

THAI WACOAL PUBLIC COMPANY, LIMITED,	}	Inter Partes Case No. 14-2005-00100
	}	Opposition to:
<i>Opposer,</i>	}	
	}	Appln. Serial No.: 4-2000-000976
	}	Date Filed : 10 Feb. 2000
-versus-	}	Trademark : "ENFANT & LOGO"
	}	Class : 16
	}	Goods : Disposable baby diapers
	}	and cellulose disposable),
RICHARD LIM,	}	albums, cards and bags
<i>Respondent-Applicant.</i>	}	(paper)
x-----x	}	Decision No. 2006-92

DECISION

This is an opposition to the registration of the trademark "ENFANT & Logo" bearing Serial No. 4-2000-000976 filed on February 10, 2000 for goods, disposable baby diapers and cellulose disposable, albums, cards and bags (papers) falling under class 16 of the international classification of goods, which application was published in the Intellectual Property Office (IPO) E-Gazette, released for circulation on August 24, 2005.

The Opposer in the instant case is THAI WACOAL PUBLIC COMPANY LIMITED, a foreign CORPORATION FORMED AND EXISTING UNDER THE LAWS OF Thailand with business address at 93011, Soi Pradoo 1, Satupradith Road, Kwang Bangklo, Khet Bangkorlaem, Bangkok, Thailand.

On the other hand, the herein Respondent-Applicant is RICHARD LIM, a Filipino with address at 2328 Severino Reyes Street, Sta. Cruz, Manila.

The grounds for the opposition are as follows:

- "1. Opposer is the true owner of the mark "ENFANT" and its variations such as, but not limited to "ENFANT & DESIGN", "ENFANT & Logo" and "ENFANT & Device". Opposer has been using the mark "ENFANT" and its variations in connection with its goods in international commerce for many years, and it enjoys a strong reputation for high-quality infant and children's products.
- "2. Respondent-Applicant is fully aware of Opposer's ownership of the mark "ENFANT" and its variations since Respondent-Applicant is in fact one of the majority stockholders, as well as the President and General Manager of Opposer's distributor in the Philippines, Golton Corporation. A copy of the Distributorship Agreement between Opposer and Respondent-Applicant's Golton Corporation is attached hereto as Exhibit "D". A copy of Golton Corporation's latest General Information Sheet is likewise attached hereto as Exhibit "E".
- "3. The subject Trademark Application No. 4-2000-000976 for the mark "ENFANT & Logo" was filed by Respondent-Applicant without the knowledge, consent or authority of Opposer who naturally believes that it would be damaged by the registration of Trademark Application No. 4-2000-000976 for the mark "ENFANT & Logo" IN THE NAME OF Respondent-Applicant.
- "4. To repeat, Opposer is the true owner, prior adopter and user of the mark "ENFANT" and its variations and Respondent-Applicant as a mere

distributor of Opposer, has absolutely no right to have Trademark Application No. 4-2000-000976 for the mark “ENFANT & Logo” registered in his name.

- “5. Opposer has registered the mark “ENFANT” and its variations in numerous countries throughout the world, most of which, if not all, are members of the Paris Convention and/or the TRIPS. Among Opposer’s trademark registrations for the mark “ENFANT” and its variations are as follows:

Country	Mark	Registration Number	Filing / Registration Date	Class (es)
SINGAPORE	ENFANT & DEVICE	T9100844F	13 FEBRUARY 1991	25
VIETNAM	ENFANT & DEVICE	5164	25 DECEMBER 1991	25
REPUBLIC OF CHINA	ENFANT & DEVICE	56343	01 JULY 1992	39
VIETNAM	ENFANT & DEVICE	17076	26 JUNE 1993	3, 5, 10, 12, 18, 20, 21, 24 and 25
UNITED ARAB EMIRATES	ENFANT & DEVICE	5137	07 MARCH 1995	25
PEOPLE’S REPUBLIC OF CHINA	ENFANT & DEVICE	747088	21 MAY 1995	25
KUWAIT	ENFANT & EF DEVICE	31408	20 JANUARY 1998	25
BELGIUM/ NETHERLANDS/ LUXEMBOURG	ENFANT & EF DEVICE	651-274	08 JANUARY 1999	16, 24 and 25
PHILIPPINES	ENFANT & DEVICE	4-1996-105435	02 JANUARY 2002	25
AFRICAN INTELLECTUAL PROPERTY ORGANIZATION (O.A.I.P.)	ENFANT & EF DEVICE	46831	01 NOVEMBER 2002	25
KINGDOM OF SAUDI ARABIA	ENFANT & DEVICE	695/70	28 SEPTEMBER 2003	25

Copies of the foregoing Certificates of Registration are attached hereto as Exhibits “F-1” to “F-11”.

