

COLGATE PALMOLIVE COMPANY,
Opposer,

IPC NO. 14-2009-000173
Case Filed on: 13 July 2009

- versus -

Opposition to:
App. Serial No. 4-2008-000924
Date Filed: 25 January 2008
TM: "LISTERINE TOTAL CARE"

JOHNSON & JOHNSON,
Respondent-Applicant.
X-----X

DECISION NO. 2010-55

DECISION

Opposer, COLGATE PALMOLIVE COMPANY ("Opposer"), a corporation organized and existing under the laws of Delaware, U.S.A. with principal office at 300 Park Avenue, New York, N.Y. 10022 U.S.A filed an opposition to Trademark Application Serial No. 4-2008-000924.¹ The application filed by JOHNSON & JOHNSON ("Respondent-Applicant"), a foreign corporation with principal office address at One Johnson & Johnson Plaza, New Brunswick, New Jersey, U.S.A, covers the mark "LISTERINE TOTAL CARE" for use on "*non medicated mouth washes and mouth rinses*" and "medicated mouth washes and mouth rinses" under Classes 03 and 05 respectively of the International Classification of Goods.²

The Opposer alleges the following:

"1. Opposer is the registered owner in the Philippines of the following trademarks, which registration it has applied for and/or obtained long before the filing of Respondent's application on January 25, 2008:

Trademark: COLGATE TOTAL in Class 3
Reg. No.: 59737
Appn. Date: May 13, 1992
Date Issued: January 10, 1995

Trademark: COLGATE TOTAL in Class 3
Reg. No.: 4-1997-117360
Appn. Date: January 27, 1997
Date Issued: April 14, 2005

Trademark: COLGATE TOTAL in Class 3
Reg. No.: 4-2004-006127
Appn. Date: July 12, 2004
Date Issued: May 14, 2007

Trademark: COLGATE TOTAL in Class 3
Reg. No.: 4-1993-86036
Appn. Date: January 29, 1993
Date Issued: February 16, 2000

Trademark: COLGATE TOTAL CRT FRESH STRIPE in Class 3
Reg. No.: 66760
Appn. Date: December 16, 1994

¹ The application was published in the Intellectual Property E-Gazette on 13 March 2009.

² The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

Date Issued: December 8, 1998

Trademark: COLGATE TOTAL CRT FRESH STRIPE in Class 3
Reg. No.: 4-1999-006406
Appn. Date: November 3, 1999
Date Issued: July 16, 2006

Trademark: COLGATE TOTAL PLUS in Class 3
Reg. No.: 4-2001-02992
Appn. Date: April 27, 2001
Date Issued: July 8, 2004

Trademark: COLGATE TOTAL PROFESSIONAL CLEAN in Class 3
Reg. No.: 4-2006-008454
Appn. Date: August 3, 2006
Date Issued:

Trademark: COLGATE TOTAL in Class 3
Reg. No.: 4-1999-008407
Appn. Date: November 3, 1999
Date Issued: July 1, 2005

"2. Opposer is also the registered owner of numerous trademark Registrations for COLGATE TOTAL and TOTAL-formative marks in almost all countries throughout the world, most of which registration it has applied for and/or obtained long before the filing of Respondent's local application in January 2008.

"3. Opposer is the first user of the foregoing trademarks (collectively, "COLGATE TOTAL trademarks") for its toothpaste and mouthwash products, having started using and registering its said marks in the 1990s around the world. Opposer's first trademark registrations for COLGATE TOTAL in Classes 3, 5 and 21 were obtained in Ecuador and France as early as December 18, 1991. In the Philippines, Opposer started using and obtained its first registration for COLGATE TOTAL in Class 3 under Reg. No. 59737 issued on January 10, 1995, more than thirteen (13) years long before Respondent-Applicant appropriated the confusingly similar mark LISTERINE TOTALCARE mark by filing its application for identical goods (i.e., toothpastes and mouthwashes) in Class 3 and closely related goods in Class 5.

