

WILFRO P. LUMINLUN
Opposer,

-versus-

COSMETICS REVELATION
MFG. CORP.

Respondent-Applicant.

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IPC No. 14-2008-00095
Opposition to:

Appl'n. Serial No. : 4-2005-003370
Filed: 14 April 2005
Trademark: "ACTIVE/COLOURS
AND DESIGN"

Decision No. 2009-54

DECISION

For decision is an Opposition filed by Wilfro P. Luminlun, Inc., with business and postal address at 1026-PP R. Square Building, Roman Street, Binondo, Manila, against the application for registration of the trademark ACTIVE/COLOURS AND DESIGN for colored cosmetics namely face powder, eyeshadow, blush-on, liquid foundation, concealer, lipstick, mascara, liquid and pencil eyeliner, lipstick, lip gloss, perfumes, colognes, lotions and body soap under Application Serial No. 4-2005-003370 and filed on 14 April 2005 in the name of Cosmetics Revelation Mfg. Corporation.

The grounds for opposition to the registration of the trademark ACTIVE/COLOURS AND DESIGN are as follows:

- "1. Approval of the application in question is contrary to Sections 123.1 (d) and 138 of Republic Act No. 8293.
- "2. As registered owner of the trademark COULOURS and variations thereof, the approval of the application in question will violate his right to the exclusive use of his registered trademarks.
- "3. The approval of the application in question has caused and will continue to cause great and irreparable damage and injury to herein Opposer.
- "4. Respondent-Applicant is not entitled to register the mark ACTIVE/COLOURS AND DESIGN in its favor.

Opposer relied on the following facts to support his contentions in this Opposition:

- "1. Opposer is the registered owner of the trademark COLOURS for use on shoes, sandals, slippers, boots, jeans, pants, t-shirts, shirts, briefs, shorts, socks, handkerchiefs, belts, jogging pants, sweatshirts falling under Classes 18, 24, and 25, under Registration No, 45840 issued on July 26, 1989.
A certified copy of Certificate of Registration no. 45840 is hereto attached as Exhibit "A" and made an integral part hereof.
Registration No. 45840 continues to be in full force and effect.
- "2. Opposer is the registered owner of the trademark COLOURS for use on suits, coats, overcoats, topcoats, jackets, neckties, vests, handbags, overnight bags, travel bags and school bags falling under Classes 18 and 25, under Registration No. 4-1990-070641 issued on August 28, 2004.
A certified copy of Certificate of Registration No. 4-1990-070641 is hereto attached as Exhibit "B" and made an integral part hereof.
Registration No. 4-1990-070641 continues to be in full force and effect.

"3. Opposer is the registered owner of the trademark COLOURS AGAINST A RECTANGULAR BACKGROUND COLORED BLUE, RED, GREEN for use on shoes, sandals, slippers, boots, jeans, pants, t-shirts, shirts, briefs, shorts, socks, handkerchiefs, belts, jogging pants, sweatshirts, suits, coats, overcoats, topcoats, jackets, neckties, travel bags, school bags, stationeries, notebooks, note pads, pens, ballpens, pencils, picture frames, combs, hair brushes, greeting cards, perfume, falling under Classes 3, 16, 18, 21, 24 & 25 under Registration No. 62139 issued on December 1, 1995.

A certified copy of Certificate of Registration No. 62139 is hereto attached as Exhibit "C" and made an integral part hereof. Registration No. 62139 continues to be in full force and effect.

"4. Opposer has continued since the use of his registered trademark COLOURS and variations thereof (Exhibits "A", "B", and "C") since January 1, 1982 up to the present.

"5. That portion of Exhibit "A" which is marked as Exhibit "A-1" clearly indicates that Opposer has submitted the required affidavits of use following the 5th, 10th, and 15th anniversaries of Registration No. 45840.