Opposer reserves the right to submit other certificates of registration or applications for the mark “ENFANT” and its variations during the course of proceedings.

- “6. Opposer has been widely selling its goods bearing the mark “ENFANT” and its variations worldwide. Among the countries where Opposer’s goods bearing the marks “ENFANT” and its variations are sold are Singapore, Vietnam, Taiwan, United Arab Emirates, China, Kuwait, Belgium, Netherlands, Saudi Arabia and the Philippines.

- “7. In the Philippines, Opposer’s goods bearing the “ENFANT” and its variations have been sold since 1989 in reputable establishments such as, but not limited to Glorietta Mall in Makati City and SM Department Stores.
- “8. Opposer has obtained Philippine Trademark Registration No. 4-1996-105435 for the mark “ENFANT and Device” in International Class 25, which was issued on 02 January 2001 and covers babies, napkins of textile, skirts, trousers, bathing trunks, bathing suits, swimming suit, beach clothes, babies pants, suits, sweat-absorbent underwear, pajamas, collars protectors, collar (clothing), detachable collars, neckties, dressing gowns, frocks, waistcoats, babies napkins, robes, camisoles, ready-made clothing, shirts, layettes (clothing), pullovers (sweater), jackets, combinations (clothing), hats, shoes, suspenders, babies diapers of textile, babies mittens, gloves (clothing) and stockings (sweat absorbent). A copy of Certificate of Registration No. 4-1996-105435 is attached hereto as Exhibits “G”.
- “9. Opposer has likewise filed Application No. 4-2000-002521 for “ENFANT & Design” in International Class 3 on 30 March 2000 for baby powder (talcum), baby soap, clothes washer, baby shampoo, baby lotion, baby bath, baby bath cream, baby powder (cornstarch), baby cologne. A copy of Opposer’s Application No. 4-2000-002521 for the “ENFANT & Design” in International Class 3 is attached hereto as Exhibit “H”.
- “10. Opposer’s “ENFANT” mark and its variations are well-known internationally and in the Philippines by reason of Opposer’s long, exclusive and continuous use thereof and the numerous registrations that Opposer has obtained for said marks worldwide. By reason of its long, exclusive and continuous use thereof and the numerous registrations that Opposer has obtained for said marks worldwide by reason of its long, exclusive and uninterrupted use of the mark “ENFANT” and its variations, Opposer has established worldwide goodwill over said marks such that goods bearing the said marks have acquired general international recognition to one source, i.e., Opposer.
- “11. The mark “ENFANT & Logo” sought to be registered by Respondent-Applicant is identical to or confusingly similar with the well-known trademarks owned and registered by Opposer, such that purchasers of goods on which it is used are likely to deceive purchasers that Respondent-Applicant’s goods have originated from Opposer.
- “11.1 A comparison of the competing marks as pictured below unmistakably shows that the mark “ENFANT & Logo” sought to be registered by Respondent-Applicant is identical to or confusingly similar with the trademarks owned and registered by Opposer.



Enfant

Respondent-Applicant’s mark



Opposer's mark

The word "ENFANT" is clearly the dominant feature of both marks and is indicative of Respondent-Applicant's devious intent to usurp Opposer's mark along with the goodwill attached to it.

- 11.2 Moreover, the competing marks are used in connection with the same or related goods, which are sold in the same channels or trade. Respondent-Applicant's Trademark Application No. 4-2000-000976 covers disposable baby diapers and cellulose disposable, albums, cards and bags (papers). These goods are very similar or closely related to the goods covered by Opposer's Registration No. 4-1996-105435 and application No. 4-2000-002521 considering that they all involved infant and children's products.
- 11.3 Considering that the goods covered by the trademark application subject of this opposition and Opposer's goods are extremely related, the unwary public will most definitely be misled into thinking that the products of Respondent-Applicant are manufactured and/or endorsed by Opposer.
- 11.4 Significantly, Section 138 of the Intellectual Property Code (IP Code) protects the registered owner of a mark from the use by another of a similar mark on the goods or services related to those specified in the certificate of registration, to wit:

"Certificate of registration – A certificate of registration of a mark shall be prima facie evidence of the validity of 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."
(Emphasis supplied)

Considering that Respondent-Applicant has used the identical mark on goods and products within the zone of potential, natural and logical operation of Thai Wacoal, the latter is entitled to be protected against such use. Otherwise, it would forestall and impede the normal potential expansion of Thai Wacoal's business and preclude it from using the same mark on such goods.

