

HOYU COMPANY, LIMITED,	}	Inter Partes Case No. 3896
Opposer,	}	Opposition to:
	}	Application. Serial No. 66070
-versus-	}	Filed: October 24, 1988
	}	Trademark: "DE BON BIOGEN"
	}	
	}	Goods : Perfume, common
	}	toilet water, emulsion, skin
	}	lotion, toilet cream, medical
	}	cream, hair tonic, mixed-
	}	perfume, license, and soap
LUCKY LIMITED,	}	cases.
Respondent-Applicant.	}	Decision No.: 2001-01
x-----x	}	

DECISION

This is an Opposition filed on May 13, 1993 by HOYU Company Ltd., of Nagoya, Japan against application Serial No. 66070 for perfume, common toilet water, emulsion, skin lotion, toilet cream, medical cream, hair tonics, mixed-perfume, incense and soap cases under classes 3 and 21 of the International Classification of goods which application was published on page 4, Vol. VI of the Official Gazette and officially released on March 16, 1993.

The herein Respondent-Applicant "LUCKY, LTD.", is a foreign entity whose country of origin is Korea with address at 20, Yoido-dong, Yongdunpo-Ku, Seoul Korea.

The grounds for opposition are as follow:

"1. Opposer is the owner of the trademarks:

- a) "BIGEN," Registration No. 12689 – issued February 9, 1967 filed October 31, 1963, renewed effective February 9, 1987; for cosmetics toilet preparations, hair dyes.
- b) BIGEN ELITE – Registration No. 42237, issued December 12, 1988, filed June 14, 1982 for hair dyes, shampoo, rinse hair dressing and cold wave lotion all issued by the Philippine Patent Office. The above marks are also registered by opposer in various countries of the world.

"2. On October 24, 1988 respondent-applicant filed with the Patent Office an application for registration of the trademark "DE BON BIOGEN" for perfume, common toilet water, emulsion, skin lotion, toilet cream, medical cream, hair tonics, mixed perfume, incense, and soap cases under Application Serial No. 66070. The application was duly published in the Official Gazette.

"3. The registration of the trademark "DE BON BIOGEN" in the name of respondent-applicant in violation of and runs counter to Section 4(d) of Republic Act No. 166, as amended, because it is confusingly similar to the above trademarks of Opposer Hoyu Company, Limited, as registered and previously used in the Philippines as to be likely when applied to or used in connection with the goods of respondent-applicant, to cause confusion or mistake or deception to the purchasing public;

- “4. Opposer believes, and therefore alleges that the registration of the mark “DE BO BIOGEN” in the name of respondent-applicant will cause irreparable injury and damage to opposer, as provided under Section 8 of Republic Act 166, as amended.
- “5. Registration of the mark “DE BON BIOGEN” is in violation of the provisions of Section 37 of Republic Act No. 166, as amended.

Opposer relied on the following facts to support its opposition, reserving the right to present evidence to prove other facts as may be necessary in the course of these proceedings, depending on the evidence that may be introduced by respondent-applicant:

- (a) Opposer’s marks “BIGEN” and “BIGEN ELITE” have been used in trade and commerce in the Philippines and elsewhere since before the filing of its applications for registration and the issuance of the various certificate of registrations above mentioned, and all prior to the date of filing of the application for registration on January 5, 1989 of the mark “BIOGEN” by respondent-applicant.
- (b) The mark “DE BON BIOGEN” appearing on the drawings and facsimiles submitted by respondent-applicant in its application for registration are confusingly similar to opposer’s aforementioned registered marks as used on the goods of opposer.
- (c) The trademarks “BIGEN” and “BIGEN ELITE” which opposer ha created, adopted and used are well known all over the world, having acquired international recognition and goodwill for its quality products bearing said marks. Opposer has been manufacturing and selling in the Philippines and other countries goods bearing the mark “BIGEN” and “BIGEN ELITE” which are similar if not identical to the alleged products of respondent-applicant bearing the mark “DE BON BIOGEN” under Application Serial No. 66070.
- (d) The long use of, and the large amounts spent by the opposer for popularizing its trademarks “BIGEN” and “BIGEN ELITE” have generated an immense goodwill for said trademark not only in the Philippines but also in other countries, and opposer’s good have acquired the reputation of high quality products by purchasing public.
- (e) The use and adoption by respondent-applicant of the mark “DE BON BIOGEN” which is confusingly similar to opposer’s marks would tend to falsely suggest a connection with the business of opposer and therefore constitute an intent to defraud opposer.
- (f) The similarity of the trademark “DE BON BIOGEN” subject of the application to the trademarks of opposer betrays respondent-applicant’s intention to

ride on the goodwill and popularity of opposer's trademarks "BIGEN" and "BIGEN ELITE".

