

FEDERATION DES INDUSTRIES
DE LA PARFUMERIE

Opposer,
- versus -

EBEL INTERNATIONAL LIMITED
Respondent-Applicant.
x-----x

IPC 14-2006-00127

Opposition to:
TM Application No. 4-2004-011849
(Filing Date: 14 December 2004)

TM: "L'BEL PARIS & DEVICE"

Decision No. 2007-47

DECISION

Before us is the opposition to the registration of the mark "L'BEL PARIS & DEVICE" bearing Serial No. 4-2004-011849 filed on December 14, 2004 covering the goods bleaching preparations and other substances for laundry use; cleaning; polishing; scouring and abrasive preparation; soap; perfumery; essential oils; cosmetics; hair lotions and dentifrices falling under class 3 of the international classification of goods which trademark was published for opposition purposes in the electronics gazette on May 16, 2004.

The Opposer in the instant opposition proceedings is "Federation Des Industries De La Parfumerie" a trade union organized and existing under the laws of France with principal offices at 33, Avenues Des Champs-Elysees, Eight Arrondissement, Paris, France.

On the other hand, the Respondent-Applicant is "Ebel International Limited" a corporation with main offices located at Cedar House 41, Cedar Avenue, Hamilton HM12, Bermuda.

The grounds for the opposition are as follows:

- "1. The Opposer represents and defends the common interest of its members, both in the national and international levels. It intervenes every time the words "Paris", "France", or any principal Parisian monuments such as the Eiffel Tower, are made an integral part of a proposed trademark. The principal objective of the Opposer is to prevent the use of these words and monuments that will falsely suggest that the goods covered by the proposed trademark originate from Paris, France, when in fact they do not. Considering that the Opposer's members are internationally well known for producing perfumery and cosmetics products of high quality, allowing other entities to use the said words and/or Parisian monuments in their trademarks would undoubtedly mislead the public into thinking and believing that the goods and/or service sold under said trademarks originate from Paris, France. The unwarranted and unjustified use of said words and/or monuments constitutes a false indication or origin that can mislead the public and damage the reputation and lawful interest of the Opposer and its members. The Opposer, therefore, has the requisite standing to bring the instant Opposition;
- "2. The use of the word "PARIS" in the proposed trademark constitutes a false designation of origin not only is the Respondent-Applicant based in BERMUDA: the products covered by the proposed trademark are manufactured in areas outside of Paris, France. Thus, clearly, the Respondent-Applicant intends to mislead the Filipino buying public into believing that its products originate in Paris, France, when in truth and fact, they do not.

- “3. The registration of the mark “L’BEL PARIS & DEVICE” is violative of the provisions of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, particularly Section 123.1 (g), which provides:

“Sec. 123. Registrability – 123.1. A mark cannot be registered if it:

x x x

“(g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services.”

On January 26, 2007, the Respondent-Applicant filed its Answer whereby it admitted the allegations contained in the following paragraphs of the verified Notice of Oppositions:

- “1.1 Paragraph 2, only insofar as it states the name of Respondent-Applicant, its address and that summons and other processes of this Honorable Office may be served through the undersigned Law Office.
- “1.2 Paragraph 4, only insofar as it alleges that Respondent-Applicant filed a trademark application with the Intellectual Property Office (“IPO”) on 14 December 2004 for the mark “LA’BEL PARIS & DEVICE” under Application No. 4-2004-011849 in International Class 3(“Subject Mark”).
- “1.3 Paragraph 3, only insofar as it alleges that Respondent-Applicant is based in Bermuda.

However it denied all other allegations in the Verified Notice of Opposition.

The ultimate issue to be resolved in this particular case is:

“WHETHER OR NOT THE RESPONDENT-APPLICANT’S USE OF THE WORD “PARIS” IN THE PROPOSED TRADEMARK CONSTITUTE A FALSE DESIGNATION OF ORIGIN THAT IS LIKELY TO MISLEAD THE BUYING PUBLIC.”

In order to arrive at a fair and just resolution of the issue, it is necessary to understand what geographical indication means.

The use of geographical indication is important in indicating the origin of goods and services. One of the aims of their use is to promote commerce by informing the customer of the origin of the products. Often this may imply a certain quality, which the customer may be looking for. They can be used for industrial and agricultural products.

Basically, a geographical indication is a notice stating that a given product originates in a given geographical area. For instance, the geographical indication “CHAMPAGNE” is used to indicate that a special kind of sparkling wine originates in the Champagne region of France. In the same way, “COGNAC” is used for brandy from French region around the town of “COGNAC”.

To distinguish a trademark from a geographical indication, a trademark is a sign that an individual trader or company uses to distinguish its own goods or services from the goods or services of competitors while geographical indication is used to show that certain products have certain regional origin. A geographic indication must be available for use by all the producers in that region.

For added clarification, it is likewise necessary to distinguish “appellation of origin” from “geographical indication”.

Appellations of origin are specific types of geographical indication. A geographical indication is a notice stating that a given product comes from a particular area. An appellation of origin is more precise geographical indication which specifies that a product in question has certain qualities and that those qualities are due essentially or exclusively to its place of origin. Basically an appellation that declares the quality of goods for which it is used to be derived essentially or exclusively from the area of production.

