



LANCOME PARFUMS ET BEAUTE
& CIE,

Opposer,

- versus -

CHITO L. LU and CHRISTINA YAO,
Respondent-Applicant.

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IPC No. 14-2010-00121

Opposition to:

Appln. Serial No. 4-2009-005733

Date Filed: 10 June 2009

TM: ANCOM (STYLIZED)

Decision No. 2012- 29

DECISION

LANCOME PARFUMS ET BEAUTE & CIE ("Opposer"), filed on 15 June 2010 an Opposition to Trademark Application No. 4-2009-005733. The application filed by CHITO L. LU and CHRISTINA YAO ("Respondent-Applicant"), covers the mark "ANCOM (STYLIZED)" for use on pharmaceutical preparation namely, herbal food supplement; pharmaceutical products for for slimming purposes; pharmaceutical teas; herbal food supplement; cosmetics; health foods and drinks under Class 5 of the International Classification of Goods. The Opposer alleges among other things, the following:

"1. Opposer adopts its arguments and evidence in the previous opposition case filed by Opposer against Respondent-Applicant's application for the same mark ANCOM (STYLIZED) entitled *Lancome Parfums Et Beaute & Cie vs Chito L Lu and Cristina Yao* and docketed as IPC No. 2008-00320.

"2. In the opposition case of *Lancome Parfums Et Beaute & Cie vs Chito L Lu and Cristina Yao* (IPC No. 14-2008-00320), the Honorable Director of the Intellectual Property Office ("IPO") Bureau of Legal Affairs sustained the Opposer's Notice of Opposition against Respondent-Applicant, ruling that 'ANCOM' is CONFUSING SIMILAR to the Opposer's mark LANCOME, to wit: x x x

For failure of the Respondent-Applicant to file appeal, the IPO Decision became final and executory on 27 February 2010.

"3. The IPO Decision in *Lancome Parfums Et Beaute & Cie vs Chito L. Liu and Cristina Yao* (IPC No. 14-2008-00320) being final and executory, the trademark application for the same mark ANCOM (STYLIZED) under Application No. 4-2009-005733 filed on 10 June 2009 by Respondent-Applicant Chito Lu is BARRED BY RES JUDICATA and should be REJECTED.

"4. RES JUDICATA means a matter adjudged, a thing judicially acted upon or decided; a thing or matter settled by judgment. For a claim of RES JUDICATA to prosper, the following requisites must concur: a) there must be a final judgment or order; b) the deciding body rendering it must have jurisdiction over the subject matter and the parties; c) it must be a judgment or order on the merits; and d) there must be, between the two cases, identity of parties, subject matter and causes of action.

"5. All the requisites of RES JUDICATA concur in this case.

"6. First, there is a FINAL DECISION of the IPO in the opposition case of *Lancome Parfums Et Beaute & Cie vs Chito L. Lu and Cristina Yao* (IPC No. 14-2008-00320) that the mark ANCOM

(STYLIZED) is barred from registration for being CONFUSINGLY SIMILAR to the Opposer's mark LANCOME. The IPO Decision became final and executory on 27 February 2010, as earlier stated.

"7. Second, the IPO HAS JURISDICTION OVER THE PARTIES AND THE SUBJECT MATTER of *Lancome Parfums Et Beaute & Cie vs Chito L. Lu and Cristina Yao* (IPC No. 14-2008-00320). Under Section 10.1 of the IP Code, the IPO has the power to hear and decide an opposition to the application for registration of a trademark.

"8. Third, the IPO DECISION that the Respondent-Applicant's mark ANCOM (STYLIZED) is CONFUSINGLY SIMILAR to Opposer's LANCOME was a JUDGMENT ON THE MERITS. The ruling determined that Opposer, as the registered owner of the mark LANCOME, had the exclusive right to prevent as it did prevent Respondent-Applicant from registering the CONFUSINGLY SIMILAR mark ANCOM (STYLIZED).

"9. Fourth, there is IDENTITY OF PARTIES, SUBJECT MATTER AND CAUSES OF ACTION.

9.1. Opposer and Respondent-Applicant are the same parties named in the previous opposition case *Lancome Parfums Et Beaute & Cie vs Chito L. Lu and Cristina Yao* (IPC No. 14-2008-00320), which was decided in favor of the Opposer and which has since attained finality.

9.2. The mark ANCOM (STYLIZED) subject of the previous opposition case *Lancome Parfums Et Beaute & Cie vs Chito L. Lu and Cristina Yao* (IPC No. 14-2008-00320) is the same mark filed by Respondent-Applicant and now the subject of the instant opposition filed by the Opposer. Even the description of goods in class 5 of the mark ANCOM (STYLIZED) is the exact description used for the mark rejected by the IPO, i.e., 'pharmaceutical preparation namely, herbal food supplement; pharmaceutical products for for slimming purposes; pharmaceutical teas; herbal food supplement; cosmetics; health foods and drinks.'

9.3. In both the previous and instant opposition cases, the causes of action are identical. Opposer seeks to prevent Respondent-Applicant from appropriating and registering the mark ANCOM (STYLIZED) which is confusingly similar to its mark LANCOME.

"10. The Opposer has used the mark LANCOME in the Philippines and elsewhere prior to the filing of the application subject of this opposition. The Opposer continues to use the mark LANCOME in the Philippines and in numerous other countries worldwide."

