



OFFICE OF THE DIRECTOR GENERAL

EDNA DE LOS SANTOS,
Applicant-Appellant,

-versus-

DIRECTOR OF THE BUREAU
OF TRADEMARKS,
Respondent-Appellee.

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Appeal No. 04-2012-0007

Application No. 4-2009-006618

Date Filed: 06 July 2009

Trademark: BON BON & DEVICE

DECISION

EDNA DE LOS SANTOS (“Appellant”) appeals the decision of the Director of the Bureau of Trademarks (“Director”) sustaining the rejection of the Appellants’ Trademark Application No. 4-2009-006618 for the mark “BON BON & DEVICE”.

Records show that the Appellant filed on 06 July 2009 the application to register BON BON & DEVICE for noodles falling under Class 30. Subsequently, the Examiner-in-Charge (“Examiner”) issued a “REGISTRABILITY REPORT”¹ stating that the mark may not be registered because it nearly resembles a registered mark belonging to a different proprietor and the resemblance is likely to deceive or cause confusion.

The Appellant filed on 05 January 2010 a response letter to the REGISTRABILITY REPORT claiming that her mark covers goods different from those covered by the mark cited by the Examiner, and that these marks can co-exist. The Examiner issued another official action² stating that the Appellant’s mark nearly resembles the registered mark³ “BON O BON” issued in favor of Arcor S.A.I. C. for goods under Class 30 including pasta. The Appellant filed on 06 May 2010 a response that a conflict with the cited registered mark is unlikely to happen due to the disparity in meaning and presentation of the marks. According to the Appellant, her mark is a composite mark with the device of a boy and girl while the cited registered mark has the plain words BON O BON. On 09 June 2010, the Examiner issued a “FINAL REJECTION”⁴ of the Appellant’s trademark application on the ground that it is confusingly similar with the registered mark BON O BON.

On 03 March 2011, the Appellant appealed to the Director the final rejection of her trademark application maintaining that her mark is not confusingly similar to

¹ Paper No. 2 with mailing date of 11 November 2009.

² Paper No. 04 with mailing date of 08 March 2010.

³ Registration No. 4-1998-001423 with registration date of 18 September 2006.

⁴ Paper No. 06 with mailing date of 25 June 2010.

BON O BON. The Director issued on 28 June 2012 a decision denying the appeal and sustaining the rejection of the Appellant's trademark application. The Appellant filed on 11 July 2012 a motion for reconsideration which was denied by the Director.

Not satisfied, the Appellant filed on 10 December 2012 an "APPELLANT'S MEMORANDUM" contending that the Director erred in concluding that her mark is confusingly similar with BON O BON. The Appellant argues that her mark's actual appearance is very different from this mark cited by the Examiner and that there is no way for the consumers to be confused by these marks. According to the Appellant, taken in their entirety, there are significant and substantive differences between these marks. The Appellant maintains that the primary rule in the examination of a mark for validity and distinctiveness is the anti-dissection rule where the mark should be viewed as a whole, as it appears in the marketplace. The Appellant asserts that her goods and those covered by the mark cited by the Examiner appeal to different consumers and that belonging to the same class of goods cannot serve as the decisive factor in the resolution of whether the goods are related. The Appellant claims that fairness dictates that if BON O BON bar the registration of her mark, other applications for the "BON BON" mark should also be denied. However, according to the Appellant, the application for registration by Earnest Multinational Trading Corporation of a mark similar as that of the Appellant was allowed for publication.

On 14 February 2013, the Director filed her comment on the appeal maintaining the confusing similarity of the Appellant's mark with the mark cited by the Examiner. The Director contends that a finding of confusing similarity between marks is not precluded by the fact that one of them is a composite mark and the other is a word mark. According to the Director, the question central to a likelihood of confusion is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the goods they identify emanate from the same source. The Director points out that BON O BON is too phonetically and aurally similar to BON BON & Device and the similarity in sound and meaning of marks is an important consideration in finding confusing similarity. As to the Appellant's claim of "fairness" in treating similar trademark applications, the Director asserts that the findings of the Examiner is entitled to great weight absent manifest bias, partiality or utter lack of legal basis.

