



S.P.M.D.,

Opposer,

- versus -

PL ASIA PACIFIC (PHILS), INC.,

Respondent-Applicant.

x-----x

IPC No. 14-2009-00164

Opposition to:

Appln. Ser. No. 4-2008-013423

Date Filed: 31 October 2008

Trademark: SEFOREL

Decision No. 2012 - 52

DECISION

S.P.M.D.¹ ("Opposer") filed on 01 July 2009 a Verified Notice of Opposition to Trademark Application No. 4-2008-013423. The application, filed by PL ASIA PACIFIC (PHILS), INC.² ("Respondent-Applicant"), covers the mark SEFOREL for use on "*preparations for feminine hygiene wash*" under Class 03 of the International Classification of Goods³. The Opposer alleges, among other things, the following:

"1. The trademark SEFOREL being applied for by Respondent-Applicant is confusingly similar to Opposer's trademark SAFORELLE, as to be likely, when applied to or used in connection with the goods of Respondent-Applicant, to cause confusion, mistake and deception on the part of the purchasing public.

"2. The registration of the trademark SEFOREL in the name of Respondent-Applicant will violate Section 123.1, subparagraph (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, as follows:

x x x

"3. The registration of the trademark SEFOREL in the name of Respondent-Applicant is contrary to Section 123.1, subparagraph (e) of the Intellectual Property Code of the Philippines, as follows:

x x x

"4. The registration of the trademark SEFOREL in the name of Respondent-Applicant is also contrary to Section 123.1, subparagraph (f) of the Intellectual Property Code of the Philippines, as follows:

x x x

"5. The registration of the trademark SEFOREL in the name of Respondent-Applicant will also violate Article 6bis of the Paris Convention for the Protection

1 A corporation duly organized and existing under and by virtue of the laws of France, with business address at 174 Quai de Jemmapes, 75010 Paris, France.

2 Located at 26th Floor, Philippine Axa Life Center, 1286 Sen. Gil Puyat Avenue corner Tindalo St., Makati City.

3 The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral 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.

of Industrial Property, to which the Philippines is a party having acceded to as early as September 27, 1965, as follows:

x x x

"6. The registration and use by Respondent-Applicant of the trademark SEFOREL will diminish the distinctiveness and dilute the goodwill of Opposer's trademark SAFORELLE.

"7. The registration of the trademark SEFOREL in the name of Respondent-Applicant is contrary to other provisions of the Intellectual Property Code of the Philippines."

The Opposer's evidence consists of the following:

1. Exh. "A": Cert. of Trademark Reg. No. 4-2008-003538 issued by Intellectual Property Office of the Philippines;
2. Exh. "B": original copy of the Distribution Agency Agreement Laboratories Iprad and Innoledge International Ltd.;
3. Exhs. "C-1" to "C-13": copies of advertisements in the print media of Opposer's mark SAFORELLE;
4. Exhs. "D-1" to "D-4": computer print out of the website www.saforelle.com dedicated to goods bearing the Opposer's mark SAFORELLE;
5. Exh. "E": computer print out of the Dictionnaire VIDAL's website listing Opposer's goods bearing the mark SAFORELLE;
6. Exh. "F": certified true copy of the Opposition Decision by the French Patent Office in the case SAFORELLE v. FORELLE and its translation in English language;
7. Exh. "G": Cert. of Product Registration issued by the Bureau of Food and Drugs;
8. Exh. "H": copy of the letter of the Respondent-Applicant dated 18 Dec. 2008;
9. Exh. "I": print-out copy of an on-line article in Philstar.com;
10. Exh. "L": copy of advertisement in the print media for SEFOREL;
11. Exh. "M": List of countries where SAFORELLE is registered and/or applied for registration;
12. Exhs. "N" series: copies of the certificates of registration issued by the countries where SAFORELLE is registered;
13. Exh. "O": list of countries where SAFORELLE is used;
14. Exhs. "P-1" to "P-3": print-out of the websites www.micrex.com.br, www.pcfam.ro and <http://apteka.we-dwoje.pl>; and
15. Exh. "Q": duly signed, notarized and authenticated Affidavit-Testimony of witness Pierre-Marie Defrance and its English translation.

