

NGO YET TE  
Opposer,

IPC No. 14-2008-00331  
Case Filed: 08 December 2008

- versus -

Opposition to:

Appl'n Serial No. 4-2007-013636  
Date Filed: 11 December 2007  
TM: "SPEED-ABSORB"

JOHNSON & JOHNSON  
Respondent-Applicant  
x-----x

Decision No. 2009-101

### DECISION

This is a VERIFIED OPPOSITION filed by opposer Ngo Yet Te to the application for registration of the mark "SPEED-ABSORB" bearing Application Serial No. 4-2007-013636 filed on 11 December 2007 by respondent-applicant Johnson & Johnson for goods under Class 03: "FEMININE HYGIENE PRODUCTS NAMELY SANITARY NAPKINS" which application was published for opposition in the Intellectual Property Philippines (IP Philippines) E-Gazette.

Opposer is chairman and president of Well made Manufacturing, Inc. ("WELLMADE") a corporation organized and existing under the laws of the Philippines with principal address at 32 Engacio Street, Marulas, Valenzuela City, Metro Manila. Respondent-applicant is a corporation organized under the laws of the United States with business address at One Johnson & Johnson Plaza, New Brunswick, New Jersey 08933 U. S. A.

Opposer alleges the following factual background:

1. Opposer is the chairman and President of Wellmade Manufacturing, Inc. ("WELLMADE") a corporation organized and existing under the laws of the Philippines with principal address at 32 Engacio Street, Marulas, Valenzuela City, Metro Manila.
2. The Opposer, since the year 1981, has been engaged in the business of manufacturing and selling laundry detergent bars, cleansing and washing detergent bar and powder, detergent powder, laundry soap, bleaching preparations, cleaning preparations, laundry preparations, laundry bleach and washing preparations, fabric conditioner, and other laundry products.
3. As early as April 05, 2005, the Opposer filed an application for registration of the word "SPEED" as a trademark for Class 03 and was subsequently granted registration on March 05, 2007.
4. A early as January 25, 1989, the Opposer filed an application for registration of "SPEED & DESIGN LABEL" as a trademark for Class 03 and was subsequently granted registration on December 18, 1989.
5. In addition to the said trademark registrations, the Opposer has the following trademark registrations and application for the "SPEED" marks:
  - a. Trademark Certificate of Registration No. 4-2003-004820 for SPEED MACHO "KALAMANSI" and DESIGN CONSISTS OF THE WORDS "SPEED MACHO KALAMANSI" and DE SIGN OF BOOMERANG and REPRESENTATION OF KALAMANSI FRUITS;