"4. The Respondent-Applicant's mark TOTALCARE & DESIGN which covers identical products in Class 3 and closely similar goods in Class 5 is confusingly similar to Opposer's COLGATE TOTAL trademarks as to be likely, when applied to or used in connection with the products of Respondent-Applicant, to cause confusion, mistake and deception on the part of the purchasing public and to create a false connection between Respondent-Applicant's products and those of Opposer, and damage the latter's interest as owner of the internationally well-known COLGATE TOTAL trademarks. This is because Respondent's mark appropriates the essential and dominant word feature TOTAL of Opposer's prior registered mark. The addition by Respondent-Applicant of the element CARE and LISTERINE creates an insignificant difference that does not preclude the likelihood of consumer confusion as to the origin of the goods bearing the Respondent's trademark because the most prevalent feature of said mark remains to be the word TOTAL, which is also a dominant and prevalent feature of Opposer's COLGATE TOTAL trademarks. The use of marks which are derived from variations or abbreviations of a senior mark owned by the same owner is very common in the industry that the close similarity between COLGATE TOTAL (and its variations like COLGATE TOTAL PLUS, COLGATE TOTAL PROFESSIONAL CLEAN, etc.) and Respondent's mark inevitably leads to no other conclusion than that the said mark is a derivative of COLGATE TOTAL; and identical goods bearing such marks emanates from one same source or from a collaboration or that the junior user is licensed by Colgate to use said mark.

“5. The registration and use by the Respondent-Applicant of the mark LISTERINE TOTALCARE will diminish the distinctiveness and dilute the goodwill of Opposer’s COLGATE TOTAL trademarks, which have been widely used and registered on the Opposer’s name in the Philippines and in other industrial property offices worldwide.

“6. Respondent-Applicant’s use of the trademark LISTERINE TOTALCARE infringes upon Opposer’s exclusive right to use the COLGATE TOTAL trademarks, which are well-known trademarks protected under Section 123.1(e) and (f) of Republic Act No. 8293, the Intellectual Property Code (the “IP Code”), Article 6bis of the Paris Convention for the Protection of Industrial Property (the “Paris Convention”), and Article 16(1) of the Agreement on Trade Related Aspects of Intellectual Property Rights (the “GATT-TRIPS Agreement”), to which the Philippines and Respondent’s state of incorporation, the United States, adhere.

“7. The registration of the trademark LISTERINE TOTALCARE in the name of the Respondent-Applicant is contrary to the provisions of the IP Code.

“In support of this opposition, the Opposer will prove and rely upon, among other facts, the following:

“1. Opposer is the owner and prior registrant of COLGATE TOTAL trademarks in respect of toothpastes and mouthwashes in Class 3 and related products in Class 5. It is the prior registrant of these TOTAL-formative marks in respect of eight 8 registrations in the Philippines. Opposer is also the registered owner of numerous trademark registrations for COLGATE TOTAL and TOTAL-formative marks in over 225 countries throughout the world. Most of these registrations have been applied for and/or obtained long before the filing of Respondent’s local application in January 2008.

“2. Opposer is the originator, first user and rightful owner of the COLGATE TOTAL trademarks in respect of toothpastes and mouthwashes in Class 3 and related products in Class 5. Opposer adopted and has been using the COLGATE TOTAL trademarks in respect of toothpastes and mouthwashes since the 1990’s, long before Respondent-Applicant’s unauthorized usage of the confusingly similar mark LISTERINE TOTALCARE. In the Philippines, Opposer has been commercially using the COLGATE TOTAL trademarks in respect of toothpastes in Class 3 since 1992, or for 17 years now. Opposer has also adopted, used and registered the COLGATE TOTAL trademarks for other oral care products. Opposer has been actively promoting and selling in many countries around the world. By virtue of such worldwide use, Opposer has strengthened the reputation and goodwill of its COLGATE TOTAL trademarks and the products covered by these marks as of superior quality and reliability among the public, which have identified these TOTAL-formative marks, as used on oral care products, with Opposer.

“3. Having regard to the existence of the Opposer’s COLGATE TOTAL trademarks, the unauthorized appropriation and use by the Respondent-Applicant of TOTALCARE will mislead consumers into believing that the products of the Respondent-Applicant are those of, or in some way associated or connected with, or sponsored, approved or endorsed by Opposer, particularly since Respondent-Applicant seeks the registration of its mark in respect of identical goods toothpastes and mouthwashes-in Class 3 and Class 5. Respondent-Applicant’s appropriation of the confusingly similar mark LISTERINE TOTALCARE will damage the Opposer’s interests as registered owner of the COLGATE TOTAL trademarks.