On 06 July 2009, the Opposer filed a "Supplemental Submission" submitting the actual packaging material of SAFORELLE and the actual product itself of the Opposer, and the actual packaging material of SEFOREL and the actual product

itself of Respondent-Applicant.⁴

This Bureau served a Notice to Answer upon the Respondent-Applicant's agent and/or representative on 15 July 2009. The said party, however, did not file the Answer.

Should the Respondent-Applicant be allowed to register the mark SEFOREL?

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.⁵ Thus, Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code ("IP Code") provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date in respect of the same goods or services or closely related goods or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The records and evidence show that at the time the Respondent-Applicant filed its application on 31 October 2008, the Opposer has an existing registration for the mark SAFORELLE (Reg. No. 4-2008-003538) issued on 21 July 2008 and valid for ten years (or until 21 July 2018). The registration covers goods under Classes 03 and 05, namely, *"cleaning solutions, solid soaps, liquid soaps and cleaning gels for mucosa and sensitive skins, cleansing milk for toilet purposes; pharmaceutical products, namely soothing cream for the care of itchings and irritations of mucosae and sensitive skins"*, which are similar or closely related to the goods indicated in the Respondent-Applicant's application including *"preparations for feminine hygiene wash"*. The goods covered by the competing marks belong to the same class of goods (Class 03), serve the same purpose being both toilet articles, and flow through the same channels of trade.

But do the competing marks, shown below, resemble each other such that confusion, mistake or deception is likely to occur?

SAFORELLE

Opposer's mark

Seforel

Respondent-Applicant's mark

When pronounced, the competing marks practically sound identical and thus, undistinguishable from one another. Considering that the competing marks are used on goods that are now considered common household items, and which are readily found on the shelves of retail stores, supermarkets and similar establishments, the differences in the competing marks' visual presentations as to spelling, font and style have become inconsequential. Confusion cannot be avoided

⁴ "Marked" as Annexes "J" and "K", the Opposer is actually referring to these as its Exhs. "J" and "K".

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

by merely dropping, adding or changing one of the letters of a registered mark.⁶ Confusing similarity exists when there is such a close of ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.⁷ Indeed, to constitute an infringement of an existing trademark patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two marks is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.⁸

Succinctly, for common household and similar goods, how the brand or mark composed of, or mainly, of word or words is very important. Knowledge of the product is also passed on through non-visual medium like radio or by simple word-of-mouth. Even television and other "visual" advertisements, emphasis is accorded on how the brand or trademark is said as well. As recall is a mental activity, it is likely that consumers will remember the products not only on how the labels or packaging look like but also on the basis of how the brand or mark rings to the ear.

SAFORELLE is a very unique mark as regards goods under Class 03. Hence, it is highly improbable for another person to come up with an identical or nearly identical mark for use on the same or related goods purely by coincidence. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the answered riddle is why, of the millions of terms and combination of letters and available, the Respondent-Applicant had come up with a mark identical or so clearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark⁹.

Clearly, the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code, and therefore, should not be allowed. With this finding, this Bureau deems that there is no need to dwell on the issue of whether or not the Opposer's mark is a well-known mark.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application No. 4-2008-013423 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 19 March 2012.


Atty. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

⁶ *Continental Connector Corp. v. Continental Specialties Corp.*, 207 USPQ.

⁷ *Societe Des Produits Nestle, S. A. v. Court of Appeals*, G. R. No. 112012, April 4, 2001.

⁸ *American Wire & Cable Co. v. Director of Patents, et. al.*, G. R. No. L-26557, 18 Feb. 1970.

⁹ *American Wire and Cable Co. v. Director of Patents et. al*, G.R. No. L-26557, 18 Feb. 1970.