"6. Submitted herewith as Exhibits "B-1" to "B-8" and made integral parts hereof is the Declaration of Actual Use submitted by Opposer on November 29, 2001 in connection with his Application Serial No. 4-1990-070641 which has ripened into Registration No. 4-1990-070641.

"7. Submitted herewith as Exhibits "D" and "D-1", and made integral parts hereof are copies of the duplicate originals of the accepted Affidavit of Use and Declaration of Actual Use submitted by Opposer last March 5, 2001 and November 30, 2006 following the 5th and 10th anniversaries of his Registration No. 62139 (Exhibit "C").

"8. As additional proof of the continuous use of his registered trademark COLOURS and variations thereof, Opposer submits herewith representative sales invoices of his company, Basic Clothing International Manufacturing, marked as Exhibits "E" to "E-9" and made integral parts hereof.
A photograph of Opposer's perfume bearing his trademark COLOURS is marked as Exhibit "F" and made an integral part hereof.

"9. Through continuous commercial use, promotion and/or advertising of his registered trademark COLOURS and variations thereof, the relevant sector of the public in the Philippines has come to know and identify said mark, including the mark COLOURS AGAINST A RECTANGULAR BACKGROUND COLORED BLUE, RED, GREEN as belonging to Opposer and his company, Basic Clothing International Manufacturing.

"10. The trademark ACTIVE/COLOURS AND DESIGN being applied for registration by Respondent-Applicant, nearly resembles Opposer's registered trademark COLOURS and variations thereof.

A print-out of Respondent-Applicant's mark as published, is hereto attached as Exhibit "G", and made an integral part hereof.

"11. The goods, particularly, perfume and cologne of Respondent-Applicant's application are identical to, and/or closely related to the goods covered by Registration No. 62139 (Exhibit "C") of Opposer.

Accordingly, the approval of the application in question is contrary to Section 123.1 (d) of Republic Act No. 8293, which provides:

“Section 123. Registrability.—123.1. A mark cannot be registered if it:

- | | | |
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| x | x | x |
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- (d) Is identical with a registered mark belonging to a different proprietor or 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;”

“12. Further, the approval of the application in question violates the right of Opposer to the exclusive use of his registered trademark COLOURS and variations thereof, particularly his mark COLOURS AGAINST A RECTANGULAR BACKGROUND COLORED BLUE, RED, GREEN, on the goods listed in his certificate of registration (Exhibit “C”) which included perfume.

Section 20 of Republic Act No. 166, as amended, the law under which Opposer’s application which ripened into Registration No. 62139 was filed, examined, and approved, provided:

Section 20. Certificate of registration prima facie evidence of validity.—A certificate of registration of a mark or trade-name shall be prima facie evidence of the validity of the registration, the registrant’s ownership of the mark or trade-name, and registrant’s ownership exclusive right to use the same in connection with the goods, business or services specified in the certificate, subject to any conditions and limitations stated therein.”

Section 20 of Republic Act as amended, is now found in Section 138 of the IP Code.

“13. Should the trademark ACTIVE/COLOURS AND DESIGN be registered in the name of Respondent-Applicant, the likelihood of confusion on the part of the consuming public is bound to occur, as well as confusion of source, affiliation or connection. Compounding the likelihood of confusion and deception is the fact that the goods upon which Respondent-Applicant’s trademark are to be used are identical, as well as closely related, to the goods of Opposer.

“14. Opposer has been damaged and will continue to be damaged by the registration of the trademark ACTIVE/COLOURS AND DESIGN in the name of Respondent-Applicant, in that the use of said mark by Respondent-Applicant will prejudice the rights of Opposer over his registered trademark COLOURS and variations thereof, particularly his mark COLOURS AGAINST A RECTANGULAR BACKGROUND COLORED BLUE, RED, GREEN, and irreparably impair and/or destroy the goodwill generated by Opposer’s trademarks. For the above reasons, Respondent-Applicant is not entitled to the registration of the mark ACTIVE/COLOURS AND DESIGN in favor and its application should be rejected.

