REVLON CONSUMER PRODUCTS CORPORATION, *Petitioner*,	}	INTER PARTES CASE NO. 4274 Petition for Cancellation of:
-versus-	}	Regn. No. : 61900 Date Issued : 10 November 1995 Trademark : "BOBBIE DIAMOND FLEX" Goods : Nail Creme
CFC CORPORATION *Respondent-Registrant*.	}	
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DECISION

On November 8, 1996, a Petition for Cancellation of the registration of the trademark "BOBBIE DIAMOND FLEX" under Certificate of Registration No. 61900 issued on 10 November 1995 covering the goods nail crème, issued in the name of herein Respondent-Registrant, CFC CORPORATION, a corporation duly organized and existing under the laws of the Philippines, with office address at CFC Building, E. Rodriguez Avenue, Pasig, Metro Manila, was filed by Revlon Consumer Products Corporation, a corporation duly organized and existing under the laws of the States of Delaware, United States of America with principal office at 625 Madison Avenue, New York, New York, United States of America.

The grounds for the cancellation of said registration are as follows:

"1. Petitioner is the first user and owner of the trademark FLEX of which bobbie DIAMOND FLEX is a derivative, for goods in Class 3 including use of its FLEX trademarks in the United States dates back to October 1958 and in the Philippines to 1972;

"2. Respondent-Registrant's use and registration of the trademark FLEX, as to be likely, when applied to or used in connection with the goods of Respondent-Registrant, to cause confusion, mistake or deception on the part of the purchasing public by misleading them into thinking that Respondent-Registrant's goods either come from Petitioner or are sponsored or licensed by it;

"3. The registration and use by Respondent-Registrant of the trademark bobbie DIAMOND FLEX will diminish the distinctiveness and dilute the goodwill of Petitioner's trademark FLEX which is an arbitrary mark when applied on the above-mentioned goods;

"4. Respondent-Registrant adopted the trademark bobbie DIAMOND FLEX on its own goods with obvious intention of misleading the public into believing that its goods bearing the trademark originated from, or are licensed or sponsored by Petitioner which has been identical in the trade and by consumers as the source of goods bearing the trademark FLEX.

"5. The approval. Of Respondent-Registrant's trademark bobbie DIAMOND FLEX is based on the representation that it is the originator, true owner and first user of the trademark, which was merely derived from Petitioner's FLEX trademarks;

"6. Respondent-Registrant's appropriation and use of the trademark bobbie DIAMOND FLEX infringe upon Petitioner's exclusive right to use the

trademark FLEX, which is a well-known trademark protected under Article 6 bis of the Paris Convention to which the United States of the Philippines adhere;

"7. The registration of the trademark bobbie DIAMOND FLEX in the name of the Respondent-Registrant is contrary to other provisions of the Trademark Law."

Petitioner relied on the following facts to support its petition for cancellation:

"1. Petitioner has adopted and used the trademark FLEX for goods in Class 3 including hair conditioner and shampoo, among other. Petitioner has been commercially using the trademark FLEX prior to the appropriation and the filing of the application for the registration of the trademark bobbie DIAMOND FLEX by Respondent-Registrant;

"2. Petitioner is the first user and rightful owner of the trademark FLEX. Petitioner has also used and registered or applied for the registration of the trademark FLEX in the United States of America and other countries worldwide, much earlier than Respondent-Registrant's claimed date of first use or filing date for its application that led to the subject registration;

"3. Petitioner's trademark FLEX is an arbitrary trademark when used on goods in Class 3 and is entitled to broad legal protection against unauthorized user like Respondent-Registrant who has appropriated the derivative bobbie DIAMOND FLEX for its own goods;

"4. Petitioner is the first user of the trademark FLEX for the above-mentioned goods. Respondent-Registrant has appropriated the trademark bobbie DIAMOND FLEX for the obvious purpose of capitalizing upon the reknown of Petitioner's self-promoting trademark by misleading the public into believing that its goods originated from, or are licensed or sponsored by Petitioner;

"5. The registration and use of a confusingly similar trademark by the Respondent-Registrant will tend to deceive and /or confuse purchasers into believing that Respondent-Registrant's products emanate from or under the sponsorship of Petitioner, for the following reasons:

"i) The trademarks are substantially identical.

