PHILUSA CORPORATION, Opposer	}	Inter Partes Case No. 4007 Opposition to:
-versus-	}	Appln.Serial No. : 77333 Date Filed : 16 August 1991 Trademark : "BABY JOY"
CYMAR INTERNATIONAL, INC., Respondent-Applicant,	}	Decision No. 2006-29

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DECISION

This is an opposition to the application for registration of the mark "BABY JOY" bearing Serial No. 77333 filed on August 16, 1991 for feeding bottles, feeding nipples, feeding trainers, training bottles, training cups, feeding disk set, food preparation/keeper, milk powder container, funnel land strainer set, baby food marker/grinder set, bottle warmer and other goods falling under classes 20, 21, 24, 25 and 28 of the international classification of goods, which application was published in Volume VI, No. 6 of the Intellectual Property Philippines (IPP) Official Gazette and released for circulation *January 27, 1994.*

The Respondent-Applicant in the above-entitled case is CYMAR INTERNATIONAL, INCORPORATED, a corporation organized under the laws of the Philippines, with address at Sunville Condominium, Ground O, 2135 corner Luna & Villaruel Streets, Pasay City.

On the other hand, the herein Opposer is PHILUSA CORPORATION, of Pasig, Metro Manila.

The grounds for the opposition are as follows:

"1. The Opposer is the owner of the trademark "BABYFLO", registration No. 49255, issued on October 1, 1990, filed January 6, 1989, for feeding bottles by the Bureau of Patents, Trademarks and Technology Transfer hereinafter called BPTTT;

"2. On August 16, 1991, Respondent-Applicant filed with Bureau of Patents, Trademarks, and Technology Transfer (BPTTT) an application for registration of the trademark "BABYJOY" for feeding bottles, feeding nipples, feeding trainers, training bottles (with spout or spoon), food preparation/keeper, milk powder container, funnel land strainer set, baby food market/grinder set, bottle warmer, sterilizers/accessories, sterilization set, forceps, bottle brush, nipple brush, oral development, pacifiers, teethers/gum soothers, grooming/toiletries, powder case (with or without puff), comb and brush, safety scissors, cotton buds/swabs, toothbrush, safety pins, diapers clips, bed/bath, baby sheet, blankets, towel, safety pins, garments, clotheswear (shirt, panties, tie-sides, short pants), bib, mittens, sticable pants/vinyl pants, cloth diaper under Application No. 77333. The application was duly published in the Official Gazette.

"3. The registration of the trademark "BABYJOY" in the name of Respondent-Applicant is in violation of and runs counter to Section 4(d) of Republic Act No. 166, as amended because it is confusingly similar, if not identical to the above trademark of Opposer, PHILUSA Corporation 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, o cause confusion or mistake or deception to the purchasing public.

"4. Opposer believes and therefore alleges that the registration of the mark "BABYJOY" in the name of Respondent-Applicant will cause irreparable injury and damage to Opposer, as provided under Section 8 of Republic Act No. 166, as amended.

"5. Registration of the mark "BABYJOY" of Respondent-Applicant 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:

"a) Opposer's mark "BABYFLO" has been used in trade and commerce in the Philippines since before the filing of its application for registration and the issuance of the certificate of registration abovementioned, and all prior date of filing of the application for registration on August 16, 1991 of the mark "BABYJOY" by Respondent-Applicant;

"b) The mark "BABYJOY" appearing on the drawings and facsimiles submitted by v in its application for registration are confusingly similar, if not identical to Opposer's aforementioned registered mark as used on the goods of the Opposer;

"c) Opposer has been manufacturing and selling in the Philippines goods bearing the mark "BABYFLO" which is similar if not identical to the alleged products of Respondent-Applicant, bearing the mark "BABYJOY", under Application No. 77333;

"d) The long use of and the large amounts spent by Opposer for popularizing its trademark "BABYFLO" have generated an immense goodwill for said trademark in the Philippines and elsewhere and Opposer's goods have acquired the reputation of high quality products by the purchasing public;

"e) The use and adoption by Respondent-Applicant of the mark "BABYJOY" which is confusingly similar if not identical to Opposer's mark 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 "BABYJOY" subject of Application No. 77333 to the trademark of Opposer betrays Respondent-Applicant's intention to ride on the goodwill and popularity of Opposer's trademark "BABYFLO".