- b. Trademark Certificate of Registration No. 4-1999-005951 for SPEED POWDER ALL PURPOSE WASH AND DEVICE;
- c. Trademark Certificate of Registration No. 4-2005-006288 for SPEED DETERGENT BAR WITH "POWER WHITHENER;"
- d. Trademark Certificate of Registration No. 4-2005-006287 for SPEED POWDER WITH "POWER WHITHENER;"
- e. Trademark Certificate of Registration No. 4-2003-005311 for SPEED MACHO SPECKELD BLUE LABEL MARK;
- f. Trademark Certificate of Registration No. 4-2004-008497 for SPEED POWDER KALAMANSI LABEL MARK;
- g. Trademark Certificate of Registration No. 4-2004-008499 for SPEED MACHO LABEL MARK;
- h. Trademark Certificate of Registration No. 4-2002-0049061 for "SPEED" TIGASIN SA PAGPAPAPUTI "BLUE" & DEVICE;
- i. Trademark Certificate of Registration No. 4-2002-004907 for "SPEED" TIGASIN SA PAGPAPAPUTI "KALAMANSI ;"
- j. Trademark Certificate of Registration No. 4-2002-004909 for "SPEED" TIGASIN SA PAGPAPAPUTI "SPECKLED BLUE;"
- k. Trademark Certificate of Registration No. 4-2002-004910 for "SPEED" TIGASIN SA PAGPAPAPUTI "SPECKLED GREEN;"
- l. Trademark Certificate of Registration No. 4-2002-004908 for "SPEED" TIGASIN SA PAGPAPAPUTI "TAWAS;"
- m. Trademark Certificate of Registration No. 4-2004-008501 for "SPEED" POWDER SPECKLED BLUE ALL PURPOSE WASH;
- n. Trademark Certificate of Registration No. 4-2004-008500 for "SPEED" POWDER KALAMANSI ALL PURPOSE WASH;
- o. Trademark Certificate of Registration No. 4-2002-004911 for NEW "SPEED" POWDER ALL PURPOSE WASH "KALAMANSI;"
- p. Trademark Certificate of Registration No. 4-20C2-004912 for NEW "SPEED" POWDER ALL PURPOSE WASH "SOLAR PLUS;"
- q. Trademark Certificate of Registration No. 4-2002-004913 for NEW "SPEED" POWDER ALL PURPOSE WASH "TAWAS CRYSTAL;"
- r. Trademark Certificate of Registration No. 4-2002-005278 for NEW "SPEED" POWDER ALL PURPOSE WASH WITH BLEACH;
- s. Trademark Certificate of Registration No. 4-2002-005277 for NEW "SPEED" FABRIC CONDITIONER AND DEVICE;
- t. Trademark Certificate of Registration No. 4-2004-008498 for NEW SPEED TIGASIN SA KAPUTIAN BLEACH WITH KALAMANSI ANG PINAKAMATAGAL MATUNAW;

- u. Trademark Certificate of Registration No. 4-2003-007750 for NEW "SPEED" LABEL MARK;
- v. Trademark Certificate of Registration No. 4-2003-010748 for NEW "SPEED" MACHO WITH FABRIC CONDITIONER AND DESIGN.

ALL THESE TRADEMARK REGISTRATIONS HAVE "SPEED" AS ITS DOMINANT WORD AND FEATURE.

- 6. Since its adoption in the year 1981 and its continued used in commerce up to the present day, the "SPEED" trademarks have been developed and extensively advertised by the Opposer in the Philippines.
- 7. The Opposer is filing this Opposition against the registration of the subject mark on the ground that it creates confusion of origin, source, and business - causing injury and damage on the original "SPEED" trademarks. The Opposer is entitled to the preservation of the valuable link between it and the public that has been created by its adoption and use of the "SPEED" trademarks on its business and products by restraining the use by the Opposer of the subject mark.

The grounds for opposition are as follows:

"The Opposer is a Senior Registrant of the mark "SPEED" in Class 03, the same class where the subject mark "SPEEDABSORB" is being applied for. If the subject mark is allowed for registration, this will lead to a confusion of source, as prospective purchasers would be misled into thinking that the Opposer has extended its business into the field. Thus, the subject application should be rejected."

Opposer relies on the following discussion to support its opposition:  
The Opposer is the senior registrant in Class 3 for "SPEED."

- 1. The Opposer has priority over the Respondent because the latter's use and dates of registration of the "SPEED" family of marks precedes the dates of filing of the Respondent's subject trademark application, which was filed only on December 11, 2007. As early as January 25, 1989, the Opposer filed an application for registration of "SPEED & DESIGN LABEL" as a trademark for Class 03 and was subsequently granted registration on December 18, 1989. And as early as April 05, 2005, the Opposer filed an application for registration of the word "SPEED" as a trademark for Class 03 and was subsequently granted registration on March 05, 2007.
- 2. The Opposer has 22 other trademark registrations under Class 03 featuring the mark "SPEED," all of which as to the dates of filing and dates of registration precede the Respondent's trademark application. Furthermore, the Opposer's numerous registrations of the mark "SPEED" is not limited to Class 03 only but extends also to other classes.

The subject mark is merely descriptive of the goods identified.