The main issue in this appeal is whether the Director was correct in sustaining the final rejection of the Appellant's application to register BON BON & DEVICE. Moreover, the relevant question in this case is whether BON BON & DEVICE is confusingly similar to BON O BON.

In trademark cases, 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 is decided on its own merits.⁵ As the likelihood of confusion of goods or business is a relative concept, to be determined only according to the particular, and sometimes peculiar, circumstances of each case,⁶ the complexities

⁵ Emerald Garment Manufacturing Corporation vs. Court of Appeals, 251 SCRA 600 (1995).

⁶ Esso Standard Eastern, Inc. vs. CA, 116 SCRA 336 (1982).

attendant to an accurate assessment of likelihood of such confusion requires that the entire panoply of elements constituting the relevant factual landscape be comprehensively examined.⁷

Below are the reproductions of the Appellant's and Appellee's marks:



Appellant's Mark

BON O BON

Mark cited by the Examiner

At a glance, one can see the similarity of these marks which both contained "BON BON". The Appellant's trademark application was filed on 06 July 2009 covering the goods noodles under Class 30 of the Nice Classification.⁸ On the other hand, the mark cited by the Examiner was filed on 26 February 1998 and was registered on 18 September 2006 for goods falling under Class 30 that includes pasta. In this regard, Sec. 123.1 (d) of the IP Code provides that 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 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 Director and the Examiner are, therefore, correct in rejecting the registration of the Appellant's mark pursuant to Sec. 123.1 (d) of the IP Code. This provision bars the registration of the Appellant's mark that resembles the registered mark cited by the Examiner and which would likely cause confusion.

Because of the similarity in the appearance of the marks and the goods to which the marks are used, it is very likely that the purchasing public would be deceived or be confused on the source or origin of the goods. The purchasing public

⁷ Societe Des Produits Nestle, S.A., et.al vs. CA, et. al., G.R. No. 112012, 04 April 2001.

⁸ The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

may associate or mistake the Appellant's goods as those of the owner of the mark cited by the Examiner or vice versa.

The essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁹

To allow the registration of the Appellant's mark would be contrary to the provisions of the IP Code and defeat the very rationale of trademark registration. Sec. 123.1 (d) of the IP Code bars the registration of BON BON & DEVICE in the name of the Appellant because this mark resembles a registered mark belonging to a different proprietor which is used on the same or related goods.

As correctly discussed by the Director:

A careful comparison of the marks would show that they are confusingly identical except for the letter O in between the two words, BON BON. The dominant feature in both marks is BON BON. The impact of the design in the subject mark is so minimal that it does not override the similarities between the marks. The resemblances dominate the differences as to be likely to deceive ordinary purchasers. Both marks are aurally, visually and phonetically the same.

Further the goods of both marks are classified under Nice Class 30 which will definitely cause confusion. The goods covered by both marks are also closely related such that it will cause confusion as to source. Verily, there would not only be confusion in the mind of the public as to the goods but also to source.¹⁰

Significantly, the proceeding for the registration of a mark before an examiner in the Bureau of Trademarks is *ex-parte*. It is prosecuted *ex parte* by the applicant, that is, the proceedings are like a lawsuit in which there is a plaintiff (the applicant) but no defendant, the court itself (the Examiner) acting as the adverse party.¹¹ The Intellectual Property Office of the Philippines represented by the Examiner is not supposed to look after the interest of an applicant. The law imposes that duty upon the applicant himself. The Examiner is charged with the protection of the interests of the public and, hence, must be vigilant to see that no registration issues for a mark contrary to law and the Trademark Regulations.¹² The Examiner will look if the trademark can be registered or not.

WHEREFORE, premises considered, the appeal is hereby DISMISSED.

⁹ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 November 1999.

¹⁰ DECISION dated 28 June 2012, page 4.

¹¹ Trademark Regulations, Rule 600.


¹² Trademark Regulations, Rule 602.

Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Trademarks. Let a copy of this Decision be furnished also the library of the Documentation, Information and Technology Transfer Bureau for its information and records purposes.

SO ORDERED.

DEC 03 2013

Taguig City



RICARDO R. BLANCAFLOR
Director General