- (g) Respondent has no valid home registration for the mark "DE BON BIOGEN" for the products covered by Application Serial No. 66070.

On July 19, 1993, Respondent-Applicant filed its answer to the Notice of Opposition and averred that:

- a. It strongly specifically denies par. 3 since it is clear as day that "DE BON BIOGEN" is different from "BIGEN". There is a whale of difference between the two marks like an elephant and a rabbit compared together, or a pygmy and a giant if opposer cannot see the difference to put it more lucidly. Hence, obviously, there could be no confusion.
- b. Under the foregoing circumstances, therefore, opposer will not incur any irreparable injury and damage.
- c. Registration of the mark "DE BON BIOGEN" is not all a violation of the provisions of Section 37 of Republic Act No. 166 as amended.
- d. As regards opposer's facts on which it relies to support its opposition, Respondent-Applicant reiterates its position that "DE BON BIOGEN" in spelling and pronunciation that even an unwary purchaser or buyer could easily distinguish the differences. Beside any buyer of cosmetics is always discriminating and under such circumstances, any mistake or confusion would be unlikely to happen.
- e. Respondent-Applicant states that "DE BON BIOGEN" is not confusingly similar with "BIGEN" as any ordinary person could see except opposer, and it is usual for opposer to corner or monopolize this class of products in their desire to lord the market that even for the use of the letter "B" would mean their mark "BIGNE" which is absurd and ridiculous.
- f. The use of the word "DE BON BIOGEN" will not be considered as riding on the popularity of the mark "BIGEN" since how could an elephant ride a rabbit as stated above.

Records will show that a Notice of Hearing, (Pre-trial Conference) was sent to Respondent-Applicant's counsel and same was duly received on July 30, 1993 which was held on August 3, 1993 at 9:00 a.m. but on said scheduled hearing, Respondent-Applicant and its Counsel failed to appear.

Another hearing was scheduled on November 2, 1993 and on December 7, 1993 at 2:30 p.m. and again Respondent-Applicant and its Counsel failed to appear despite due notice prompting Counsel for the Opposer to move in Open Court that Respondent-Applicant be

declared as in Default which Motion was GRANTED under ORDER NO. 93-869 dated December 11, 1993.

Pursuant to the Order of default Opposer presented its evidence Ex-Parte consisting of Exhibits "A" to "G-2" inclusive of their sub-markings.

THE ULTIMATE ISSUE TO BE RESOLVED IN THIS CLASS IS:

WHETHER OR NOT the trademark of Respondent-Applicant is confusingly similar to the mark of the Opposer as to be likely, when applied to or used in connection with the goods of the Opposer to cause confusion, mistake or to deceive purchaser to SECTION 4 (d) OF R.A. NO. 166 as amended.

SEC.4 (d) R.A. 166 as amended provides:

SEC. 4. Registration of trademark, tradenames and service marks on the principal register. there is hereby established a register of trademarks, tradenames and service marks which shall be known as the principal register. the owner of a trademark, tradename, or service mark used to distinguish his goods, business or service from the goods, business or services of the others shall have the right to register the same on the principal register unless it:

"(d) Consists of or comprises a mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark or trade-name 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 service of the applicant, to cause confusion or mistake or to deceive purchasers."

In cases involving registration of trademarks, the question of "Colorable imitation" of the older trademark comes into play. Colorable imitation means such close imitation as to be calculated to deceive ordinary persons and cause them to purchase the goods of one supposing it to be the goods of the other. (ETEPHA vs. DIRECTOR OF PATENTS, 16 SCRA 495 Citing 87 C.F.S. 287)

It has been stated that to constitute infringement of marks it is not necessary that one mark is an exact copy of the other or that the same words were used. It is sufficient that the essential characteristics have been copied or imitated (SAPOLIN CO. vs. BALMACEDA, and GERMAN & CO., 67 PHIL. 705) as to deceive or mislead ordinary persons into the belief that they are dealing with one concern when in fact they are dealing with the other.

The "dominancy" test is usually applied to determine whether two marks are confusingly similar. If the competing marks contain the essential or dominant features of another mark and confusion and deception is likely to result, then there is confusing similarity (CO. TIONG SO vs. Director of Patents, 95 Phils, LIM HOA vs. Director of Patents, 100 Phil. 214 American Wire & Cable Co. vs. Director of Patents 31 SCRA 544).