“4. Opposer’s COLGATE TOTAL trademarks are well-known marks within the meaning of Section 123.1(e) of the IP Code, Article 6bis of the Paris Convention, and Article 16(1) of the GATT-TRIPS Agreement and are entitled to broad legal protection against unauthorized users like the Respondent-Applicant who has appropriated it for its own services.

“5. The registration and use of a confusingly similar mark by Respondent-Applicant will diminish and dilute the distinctiveness and dilute the goodwill of Opposer’s COLGATE TOTAL trademarks.

“6. Respondent-Applicant has appropriated the trademark LISTERINE TOTALCARE for the obvious purpose of capitalizing upon the renown of Opposer’s self-promoting COLGATE TOTAL trademarks by misleading the public into believing that its goods originate from, or are licensed or sponsored by Opposer or result from collaboration with the Opposer. The registration and use of the closely similar mark by Respondent-Applicant will tend to deceive and/or confuse purchasers into believing that Respondent-Applicant’s products emanate from or are under the sponsorship or with the cooperation of the Opposer and damage the Opposer’s interest for the following reasons:

- a. Trademarks are confusingly similar;
- b. The trademarks are applied on identical or related goods;
- c. Respondent-Applicant intends to use LISTERINE TOTALCARE on its own goods as a self-promoting trademark to gain public acceptability for its products through its association with Opposer’s popular COLGATE TOTAL trademarks, which have attained international renown as marks for high quality and reliable toothpastes;
- d. The goods on which the trademarks are used are bought by the same class of consumers and flow through the same channels of trade;
- e. The Respondent-Applicant’s unauthorized appropriation and use of TOTAL as part of its mark will dilute the Opposer’s goodwill and reputation among consumers; and
- f. The Respondent-Applicant intends to trade on the Opposer’s goodwill.”

The Opposer’s evidence consists of the following:

1. Exhibit “A” - Affidavit of Lucie Claire O. Vincent;
2. Exhibit “A-2” - Copy of relevant pages from the website of Colgate-Palmolive Company;
3. Exhibit “B” to “D-1” - Copy of relevant pages from the “History” section of Colgate-Palmolive Company website;
4. Exhibit “E-1” - Certified copy of Certificate of Registration No. 4-1999008406 for the mark COLGATE TOTAL FRESH STRIPE PACKAGE DESIGN;
5. Exhibit “E-2” - Certified copy of Certificate of Registration No. 066760 for the mark COLGATE TOTAL FRESH STRIPE & DEVICE;
6. Exhibit “E-3” - Certified copy of Certificate of Registration No. 4-2001002992 for the mark COLGATE TOTAL PLUS WHITENING LABEL;
7. Exhibit “E-4” - Certified copy of Certificate of Registration No. 4-1997117360 for the mark COLGATE TOTAL FLOURIDE TOOTHPASTE & DESIGN;
8. Exhibit “E-5” - Certified copy of Certificate of Registration No. 4-2004006127 for the mark COLGATE TOTAL 12 & DESIGN;
9. Exhibit “E-6” - Certified copy of Certificate of Registration No. 4-199386036 for the mark COLGATE TOTAL WITH SPECTRUM ARROW DESIGN;
10. Exhibit “E-7” - Certified copy of Certificate of Registration No. 4-1999008407 for the mark COLGATE TOTAL PACKAGE DESIGN;
11. Exhibit “E-8” - Certified copy of Certificate of Registration No. 59737 for the mark COLGATE TOTAL;
12. Exhibits “F-1” to “F-8” - Certified copies of trademark registrations of COLGATE TOTAL in China, OHIM, Malaysia, France, USA, Argentina, Brazil and Australia;
13. Exhibits “G-1” to “G-23” - Representative samples of advertising materials used to promote COLGATE TOTAL product in some countries; and

14. Exhibits “H-1” to “H-5” - Representative samples of advertising materials used to promote COLGATE TOTAL in the Philippines.

This Bureau issued on 27 July 2009 a Notice to Answer and served a copy thereof to the Respondent-Applicant’s counsel on 11 August 2009. The Respondent-Applicant filed several Motions for Extension to File Answer which was granted by this Bureau. On 07 December 2009, the Respondent-Applicant filed its Answer alleging the following, among other things:

“13. First of all, the opposition is dismissible on the ground of opposer’s fatally defective certification of non-forum shopping did not attach to it the board resolution authorizing opposer’s officer to execute the certification. The dismissal will be with prejudice because the period to file the verified opposition has already lapsed.

