



ABBOT LABORATORIES,
Opposer,

-versus-

VINCENT S. CHAN,
Respondent-Applicant.

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}
} IPC No. 14-2011-00365
} Opposition to:
} Appl. Serial No. 4-2010-013859
} Date filed: 21 Dec. 2010
} TM: "Eye Q"

NOTICE OF DECISION

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VINCENT S. CHAN
Respondent-Applicant
286 Lara Street San Nicolas
Manila

GREETINGS:

Please be informed that Decision No. 2012 - 144 dated August 10, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 10, 2012.

For the Director:


Atty. RAUST U. SAPAK
Hearing Officer, BLA

CERTIFIED TRUE COPY

SHARON S. ALCANTARA
Records Officer II
Bureau of Legal Affairs, IPO



ABBOT LABORATORIES,
Opposer,

IPC No. 14-2011-00365

Opposition to:

- versus -

Appln. Serial No. 4-2010-013859

(Filing Date: 21 Dec. 2010)

Trademark: "Eye Q"

VINCENT S. CHAN

Respondent-Applicant.

Decision No. 2012- 144

X-----X

DECISION

ABBOTT LABORATORIES, ("Opposer")¹ filed on 13 October 2011 an opposition to Trademark Application Serial No. 4-2010-013859. The application, filed by VINCENT S. CHAN ("Respondent-Applicant")², covers the mark "Eye Q" for use on "*pencils, crayon, water and poster color, rulers scissors, punchers, staplers, templates, artist brush, chalk, coloring paint, sharpeners, pens, adhesive, fastener, expanding file, paper clips, stamp pad, plastic material for packaging, blades, staple wire, dater, numbering machine*" under Class 16 of the International Classification of goods.³

The Opposer alleges, among other things that it is the first user and owner of the mark "EYE Q" and the first registrant thereof in the Philippines. According to the Opposer, the Respondent-Applicant's mark "Eye Q" is confusingly similar to its registered mark in many countries of the world including in the Philippines. The Opposer thus, claims that the Respondent-Applicant's mark runs contrary to the provisions of Section 123.1, paragraphs (d) to (g) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code").

In support of its opposition, the Opposer submitted as evidence the Verified Notice of Opposition; affidavit of Elisa M. Valenzona; table showing the details of the Opposer's trademark applications and registrations for EYE Q marks worldwide; representative copies of the registrations for EYE Q in various jurisdictions around the world; copies of the Opposer's annual reports for the year 2008 to 2010; samples of promotional materials, catalogues, articles, advertisements, studies, letters, screen shots, awards and other evidence of extensive promotion and reputation of the EYE Q mark worldwide; and Secretary's Certificate and Special Power of Attorney.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 09 November 2011. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant's trademark application for the mark Eye Q be allowed?

¹ A corporation organized under the laws of the State of Illinois, United States of America, with principal place of business at Abott Park, Illinois 60064, United States of America.

² With address at 286 Lara Street, San Nicolas, Manila, Philippines.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

⁴ Marked as Exhibits "A" to "G".

The Opposer anchors its case on Sec. 123.1, pars. (d) to (g), of the IP Code, 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 constitutes 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 of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use;

(g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;

In this regard, records show that at the time the Respondent-Applicant filed its trademark application on 21 December 2010, the Opposer already has several registrations in the Philippines for the mark EYE Q and variations thereof, the earliest of which is Reg. No. 4-2003-011151 (issued on 20 November 2005). There is also no doubt that the Respondent-Applicant's mark "Eye Q" is identical to the Opposer's mark.

However, the Opposer's trademark registrations cover goods under Class 5. These goods are not the same and/or closely related to the goods covered by the Respondent-Applicant's trademark application. Sec. 123.1 (e) of the IP Code therefore is not applicable. Neither is the application proscribed under pars. (d), (f) and (g) of Sec.123.1. The resemblance between the subject marks is not likely to deceive or to cause confusion, or to mislead the public.

Goods falling under Class 05 includes

"Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides".

On the other hand, those under Class 16 are the following:

“Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artist's materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type printing blocks.”

Obviously, there is no commonality between the two classes of goods in terms of composition, purpose and/or use. A consumer would find them on different and separate outlets, locations, or stores.

Hence, it is inconceivable for a consumer looking to procure or buy the Opposer's products, to be deceived or to commit mistake by purchasing the Respondent-Applicant's products instead, and *vice-versa*. Corollarily, it is unlikely that the consumer who purposely looked for and/or bought the Respondent-Applicant's product will think or be reminded of the Opposer's mark.

There is simply no reason to believe that the Respondent-Applicant's use of the mark Eye-Q would indicate a connection between its goods and the Opposer's. There is no evidence or indication that the Opposer has ventured or intends to venture into the business or producing goods under Class 16. Its trademark registrations in the Philippines all cover goods under Class 5. The possibility of the Opposer incurring damage in this instance, therefore, is very remote.

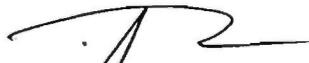
With the foregoing findings and conclusions, there is no need to dwell on the issue of whether the Opposer's mark is a well-known mark. The protection accorded to well-known marks applies only in cases when there is confusing similarity between the competing marks. In this case, there is none.

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 This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE, premises considered, the opposition is hereby **DISMISSED**. Let the file wrapper of Trademark Application Serial No. 4-2010-013859 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 10 August 2012.


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

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