- 3. The mark "SPEED-ABSORB" merely designated the kind, quality, and intended purpose of the goods it identifies i.e., sanitary napkins.
- 4. The word "SPEED" as defined in [www.dictionary.com](http://www.dictionary.com) means: rapidity in moving, going, traveling, proceeding, or performing; swiftness; celerity: the speed of light; the speed of sound. As a verb it means: to move, go, pass, or proceed with speed or rapidity. In other words, the word "SPEED" connotes fast action and quickness.

5. A feminine hygiene product such as a sanitary napkin is made of absorbent materials. Its purpose is to absorb menstrual waste.
6. Together, the words "SPEED" and "ABSORB" forming the mark "SPEED-ABSORB" merely indicate and designate the kind, quality, and intended purpose of the product that it identifies: sanitary napkins. The word "ABSORB" designates the kind and intended purpose of a sanitary napkin, and the word "SPEED" indicated the kind and quality of the sanitary napkin - how fast and how quick a sanitary napkin can absorb menstrual waste.
7. Women do not have to analyze the subject mark. The subject mark will instantly tell them that it is the kind of sanitary napkin they look for: a fast-absorbing sanitary napkin that can make them feel dry quickly.
8. Section 123.1 (j) of R.A. 8293 provides:

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

*(j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services... ;"*

The subject mark dilutes the Opposer's "SPEED" marks.

9. The subject mark is confusingly similar with the Opposer's mark since the dominant feature of the subject mark is the word "SPEED" such that an ordinary purchaser can conclude an association or relation between the marks.
10. In the case of McDonalds Corporation, et al., v. L.C. Big Mak Burger, Inc., et al., G.R. No. 143993, August 18,2004, it was held:

... Thus, the Court has declared:

*Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trademark or trade name is likely to lead to a confusion of source, as where prospective purchasers would be misled into thinking that the complaining party has extended his business into the field (see 148ALR 56 ets seq; 53 Am Jur. 576) or is in any way connected with the activities of the infringer; or when it forestalls the normal potential expansion of his business (v. 148 ALR, 77, 84; 52 Am. Jur. 576, 577). (Emphasis supplied)*

11. The products of the Opposer are sold in supermarkets and groceries. The Respondent's goods will also be sold in the same distribution channels. Ergo, confusion is really likely. Indubitably, if the subject mark is allowed registration, this will forestall the normal potential expansion of the Opposer's business and will likely to lead a confusion of source, as prospective purchasers would be misled into thinking that the Opposer has extended its business into the field.

Opposer prays, thus, that the subject application for registration be denied.

Opposer submitted the following evidences to support its opposition:

Exhibit A		Copy of Trademark Certification of Registration No. 4-2005-003014
Exhibit B		Copy of Trademark Certification of Registration No. 8273S
Exhibit C		Trademark Certificate of Registration No. 4-2003-004820
Exhibit D		Trademark Certificate of Registration No. 4-1999-005951

Exhibit E		Trademark Certificate of Registration No. 4-2005-006288
Exhibit F		Trademark Certificate of Registration No. 4-2005-006287
Exhibit G		Trademark Certificate of Registration No. 4-2003-005311
Exhibit H		Trademark Certificate of Registration No. 4-2004-008497
Exhibit I		Trademark Certificate of Registration No. 4-2004-008499
Exhibit J		Trademark Certificate of Registration No. 4-2002-004906
Exhibit K		Trademark Certificate of Registration No. 4-2002-004907
Exhibit L		Trademark Certificate of Registration No. 4-2002-004909
Exhibit M		Trademark Certificate of Registration No. 4-2002-004910
Exhibit N		Trademark Certificate of Registration No. 4-2002-004908
Exhibit O		Trademark Certificate of Registration No. 4-2004-008501
Exhibit P		Trademark Certificate of Registration No. 4-2004-008500
Exhibit Q		Trademark Certificate of Registration No. 4-2002-004911
Exhibit R		Trademark Certificate of Registration No. 4-2002-004912
Exhibit S		Trademark Certificate of Registration No. 4-2002-004913
Exhibit T		Trademark Certificate of Registration No. 4-2002-005278
Exhibit U		Trademark Certificate of Registration No. 4-2002-005277
Exhibit V		Trademark Certificate of Registration No. 4-2004-008498
Exhibit W		Trademark Certificate of Registration No. 4-2003-007750
Exhibit X		Trademark Certificate of Registration No. 4-2003-010748
Exhibit Y to Y-10		Advertising materials of the Opposer