“14. Also, opposer has no valid and legal ground to oppose the registration of J&J’s LISTERINE TOTAL CARE for non-medicated mouth washes and mouth rinses (Class 3) and medicated mouth washes and mouth rinses (Class 5).

“15. The question as to whether two marks or trade names are confusingly similar is generally determined by the test of dominancy. The test of dominancy focuses on the similarity of the prevalent, essential or dominant features of the competing marks which might cause confusion.

“16. The test of dominancy is usually applied where the marks involved are composite marks. A composite mark consists of two or more features, one of which is dominant. If the dominant feature is imitated, or if such dominant feature is made a part of another composite mark, a case of confusing similarity may result.

“17. Contrary to opposer’s erroneous premises, the dominant and distinctive component of its COLGATE TOTAL composite trademarks is the word “COLGATE” and not “TOTAL”. On the other hand, the dominant and distinctive component of J & J’s composite LISTERINE TOTAL CARE trademark is the word ‘LISTERINE’ and not ‘TOTAL’.

“18. Between the composite marks’ dominant features ‘COLGATE’ (opposer) and ‘LISTERINE’ G&J) and their respective packaging is a very obvious difference in sound, appearance, meaning and presentation, rendering trade confusion next to impossible

x x x

“19. Another basic flow of the opposition is that the opposer did not view the composite marks (oppose and J&J’s) in their respective whole with the combination of all elements. Rather, opposer segregated the component word ‘TOTAL’ apart from the composite marks and concentrated on it. And from this segregation of ‘TOTAL’, opposer erroneously claims confusing similarity.

“19.1. In a composite mark the component elements are .not to be considered as separate and apart. The mark as a whole, the combination of all elements, must be looked into.

“19.2. For the commercial impression of a trade name is derived from it as a whole, not from its elements, separate and considered in detail.

“20. It is well to note too that the composite mark’s commonality, the segregated component word ‘TOTAL’, is an ordinary word commonly used in most fields of products and services. ‘TOTAL’ means (which is very significant to a trademark’s advertising function) that the product/service is whole or complete. Thus, one finds a host of composite marks carrying the component word ‘TOTAL’ registered to different persons for various goods and services. Certainly, opposer cannot claim to be the originator of much less with exclusive right over the very common word ‘TOTAL’.

“21. It must be pointed out that J&J’s composite TM LISTERINE TOTAL CARE is one among the several formatives of its well-known LISTERINE mark.

“22. The history of LISTERINE products dates back 130 years to 1879. The original amber colored LISTERINE product was formulated by Dr. Joseph Lawrence and Jordan Wheat Lambert as disinfectant for surgical procedures. They named their product after the English physician Sir Joseph Lister who performed the first ever antiseptic surgery in 1865. In 1884, Jordan Wheat Lambert formed the Lambert Company to manufacture and market LISTERINE products, as multi-purpose antiseptic, to the medical community.

“23. LISTERINE was later discovered to be excellent for killing germs commonly found in the mouth. So in 1895, the Lambert Company extended the sale of LISTERINE disinfectant to the dental profession as a powerful oral antiseptic. By 1914, the LISTERINE formula was so effective and popular, it became one of the first prescription products to be available over the counter, thereby founding the mouth wash category.

“24. In the 1920s, the manufacturers of LISTERINE started a bold advertising campaign designed to target bad breath. Before the advent of this campaign, bad breath was not a major concern for most people; the LISTERINE manufacturers popularized the term ‘halitosis’ and put bad breath into the forefront of the minds of consumers, encouraging them to solve the problem with regular LISTERINE usage. Sales of the product exploded, and bad breath became a major social concern.

“25. The strong product success, 130 years of heritage, consumer trust and powerful brand communications have made, and continues to make, LISTERINE a global leader in oral care. LISTERINE holds the number one position in the mouth wash market in the Philippines (38.7% of the market share) and all over the world.

“26. The LISTERINE mark was first registered in the United States under Registration No. 45, 682 on August 29, 1905. Subsequently, the LISTERINE mark and formatives have been registered or are pending registrations in trademarks registries all over the world including the Philippines.

“27. Over one billion people have tried LISTERINE. In 2008, total worldwide LISTERINE-branded sales exceeded \$1 billion (U.S.).

