



BAUSCH & LOMB INCORPORATED,
Petitioner,

-versus-

ROMAN TIU,
Respondent- Registrant.

X-----X

} **IPC No. 14-2010-00126**
} Cancellation of:
} Reg. No. 4-2009-002384
} Date Issued: 26 November 2009
} **TM: "BIO BLUE (Stylized)"**

NOTICE OF DECISION

HECHANOVA BUGAY & VILCHEZ
Counsel for the Petitioner
G/F Chemphil Building
851 Antonio Arnaiz Avenue, Makati City

PALARAN & PARTNERS LAW OFFICES
Counsel for Respondent-Registrant
Suite 601-A State Center Bldg.,
333 Juan Luna Street
Binondo, Manila

GREETINGS:

Please be informed that Decision No. 2013 - 184 dated September 10, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 10, 2013.

For the Director:

ATTY. PAUSI U. SAPAK
Bureau of Legal Affairs



BAUSCH & LOMB INCORPORATED,
Petitioner,

IPC No. 14-2010-00126
Case Filed: 24 June 2010

-versus-

Cancellation of:
Reg. No.: 4-2009-002384
Date Issued: 26 November 2009

ROMAN TIU,
Respondent-Registrant.

Title: "BIO BLUE (Stylized)"

X-----X

Decision No. 2013- 184

DECISION

BAUSCH & LOMB INCORPORATED ("Petitioner")¹ filed on 24 June 2010 a petition to cancel Reg. No. 4-2009-002384 issued on 26 November 2009 to ROMAN TIU ("Respondent-Registrant")², covering the mark "BIO BLUE" for use on ophthalmic solution under Class 5 of the International Classification of Goods and Services³. The Petitioner alleges among other things that the registration of the mark "BIO BLUE" in the name of Respondent-Registrant contravenes and violates Section 123.1 paragraphs (d), (e), (f) and (g), of Rep. Act No.8293, also known as the Intellectual Property Code of the Philippines ("IP Code") because said mark is confusingly similar to Petitioner's earlier filed and registered "BIOTRUE" owned, used and not abandoned by the Petitioner as to be likely when applied to or used in connection with the goods of Respondent-Registrant to cause confusion or mistake, or deceive the purchasers thereof as to the origin of the goods.

To support its Petition, the Petitioner submitted the following:

1. Exhibits "A" to "A-3" – Special Power of Attorney;
2. Exhibit "B" – Certified true copy of Cert. of Reg. No. 4-2009-000897 for the mark BIOTRUE;
3. Exhibits "C" to "C-111" – Affidavit Direct Testimony of John F. La Fave, the Vice President and Assistant Secretary of Bausch & Lomb Incorporated wherein he attests to the aforementioned registrations and applications filed and obtained for the mark BIOTRUE in many countries of the world; and

¹ A corporation duly organized and existing under the laws of New York State, United States of America, with principal address at One Bausch & Lomb Place, Rochester, New York, 14606, U.S.A.

² An individual with address at 647 Paterno St., Quiapo, Manila.

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. Exhibit "D" – Notarized affidavit executed by Atty. Chrissie Ann L. Barredo, wherein she identifies print outs from the Petitioner's website which contain information on the Petitioner's corporate history and products.

On 13 October 2010, the Respondent-Registrant filed his Verified Answer denying all the material allegations of the Petition and argued that his mark "BIO-BLUE" is not confusingly similar with the Petitioner's mark "BIOTRUE". Further, Respondent-Registrant claims that he is the prior and actual user of the mark "BIO BLUE" which is being sold as early as 2008 compared to the Petitioner's "BIOTRUE" which is not even available in the Philippine market.

Respondent-Registrant's evidence consists of the following:

1. Exhibit "1" – Trademark Cert. of Reg. No. 42009002384 of the Respondent-Registrant;
2. Exhibit "2" with sub-markings – Affidavit executed by Ms. Buena Blas, Legal Secretary of the Respondent's counsel;
3. Exhibit "2-A" – Printouts from Petitioner's website showing that the only product of the Petitioner with tradename "BIOTRUE" is Biotrue Multi-Purpose Solution;
4. Exhibits "2-B" and "2-C" – Search in the internet reveals news articles which show that Biotrue Multipurpose Solution was only launched in the United States in June 2010 and will be available within Europe only in October 2010;
5. Exhibit "3" – Affidavit of Merly Beriso;
6. Exhibit "3-A" – Sales Invoice No. 44474 dated 06 February 2008 of I.O.S. issued to Dr. Cromwel Maglinao;
7. Exhibit "4" – Affidavit of Dr. Mamiko Pascual; and
8. Exhibit "4-A" – Affidavit of Dr. Ana R. Cruz-Pe.

The Preliminary Conference was conducted and terminated on 22 November 2010. Then after, the Petitioner submitted its Position Paper on 27 January 2011 while the Respondent-Registrant did so on 7 February 2011.