The Supreme Court held in the case of MARVEX COMMERCIAL CO. INC., V. PETRA HAWPIA & CO. (18 SCRA 1178) that –

The trademarks "Lionpas" medicated plaster cannot be registered because it is confusingly similar to "Salonpas" a registered trademark also for medicated plaster. Both words have same suffix, "pas" which denoted a plaster, with curative powers, that adheres to the body. However, as "pas" is merely descriptive and furnishes no indication of the origin of the article, it is

open for appropriation by anyone and may properly become the subject of a trademark by combination with another word or phrase. Although two letters of "Salonpas" are missing in "Lionpas" nevertheless, when the two words are pronounced, the sound effects are confusingly similar. Where goods are advertised over the radio, similarity in sound is of special significance. Similarity of sound is a significant ground for holding that the two marks are confusingly similar when applied to merchandise of the same descriptive properties.

In *CO. TIONG SO V. DIRECTOR OF PATENTS* the Supreme Court held that "CELDURA" and "CORDURA" are confusingly similar in sounds. Likewise, in the case of *SAPOLIN CO. V. BALMACEDA*, 67 PHIL. 795, Supreme Court held that the name "LUSOLIN" is an infringement of the trademark "SAPOLIN", as the sound of the two names is almost the same.

In the case at bar, Respondent-Applicant copied Opposer's mark "BIGNE" to constitute the dominant word "BIOGEN". In spite of the millions of terms and combinations of the letters available to Respondent, it adopted and applied for the registration of a mark similar to that of the Opposer. Under the foregoing circumstances, the intention of Respondent is to take advantage of the reputation and goodwill generated by Opposer's trademark is likewise evident.

Attention must be given to the fact that Respondent's mark although accompanied by the words "DE BON" written in a small letters above the word "BIOGEN" WHICH IS MORE PROMINENT AND CONSTITUTE THE dominant PART OF Respondent-Applicant's mark. Therefore, the eyes of the purchasing public are attracted more to the larger word "BIOGEN".

There is evidence that Opposer's mark "BIGEN" is pronounced like "BYGONE" with the letter "I" pronounced like "Y" in "BYGONE", "BITE", "DIKE", "DIE", "LIKE", "NIGHT", "FIGHT", "PIE", "TIRE", "WIRE" and etc. On the other hand, it cannot be denied that respondent-applicant's mark is pronounced like "BYGEN".

There is evidence to show that Opposer's mark "BIGEN" is pronounced like "BIGEN" where the letter "I" pronounced like "Y" in "BYGONE", "BITE", "DIKE", "DIE", "WIRE" and etc. (Exhibits "F", "F-1", to "F-3").

In one case, the Directorate for Commercial and Industrial Property in ATHENS, GREECE, have decided a Trademark case involving the mark "BIGNE" and "BIOGEN", Decision No. 5064/1988, it was held that:

"Concerning the case under judgment, both trademarks are almost identical given that words which constitute them" "BIOGEN" of the respondent in the appeal and "BIGEN" of the opposing party have five common letters "BIGEN" and the only difference is that the trademark of the respondent contains the letter "O" in the middle of the word, which addition cannot differentiate it sufficiently from the trademark registered prior to its own registration and prevent the risk of confusing the consumer with regard to the enterprise from which the products with the contested trademark originate, and which are similar to those distinguishes by the trademarks of the opposing party registered prior to those of the respondent." (Exhibits "G", "G-1" and "G-2").

It is worthy to note, however, that decisions made by any court or body outside the Philippines is not conclusive, but has a persuasive effect.

Considering the foregoing, it is reasonable to conclude that Respondent-Applicant's mark is confusingly similar, if not identical, to Opposer's mark "BIGEN" and that the competing trademarks cover the goods falling in the same classification, class 3.

It must be noted that the herein Respondent-Applicant was declared in DEFAULT in accordance with the Rule of Court (ORDER NO. 93-869) dated December 11, 1993.

It was held by the Supreme Court in *DELBROS HOTEL CORP. vs. INTERMEDIATE APPELLATE COURT* 159 SCRA 533, 543 (1988) that:

“Fundamentally, default orders are taken on the legal presumption that in failing to file an Answer, the defendant does not oppose the allegations and relief demanded in the complaint.”

Indeed, this Office cannot but notice the lack of concern the Respondent-Applicant had shown in protecting the mark which is contrary to the norm that:

“A person takes ordinary care of his concern SEC. 3(d) Rule 131 of the Rules of Court”

WHEREFORE, the Opposition is SUSTAINED. Consequently trademark application bearing Serial No. 66070 for the mark “DE BON BIOGEN” filed October 24, 1988 by LUCKY, LTD. is, as it is hereby, REJECTED.

Let the record of this case be forwarded to the Administrative, Financial and Human Resource Development Services Bureau (AFHRDSB) for appropriate action in accordance with this DECISION with a copy thereto be furnished the Bureau of Trademarks for information and to update its record.

SO ORDERED.

Makati City, July 25, 2001.

ESTRELLITA BELTRAN-ABELARDO
Director
Bureau of Legal Affairs