- "12. Section 123.1 (d) and 123.1 (e) of the Intellectual Property Code explicitly provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor, or to a well-known mark, whether or not it is registered in the Philippines, to wit:

"123.1. A mark cannot be registered if it:

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;

(e) Is identical with, or confusingly similar to, or constitute 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 sector of the public, rather than the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

x x x.” (Emphasis supplied)

- “13. Considering that: (1) the mark “ENFANT & Logo” sought to be registered by Respondent-Applicant is identical to or confusingly similar with the well-known trademarks owned and registered by Opposer, and; (2) Respondent-Applicant’s trademark application covers goods that are similar or closely related to Opposer’s goods, Respondent-Applicant is clearly not entitled to the registration thereof.
- “14. Moreover, Respondent-Applicant has already assigned unto Opposer his rights, title and interest in the Philippine Trademark Application No. 4-2000-000972 issued on 10 February 2000 for the mark “ENFANT & Logo” in International class 03 for the following goods: baby powder, baby cologne, baby soap, baby lotion, baby bath cream, nappy cream and cotton beauty set. A copy of Application No. 4-2000-000972 for “ENFANT & Logo” in International Class 03 is attached hereto as Exhibit “I”. While a copy of the legalized Deed of Assignment dated 30 June 2005 between Thai Wacoal and Respondent-Applicant as filed with the duly stamped received by the Intellectual Property Office (IPO) is likewise attached hereto as Exhibit “J”.
- “15. It is evident that Respondent-Applicant is intending to ride-on and cash-in on the worldwide popularity of Opposer’s trademarks and to palm-off its goods as originating from or being sponsored by Opposer. The fact that Respondent-Applicant is likewise Opposer’s distributor makes Respondent-Applicant’s act even more underhanded and should not be tolerated by the Honorable Bureau.
- “16. The registration of the mark “ENFANT & logo” in the name of Respondent-Applicant will not only violate the intellectual property rights of Opposer, but will also cause Respondent-Applicant to unfairly benefit from the business reputation and goodwill of Opposer over its trademark thereby causing irreparable injury to Opposer.

The Bureau of Legal Affairs issued a Notice to Answer and sent to the Respondent-Applicant through registered mail with Return Card bearing No. J-06-049, on January 17, 2006

by his counsel of record LACIERDA & MANANTAN LAW OFFICE at 154-B Josefa Drive, San Juan, Metro Manila.

Despite his counsel of record having received the Notice to Answer, Respondent-Applicant did not file his answer as well as the affidavit of his witness and accordingly, it shall be construed as a waiver to file such affidavit of his witness and documents to be attached thereto, hence, the Bureau of Legal affairs proceed to render judgment accordingly.

The Opposer presented its evidences consisting of Exhibits "A" to "J" inclusive of sub-markings.

As earlier discussed, the v did not file his answer to the Verified Notice of Opposition nor submit the affidavit of his witness and documents to support his application.

The only issue to be resolved in the instant opposition proceedings is:

WHETHER OR NOT THE RESPONDENT-APPLICANT IS ENTITLED TO THE REGISTRATION OF THE MARK "ENFANT & LOGO".

The applicable provision of law is Section 123.1 of Republic Act No.8293, otherwise known as the Intellectual Property Code of the Philippines, which provides:

"123.1 *A mark cannot be registered if it:*

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 trademark of the Opposer consist of the word "ENFANT" within an oblong Logo while that of the Respondent-Applicant consist of the word "ENFANT & Logo".

The dominant feature of the competing trademarks is the word "ENFANT", hence they are confusingly similar.

The Opposer has registered the mark "ENFANT" and its variations in numerous countries of the world, if not all, are members of the Paris Convention and/or TRIPS. Among Opposer's trademark registrations for the mark "ENFANT" and its variations are as follows: (Exhibits "F-1" to "F-11")

Country	Mark	Registration Number	Filing / Registration Date	Class (es)
SINGAPORE	ENFANT & DEVICE	T9100844F	13 FEBRUARY 1991	25
VIETNAM	ENFANT & DEVICE	5164	25 DECEMBER 1991	25
REPUBLIC OF CHINA	ENFANT & DEVICE	56343	01 JULY 1992	39

VIETNAM	ENFANT & DEVICE	17076	26 JUNE 1993	3, 5, 10, 12, 18, 20, 21, 24 and 25
UNITED ARAB EMIRATES	ENFANT & DEVICE	5137	07 MARCH 1995	25
PEOPLE'S REPUBLIC OF CHINA	ENFANT & DEVICE	747088	21 MAY 1995	25
KUWAIT	ENFANT & EF DEVICE	31408	20 JANUARY 1998	25
BELGIUM/ NETHERLANDS/ LUXEMBOURG	ENFANT & EF DEVICE	651-274	08 JANUARY 1999	16, 24 and 25
PHILIPPINES	ENFANT & DEVICE	4-1996-105435	02 JANUARY 2002	25
AFRICAN INTELLECTUAL PROPERTY ORGANIZATION (O.A.I.P.)	ENFANT & EF DEVICE	46831	01 NOVEMBER 2002	25
KINGDOM OF SAUDI ARABIA	ENFANT & DEVICE	695/70	28 SEPTEMBER 2003	25