A Notice to Answer was issued to and received by respondent-applicant on 11 February 2009. However, despite having received said notice, respondent-applicant failed to file its answer for which reason, thus, it is deemed to have waived its right to file the same. Per Section 11 of Office Order No. 79 Series of 2005, the instant case shall be decided on the basis of the opposition, the affidavit/s of witness/es and the documentary evidences submitted by opposer.

The issues to be resolved are as follows:

1. Whether the subject mark, "SPEED," is confusingly similar to opposer's mark "SPEED-ABSORB;" and
2. Whether respondent-applicant is entitled to the registration of the mark "SPEED-ABSORB."

The contending marks of the parties are reproduced below for comparison and scrutiny.



“SPEED” for Class 03 under Registration No. 4-2005-003014



under Registration No. 4-2003-004820



“SPEED POWDER ALL PURPOSE WASH & DEVICE” for Class 03 under  
Registration No. 4-1999-005951

SPEED Detergent Bar  
With “Power Whitener”

Registration No. 4-2005-006288 "SPEED DETERGENT BAR WITH 'POWER WHITENER,'" for Class o3 under Registration No. 4-2005-006266



"SPEED MACHO SPECKLED BLUE LABEL MARK" for Class 03 under Registration No. 4-2003-005311



"SPEED POWDER KALAMANSI LABEL MARK" FOR Class 03 under Registration No. 4-2004-008497



“SPEED MACHO LABEL MARK” for Class 03 under  
Registration No. 4-2004-008499



“SPEED” TIGASIN SA PAGPAPAPUTI “BLUE” & DEVICE for Class 03  
Under Registration No. 4-2002-004906



“SPEED TIGASIN SA PAGPAPAPUTI “KALAMANSI” for Class 03 under



“SPEED” TIGASIN SA PAGPAPAPUTI “SPECKLED BLUE for Class 03  
Under Registration No. 4-2002-004909





“SPEED” TIGASIN SA PAGPAPAPUTI “SPECKLED GREEN for Class 03  
Under Registration No. 4-2002-004910



“SPEED POWDER SPECKLED BLUE ALL PURPOSE WASH” for Class  
03 under Registration No. 4-2004-008501



“SPEED POWDER KALAMANSI ALL PURPOSE WASH” for Class 03  
under Registration No. 4-2004-008500



NEW “SPEED” POWDER ALL PURPOSE WASH “SOLAR PLUS” for  
Class 03 under Registration No. 4-2002-004912



NEW “SPEED” POWDER ALL PURPOSE WASH “TAWAS CRYSTAL” for  
Class 03 under Registration No. 4-2002-004913



NEW "SPEED" POWDER ALL PURPOSE WASH WITH BLEACH for  
Class 03 under Registration No. 4-2002-005278



NEW "SPEED" FABRIC CONDITIONER AND DEVICE for Class 03 under  
Registration No. 4-2002-005277



NEW "SPEED" TIGASIN SA KAPUTIAN BLEACH WITH KALAMANSI ANG PINAKAMATAGAL  
MATUNAW for Class 03 under Registration No. 4-2004-008498



Registration No. 4-2003-007750 NEW "SPEED" LABEL MARK for Class 03 under  
Registration No. Registration No. 4-2003-007750



NEW "SPEED" MACHO WITH FABRIC CONDITIONER ANC DESIGN for Class  
03 under Registration No. 4-2003-010748

MARK FOR RESPONDENT-APPLICANT



A careful perusal of opposer's "SPEED" marks on the one hand and respondent-applicant's mark "SPEED-ABSORB" shows that they are confusingly similar: Obviously, the word "SPEED" is the dominant feature of the competing marks. Said word is pronounced and spelled alike in the competing marks. Further, both marks are written in black, uppercase and Times Roman font. Visually and aurally, thus, the competing marks are confusingly similar.