"ii) The parties are using the trademarks FLEX and bobbie DIAMOND FLEX on related products.

"iii) Respondent-Registrant used bobbie DIAMOND FLEX on its own products as a self promoting trademarks to gain public acceptability for its products through its association with Petitioner's popular FLEX trademark;

Respondent-Registrant obviously intends to trade, and is trading on Petitioner's goodwill;

"6. The registration and use of an identical trademark by Respondent-Registrant will diminish the distinctiveness and dilute the goodwill of Petitioner's trademarks."

A NOTICE TO ANSWER dated November 13, 1996 was sent to herein Respondent-Registrant requiring it to file an ANSWER to this Petition within fifteen (15) days from receipt thereof. However, no Answer had been filed. Subsequently, upon motion of Petitioner, Respondent-Registrant was declared IN DEFAULT by this Office for the failure to file its Answer under Order No. 97-80, dated March 3, 1997. Correspondingly, the evidence appertaining to this case was received *ex-parte.*

On May 7, 1998, Petitioner formally offered its evidence consisting of Exhibits "A" to "N-2" inclusive of sub-markings, which were all ADMITTED in evidence, per Office Order No. 98-543 dated December 28, 1998.

Petitioner filed its Memorandum on February 13, 1999 submitting the case for decision.

The issue to be resolved are the following:

1. Whether or not Respondent-Registrant's trademark's "bobbie DIAMOND FLEX and Device" used on nail crème is CONFUSINGLY SIMILAR with Petitioner's trademark "FLEX" used on conditioning preparation for the hair, hair shampoo, and hair setting lotion, and

2. Who between Petitioner and Respondent-Registrant is the prior user and owner of the trademark "FLEX", and therefore entitled to its registration?

Section 4(d) of the trademark law, Republic Act No. 166 provides as follows:

> "Sec. 4. Registration of trademarks, trade names and service marks on 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 a trade mark, trade name and service mark used 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:
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> x x x
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> (d). Consists of r comprises a mark or trade name which so resembles a mark or trade name registered in the Philippines or a mark, 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 consumers." (underscoring provided)

In cases involving infringement of trademark brought before the Court, it has been consistently held that there is infringement of trademark when the use of the mark involved would be likely to cause confusion or mistake in the mind of the public or to deceive purchasers as to the origin or source of the commodity; that whether or not a trademark causes confusion and is 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; that duplication or imitation is not necessary, a similarity in the dominant features of the trademarks would be sufficient. (Phil. Nut Industry, Inc. Petitioner, versus Standard Brands, Inc. and Tiburcio Evalle as Director of Patents, Respondent G.R. No. L-23035, July 31, 1975). In the said case, the Supreme Court ruled that the marks PHILIPPINE PLANTERS CORDIAL PEANUTS used by Philippine Nuts Industry is confusingly similar to PLANTERS COCKTAIL PEANUTS used by Standard Brands, Inc. due to the presence of the dominant word PLANTERS in both labels.

In the instant case a close comparison of the two subject marks disclose that both contain the word mark “FLEX” on their respective labels (Exhibits “M” to “M-14”). While Respondent-Registrant’s mark “BOBBIE DIAMOND FLEX and Device” contain the bigger words “BOBBIE” accompanied by the words “diamond flex” underneath which is found inside the octagonal device, unwary purchasers cannot help but conclude that Respondent-Registrant’s trade mark and that Petitioner’s are one and the same or the subsidiary or under the sponsorship of the other primarily because of the inclusion of the word “FLEX” on both marks.

The determinative factor in a contest involving registration of a 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 trademarks must be so identical as to produce actual error or mistake. For infringement to exist, it would be sufficient that the similarity between the two trademarks is such that there is a possibility of likelihood of the older brand mistaking the newer brand for it.

In Continental Connector Corp. vs. Continental Specialist Corp., 207 USPQ 60, the repeated rule was applied to wit: that the confusion created by the same word as the primary element in a trade marks is not counteracted by addition of another term. Examples: “Miss U.S.A. and “Miss U.S.A. World” (Miss Universe, Inc., vs. Partrecelli, 161 USPQ 129); “Gucci” and “Gucci 600” (Gucci Shops, vs. R.H. Macy and Co., 446F Supp. 838); “Comfort” and “Foot Comfort” (School, Inc., vs. Ops E.H.R. Corp., 185 USPQ 754); “ACE” and “TEN-ACE” (Bechon, Dickinson and Co., vs. Wignam Mills, Inc., 199 USPQ 607).