Attached herewith are labels showing how the trademark COLOURS AGAINST A RECTANGULAR BACKGROUND COLORED BLUE, RED, GREEN is actually being by Opposer and a check for P8, 686.00 for filing fee, legal research and processing and hearing fees.

The Notice to Answer dated 13 May 2008 was sent to Jim Marty Ting directing Respondent-Applicant to file their Verified Answer within thirty (30) days from receipt of the said notice. For failure of Respondent-Applicant to file their Verified Answer within the thirty (30)-day period, this Bureau in Order No. 2008-1613, after receipt of the Manifestation filed by Opposer on 15 September 2008, considered the case submitted for decision based on the opposition, affidavits of the witnesses and documentary evidence submitted by the Opposer, pursuant to Section 11 of the amended Rules on Inter Partes Proceedings.

Filed as evidence for the Opposer, based on the records, are the following:

1. Certified copy of Opposer's Certificate of Registration No. 45840 issued on July 26, 1989 for the trademark COLOURS - Exhibit "A"
2. Certified copy of Opposer's Certificate of Registration No. 4-1990-070641 issued on August 28, 2004 for the trademark COLOURS - Exhibit "B"
3. Copy of the Declaration of Actual Use Submitted last November 29, 2001 in connection with Opposer's Application Serial No. 4-1990-070641 which has ripened into Registration No. 4-1990-070641 - Exhibit "B-1" and "B-8"
4. Certified copy of Opposer's Certificate of Registration No. 62139 issued on December 1, 1995 for the trademark COLOURS AGAINST A RECTANGULAR BACKGROUND COLORED BLUE, RED, GREEN - Exhibit "C"
5. Duplicate originals of the accepted Affidavit of Use and Declaration of Actual Use submitted last March 5, 2001 and November 30, 2006 following the 5th and 10th anniversaries of Registration No. 62139 for the trademark COLOURS AGAINST A RECTANGULAR BACKGROUND COLORED BLUE, RED, GREEN - Exhibit "D" and "D-1"
6. Representative sales invoices of Opposer for goods bearing the trademark COLOURS and variations thereof - Exhibit "E" and "E-9"
7. Photograph of Opposer's goods bearing his trademark COLOURS - Exhibit "F"
8. Print-out of Respondent-Applicant's mark ACTIVE/ COLOURS AND DESIGN as published in the e-Gazette Released last January 11, 2008 - Exhibit "G"
9. Duly notarized affidavit of Opposer Wilfro P. Luminlin - Exhibit "H"

For consideration in particular is the propriety of Application Serial No. 4-2005-003370, particularly resolving on the following issues:

1. Whether or not there is confusing similarity between Opposer's trademark, ACTIVE/COLOURS AND DESIGN and Respondent-Applicant's COLOURS mark or family of COLOURS mark; and
2. Whether or not Respondent-Applicant's trademark application for ACTIVE/COLOURS AND DESIGN should be granted registration.

The issue stems of springs from Respondent-Applicant's appropriation of the word COLOURS which is the same in sound and spelling vis-a-vis Opposer's COLOURS trademarks. There is no issue that the marks involved are identical, not with the style these marks were printed or presented or with the device used thereon but the word COLOURS appears in both labels of the contending parties. Shown below are the family of COLOURS trademarks of Opposer and Respondent-Applicant's ACTIVE/COLOURS, for purposes of comparison:

Opposer's family of COLOURS trademarks:

COLOURS

COLOURS



Respondent-Applicant's ACTIVE/COLOURS AND DESIGN:



On the basis of the evidence and proofs presented, there are shown clear and convincing proofs that the two (2) competing trademarks, COLOURS trademarks of Opposer and Respondent-Applicant's ACTIVE/COLOURS AND DESIGN are confusingly similar. Both trademarks contain the word COLOURS, although Respondent-Applicant's mark has inserted another word ACTIVE with a DOUBLE "A" WAVE DESIGN, the word COLOURS still dominates the whole appearance of Applicant's mark notwithstanding the inserted word and device that Applicant's mark bore, thus, similarities in the dominant features of both marks are not lost. It is noteworthy to cite at this juncture the ruling of the Supreme Court in the cases of *Co Tiong Sa v. The Director of Patents* (95 Phil 1 (1954)); *Sapolin Corp. vs. Balmaceda* (67 Phil. 705); and *Forbes Nurma & Co. vs. Ang San To* (40 Phil 272) which applied the dominancy test in determining the existence of confusing similarity between trademarks, that "if there is similarity with the essential or dominant feature of the trademark, despite some differences or variations in detail, there is infringement."

The insertion and addition of another word ACTIVE including the adoption of a DOUBLE "A" WAVE DESIGN are insubstantial to claim distinctiveness for Respondent-Applicant's mark, ACTIVE/COLOURS AND DESIGN, under the Trademark law. It only convinced this Office that it is indeed the word COLOURS that Respondent-Applicant intended to put emphasis on as the first word ACTIVE is a mere adjective or the word COLOURS, the word COLOURS is prominent in the subject composite mark. The court observed in *Philippine Refining Co., Inc., vs. Dir. Of Patents and Sparklets Corp. vs. Walter Kidde Sales Co.*, 104 F. 2d 396, that "a trademark is designed to identify the user. But it should be so distinctive and sufficiently original as to enable

those who come into contact with it to recognize instantly the identity to the user. It must be affirmative and define, significant and distinctive, capable to indicate the origin.”

The word COLOURS remains the prominent and distinctive feature in the new mark, the first word ACTIVE including the DOUBLE “A” WAVE DESIGN are insignificant as to yield a distinct appearance because the word COLOURS standing alone continues to cause or create confusion between the competing trademarks. This Office quote with approval the pronouncement of the Court in the case of Emerald Garment Mfg. Corp. vs. Court of Appeals, 251 SCRA 600, which states:

“While it is true that there are other words such as “STYLISTIC”, printed in the appellant’s label, such word is printed in such small letters over the word “LE” that it is not conspicuous enough to draw the attention of ordinary buyers whereas the word “LEE” is printed across the label in big, bold letters and of the same color, style, type and size of lettering as that of the trademark of the appellee. The alleged difference is too unsubstantial to be noticeable.”

The right to register trademarks, trade names and service marks is based on ownership. Only the owner of the mark may apply for its registration (*Bert R. Bagano v. Director of Patents, et.al.*, G.R. No. L-20170, august 10, 1965). And where a trademark application is opposed, the Respondent-Applicant has the burden of proving ownership (*Marvex Commercial Co., Inc. v. Peter Hawpia and Co.*, 18 SCRA 1178). In the instant case, Opposer, Wilfro P. Luminlun, on 17 March 1987 (*Exhibit “A”, Opposer*) filed with the Bureau of Patents, Trademarks and Technology Transfer (BPTTT) an application for the registration of the MARK COLOURS for the following:

24	<i>Handkerchiefs</i>
18	<i>Belts</i>
25	<i>Shoes, sandals, slippers, boots, jeans, pants, t-shirts, shirts, briefs, shorts, socks, jogging pants, sweatshirts</i>

Five (5) years thereafter, Opposer conceptualized another COLOURS mark described as COLOURS AGAINST A RECTANGULAR BACKGROUND COLORED BLUE, RED, GREEN bearing Registration No. 62139 (*Exhibit “C”, Opposer*), to cover the following goods:

24	<i>Handkerchiefs</i>
18	<i>Travel Bags, School Bags</i>
25	<i>Shoes, sandals, slippers, boots, jeans, pants, t-shirts, shirts, briefs, shorts, socks, belts, jogging pants, sweatshirts, suits, coats, overcoats, topcoats, jackets, neckties</i>
16	<i>Stationeries, note books, note pads, pens, ballpens, pencils, picture frames, greeting cards</i>
21	<i>Combs & Hair Brusshes</i>
03	<i>Perfume</i>

Respondent-Applicant, on its part, filed their application for registration on the mark ACTIVE/ACTIVE COLOURS AND DESIGN on 14 April 2005 for goods under Class 03 specifically for *colored cosmetics namely: face powder, eyeshadow, blush on liquid foundation, concealer, lipstick, mascara, liquid and pencil eyeliner, lipstick, lip gloss; perfumes, colognes, lotions and body soap*, which is more than 15 years after Opposer filed his application for the mark COLOURS in 1987. As it now stands, we may safely deduce that it is Opposer, not Respondent-Applicant, who can claim priority of an earlier filing date or registration date pursuant to Section 123.1 (d) of R.A. 8293.

A cursory reading of paragraph (d) of R.A. 8293 with emphasis on prior registration and/or application of the same mark involving same or similar goods/services states that:

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

(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;”*

xxx

The preceding section provides that it is the owner of a registered mark or an owner of a mark with an earlier filing date or priority date that can oppose an application for registration of another mark involving the same or related goods or services. The purpose of the Trademark Law is to provide protection not only to the owner of the trademark or proprietor of a mark with an earlier filing or priority date in exact adherence to the First-to-File Rule as one important factor of registrability under R.A. 8293, likewise, and more importantly, to the unwary public that they may not be confused, mistaken or deceived by goods they buy or services they avail.

Having thoroughly discussed and resolved issues on confusion and priority in use and application, we shall now be delving on the goods involved.

The goods involved in both competing marks are the same, they pertain to perfumes and cosmetics under Class 03. Thus, applying these competing marks to the same goods belonging to Class 03 may lead to confusion in trade and would damage Opposer’s goodwill or reputation which it has painstakingly earned and established for a considerable period of time.

In like manner, the Supreme Court made the following pronouncements to the effect that:

“The tradename “LIONPAS” for medicated plaster cannot be registered because it is confusingly similar to “SALONPAS”, a registered trademark also for medicated plaster. xxx Although the two letters of “SALONPAS” are missing in “LIONPAS”, the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. “(Marvex Commercial Co vs Hawpia & Co., 18 SCRA 1178),

“The similarity between the two competing trademarks, DURAFLEX and DYNAFLEX is apparent. Not only are the initial letters and the last half of the appellations identical but the difference exists in only two out of the eight literal elements of the designations. Coupled with the fact that both marks cover insulated flexible wires under Class 20; x x x no difficulty is experienced in reaching the conclusion that there is a deceptive similarity that would lead the purchaser to confuse one product with the other.” (American Wire and Cable Co. vs Director of Patents, 31 SCRA 544),

Opposer is the registered owner, originator, prior applicant of the COLOURS mark or family of COLOURS trademarks used on different goods including those covered by Class 03. The use and adoption by Applicant of substantially the same mark as subsequent user can only mean that Applicant wishes to reap on the goodwill, benefit from the advertising value and reputation of Opposer’s family of COLOURS trademarks.

In the case of American Wire & Cable Co. vs. Director of Patents, 31 SCRA 544, it was observed that:

“Why of the million of terms and combination of letters and designs available the appellee had to choose a mark so closely similar to

another's trademark if there was no intent to take advantage of the goodwill generated by the other mark"

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby SUSTAINED. Consequently, application bearing Serial No. 4-2005-003370 filed by Cosmetics Revelation Mfg. Corp. on 14 April 2005 for registration of the mark "ACTIVE/COLOURS" for use on goods falling under Class 03 is, as it is hereby, REJECTED.

Let the filewrapper of ACTIVE/COLOURS AND DESIGN, subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Makati City, 22 April 2009.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office