Per the Dominancy Test, greater weight in determining confusing similarity is attributed to the dominant features of the competing marks, or to the similarity of the appearance of a product arising from the dominant features of the mark attached to said product in determining whether such mark is confusingly similar with another mark (McDonald's Corporation v. MacJoy Fast food Corporation, G. R. No. G.R. No. 166115. February 2,2007; McDonalds Corporation v. L. C. Big Mak, Inc., G. R. No. 143993, August 18, 2004).

The confusing similarity of both marks is heightened by the fact that the respective goods of the parties fall under Class 03 and are related: Opposer's goods are essentially laundry soap and/or preparations while respondent-applicant's goods are sanitary napkins. Both evoke the same visual and aural impressions in the sense that when the dominant device which is the word "SPEED" is either read or pronounced, what comes to mind is the idea of personal hygiene or cleanliness whether it is on one's own body or one's personal effects like clothing apparel.

As the competing marks are confusingly similar, and as both are applied to related goods under the same Class 03, there is likelihood of confusing opposer's with respondent-applicant's marks as marks that are applied interchangeably to the goods of either party, and of believing

that there is a connection between the two marks in the sense that the purchasing public may think there is a connection between the two parties when in fact there is none (McDonald's Corporation et. al. v. L.C. Big Mak Burger, Inc., et al., supra; Converse Rubber Corporation v. Universal Rubber Products, inc. et. al., G.R. No. L-27906, January 8, 1987; Sterling Products International, Inc. v. Farbenfabriken Bayer Aktiengesellschaft, G.R. No. L-19906, April 30, 1969). Similarity in size, form and color, while relevant, is not conclusive. Neither duplication/imitation, or the fact that the infringing label suggests an effort to emulate, is necessary. The competing marks need only contain the main, essential or dominant features of another; and that confusion and deception are likely (Sterling Products International, Inc. v. Farbenfabriken Bayer Aktiengesellschaft, supra; Lim Hoa v. Director of Patents, G. R. No. L-8072, October 31, 1956; Co Tiong Sa v. Director of Patents, et. al., G. R. No. L-5378, May 24, 1954).

As to the first issue, thus, this Bureau rules in the affirmative.

Records show that opposer's mark "SPEED" was applied for registration on April 05, 2005 and registered on March 05, 2007 per Certificate of Registration No. 4-2005-003014. Moreover, opposer has other "SPEED" marks for goods under Class 03 which were registered prior to December 17, 2007, the date of respondent-applicant's application for registration of the subject mark "SPEED-ABSORB". As already discussed, respondent-applicant's mark "SPEED-ABSORD" is confusingly similar with opposer's "SPFED" marks.

Section 123.1 (d) of the IP Code provides:

"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
- (ii) Closely related goods ... or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion"  
(Underscoring supplied.)

Moreover, Section 138 of the IP Code provides:

"A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate."

Considering, then, that opposer has certificates of registration for its "SPEED" marks for goods that are related to respondent-applicant's goods, and further considering that, respondent-applicant's mark "SPEED-ABSORB" is confusingly similar to opposer's "SPEED" marks, the Bureau likewise rules in the negative as to the second issue.

WHEREFORE, the VERIFIED OPPOSITION is, as it is, hereby SUSTAINED. Consequently, Application Serial No. 4-2007-013636 filed on December 11, 2007 by respondent-applicant Johnson & Johnson for goods under Class 03, namely, "FEMININE HYGIENE PRODUCTS NAMELY SANITARY NAPKINS" is, as it is hereby, REJECTED.

Let the filewrapper of SPEED-ABSORB subject matter of this case be forwarded to the Bureau of Trademarks (BOT) for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, August 25, 2009.

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