“28. Apparent from these vast worldwide sales, long established goodwill and worldwide registrations and applications, J&J’s LISTERINE is a well-known mark. It is thus preposterous for opposer to accuse J&J of trying to capitalize on the ‘renown’ of opposer’s COLGATE TOTAL trademarks to mislead and confuse the buying public as to source and sponsorship of the product.

“29. Besides, the ordinary purchaser will not go out looking for the ‘TOTAL’ word if he is in the market for oral health care products. He may look for COLGATE if he is out to get toothpaste and certainly ask for LISTERINE, being the number one brand, if looking for mouth wash. On the other hand, the subject opposed mark is obviously not similar to opposer’s mouth wash brand LISTERINE. There will be no occasion for confusion.

“30. Opposer’s COLGATE TOTAL trademarks and J&J’s LISTERINE TOTAL CARE mark co-exist in trademark registries and markets all over the world.”

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

1. Exhibit “1”- Authenticated Affidavit of Mr. Jake D. Feldman;
2. Exhibit “2” - Copy of Schedule (Current Details of LISTERINE and formative marks’ registration and pending application worldwide;

3. Exhibit "3" - Certified copies of samplings of registration of the LISTERINE and formative marks worldwide;
4. Exhibit "4"- Certified copy of Certificates of Registration issued by the Intellectual Property Office for the mark LISTERINE and its formative marks;
5. Exhibit "5" - Samples of worldwide print brochures and advertisements;
6. Exhibit "6" - Copies of print-out of www.listerine.com advertising and selling LISTERINE products;
7. Exhibit "7" - Nielsen Audit Retail Survey Result; and
8. Exhibit "8" - Print-outs of Philippine IPO search result showing the widespread use of the component word "TOTAL".

Opposer filed a Reply on 17 December 2009 and a Rejoinder thereto was filed by Respondent-Applicant on 04 January 2010 attaching the following additional evidence:

1. Exhibit "9" -List of marks containing the word "TOTAL" registered with the IPO; and
2. Exhibits "10" to "10-C" -Copies of foreign decisions of oppositions filed by Opposer against Respondent-Applicant in El Salvador, Colombia, Ecuador and Peru³;

The issues having been joined, a Notice of Preliminary Conference was issued by this Bureau. On 12 March 2010, the Preliminary Conference was terminated. Accordingly, Order No. 2010-601 was issued on 21 May 2010 directing the parties to submit their respective position papers. Respondent-Applicant filed its Position Paper on 03 June 2010 while Opposer did so on 04 June 2010.

The issues to be resolved in this case are:

1. Whether the Opposer's mark COLGATE TOTAL is a well-known mark;
2. Whether the Notice of Opposition should be dismissed for failure to attach a Board Resolution; and
3. Whether the Respondent-Applicant's mark LISTERINE TOTAL CARE should be registered.

The Opposer claims that its mark COLGATE TOTAL is a well-known mark citing Sec. 123.1 (e) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), which provides:

SEC. 123. *Registrability.* -123.1 A mark cannot be registered if it:

x x x x

(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 section 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;

In this regard, Rule 102 of the Trademark Regulations sets forth the criteria in determining whether a mark is a well-known mark, to wit:

- (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;

³ Translations of Exhibits "10" to "10-C" of Respondent filed on 10 February 2010 and marked as Exhibits "11" to "11-C".

- (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 or 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.

The rule requires that the party claiming a mark to be well-known satisfies at least a combination of the above stated criteria. In this case, the Opposer submitted certificates of registration of the trademark COLGATE TOTAL in China, OHIM, Malaysia, France, United States, Argentina, Brazil and Australia including registration in the Philippines of the mark COLGATE TOTAL in different variants⁴, representative samples of advertising materials used to promote COLGATE TOTAL products in some countries as well as in the Philippines⁵. These are insufficient, however, to declare the mark COLGATE TOTAL as an internationally well-known mark as it failed to substantiate that at least a combination of any of the criteria under the aforementioned rule, concurs.

On the second issue, the Respondent-Applicant's posits that the instant opposition should be dismissed on the ground that the Opposer did not attach a board resolution authorizing its officer to execute the certification. In this regard, Rule 2, Sec. 7.3 of the Rules and Regulations of Inter Partes Cases, as amended, provides:

7.3. If the petition or opposition is in the required form and complies with the requirements including the certification of non-forum shopping, the Bureau shall docket the same by assigning the Inter Partes Case Number. Otherwise, the case shall be dismissed outright without prejudice. A second dismissal of this nature shall be with prejudice.

