

SAMUEL L. PO,	}	IPC NO.14-2009-00260
Petitioner,	}	Petition for Cancellation:
	}	
-versus-	}	Registration No. 4-2008-011212
	}	
JOHNSON & JOHNSON,	}	Trademark "SECURE"
Respondent-Registrant	}	Decision No.2011-13
x-----x		

DECISION

SAMUEL L. PO ("Petitioner"), of 31<sup>st</sup> Floor Raffles Corporate Center, Emerald Avenue, Ortigas Center, Pasig City, filed on 11 November 2009 a petition for cancellation of Trademark Registration No.4-2008-011212, issued on 06 August 2009 to Johnson & Johnson ("Respondent –Registrant"), a foreign corporation with principal address at One Johnson & Johnson plaza, New Brunswick, New Jersey 08933, U.S.A., covering the mark SECURE for use on good under Class 05<sup>2</sup> namely, "sanitary napkins and pads".

The Petitioner alleges the following:

"2. The trademark SECURE so resembles the trademark SECURE, owned by oppose, which was registered by this honorable office on 07 July 2008. The trademark SECURE, which was registered by respondent, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark SECURE is apply for the same class and goods as that of the Opposer's trademark SECURE, i.e. Class 5.

x x x

"2.2. Without doubt, under the above-quoted provision of law, any mark which is identical to a registered mark should be denied registration in respect of similar or related goods.

"2.3. On the other hand, the products of parties are very much related as they address the protection of uncontrollable discharges i.e. incontinence for the Opposer thus Diapers, and menstrual discharge for the Respondent thus sanitary napkins and pads. In fact, under the explanatory note of Nice Classification of Goods and Services, Class 5 encompasses a group of products that include sanitary preparation for medical purposes and personal hygiene. It cannot be denied that diapers and feminine are preparation for personal hygiene.

"2.3.1 Furthermore, in supermarkets, groceries and other outlets, the products of the parties are generally clustered into section called paper products because the absorbent used in both goods are made of paper.

"2.3.2 Moreover, the structure of the products is the same, i.e. an absorbent core enclosed in a permeable inner lining and non-permeable outer lining and generally used by placing in the crotch area of the user and inside the underwear.

"2.3.3 The potential zone of expansion of the Opposer using the mark SECURE is also to produce feminine napkins. In fact, he is already manufacturing feminine napkins under the mark CHARMEE and registered under Registration No.4-2008-8229 based on the application filed on 29 September 2000.

“2.4 Respondent’s use and registration of the trademark SECURE will diminish the distinctiveness and dilute the goodwill of Opposer’s trademark SECURE.

“In support of these Oppositions, Opposer will rely upon and prove the following facts:

“3.0 Opposer, Samuel L. PO, the registered owner of the trademark SECURE and is engaged in the business of cotton and paper products such as baby and adult diapers, bathroom tissues and paper towels, sanitary napkins and panty liner. The trademark application for the trademark SECURE was filed with the Intellectual Property Office on 19 December 2007 by the opposer and was approved for registration by this honorable office on 07 July 2008 and valid for the period of ten (10) years or until 07 July 2017. The Opposer’s registration of the SECURE trademark subsists and remains valid to date. x x x

“3.1 The trademark SECURE has been extensively used in the Philippines.  
x x x

The Petitioner’s evidence consists of the following:

1. Exh. “A” - Computer printout downloaded from the IPO website bearing the trademark SECURE filed by Samuel Po on 19 Dec. 2007 with Reg. No.42007013972;
2. Exh. “B” - Computer printout downloaded from the IPO website bearing the trademark CHARMEE AND DEVICE filed by Samuel Po on Sept. 2000 with Reg. No.42000008229;
3. Exh. “C” - Computer printout downloaded from the IPO website bearing the trademark SECURE filed by Johnson & Johnson on 16 Sept. 2008 with Reg. No.42008011212;
4. Exh. “D”, “D-1” and “D-2” – Copies of sales invoices issued by J.S. Unitrade Merchandise, Inc. to Supervalve, Inc. bearing the product SECURE; and
5. Exh. “E”, “E-1” and “E-2” – Copies of sales invoices issued by J.S. Unitrade Merchandise, Inc. to Supervalve, Inc. bearing the product SECURE, among others.

