



OFFICE OF THE DIRECTOR GENERAL

KISS NAIL PRODUCTS, INC.,
Appellant,

Appeal No. 04-2010-0004

-versus-

Application No. 4-2006-002467
Date Filed: 03 March 2006

**DIRECTOR OF THE BUREAU
OF TRADEMARKS,**
Appellee.

Trademark: KISS (Stylized)

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DECISION

KISS NAIL PRODUCTS, INC. (“Appellant”) appeals the decision¹ of the Director of the Bureau of Trademarks (“Director”) sustaining the final rejection of the Appellant’s Trademark Application No. 4-2006-002467 for the mark “KISS (Stylized)”.

Records show that the Appellant filed on 03 March 2006 the trademark application covering the goods² falling under Classes 3, 8, and 21 of the Nice Classification.³ The Examiner-in-Charge (“Examiner”) issued an official action⁴ stating that the Appellant’s mark cannot be registered because it nearly resembles registered marks belonging to different proprietors and the resemblance is likely to deceive or cause confusion. The Examiner cited the following marks: “KISS ME”;⁵ “KISS & DEVICE”;⁶ and “KISSKISS”.⁷

¹ DECISION dated 16 February 2010.

² Class 3 – Nail care products, namely, artificial fingernails, artificial fingernail adhesive; fingernail adhesive remover; fingernail strengthener; fingernail sealer; fingernail protector; nail polish kits; acrylic fingernail sculpturing kits; nail art kits; fingernail enhancing products, namely nail decals, nail glitter, nail charms, nail dangles, and any printed matter that can be adhered to the nail which beautifies and decorates the nail; color cosmetics; hair color preparations.

Class 8 – Manicure and pedicure implements; emery boards; nail files; nail clippers; nail punchers; nail drills; cuticle scissors and tweezers; fingernail sculpturing and nail art application implements.

Class 21 – Fingernail treatment utensils, namely brushes.

³ 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.

⁴ Paper No. 03 Registrability Report, mailed on 19 December 2006.

⁵ Registration No. 065917 issued on 26 June 1998 in favor of Isehan Company Limited for goods on Class 3 - soaps, perfumery, essential oils, cosmetics, namely, lipsticks, eyebrow pencils, eyeshadows, cheek brush, foundation, skin creams, cleansing milk for toilet purposes, skin lotions, eyeliners, mascara, manicure liquid, make-ups, essences, washing preparations, face powders, hair lotions, dentrifices.

⁶ Registration No. 4-1986-059830 issued on 13 May 2002 in favor of D World 2000 Enterprises Corporation for goods on Class 3 – air fresheners, telephone deodorizers, facial puff, facial tissue papers,

The Appellant filed on 19 February 2007 a "RESPONSIVE ACTION" contending that its mark and the marks cited by the Examiner are not confusingly similar and that there are sufficient visual, phonetic and conceptual differences as well as differences in the overall commercial impression between these marks. The Appellant claimed that the marks cited by the Examiner which are all registered in goods in Class 3 with the common element "KISS" show that they co-exist in the market without confusion or deception and that the cosmetics industry is crowded with marks including "KISS" such that it has become a common term which enjoys a limited protection.

The Examiner issued Paper No. 05⁸ reiterating the finding that KISS (Stylized) is confusingly similar with the cited marks which are used on closely related goods. The Appellant maintained⁹ that its mark is not confusingly similar with the marks cited by the Examiner and that the registry is crowded with registrations under Class 3 incorporating the element KISS such that the registrants cannot appropriate 'KISS' exclusively.

The Examiner issued a "FINAL REJECTION"¹⁰ claiming that the Appellant's mark cannot be registered because it nearly resembles the registered mark "KISS & Device" under Cert. of Reg. No. 4-1986-059830 and is likely to deceive or cause confusion. Consequently, the Appellant appealed the final rejection to the Director who denied the appeal and sustained the final rejection of the Appellant's trademark application.