In *Fuentebella v. Rolling Hills Memorial Park, Inc*⁶, the Supreme Court held:

"[I]t is obligatory that the one signing the verification and certification against forum shopping on behalf of the principal party or the other petitioners has the authority to do the same.

Rule 7, Section 5 of the 1997 Revised Rules on Civil Procedure provides:

⁴ See Exhibits "E- 1" to "F-8".

⁵ See Exhibits "G-1" to "H-5".

⁶ G.R. No. 150865, 30 June 2006.

x x x

The above provision mandates that the petitioner or the principal party must execute the certification against forum shopping. The reason for this is that the principal party has actual knowledge whether a petition has previously been filed involving the same case or substantially the same issues. If, for any reason, the principal party cannot sign the petition, the one signing on his behalf must have been duly authorized.

This requirement is intended to apply to both natural and juridical persons as Supreme Court Circular No. 28-91 and Section 5, Rule 7 of the Rules of Court do not make a distinction between natural and juridical persons. Where the petitioner is a corporation, the certification against forum shopping should be signed by its duly authorized director or representative. This was enunciated in *Eslaban, Jr. v. Vda. de Onorio*, where the Court held that if the real party-in-interest is a corporate body, an officer of the corporation can sign the certification against forum shopping so long as he has been duly authorized by a resolution of its board of directors.” [Emphasis supplied.]

The records disclose that the verification and certification of non-forum shopping was executed and signed by one Lucie Claire O. Vincent, purportedly, the Vice-President of the Opposer, in the Philippines. However, no resolution by the Board of Directors of Opposer Company was submitted regarding the authority of Lucie Claire O. Vincent to sign the said verification and certification of non-forum shopping. Absence of such authority, the certification of non-forum shopping is fatally defective and therefore, the herein opposition case should be dismissed.

But even if the Opposer submitted proof that Lucie Claire O. Vincent has the authority to sign the verification and the certification of non-forum shopping, the opposition must still fail.

It must be emphasized the essence of trademark registration is to give protection to the owner of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the article to which it is affixed, to secure to him, who has been instrumental in bringing into a 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 products.⁷

Sec. 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines (IP Code”), states that 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 confusion;

The competing marks are shown below for comparison

⁷ *Pribhdas J. Mirpuri v. Court O/Appeals*, G.R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents*, 16 SCRA 495.



Opposer's Marks

**LISTERINE
TOTAL CARE**

Respondent's Mark

This Bureau finds the competing marks not confusingly similar. What the consumer or purchasing public remembers or what stick to his mind when he sees the Opposer's product is the word COLGATE not TOTAL. The distinguishing feature in the Opposer's mark, therefore, is obviously the word "COLGATE". This is not so in the case of Respondent-Applicant's mark, the prominent feature being the word "LISTERINE". The differences in the features, the visual, aural, connotative comparisons and overall impressions of the competing marks are clearly perceptible, such that, the likelihood of confusion or mistake on the part of the public is remote. One cannot mistake the mark and the products of the Opposer as those of the Respondent-Applicant. The word "total" is an ordinary word and is suggestive. When paired with a highly-distinctive word mark or brand, like Colgate, the word "total" is hardly noticeable, until the consumer scrutinizes and assumes that the word suggests an "enhancement" of the product. Hence, the Respondent-Applicant's LISTERINE TOTAL CARE cannot be said to be a derivative of Opposer's COLGATE TOTAL or that the goods upon which the herein subject mark is used emanates from one same source.

Thus, even if the Opposer has submitted evidence sufficient to declare its mark well-known under Rule 102 of the Trademark Regulations, the Bureau cannot sustain the opposition. The protection to well-known marks under Sec. 123.1, paragraphs (e) and (f) applies only if the competing marks are found to be confusingly similar.

WHEREFORE, premises considered the instant opposition to Trademark Application Serial No. 4-2008-000924 is hereby DENIED. Let the filewrapper of Trademark Application Serial No. 4-2008-000924 be returned together with a copy of this DECISION to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 29 July 2010.

Atty. NATHANIEL S. AREVALO
Director
Bureau of Legal Affairs