On June 24, 1994, Respondent-Applicant filed its answer denying all the material allegations in the Notice of Opposition and further alleged the following as its special and affirmative defenses:

"1. That the marks "BABYFLO" and "BABYJOY" are quite different and distinct from each other both in sound, in appearance in spelling and in meaning that Opposer's products which are solely for feeding bottles cannot be mistaken for Respondent-Applicant's baby products;

"2. That the word "baby" is a word which Opposer cannot claim exclusively and therefore, as stated above, it is in the nature of an ordinary word

found in the dictionary and would constitute a sort of generic word and therefore cannot be claimed by the Opposer to the exclusion of all others.

"3. That the word "flo" as used by the Opposer in its trademark is a word which is presumably an abbreviated version of the word "flow" since Opposer' products when approved by the Director of Patents solely for :feeding bottles". On the other hand, the word "JOY" as appearing after the word BABY as used by the Respondent-Applicant connotes an entirely different meaning since babies are indeed considered "bundles of joy" and the use of this second word was precisely taken from said phrase, especially since Respondent-Applicant's application is not only limited to feeding bottles but to practically different products used by babies in their infancy.

During the pre-trial conference, the parties failed to reach an amicable settlement, thereby a full blown was conducted of which both parties submitted their respective evidences.

Opposer submitted its evidence consisting of Exhibits "A" to "C-3" inclusive of sub-markings. (Order No. 2001-71 dated 31 January 2001).

On the other hand, Respondent-Applicant submitted its evidence consisting of Exhibits "1" to "59-a", inclusive of sub-markings on *September 20, 2005.*

The issue to be resolved in the case at bar is:

WHETHER OR NOT TEHRE IS CONFUSING SIMILARITY BETWEEN THE OPPOSER'S MARK "BABYFLO" AND THAT OF THE RESPONDENT-APPLICANT'S MARK "BABY JOY".

To be noted is the fact that the trademark "BABY JOY" bearing Serial No. 77333, subject of the instant opposition was filed on August 16, 1991 and the law on trademarks in full force at that time is Republic Act No. 166, as amended, hence this case shall be decided on the provisions thereof so as not to prejudice vested rights of the parties.

Section 4(d) of Republic Act No. 166, as amended provides:

> "Sec. 4. *Registration of trademarks, trade names and service marks in the principal register.* – There is hereby established a register of trademarks, trade names and service marks which shall be known as the Principal Register.
>
> The owner of the trademark, trade name or service mark use to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register, unless it:
>
> (d) Consist of or comprises a mark or trade name registered in eth 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 services of the applicant to cause confusion or mistake or to deceive purchasers". (Emphasis supplied)

In *Emerald Garment Manufacturing Corporation vs. Court of Appeal, 251 SCRA 600,* the Supreme Court states that "the practical application, however, of the aforesaid provision is easier that done. *In the history of trademark cases in the Philippines, particularly in ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, no set of rules can be deduced. Each case must be decided on its own merits."*

In ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, two kinds of test have been developed, the Dominancy test applied in *Asia Brewery, Inc., vs. Court of Appeals, 224 SCRA 437; Co Tiong Co vs. Director of Patents, 100 Phil. 214; American Wire & Cable Co., vs. Director of Patents, 31 SCRA 544; Philippine Nut Industry, Inc. vs. Standards Brands, Inc., 65 SCRA 575; Converse Rubber Corp., vs. Universal Rubber Products, Inc., 147 SCRA 154;* and the Holistic test, developed in *Del Monte Corp., vs. Court of Appeals, 181 SCRA 410; MEAD Johnson & Co., vs. N.V.J. Van Dorp, Ltd., vs. Director of Patents, 17 SCRA 128; Fruit of the Loom, In., vs. Court of Appeals, 133 SCRA 405.* As its title implies, the test of dominancy focuses on the similarity of the prevalent, essential or dominant features of the competing trademark which might cause confusion or deception. On the other side of the spectrum, the holistic test mandates that the entirety of the marks in question must be considered in determining confusing similarity.

Likewise, in the case of *Societe Des Produits Nestle, S.A. et. al. vs. Court of Appeals, et. al., 356 SCRA 207,* the Supreme Court reiterated that:

> "The likelihood of confusion is a relative concept, to be determined only according to the particular and sometimes peculiar circumstances of each case. In trademark cases, even more than in any other litigation, precedent must be studied in the light of the facts of the particular case. The wisdom of the likelihood of confusion test lies in its recognition that each trademark infringement case presents its own unique set of facts. Indeed, the complexities attendant to an accurate assessment of the likelihood of confusion require that the entire panoply of elements constituting the relevant factual landscape be comprehensively examined.