Moreover, the goods covered by Respondent-Registrant’s “BOBBIE DIAMOND FLEX and Device” mark and Petitioner’s “FLEX” mark apply to related goods, both falling under international class 3, thus, aggravating the likelihoods of confusion or deception on the part of the buying public.

In connection with the use of a confusingly similar of identical mark the Supreme Court had ruled that:

> “Those who desire to distinguish their goods from the goods of another have a broad field from which to select a trademark for their wares and there is no such poverty in the English language or paucity of signs, symbols, numerals etc., as to justify one who really wishes to distinguish his products from those of all others entering the twilight zone of a field already appropriated by another (Weco Products Co. vs. Milton Ray Co., 143 F 2nd, 985, C.C.P.A. Patents 1214.”
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> “Why of the million of terms and combination of letters and designs available the appellee had to choose those so closely similar to another’s trademark if there was no intent to take advantage of the goodwill generated by the other mark (American Wire & Cable Co. vs. Director of Patents, 31 SCRA 544).”
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> “xxx Why, with all the birds in the air, and all the fishes in the sea, and all the animals on the face of the earth to choose from the defendant company (Manila Candy Co.) elected two roosters as its trademark, although its directors and managers must have been well aware of the long continued use of a rooster by the plaintiff with the sale and achievement of its goods? xxx a cat, a dog, a carabao, a shark or an eagle stamped upon the container in which candies are sold would serve as well as a rooster for the product of defendants factory. Why did defendant select two roosters as its trademark? (Clarke vs. Manila Candy Co., 36 Phil. 100).”

In the light of the above-quoted provision of the Trademark Law and jurisprudence, there is no doubt that confusing similarity exists between the two marks.

The next issue to be resolved is who between Petitioner and Respondent-Registrant is the prior user of the mark FLEX and is therefore entitled to its registration?

Based on the evidence presented which include registrations and applications by herein Petitioner worldwide for the "FLEX" mark covering international applications and registrations (Exhs. "C", "C-4" to "C-6" to "C-8", "1 to 116", Class 3 "K to "-64", "L" to "L-10") showing the fact of prior actual use of the same mark as early as forty two (42) years ago (Exh. "C-12"), the presentation of promotional and advertising materials, pictures, markets worldwide (Exhs. "M" to "M-14", "E" to "E-3", "F"), commercial invoices (Exhs. "D" to "D-1", "N" to "N-2", "E" to "E-3"), Philippine Registration No. 37636 for the trademark FLEX (Exh. "G"), and Philippine Registration No. 61690 for the same mark (Exh. "H"), there was a very clear showing that Petitioner's mark is internationally known and had been registered and used prior to Respondent-Registrant not only in other countries but in the Philippines as well.

On the other hand, the records of this case showed that Respondent-Registrant's mark had used its mark only on November 12, 1992 as shown in Certificate of Registration No. 61900 issue to it on November 10, 1995, which was several years after Petitioner's registration in the Philippines sometime in 1987 (Exh. "G").

Moreover, the non-filing of the Answer and Motion to Lift Order of Default by the herein Respondent-Registrant signifies lack of interest on its part.

In this connection, the Supreme Court held DELBROS HOTEL CORPORATION vs. INTERMEDIATE APPELATE COURT, 159 SCRA 533, 5H3 (1998) that:

> "Fundamentally, default orders are taken on the legal presumptions that in falling to file an ANSWER the defendant does not oppose the allegations and relief demanded in the complain." (Underscoring ours)

WHEREOF, the PETITION FOR CANCELLATION is hereby GRANTED. Accordingly, Certificate of Registration No. 61900 for the trademark "BOBBIE Diamond FLEX and Device" issued to CFC Corporation, herein Respondent-Registrant is, as it is hereby CANCELLED

Let the filewrapper of "BOBBIE Diamond FLEX and Device" subject of this case be forwarded to the Administrative, Financial Human Resource Development Service Bureau for appropriate action in accordance with this Decision with a copy thereof to be furnished the Bureau of Trademarks for information and update of its records.

SO ORDERED.

Makati City, August 30, 2002.

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