CLINIQUE" and C Device duly registered with the Bureau of Patents, Trademarks & Technology Transfer (formerly Philippine Patent Office) under Certificates of Registration No. 19208 and 41565 issued on June 19, 1973 and October 28, 1988 respectively. Copies of said Certificate of Registration are hereto attached as Annexes "A" and "B" and made integral parts hereof;

3. Opposer's "CLINIQUE and C Device" mark is well known or world famous mark and the registration of respondent-applicant's "CLINICA" trademark will constitute a violation of Article 6bis of the convention of Paris for the

Protection of Industrial Property in conjunction with the memoranda of the then Minister of Trade dated November 28, 1980 and October 25, 1983;

4. The registration of the captioned mark will cause confusion or mistake or will deceive purchasers in view of the fact that it is confusingly similar to and/or is a colorable imitation of the Opposer's "CLINIQUE and C Device".

The Opposer relief on the following facts to support the Notice of Opposition:

"a) Long before the alleged date of first use of respondent-applicant on September 25, 1987 of the trademark "CLINICA", herein opposer has adopted, used and registered the trademark "CLINIQUE and C Device" in the United States Patent Office on June 16, 1970. A copy of Certificate of Registration No. 892, 987 is hereto attached as Annex "C" and made an integral part hereof;

b) Opposer's mark is widely promoted and featured in packaging and advertisements and by virtue of their long and extensive use and various registrations in several countries thereby gaining international fame and acceptance;

c) By virtue of the use by Opposer of its aforesaid mark in international commerce, the sale of its products depicting its said mark on an international scale, Opposer's products have acquired immense popularity and goodwill and placed the said mark in the rank or category of internationally famous marks;

d) The registration of Respondent-Applicant's trademark "CLINICA" which is obviously a colorable imitation of Opposer's well known "CLINIQUE" and C Device mark will be violative of the memoranda of the then Minister of Trade dated November 20, 1980 and October 25, 1983, which prohibits the registration of World famous marks by applicants other than their true owners;

e) The immense goodwill and business reputation established and acquired by Opposer through the years of continuous and exclusive use of the trademark "CLINIQUE" and C Device is likely to be seriously jeopardized and impaired. Consequently, Opposer will continuously suffer damages due to the dilution of the value of its mark and loss of prestige;

f) Further, Respondent-Applicant's adoption and use of his trademark "CLINICA" is not a mere coincidence but is a result of a deliberate and well calculated scheme to take advantage of the popularity and goodwill of opposer's aforesaid mark;

g) "CLINIQUE" is the dominant feature of Opposer's corporate/tradename and as such is protected in all member countries of the convention for Paris for the protection of Industrial Property also known as the Paris Union, of which the Philippines is an adherent, without the obligation of filing or registration whether or not it forms part of marks."

Upon receipt of the Verified Notice of Opposition, this Office issued a Notice to Answer on February 15, 1990 which was received by herein Respondent-Applicant on February 19, 1990.

On April 26, 1992, the Opposer filed an Ex-Parte Motion to Declare the Respondent in Default for failure to file her Answer to the Notice of Opposition within the reglementary period

which was granted by this Office on November 19, 1990 per Order No. 90-563, declaring the Respondent In Default and the Opposer was allowed to present its evidence ex-parte.

On April 22, 1991, Opposer presented its evidence ex-parte and formally submitted its documentary evidence, Exhibit "A" to "G" inclusive of its sub-markings together with the testimony of the Opposer's witness, Lesley A. Moradian, through her affidavit marked Exhibit "A". Said Exhibits were all admitted.

One of the issues to be resolved in this case is whether or not the trademark "CLINICA" for Respondent-Applicant is confusingly similar to the mark "CLINIQUE and C Device".

It cannot be denied that both marks of Respondent "CLINICA" as well as that of Opposer's "CLINIQUE" contain the common letters CLINI and that the only difference between the two marks are the letters CA and QUE attached to the common CLINI appearing in both trademarks of Respondent and Opposer.

In *Co Tiong Sa vs. Director of Patents* (95 Phil.1) our Supreme Court has held:

"It is thus not necessary that the matter sought to be protected be literally copied. Differences or variations or similarity in the details of one device or article and those of another are not the legally accepted tests, whether an action based on wrongful imitation exists. Dissimilarity in the size, form, color of a package, etc. – and the place where the same are applied, while relevant, is not conclusive. It is sufficient to constitute a cause of action for proper cases, denial or cancellation of registration of trademark or tradename that the substantial and distinctive part, the main or essential or dominant features of one device or article is copied or imitated in another".