In *Fruit of the Loom, Inc. vs. Court of Appeals, 133 SCRA 405,* the Supreme Court reiterated the ruling in *Bristol Myers Co., vs. Director of Patents, 17 SCRA 131* by stating:

> "In determining whether the trademarks are confusingly similar, a comparison of the words is not the only determinant factor. The trademarks in their entirety as they appear in their respective labels of hang tags must also be considered in relation to the goods to which they are attached. The discerning eye of the observer must focus not only on the predominant words but also on the other features appearing in both labels in order that he may draw his conclusion whether one is confusingly similar to the other."

Applying the foregoing tenets to the present controversy and taking into account the factual circumstances of this case, the whole of the trademarks pictured in the manner of display must be considered we find that the Respondent-Applicant's trademark *"BABY JOY"* is not confusingly similar to Opposer's trademark *"BABYFLO".*

The two competing trademarks are composite one. Although both marks contain the word *"BABY"*, an examination of the conflicting marks will readily show that both are accompanied by two distinct and different words wherein their *pronunciation, spelling* and *meaning* are entirely different. The Opposer's mark is accompanied by the word "FLO" while the Respondent-Applicant's mark is accompanied by the word "JOY".

The records of the Intellectual Property Office (IPO) disclose that the trademark of the Respondent-Applicant "BABY JOY" has been registered and applied for registration with the Intellectual Property Office (IPO) as shown and indicated below:

No.	Application Number	Registration Number	Trademark	Applicant/Registrant	NICE Class	Vienna Class
1.	SR-8432	SR-8432	BABY JOY	CYMAR Int'l., Inc.	25	
2.	41989068599		BABY JOY	CYMAR Int'l., Inc.	25	
3.	41991077333		BABY JOY	CYMAR Int'l., Inc.	20, 21, 24, 25, 18	
4.	SR-9044	SR-9044	BABY JOY	CYMAR Int'l., Inc.	10	
5.	SR-9176	SR-9176	BABY JOY	CYMAR Int'l., Inc.	28	
6.	008432	008432	BABY JOY LABEL	CYMAR Int'l., Inc.	25	
7.	41991078069	41991078069	BABY JOY WITH INFANT DEVICE LABEL	CYMAR Int'l., Inc.	10, 20, 21, 24, 25, 28	2.5.6
8.	41991079658	41991079658	BABY JOY WITH INFANT DEVICE LABEL	CYMAR Int'l., Inc.	20, 21, 24, 25, 28	
9.	SR-9054	SR-9154	BABY JOY / NASAL ASPIRATOR WITH INFANT DEVICE LABEL	CYMAR Int'l., Inc.	10	

On the other hand, the Opposer's trademark "BABYFLO" is likewise registered and applied for registration with the Intellectual Property Office (IPO) as shown and indicated below:

No.	Application Number	Registration Number	Trademark	Applicant/Registrant	NICE Class	Vienna Class
1.	049196	049196	BABY FLO	PHILUSA CORP.	10	
2.	049255	049255	BABY FLO	PHILUSA CORP.	10	
3.	41997124738	41997124738	BABY FLO & DEVICE	PHILUSA CORP.	03	1.15.15 5.5.20
4.	41997124739	41997124739	BABY FLO & DEVICE	PHILUSA CORP.	10	
5.	41997124740	41997124740	BABY FLO & DEVICE	PHILUSA CORP.	25	
6.	41990070845		BABY FLO EASY-GRIPNURSER	PHILUSA CORP.	10	

As illustrated above, the competing trademarks are *registered* and applied for registration with the Intellectual Property Office (IPO) independently of each other, which will show that they are not confusingly similar to each other, otherwise, either of them would be outrightly rejected pursuant to the decision of the Supreme Court in the case of *Chuanchow Soy & Canning Co., vs. The Director of Patents and Rosario Villapania [G.R. No. I-13947, June 30, 1960]* wherein the Supreme Court said:

> "When one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without opposition on he part of the owner and user of previously registered label or trademark, this is not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and in established goodwill."

With all the foregoing, this Bureau holds that no confusing similarity exists between the two contending trademarks.

WHEREFORE, this Opposition case is DISMISSED. Consequently, application bearing Serial No. 77333 for the mark “BABY JOY” filed on August 16, 1991 by CYMAR INTERNATIONAL, INCORPORATED, is hereby GIVEN DUECOURSE.

Let the filewrapper of “BABY JOY” subject matter 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 furnished the Bureau of Trademarks for information and to update of its record.

SO ORDERED.

Makati City, 26 April 2006.

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