Opposer is opposing the registration of the trademark "L'BEL PARIS & Device" on the ground that it constitutes a false designation of origin under Section 123.1 (g) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines. It claims that the Respondent-Applicant is not based in PARIS, FRANCE but in BERMUDA, and that the products covered by the trademark, cosmetics and perfume products, are manufactures outside PARIS, FRANCE. Thus, the trademark will clearly mislead the buying public into believing that its products originate in PARIS FRANCE, when they do not.

On the other hand, the herein Respondent-Applicant claims that all of the products sold under the trademark in question are manufactured in FRANCE and its use of the word "PARIS" in the trademark accurately conveys to the customers that the products are of French origin. It argues that for cosmetics and perfume products, the significant geographical location is the city of PARIS. Hence, so long as consumer's decision to purchase the products is based on the assumption that said products are French cosmetics and perfumes, the use of the word "PARIS" is proper, since it signifies a French origin. This contention is clearly not in accordance with the provisions of the TRIPS Agreement and Section 123.1 (g) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines.

It cannot be denied that when the public sees cosmetic and perfume products bearing the word "PARIS", it immediately identifies them as high quality cosmetics and perfumes found in Paris.

Opposer's claims that falsity exists as the Respondent-Applicant is not based in Paris, France and its products are not manufactured in that territory.

Respondent-Applicant admitted that its State of Incorporation is "BERMUDA", however, it has a wholly owned corporate subsidiary "EBEL INTERNATIONAL (FRANCE)", which is a corporation organized under the laws of France with head office at 16 Place Vendome 75001, Paris, France. Respondent-Applicant is the sole shareholder of Ebel International (France) which is operating within Paris, France. Moreover, the products that it sells under the trademark "L'BEL PARIS & DEVICE" are developed, produced and manufactured within the country of France through different French companies. (Affidavit of Mr. Angel Acevedo) authenticated before the Philippine Consulate in Lima, Peru.

As further claimed by the Respondent-Applicant, it manufactures all of the products covered by the subject mark within the country of France. The research and development of concepts, ingredients, formulas and that marketing of new products are all done in France, the manufacturing of the products itself is subcontracted to a French Company and is entirely done within the country of France.

As shown on the labels of the products, there is an information appearing therein that the products are "made in France, or made in Columbia, Germany, Italy, Spain, United States, Argentina, Mexico, Korea, Peru and none in Paris. (Exhibit "11")

This is Respondent-Applicant's justification, that although its products bearing the mark "PARIS" are not manufactured in Paris, and so long as there is substantial connection between the geographic word shown in a mark and the principal business office of the trademark proprietor, the geographical indication shown in the mark cannot be said to be misleading and in fact correctly identifies the origin of a product or service bearing that mark. (This argument is

based in foreign jurisprudence re: Nantuket Allserve, Inc., 329, F, 3d, 1334) In this case, the United States Patent and Trademark Office held that the “origin” of the applicant’s soft drinks sold under the mark is the Island Nantucket because the applicant maintained an office on the Island Nantucket and that office serves as the corporate headquarters and center for research and development. This holding was made despite the fact that the applicant’s soft drinks products were not produced in Nantucket and neither were any of its ingredients.

The Opposer on the other hand cited foreign decisions of which the word “PARIS” as part of the mark to be registered have been ruled to be misleading as to the geographic origin and quality of the goods and for a false designation of origin. (Exhibits “B-3a”), (Exhibit “B-3c”) and (Exhibit “B-3d”)

In this jurisdiction, Philippine jurisprudence is lacking in cases that deal with the proper interpretation of the provision provided under Section 123.1 (g) of Republic Act No. 8293. Foreign authorities although not controlling has persuasive effect.

In the case at bar, the contending parties cited foreign cases, decision to justify their respective position, however, cited authorities are not the same and are contradictory to each other.

The admission of Respondent-Applicant that its products are not manufactured in Paris, although the product covered by the mark maybe manufactured in France but outside “Paris” the inclusion of the words “PARIS” as part of its trademark is likely to cause confusion or mistake in the public’s mind or mislead purchasers, believing that the products are originating in Paris while they are not.

Article 22 of the TRIPS Agreement provides:

Section 3: Geographical Indications.

Article 22. Protection of Geographical Indications.

Geographical indications are, for the purposes of this agreement, indications which identify a good as originating in the territory of a member, or a region or locality in that territory, where a given quality, reputation or characteristic of the good is essentially attributable to its geographic origin.

In the instant case, it cannot be denied that a cursory examination of the mark subject of the opposition, the inclusion or the presence of the word “PARIS” in the mark automatically create the impression that the goods covered are made in PARIS or originating in PARIS.

It is difficult to understand why the Respondent-Applicant included the word “PARIS” as part of its trademark if not to misled the public that its product are originating from the same place considering that PARIS is popularity known for perfumes and cosmetics products of superior quality than products coming from other cities or regions.

WHEREFORE, with all the foregoing, the opposition is hereby SUSTAINED. Consequently, trademark application bearing Serial No. 4-2004-011849 filed on December 14, 2004 for the mark “L’BEL PARIS & DEVICE” is hereby REJECTED.

Let the filewrapper of the trademark “L’BEL PARIS & DEVICE” subject matter of this case together with a copy of this DECISIONB be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 30 April 2007.

Atty. ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs