

MAKE-UP ART COSMETICS, INC.,	}	IPC No. 14-2008-00181
Opposer,	}	Case Filed on: August 7, 2008
	}	
-versus-	}	Opposition to:
	}	Serial No. 4-2007-000149
SABINE WOJTASINSKI,	}	Date Filed: 04 January 2007
Respondent-Applicant.	}	TM: "MAX"
	}	
	}	DECISION NO. 2009-23

X-----X

DECISION

BEFORE us is a Verified Notice of Opposition filed against the application for registration of the mark "MAX" used for perfume, toilet water, perfume water covered by Class 03 of the international classification of goods bearing Application Serial No. 4-2007-000149 which was published in the Intellectual Property Office Electronic Gazette on 28 March 2008.

Opposer, MAKE-UP ART COSMETICS, INC. is a corporation organized and existing under the laws of Delaware, U.S.A. with office address at 756 Fifth Avenue, New York, NY 10153 U.S.A. Respondent-Applicant, SABINE WOJTASINSKI is a citizen of France with address at 31 Rue Marjolin 92300 Levallois, France with address at 31 Rue Marjolin 92300 Levallois, France.

Accordingly, the grounds for opposition are as follows:

1. The registration of Respondent-Applicant's mark MAX is contrary to Section 123.1 (d), (e) and (f) of the IP Code;
2. Respondent-Applicant's mark MAX nearly resembles Opposer's MAC marks which were registered and used in the Philippines by Opposer (and its predecessors) prior to the filing date accorded to Respondent-Applicant trademark application for the MAX mark. The striking resemblance between the Respondent-Applicant's mark MAX and Opposer's MAC mark is likely to deceive or cause confusion among the relevant sector of the consuming public. Consequently, Opposer is entitled to protection under section 123.1 (d) (i), (ii), and (iii) of the IP Code;
3. Opposer's MAC mark are well-known and world famous Respondent-Applicant's of the MAX mark on various goods in International Class 03, particularly "perfume, toilet water, perfume water"

Respondent-Applicant's use of the MAX mark on various goods in International Class 03, particularly "perfume, toilet water, perfume water" will undoubtedly indicate a connection between Respondent-Applicant's goods and Opposer thereby causing irreparable damage to the latter. Obviously, Respondent-Applicant adopted and used the mark MAX precisely to ride upon the popularity and goodwill of Opposer's MAC marks, thereby causing incalculable damage to both the Opposer and the consuming public. Accordingly, Respondent-Applicant's mark MAX cannot be allowed to proceed to registration as provided for under Section 123.1 (d), (e) of the IP Code."

Together with the Verified Notice of Opposition, Opposer submitted the following evidence:

Exhibit	Description
"A"	Printout of Respondent's trademark application for the mark MAX

"B"	Certified copy of the Philippine Certificate of Registration No. 4-1995-105574 of MAC for Class 03
"C"	Certified copy of the Philippine Certificate of Registration No. 4-1995-005140 of MAC for Classes 21, 35, 44
"D"	Legalized and authenticated Affidavit of Lesley Moradian with Annexes

On 02 September 2008, a Notice to Answer was issued by this Bureau and the same was served personally to Respondent-Applicant's Attorney-in-fact, Ortega Castillo Bacorro Odulio Calma Carbonell on September 17, 2008. Respondent-Applicant filed two Motions for Extension of time to file Answer on 16 October 2008 and 13 November 2008 respectively, which was both granted by this Bureau. However, despite the extension of time given to file the answer, Respondent-Applicant failed to file an Answer with the reglementary period. Consequently, on 19 February 2009, Order No. 2009- 349 was issued waiving Respondent-Applicant's right to file the verified answer and supporting documents and the case was submitted for decision. Hence, this case will be decided on the basis of the opposition and the documents presented by Opposer.

The sole issue to be resolved in this case is: WHETHER OR NOT RESPONDENT-APPLICANT'S MARK "MAX" IS CONFUSINGLY SIMILAR TO OPPOSER'S MARK "MAC".

Section 123.1 (d) of Republic Act No. 8293, as amended, provides:

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

x 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 determinative factor in a contest involving registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would likely cause confusion or mistake on the part of the buying public. The law does not require that the competing marks must be so identical as to produce actual error or mistake. It would be sufficient that the similarity between the two marks is such that there is possibility of the older brand mistaking the newer brand for it. Whether or not a trademark causes confusion and likely to deceive the public is a question of fact which is to be resolved by applying the "test of dominancy," meaning, if the competing trademark contains the main or essential or dominant features of another by reason of which confusion and deception are likely to result, then infringement takes place; and that duplication or imitation is not necessary of the dominant features of the trademark would be sufficient. The test of dominancy is now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code, which defines infringement as the "colorable imitation of a registered mark . . . or a dominant feature thereof."