It was argued that Respondent's mark "CLINICA" and the Opposer's mark "CLINIQUE" are differently pronounced. Similarity is the test of infringement of the trademark. Exact copies could hardly be expected to be found. The deceptive tendency of the distinctive part of the trademark so as to pass off the goods of one man as those of another is sufficient to show infringement. (*Forbes, Mun. & Co. vs. Ang San Ton*, 40 Phil. 727)

Furthermore, the mark "CLINICA" of Respondent is being used on pressed powder and facial powder which are related to the goods for which the Opposer's trademark "CLINIQUE and C Device" are being used, namely cosmetic creams, lotions and oils – namely, mascara, eye liner, eye shadow, eyebrow pencil and eye make-up remover; lipsticks; anti-perspirants; hair sprays and bath oils.

Hence, it cannot be denied that confusion as to origin maybe likely as consumer might be led to believe that the goods of Respondent came from the Opposer.

Opposer's foreign witness Lesley A. Moradian, Assistant Secretary of Clinique Laboratories, Inc. categorically stated in her affidavit (Exhibits "A", "A-1" to "A-4") that "CLINIQUE" brand cosmetic creams, lotions and oils, make-up and eye make-up preparations, one of the largest selling cosmetic products in the world, are sold or have been sold, in over sixty four (64) countries such as, among others, the United States, Philippines, Japan, Canada and United Kingdom. She emphasized that the trademark "CLINIQUE and C DEVICE" has been used by the Opposer for approximately twenty-one (21) years, since 1970 up to the present. In the process, she attached to her affidavit (Exhibit "A") representative documents evidencing such long and extensive use. (Exhibits "B", "B-1" to "B-2").

Opposer's witness further stated that the trademark "CLINIQUE & C DEVICE" was first registered in the United States on 29 October 1968 under Certificate of Registration No. 859,445 (Exhibit "D") and is now registered by Opposer Clinique and/or its subsidiary companies in over 100 countries including the Philippines. (Exhibits "C", "C-1" to "C-17").

With particular reference to the Philippines, witness attached to her affidavit a certified copy of Certificate of Registration No. 41565 issued by this Office on 28 October 1988 (Exhibits "E", "E-1" to "E-4") and Certificate of Registration No. 19208 issued by the then Philippine Patent Office on June 19, 1973 (Exhibits "F", "F-a" to "F-4").

Other representative selection of certificates of registration were also attached to the affidavit of the witness, i.e., Certificate of Registration No. 263,613 issued by the Consumer and Corporate Affairs of Canada on 23 October 1981 (Exhibits "G", "G-1" to "G-2"); Certificate of Registration No. 0877162 issued by the Ministry of International Trade and Industry of Japan on 22 October 1970 (Exhibits "H", "H-1" to "H-4") with associated Certificates of Registration Nos. 1178200, 16634177, 1708686, 1819019, 1852432, 1948728 and 2103575 dated 8 January 1976.

Aside from being well known and registered worldwide, there were also evidences presented to the effect that the "CLINIQUE & C DEVICE" trademark of the Opposer has been promoted and advertised in several countries of the world including the Philippines (Exhibits "J", "J-1" to "J-6").

As in all other cases of colorable imitation, the unanswered riddle is why, of the million of terms and combination of letters and designs available, the appellee has to choose those so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark (American Wire & Cable Co. vs. Director of Patent, 31 SCRA 544).

It is thus clear and evident that Opposer's trademark "CLINIQUE & C DEVICE" is entitled to effective protection against unfair competition or infringement in the Philippines.

WHEREFORE, finding that the Opposer has made a clear Notice of Opposition, it appearing that the Opposer has sufficiently established its case, the same is, as it is hereby SUSTAINED. Accordingly, Application Serial No. 66665 filed on January 12, 1989 by the Applicant's trademark "CLINICA" for used on pressed powder/facial powder is, as it is hereby, REJECTED.

Let a filewrapper of this case be forwarded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision. Likewise, let a copy of this Decision be furnished the Trademark Examining Division for information and to update its record.

SO ORDERED.

IGNACIO S. SAPALO
Director