

THE PROCTER AND GAMBLE  
COMPANY,

Opposer,  
-versus-

PRIMAL ENTERPRISES  
CORPORATION,

Respondent-Applicant.

x-----x

IPC NO. 14-2010-001144

Opposition to:  
Appln. Ser. No. 4-2009-006435  
(Filing Date: 30 June 2009)

TM: SAFEGUARD

Decision No. 2011-56

## DECISION

THE PROCTER AND GAMBLE COMPANY ("Opposer") filed on 01 June 2010 an opposition to Trademark Application Serial No. 4-2009-006435. The application, filed by PRIMAL ENTERPRISES CORPORATION ("Respondent-Applicant") covers the mark SAFEGUARD for use on "Car Audio and Video System Class 09, HID Lighting System, Flag Lamp Bulbs" under Class 11, and "Central Door Lock, Parking Sensor, Car Security System" under Class 12. The Opposer alleges the following:

1. The registration of the mark SAFEGUARD trademark is contrary to the provisions of Sections 123.1 (d), (e) and (f) of Republic Act. No. 8293, as amended, which prohibit the registration of a mark that:

x    x    x

2. Opposer is the owner of and has exclusive rights over the world famous and well-known SAFEGUARD trademark. The SAFEGUARD trademark is used, among others, in connection with soaps, anti-bacterial cleansing soap, anti-bacterial wipes, cosmetic preparations for the care of skin, cosmetic preparations for the care of body, cleaning preparations for personal use, body wash and deodorants for personal use. The SAFEGUARD trademark is also used in installations and apparatuses, which are for sanitary purposes, and for education and training aimed at raising health and hygiene levels.
3. Several trademarks that involve the SAFEGUARD mark are registered in the Opposer's name with Philippine Intellectual Property Office ("IPO") in classes 3, 11, 16 and 41. The details of the registrations appear below.

<u>Mark</u>	<u>Registration No.</u>	<u>Date Registered</u>	<u>Class</u>
	4-1997-122545	15-Jan-02	3
	4-2001-003539	11-Mar-04	3
	4-1997-125834	8-Jul-04	3
	4-2003-008520	11-Aug-05	3
	4-2002-009814	10-Feb-05	3
	4-2006-005723	14-Apr-08	3
	4-2007-007840	10-Dec-07	3
	4-1999-005400	16-Jul-06	3
	4-2002-003768	21-May-04	3
	4-2004-005962	16-Dec-05	3
	4-2003-005042	26-May-06	3
	4-2008-013800	17-Sep-09	3

	4-2003-001736	8-Jul-04	3,41
	4-2008-002981	27-Oct-08	3

4. Respondent-Applicant's SAFEGUARD trademark is confusingly similar to the Opposer's world famous and well-known trademark SAFEGUARD. Respondent-Applicant's SAFEGUARD mark is identical to the Opposer's SAFEGUARD mark. Ostensibly, one may mistake the other as one and the same, effectively diluting and diminishing the unique SAFEGUARD word mark. Hence, the registration of the Respondent-Applicant's mark will be contrary to Section 123.1 (d) of Republic Act No. 8293.
5. The Opposer is entitled to the benefits granted to foreign nationals under Section 3 of Republic Act No. 8293, which provides:

x            x            x

The Opposer is domiciled in the United States of America. Both the Philippines and the United States of America are members of the Paris Convention for the Protection of Industry Property. The Paris Convention provides:

`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 translation considered by competent authority of the country of registration or use to be well known in that country as being the mark of the person entitled to the benefits of this Convention for identical or similar goods x x x."

`Article 10bis

- (1) The countries of the Union are bound to assure nationals of such countries effective protection against unfair competitions.
6. The SAFEGUARD trademark is well-known and world famous. Hence, the registration of Respondent-Applicant's SAFEGUARD mark will constitute a violation of Articles 6bis and 10bis of the Paris Convention in conjunction with Sections 3, 123.1 (e) and 123.1 (f) of Republic Act No. 8293.
7. The Opposer first introduced the SAFEGUARD brand in the United States of America in July 1965. The SAFEGUARD mark was first used for soap products and later for other products such as body washes, among others. Back then, SAFEGUARD soap was considered as one of the best deodorant bars available in the market. At present, SAFEGUARD is one of the most recognizable brands in the world and is currently the number one selling antibacterial brand in the Philippines. The SAFEGUARD prior to the filing date of the application subject of this opposition. Opposer constitutes to use well-known trademark SAFEGUARD. Among others, in connection with soaps, anti-bacterial cleansing soap, anti-bacterial wipes, cosmetic preparations for the care of skin, cosmetic preparations for the care of body, cleaning preparations for personal use, body wash and deodorants for personal use. The SAFEGUARD trademark is also used in installations and apparatuses, which are for sanitary purposes, and for education and training aimed at raising health and hygiene levels.
8. The Opposer has extensively promoted the SAFEGUARD trademark worldwide. Over the years, the Opposer has obtained significant exposure for its SAFEGUARD

trademark, in various media, including television commercials, advertisements, internationally well-known print publications, the internet, and other promotional events.