On the 27 May 2010, the Respondent-Registrant filed its verified Answer denying the material allegations in the petitions and alleges the following:

“10. Petitioner has no valid and legal ground to cancel the registration of J&J’s trademark SECURE for the sanitary napkins and pads in Class 5.

“11. The term ‘SECURE’ is an ordinary word commonly used in the fields of products and business. Secure means (which is very significant to a trademark’s advertising function) that the thing is reliable, dependable; free from care, doubt and anxiety; or it is firm, tight or snug fit. Thus, one finds a host of Secure and formative marks registered to different person for various goods and services. The word SECURE is not very distinctive; it is not strong mark. That is why J&J’s trademark SECURE is used together with its world famous trademark Modess.

“12. The greater number of similar marks used in similar goods and services, the less distinctive and strong is any one of those marks. A mark hemmed in on all sides by similar marks on similar goods cannot be very distinctive. In such a ‘crowded’ field of similar mark, each member of the crowd is relatively weak in its ability to prevent others in the crowd from using the mark. Customers will not likely be confused between any two of the crowd and may have to learn to carefully pick out one from the other. (Amador, Trademark under the Intellectual Property Code, 1999 Ed, p. 10 Mc Carthy’s Desk Encyclopedia of Intellectual Property, 1991 Ed., p.318)

“13. As stated earlier, J&J’s mark is used together with is strong and well-known brand Modess. Its packaging also prominently carries its world famous house mark Johnson & Johnson and J&J. Where one of the parties’ marks its typically accompanied by other textural or design material, that juxtaposition will lower the likelihood of confusion

between two similar marks. That material might include a logo or house mark. (Care first of Maryland, Inc. v. First Care, P.C. 434 F. 3<sup>rd</sup> 263, 271; Auto Zone, Inc. v. Tandy Corp., 373 F. 3<sup>rd</sup> 786, 797). Easily, the purchasers are apprised that J&J's goods are manufactured by the world famous company Johnson & Johnson under its equally well-known Modess line of sanitary napkins and pads. There will be no occasion for conclusion.

"14. Moreover, the word SECURE is set forth in a distinctive script in J&J's Secure product far different from the Petitioner's block-letter trademark SECURE.

**SECURE**

Petitioner's mark

Respondent-Registrant's mark

"15. The packaging of the two products is very different, likewise rendering trade confusion next to impossible.

x x x

"16. It must be stressed the Section 123 I (d) (ii), R.A. 8293 precludes the registration of a mark that is identical with a registered mark belonging to another with closely related goods. While J&J's and Mr. Po's goods may be related, they are clearly not closed related. They do not possess the same physical attributes/characteristics in terms of form, compositions, or texture. Evidently they served totally different purposes. J&J's goods are worn by women during menstruation. Mr. Po's good are worn by the elderly folk to absorb and contain excretion. They cater to different markets. The goods do not even complement one another and are foreign to each other. The goods are located in different sections of the supermarket or store"

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

1. Exh. "1"- Authenticated copy of the affidavit of Brian T. Jaenicke, the authorized signatory of Johnson & Johnson;
2. Exh. "2"- Copy of the schedule providing current details of the Modess and variant marks worldwide registration and pending applications;
3. Exh. "3"- Copies of record details for the brand MODESS in various Countries;
4. Exh. "4"- Certified true copy of the Cert. of Reg. No. 4-2003-010120 for the trademark MODESS issued to Johnson & Johnson on 24 Feb. 2005 by the intellectual Property Philippines ("IPOP HL");
5. Exh. "4-a"- Certified true copy of Cert. of Reg. No. 4-2006-010554 for the trademark MODESS ALL NIGHT issued to Johnson & Johnson on 20 Aug. 2007 by the IPOP HL;
6. Exh. "4-b"- Certified true copy of Cert. of Reg. No.4-2009-002970 for the trademark MODESS SECURE issued to Johnson & Johnson on 24 Sept. 2009 by the IPOP HL;
7. Exh. "4-c"- Certified true copy of Cert. of Reg. No.4-1999-008232 for the trademark MODESS SPIRIT LOGO issued to Johnson & Johnson on 11 Aug. 2005 by the IPOP HL;
8. Exh. "4-d"- Certified true copy of Cert. of Reg. No.4-2008-011212 for the trademark SECURE issued to Johnson & Johnson on 16 Sept. 2008 by the IPOP HL;
9. Exh. "5"- Samples of worldwide print brochures and advertisements;
10. Exh. "6"- Copies of print out of websites advertising and selling Modess and variant marks products.