The Opposer's evidence consists of the following:

1. Exh. "A" - Copy of the legalized Verified Notice of Opposition;
2. Exh. "B" - Copy of the Affidavit of Jose Monteiro, the Opposer's Chief Trademark Counsel;
3. Exh. "C" - Copy of the Affidavit of Ms. Peregrina L. Malacad, Scientific and Technico-Regulatory Affairs Director of L'Oreal Philippines, Inc. which is the authorized importer and distributor of Lancome cosmetic products in the Philippines;
4. Exh. "D", and series"- Copies of various marketing materials used in the Philippines and worldwide to promote the Lancome cosmetic products;
5. Exh. "E" - Copy of the certified true copy of Canadian Cert. of Reg. No. TMA 323,205;
6. Exh. "F" - Copy of the certified true copy of French Cert. of Reg. No. 1,557.084;
7. Exh. "G" - Copy of the certified true copy of Hongkong Cert. of Reg. No. 19570375;
8. Exh. "H" - Copy of the certified true copy of Irish Cert. of Reg. No. 42828;
9. Exh. "I" - Copy of the certified true copy of New Zealand Cert. of Reg. No. 77386;
10. Exh. "J" - Copy of the certified true copy of South African Cert. of Reg. No. 1947/00559;

11. Exh. "J" - Copy of the certified true copy of U.S. Cert. of Reg. No. 425,129;
12. Exh. "L" - Copy of the certified true copy of U.S. Kingdom Cert. of Reg. No. 655072;
13. Exh. "M" - Copy of the certified true copy of Phil. Cert. of Reg. No. 19328;
14. Exh. "N" - Copy of the certified true copy of Phil. Cert. of Reg. No. 54821;
15. Exh. "O" - Copy of the certified true copy of Phil. Cert. of Reg. No. 4-1997-125374;
16. Exh. "P" - Copy of the certified true copy of Phil. Cert. of Reg. No. 4-1994-98676;
17. Exh. "Q" - Copy of the Certificate signed by Mr. Odile Roujol, the Opposer's President, Attesting to the authority of Jose Monteiro to execute the verification and certification of non-forum shopping and authorizing the undersigned to represent the Opposer in opposition case;
18. Exh. "R" - Certified true copy of the IPO Decision in IPC No. 14-2008-00320; and
19. Exh. "S" - Copy of the Affidavit of Pregrina L. Malacad, the Scientific and Technico-Regulatory Affairs Director of L'Oreal Philippines, Inc. which is the authorized importer and distributor of Lancome cosmetic products in the Philippines.

This Bureau issued on 29 June 2010 a Notice to Answer, a copy of which was served upon the Respondent-Applicant on 21 July 2010. However, the Respondent-Applicant did not file the required Verified Answer. Hence, the instant case was deemed submitted for decision based on the Verified Notice of Opposition and evidence submitted by the Opposer.

Res judicata, also known as bar by prior judgment, means that a final order or judgment on the merits, rendered by a court having jurisdiction of the subject matter and of the parties, is conclusive in a subsequent case between the parties and their successor-in-interest by title subsequent to the commencement of the action or special proceeding, litigating for the same thing and under the same title and in the same capacity. The requisites essential for the application of the principle are: (1) the former judgment or order is final; (2) it must be a judgment or order on the merits, that is, it was rendered after a consideration of the evidence or stipulations submitted by the parties at the trial of the case; (3) it must have been rendered by a court having jurisdiction over the subject matter and the parties; and (4) there must be, between the first and second actions, identity of parties, subject matter and causes of action. In this particular instance, there is no dispute as regards the existence of all the requisites of *res judicata*.

A scrutiny of the records and evidence shows that there is reason or basis to apply the principle of *res judicata* in this case. The decided case cited by the Opposer (IPC No. 14-2008-00320) involved the same parties, the same subject matter which is the trademark ANCOM (STYLIZED), and the same issue of whether or not there is confusing similarity between the marks "LAMCOME" and "ANCOM". In its Decision No. 2009-169, dated 15 December 2009, this Bureau found and concluded that the marks "LANCOME" and "ANCOM" are confusingly similar, to wit:

"A perusal of the marks show that both words contain five identical literal elements. The only difference is that the opposer's mark begins with the letter 'L' and ends with the letter 'E'. When pronounced, the words sound very similar except that opposer's mark begins with the letter 'L'. The presence of the letter 'E' at the end of the word LANCOME does not create any difference in the way the last syllable of both marks are pronounced. 'COME' and 'COM' are phonetically alike.

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The dominant part of opposer's mark is (the) trademark itself, LANCOME which the respondent-applicant appropriated because all of the literal elements of its mark were copied from opposer's mark.

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In view thereof, opposer will be damaged by the use by respondent-applicants' use of the mark ANCOME for goods in Class 3. Furthermore, it is observed that respondent-applicant's in their application also included the term "cosmetics" under their application for Class 5, namely pharmaceutical preparations, therefore, the same is considered elated goods under Class 3 as the same can lead to confusion as to the affiliation of the goods.

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WHEREFORE, premises considered, the opposition filed by Lancome Parfums Et Beaute & Cie, with respect to Class 3, namely 'cosmetics' and Class 5 namely 'pharmaceutical preparations namely herbal food supplement, pharmaceutical products for slimming purposes, pharmaceutical tests, herbal food supplement, cosmetics, health foods and drinks' is, as it is, hereby SUSTAINED."


The above-cited decision has become final and executory.

Accordingly, this Bureau finds no cogent reason to depart from the cited decision.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2009-005733 be returned, together with a copy of this Decision, to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 16 February 2012.


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