On 25 March 2010, the Appellant filed an "APPEAL TO THE DIRECTOR GENERAL FROM THE DECISION OF THE DIRECTOR OF TRADEMARKS ON THE APPLICANT'S APPEAL OF THE EXAMINER'S FINAL REJECTION OF THE SUBJECT APPLICATION" reiterating its argument that its mark is not confusingly similar to the marks cited by the Examiner. The Appellant claims that its mark and these marks cited by the Examiner have sufficient visual differences. The Appellant argues that its mark cover goods that are non-related and dissimilar to the goods covered by the marks cited by the Examiner. The Appellant maintains that the trademark registry is crowded with registrations for goods under Class 3 incorporating the word "KISS" such as:

- "KISS ME" - Trademark Registration No. 002704;
- "KISS ME" - Trademark Registration No. 065917;
- "KISS RESIST" - Trademark Registration No. 4-2004-005780;
- "SWEET KISS" - Trademark Registration No. 4-2004-001464;

cotton buds and cosmetic brush; Class 16 – air fresheners, telephone deodorizers, facial puff, facial tissue papers, cotton buds and cosmetic brush; Class 21 – air fresheners, telephone deodorizers, facial puff, facial tissue papers, cotton buds and cosmetic brush.

⁷Registration No. 4-1994-095789 issued on 15 January 2002 in favor of Guerlain S.A. for goods on Class 3 – soaps, cosmetics namely cosmetic kits, cosmetic creams, lipstick cosmetic products for the care of the skin, perfumes, essential oil, shampoo, and toothpaste.

⁸ Mailed on 27 March 2007.

⁹ RESPONSIVE ACTION dated 27 May 2007.

¹⁰ Paper No. 07 mailed on 29 August 2007

“SUMMER KISS” - Trademark Registration No. 4-2005-010805;
“PINK KISS” - Trademark Registration No. 4-2003-002104; and
“VANILLA KISSES” - Trademark Registration No. 4-1995-106783.

The Director filed on 05 May 2010 her “COMMENT” contending that the Appellant’s mark and the cited mark KISS & Device are confusingly similar because they have the same dominant word element. The Director claims that KISS (Stylized) and KISS & Device identify closely related goods which share the same descriptive properties and flow through the same channels of trade.

The issue in this appeal is whether the Director was correct in sustaining the final rejection of the Appellant’s application to register KISS (Stylized) on the ground that it is confusingly similar with the previously registered mark KISS & Device.

In this regard, Sec. 123.1(d) of the IP Code, states 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 Appellant’s mark was filed on 03 March 2006 while the mark cited by the Examiner, KISS & Device, was registered on 13 May 2002. KISS & Device, therefore, was registered before the Appellant filed its trademark application. Accordingly, the relevant question is whether the Appellant’s mark nearly resembles the mark cited by the Examiner and the Director as to be likely to deceive or cause confusion. Below are the illustrations of the Appellant’s mark and the cited mark:

Appellant’s mark



Cited mark



At a glance, one can see that these marks are not identical and there are differences in the presentation of the two marks. The Appellant’s mark is written in a font and style different from the mark cited by the Examiner which also has an additional design of the lips. Nonetheless, even granting that these marks are similar

because of the presence of the word “kiss” in both of them, this Office still has to determine whether the registration of KISS (Stylized) would likely deceive or cause confusion.

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,¹¹ the complexities 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.¹²

In this case, this Office examined the goods covered by these marks to determine whether they are considered related. The Appellant’s mark is applied on the following goods:

Class 3 – Nail care products, namely, artificial fingernails, artificial fingernail adhesive; fingernail adhesive remover; fingernail strengthener; fingernail sealer; fingernail protector; nail polish kits; acrylic fingernail sculpturing kits; nail art kits; fingernail enhancing products, namely nail decals, nail glitter, nail charms, nail dangles, and any printed matter that can be adhered to the nail which beautifies and decorates the nail; color cosmetics; hair color preparations.

Class 8 – Manicure and pedicure implements; emery boards; nail files; nail clippers; nail punchers; nail drills; cuticle scissors and tweezers; fingernail sculpturing and nail art application implements.

Class 21 – Fingernail treatment utensils, namely brushes.

On the other hand, the cited mark KISS & Device covers the following goods for Classes 3, 16, and 21, namely: air fresheners, telephone deodorizers, facial puff, facial tissue papers, cotton buds and cosmetic brush.