9. The Opposer has not consented to the Respondent-Applicant's used and registration of another mark identical to the well-known trademark SAFEGUARD.
10. The Respondent-Applicant's use for the SAFEGUARD mark on goods in classes 9, 11 and 12 will mislead the purchasing public into believing that Respondent-Applicant's are produced by; originate from, or under the sponsorship of the Opposer. Potential damage to the Opposer will also caused as a result of its inability to control the quality of the products offered or put on the market by Respondent-Applicant under the SAFEGUARD mark.
11. The use by Respondent-Applicant of the mark subject of this opposition in relation to its goods, whether or not identical, similar or closely related to the Opposer's goods will take unfair advantage of, dilute and diminish the distinctive character or reputation of the world famous and well-known trademark SAFEGUARD.
12. The denial of the application subject of this opposition is authorized under other provisions of Republic Act No. 8293.

The Opposer's evidence consists of the following:

1. Exh. "A"- Verified Notice of Opposition;
2. Exh. "B"- Original affidavit of Mr. Carl J. Roof;
3. Exh. "C"- List of International registrations and applications for the SAFEGUARD mark worldwide;
4. Exh. "D"- Affidavit of Mr. Lauro Francis Guevarra;
5. Exh. "E"- Actual product label showing the SAFEGUARD trademark; and
6. Exh. "F" (inclusive) - materials showing the SAFEGUARD mark in television commercials for the year 2009 to 2010 in the Philippines; variation of product labels/packaging bearing the SAFEGUARD mark in the Philippines, and Comic books in different Philippine dialects illustrating the SAFEGUARD mark.

On 27 September 2010, the Respondent-Applicant filed its Verified Answer. The Respondent-Applicant contends that the goods covered by its mark are very different from the Opposer's. The Respondent-Applicant points out that the mark SAFEGUARD is used by the Opposer for "articles cleaning the body", specifically, soaps, deodorants, cleaning preparation for care of the body and other related articles. On the other hand, the Respondent-Applicant uses the mark on "articles for use in vehicles", particularly car audio systems; central door locks, parking sensors and car security alarms; HID lighting systems, fog lamps, and bulbs.

The Respondent-Applicant's submitted the Affidavit of the Respondent-Applicant's Sales Manager, Charlie Tiu, as its evidence marked as Exhibit "1".

Should the Respondent-Applicant be allowed to register the mark SAFEGUARD?

There is no question that the competing marks are identical. The records also clearly established that at the time the Respondent-Applicant filed its trademark application, the Opposer has existing trademark registration for SAFEGUARD. The goods covered by the Respondent-Applicant's application, however, are not similar or closely related to the Opposer's.

The Respondent-Applicant's goods are vastly different from the Opposer's in composition, nature, purpose and market channels, among other things.

Thus, it is very unlikely that consumers will be confused or deceived, or the Opposer will incur damage, if the Respondent-Applicant uses and registers the mark SAFEGUARD for goods indicated in its application. The Opposer's claim that since its mark is a well-known mark, the use by the Respondent-Applicant thereof even for different and not related goods will dilute or diminish the goodwill it already generated, is untenable. This Bureau cannot subscribe to an inference that consumers will buy the Respondent-Applicant's product because of the alleged goodwill or reputation already earned by the Opposer's mark. It is far-fetched that, regardless of the quality of the Respondent-Applicant's goods, consumers will conclude that there is a connection or association between the Respondent-Applicant's goods on one hand and the Opposer on the other.

The mark SAFEGUARD is composed of two (2) common English words, "safe" and "guard", and therefore could not qualify as a fanciful mark. Fanciful marks are generally "invented" or "coined" words or terms that had no meaning before their use as trademarks. Fanciful words are inherently distinctive and immediately function as trademarks or service marks. They are afforded the greatest amount of trademark protection.

Neither should the mark SAFEGUARD be considered as an arbitrary mark. Arbitrary marks are common English words that are used in a way such that their normal meaning bears no relationship to the good or services to which they are used. Whether a mark is arbitrary or not depends upon its context. In this instance, it is obvious that both parties chose to use and appropriate SAFEGUARD, combination of words that are related to the goods on which the mark is used.

Hence, SAFEGUARD, as used by the parties on their respective goods falls under the category of a suggestive mark. Suggestive marks require the consumer to exercise their imagination in order to determine the nature of the goods or services.

Aptly, as a suggestive mark, SAFEGUARD cannot be said to be uniquely attributable to the Opposer regardless of the goods or services involved. Thus, when one encounters the mark as used on the Respondent-Applicant's goods- security related equipment and tools- the decision to buy or not to, have nothing to do with the Opposer or its soaps and health-related products.

In conclusion therefore, this Bureau finds that the Respondent-Applicant's trademark application is not proscribed by Sec 123.1, paragraphs (d) to (f) of Rep. Act No. 8293.

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 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 of his product. This fundamental precept of trademark registration is not abridged if the Respondent-Applicant is allowed to use and register the trademark SAFEGUARD for the goods indicated in its trademark application.

WHEREFORE, premises considered the instant opposition for to Trademark Application Serial No. 4-2009-006435 is hereby DENIED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademark (BOT) for information and appropriate action.

SO ORDERED.

30 June 2011, Taguig City