In trademark registration cases, certificate of registration is *prima facie* evidence of the validity of registration, the registration and ownership of the mark and the exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate (Levi Strauss & Co., vs. Clinton Apparelle, Inc., 470 SCRA, 253-253 [2005])

In this regard, Section 147.1 of Republic Act No. 8293, provides:

“Section 147. *Rights conferred.* – Section 147.1. The owner of registered mark shall have the exclusive right to prevent third parties not having the owner’s consent from using in the course of trade identical or similar signs or containers of goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in likelihood of confusion x x x.”

Considering that the trademark “ENFANT & Device” is a registered mark in the Philippines in favor of herein Opposer, it is no longer subject of appropriation by any third party, including the herein Respondent-Applicant.

Likewise, as shown by the evidence, the trademark “ENFANT & Device” of the Opposer has been likewise registered in many countries of the world and many of them were issued prior to the filing of the Respondent-Applicant’s trademark application (Exhibits “F-1” to “F-11”).

One vital point to be emphasized in this particular case is the fact that Respondent-Applicant previously filed an application bearing Serial No. 4-2000-000972, on February 10, 2000 for the mark “ENFANT & Device” (Exhibit “I”) WHICH HE ASSIGNED TO THE HEREIN Opposer, (Exhibit “J”). The above-trademark application matured to Registration No. 4200000972 in the name of the herein Opposer “Thai Wacoal Public Company Limited”.

Subsequently, Respondent-Applicant again filed another trademark application for the registration of the mark “ENFANT & Logo” which rights, title and interest he has already assigned to the Opposer.

Evidence presented further shows that the Respondent-Applicant "Richard T. Lim" the president of Golton Corporation, is a distributor of the Opposer in the Philippines. (Exhibit "D") In addition, he has assigned his previous application for the mark "ENFANT & Device" in favor of herein Opposer. It is very clear therefore that he has committed fraud against the Opposer.

In *Gabriel-Almoradie, et.al. vs. Court of Appeals*, 229 SCRA 15, 20-1 (1994) the Supreme Court held:

"The exclusive distributor does not acquire any propriety interest in the principal's trademark.

In the absence of any inequitable conduct on the part of the manufacturer, an exclusive distributor who employs the trademark of the manufacturer does not acquire proprietary interest in the mark which will extinguish the rights to the manufacturer."

Likewise, in *Unno Commercial enterprises vs. General Milling Corporation*, (120 SCRA 804-808-9) where an agent who imported and marketed the products of a principal attempted to register locally the trademark of the principal, the Supreme Court disallowed the registration of the agent and held that:

"The right to register trademark is based on ownership. When the applicant is not the owner of the trademark being applied for, he has no right to apply for the registration of the same. Under the trademark law only the owner of the trademark, trade-name or service mark used to distinguish his goods, business or services from the goods, business and services of others is entitled to register the same.

The term owner does not include the importer of the goods bearing the trademark, trade-name, service marks or other mark of ownership, unless such importer is already the owner thereof in the country from which the goods are imported. A local importer, however, may make application for the registration of a foreign trademark, trade-name or service mark if he is duly authorized by the actual owner of the name or other marks of ownership."

The use by importer, distributor, agent, or representative of the mark or trade-name is deemed that of the latter, (*Marvex Commercial Co., vs. Petra Hawpia & Co.*, 18 SCRA 1178, 1182).

Since the Respondent-Applicant's mark is identical or confusingly similar to the Opposer's trademark and is intended to ride on the popularity and goodwill of the Opposer's mark and to confuse, deceive and/or mislead the purchasing public into believing that Respondent-Applicant's goods are the same or connected with the goods manufactured or sold by Opposer, its licensees and/or dealers, Respondent-Applicant's application for the registration of the mark "ENFANT and Logo" cannot be allowed registration.

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Consequently, trademark application bearing Serial No. 4-2000-000976 filed on February 10, 2000 by RICHARD LIM for the trademark "ENFANT and Logo" for "disposable baby diapers and cellulose disposable albums, cards and bags (paper)" under class 16 is hereby REJECTED.

Let the filewrapper of the "ENFANT and Logo" subject matter under consideration be forwarded to the Bureau of Trademarks (BOT) for information and to update its records.

SO ORDERED.

Makati City, 27 September 2006.

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