Thus, while the Appellant’s mark and the cited mark both listed goods falling under classes 3 and 21, the goods covered by these marks are not the same or closely related. The Appellant’s goods are specialized nail care products and the assistance of salespersons or merchandisers are necessary for the purchase of these items. On the other hand, the goods covered by the cited mark do not include nail care products and that these goods can easily be located and bought in groceries and supermarkets without the assistance of salespersons or merchandisers. As correctly pointed out by the Appellant:

Contrary to the findings of the Examiner and Director that these goods are similar and flow through the same channels of trade, it is clear that though they may fall within the same classes, these goods are not similar or related in nature, function and purpose. They never appear side by side in stores. It does not take great imagination to realize that the goods covered by the cited mark are sold in supermarket stalls, while specialized nail care and manicure/pedicure products are not, but, instead due to their higher prices, are kept in glass counters and require assistance of sales ladies to retrieve, if at all they are available in supermarkets. Unlike the goods

¹¹ *Esso Standard Eastern, Inc. vs. Court of Appeals*, 116 SCRA 336 (1982).

¹² *Societe Des Produits Nestle, S.A., et.al vs. Court of Appeals, et. al.*, G.R. No. 112012, 04 April 2001.

covered by the cited mark (i.e., air fresheners, telephone deodorizers, facial puffs, facial tissue papers, cotton buds, tissue papers, etc.), the specialized nail care products; manicure and pedicure instruments and fingernail treatment utensils covered by the applicant's mark are usually sold in department stores and cosmetics outlets. Thus, it is submitted that these goods flow through different trade channels and are not sold side by side on store shelves, rendering consumer confusion or deception unlikely.¹³

It is, therefore, unlikely that the Appellant's use of KISS (Stylized) will give rise to confusion, much less cause damage to the purchasing public.¹⁴ A check on the Trademark Registry showed that the Appellant had been issued certificates of registration for "RED BY KISS", Cert. of Reg. No. 4-2006-008688 issued on 09 April 2007 for goods under Class 8 that includes personal care tools and fingernail/toenail implements; and for "FIRST KISS", Cert. of Reg. No. 4-2007-003813 issued on 19 November 2007 for the same goods as those covered by KISS (Stylized). Accordingly, KISS (Stylized) is just a variation of the Appellant's registered marks embodying the word "KISS" which are also used on the same class of goods on specialized nail care products.

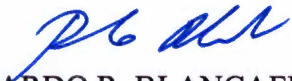
In addition, because of the nature of the products covered by the Appellant's mark, the purchasers of these products are thought of, as having, and credited with, at least a modicum of intelligence.¹⁵ It does not defy common sense to assert that a purchaser of nail care products would be cognizant of these kinds of products.¹⁶

Wherefore, premises considered, the appeal is hereby GRANTED. The Appellant's Trademark Application No. 4-2006-002467 for KISS (Stylized) is hereby allowed to be published in accordance with the provisions of the IP Code and the Trademark Regulations.

Let a copy of this Decision and the records of this case be furnished and returned to the Director of the Bureau of Trademarks for appropriate action. Further, let the library of the Documentation, Information and Technology Transfer Bureau be furnished a copy of this Decision for information, guidance, and records purposes.

SO ORDERED.

SEP 03 2012 Taguig City.


RICARDO R. BLANCAFLOR
Director General

¹³ APPEAL TO THE DIRECTOR GENERAL FROM THE DECISION OF THE DIRECTOR OF TRADEMARKS ON THE APPLICANT'S APPEAL OF THE EXAMINER'S FINAL REJECTION OF THE SUBJECT APPLICATION, dated 25 March 2010, page 4.

¹⁴ See *Philippine Refining Co., Inc. vs. Ng Sam and the Director of Patents*, G. R. No. L-26676, 30 July 1982.

¹⁵ See *Fruit of the Loom, Inc. vs. Court of Appeals and General Garments Corporation*, G.R. No. L-32747, 29 November 1984.

¹⁶ See *Acoje Mining Co., Inc. vs. Director of Patents*, 38 SCRA 480 (1971).