Colorable imitation does not mean such similitude as amounts to identity. Nor does it require that all the details be literally copied. Colorable imitation refers to such similarity in form, content, words, sound, meaning, special arrangement, or general appearance of the trademark

or trade name with that of the mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely mislead or confuse persons in the ordinary course of purchasing the genuine article.

In the case of Societe Des Produits Nestle vs. Court of Appeals, the Supreme Court stated that:

“Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser giving such attention as a purchaser usually gives, and to cause him to purchase the one supposing it to be the other.”

Moreover, it has been consistently held that the question of infringement of a trademark is to be determined by the test of dominancy. Similarity in size, form, and color, while relevant, is not conclusive. If the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place. Duplication or imitation is not necessary, nor is it necessary that the infringing label should suggest an effort to imitate. The question at issue in cases of infringement of trademarks is whether the use of the marks involved would be likely to cause confusion or mistakes in the mind of the public or deceive purchasers. In fact, even their similarity in sound is taken into consideration, where the marks refer to merchandise of the same descriptive properties, for the reason that trade *idem sonans* constitutes a violation of trade mark patents.

To determine whether Respondent-Applicant’s mark is confusingly similar to Opposer’s mark, the parties’ marks are hereunder shown for purposes of comparison:

Opposer’s Mark	Respondent-Applicant’s Mark
	

As depicted above, it is apparent that the mark MAX so resembles the trademark MAC, that it will likely cause confusion, mistake or deception on the purchasing public. By comparing the above marks, the similarities between the contending marks are: (1) MAX is aurally the same as MAC and (2) Both are composed of three letters and they have the same first two (2) letters “MA”. Except for the font used and the last letter in Opposer’s MAC was replaced with the letter “X” to form the mark MAX, such difference, however, pales into insignificance because of their similarity in sound and their indistinguishable appearance.

In one American case, the rule applied was that, the conclusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term. Analogously, confusion cannot also be avoided by the merely changing the last letter of a registered mark, as in this case. Confusingly similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other. In addition, both marks are used on same goods belonging to Class 03 i.e., perfumes and perfumery products. As such, both products flow through the same channels of trade, therefore, confusion between the two trademarks would likely result to prospective buyers. Thus, considering that Respondent-Applicant’s mark is confusingly similar with that of Opposer’s mark MAC, the application for registration of the same cannot prosper.

Anent the claim of Opposer's that its MAC mark is well-known mark, we find the same to be not well founded. In claiming that its mark MAC is well-known, Opposer relied on Section 123.1 (e) of the IP Code which states:

"SEC 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 relation thereto, Rule 102 of the Rules and Regulation on Trademarks, Service Marks, Tradenames and Marked or Stamped Containers enumerates the criteria that should be taken into account 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 Continental Connector Corp. vs. Continental Specialties Corp. 207 USPQ 60. Continental Connector Corp. vs. Continental Specialties Corp. 207 USPQ 60. Societe Des Produits Nestle, Et. Al. vs. Court of Appeals. G.R. No. 112012. April 4, 2001 the goods and/or services to which the mark applies;
- (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 by 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 this mark is a well-known mark."

Opposer, in the case at bar, did not meet the enumerated criteria or any combination thereof to be declared as a well-known mark. Opposer failed to introduce evidence substantial enough for this Bureau to declare it a well-known mark. Except for the allegations made by Lesley Moradian in the Affidavit arrogating that MAC is well-known mark by virtue of its worldwide registration, advertising campaign and massive distribution and sale, no documentary evidence was presented to establish such claims. The samples of Certificates of Registration attached to the affidavit are not sufficient to declare Opposer's MAC mark as well-known.

Nevertheless, while Opposer's mark MAC is not a well-known, the application for registration of the herein subject mark still cannot be allowed as the MAX mark of Respondent-Applicant is confusingly similar to Opposer's MAC, which has been used and registered in favor of Opposer prior to the filing date of Respondent's MAX used also in Class 03 goods.

WHEREFORE, premises considered, the Notice of Verified Opposition filed by Opposer, MAKE-UP ART COSMETICS, INC. against Respondent-applicant SABINE WOJTASINSKI is, as it is hereby SUSTAINED. Consequently, the trademark application for the registration of the mark "MAX" bearing Serial No. 4-2007-000149 filed on 20 January 2007 by Respondent-Applicant for "perfume, toilet water, perfume water" under Class 03 of the international classification of goods is, as it is hereby, REJECTED.

Let the filewrapper of "MAX" subject matter of this case together with copy of this decision be forwarded to the Bureau of Trademarks (BTO) for appropriate action.

SO ORDERED.

Makati City, 20 February 2009.

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