11. Exh "7"- Copies of Neilsen Company (Philippines), Inc. certification and retail survey result; and
12. Exh. "8"- Print outs of the Philippines IPO search results showing the widespread use of the word SECURE as trademark by itself or as component of composite marks.

The petitioners failed to appear during the Preliminary Conference on 27 July 2010. Hence, he was considered to have waived the right to submit the position paper.

Should Trademark Reg. No.402008-011212 be cancelled?

It is undisputed that the competing marks are identical notwithstanding the difference in the fonts used. The marks connote the same meaning, spelling and pronunciation. This Bureau also finds that the goods covered by the competing marks are closely related to each other. In *ESSO Standard Eastern, Inc. v. Court of Appeals, et. al.*, the Supreme Court defined what are to be considered as essentially related goods under the trademark law:

"Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores. Thus, biscuits were held related to milk because they are both food products."

The Petitioner's SECURE mark is used for adult diapers while the Respondent-Registrant's mark, for sanitary napkins and pads". These goods or products fall under Class 5, which include goods for sanitary preparation for medical purposes and personal hygiene. Obviously, the parties' respective goods are preparations for personal hygiene and have, basically, the same structure or composition, utility (absorbent products), and are usually grouped or displayed in the same section of the supermarket or groceries.

Hence, because the competing marks are practically identical and that they are used on similar or closely related goods, it is likely that the consumers will have the impression that these products originate from a single source or the sources thereof are connected or associated with one another. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:

Call man notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other' is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff, and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

Accordingly, the competing trademarks as belonging and registered to two different proprietors should not be allowed to co-exist. 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 and article; to prevent fraud and imposition; and to protect the manufacture against substitution and sale of an inferior and different article as his product.<sup>7</sup>

Sec. 138 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), states:

Sec. 138 Certification of Registration – A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.

Corollary, Sec. 121, IP Code, states in part that:

Sec. 151. Cancellation – 151.1 a petition to cancel a registration of a mark under this Act may be filed with the Bureau of Legal Affairs by any person who believe that he is or will be damaged by the registration of a mark under this Act as follows:

(a) Within five (5) years from the date of the registration of the mark under this Act. x x x

Thus the law allows any person, like the Petitioner in this instance, to file a petition to cancel a trademark registration if that person believes that the he would be damaged by the registration. As discussed above, there is a likelihood of confusion as to be goods themselves and the origins thereof. Also, the use of the Petitioner of the mark SECURE on sanitary napkins is within the potential zone of his business expansion since he is already manufacturing sanitary napkins under the mark CHARMEE.<sup>8</sup>

Once filed, a cancellation proceeding becomes basically, a review of the trademark registration in question to determine if the legal requirements for registration have been satisfied and if the maintenance or continuance of Respondent-Registrant's trademark in the trademark registry would damage.<sup>9</sup> The Supreme Court held:

"By itself, registration is not a mode of acquiring ownership. When the application is not the owner of the trademark being applied for, he has no right to apply for registration of the same. x x x

"Registration, without more, does not confer upon the registration an absolute right to the registered mark. The certificate of registration is merely a prima facie proof that the registrant is the owner of the registered mark or trade name. Evidence of prior and continuous use of the mark or trade name by another can overcome the presumptive ownership of the registrant and may very well entitle the former to be declared the owner in an appropriate case."<sup>10</sup>

In this regard, the Petitioner submitted evidence that prior to the filing of the Respondent-Registrant's application on 16 September 2008 he had already applied for the registration of his mark on 19 December 2007, has been using the mark, and had obtained trademark registration on 17 July 2008.

Therefore, being the prior user and hence, the owner, of the mark SECURE, the Petitioner's right over it is superior to the Respondent – Registrant's. The Respondent – Registrant's erstwhile trademark application should have been rejected pursuant to Sec. 123 I (d) of the IP Code, which States that a mark cannot be registered if it is identical with priority date, in respect of: the same goods and services, or closely related goods or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

Aptly, it must be stressed the intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovation were able to distinguish their goods and services by a visible sign that distinctly points out the origin and ownership of such goods and services.

WHEREFORE, premises considered, the instant Petition for Cancellation is hereby GRANTED. Let the file wrapper of Trademark Registration No. 4-2008-011212 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Makati City, 18 February 2011.

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