Section 151.1 of the IP Code provides:

Section 151. Cancellation. - 151.1. A petition to cancel a registration of a mark under this Act may be filed with the Bureau of Legal Affairs by any person who believes that he is or will be damaged by the registration of a mark under this Act as follows:

(a) Within five (5) years from the date of the registration of the mark under this Act.

(b) At any time, if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of this Act, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or

to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

(c) At any time, if the registered owner of the mark without legitimate reason fails to use the mark within the Philippines, or to cause it to be used in the Philippines by virtue of a license during an uninterrupted period of three (3) years or longer.

This provision allows any person to file a petition to cancel a trademark registration at any time if that person believes that he will be damaged by the registration. Once filed, the cancellation proceeding becomes, basically, a review of the trademark registration in question to see if the legal requirements for registration have been satisfied and if the maintenance or continuance of Respondent-Registrant's trademark in the principal register would damage the Petitioner.⁴

Should the Respondent-Registrant's trademark registration be cancelled?

It is emphasized that the essence of trademark registration is to give protection to the owner of the 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 products⁵. Thus, Sec. 123.1 (d) of 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.

Records show that Petitioner's Trademark Reg. No. 4-2009-000897 covers pharmaceutical preparations namely "disinfectants, ophthalmic pharmaceutical preparation vitamin and mineral supplements; contact lens solutions; eye drops" under Class 5 of the International Classification of Goods and Services⁶. The Petitioner's goods therefore are similar and/or closely related to the goods indicated in the Respondent-Registrant's Certificate of Trademark Registration.

But, are the competing marks resemble each other such that confusion, even deception is likely to occur? Jurisprudence says that a practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of the prospective buyer. The trademark complained should be compared and contracted with purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some factors such as sound; color; idea connoted by the

⁴ Section 154 of the IP Code provides:

"Section 154. *Cancellation of Registration.*-If the Bureau of Legal Affairs finds that a case of cancellation has been made out, it shall order the cancellation of registration. When the order or judgment becomes final, any right conferred upon the registrant or any person in interest of record shall terminate. Notice of cancellation shall be published in the IPO Gazette. (Section 19, R.A. No. 166a)

⁵ Prithdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999.

⁶ Exhibit "B".

mark; the meaning; spelling and pronunciation of the words used; and the setting in which the words appear may be considered for indeed, trademark infringement is a form of unfair competition⁷.

The competing marks are reproduced for comparison and scrutiny:

BIOTRUE

BIO-BLUE

Petitioner's Mark

Respondent-Registrant's Mark

The only difference between the composition of the Petitioner's mark and that of the Respondent-Registrant's is with respect to the fourth and fifth letters ("-TR-" as against "-BL-"). This does not negate, however, the likelihood of confusion. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or 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 other⁸. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article⁹.

Sound is sufficient ground to rule that two competing marks are confusingly similar. In the *Marvex Commercial Co., Inc. vs. Petra Hawpia & Co. and the Director of Patents*¹⁰, the Supreme Court categorically ruled:

Two letters of "SALONPAS" are missing in "LIONPAS": the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance (Co Tiong Sa vs. Director of Patents, 95 Phil. 1, citing Nims, The Law of Unfair Competition and Trademarks, 4th ed., Vol. 2, pp. 678-679). The importance of this rule is emphasized by the increase of radio advertising in which we are deprived of the help of our eyes and must depend entirely on the ear (Operators, Inc. vs. Director of Patents, supra).

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, Vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jass-Sea"; "Silver Flash" and "Supper Flash"; "Cascarete" and "Celborite"; "Celluloid" and "Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo". Leon Amdur, in his book "Trade-Mark Law and Practice", pp. 419-421, cites, as coming within the purview of the idem sonans rule, "Yusea" and "U-C-A", "Steinway Pianos" and "Steinberg

⁷ Clarke v. Manila Candy Co. 036 Phil. 100, Co Tiong S.A. v. Director of Patents, 95 Phil. 1, 4.

⁸ Societe Des Produits Nestle, S.A v. Court of Appeals, G.R. No.112012, 4 April 2001, 356 SCRA 207, 217.

⁹ Emerald Garment Manufacturing Corp. v. Court of Appeals. G.R. No. 100098, 29 Dec. 1995.

¹⁰ G.R. No. L-19297, 22 December 1966.

Pianos", and "Seven-Up" and "Lemon-Up". In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Cordura" are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin", as the sound of the two names is almost the same.

In the case at bar, "SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (see *Celanese Corporation of America vs. E. I. Du Pont*, 154 F. 2d. 146, 148).

Aptly, because the competing marks are used on similar and/or closely related goods, the difference and/or the slight variance will not diminish the likelihood of the occurrence of mistake, confusion, or even deception. Consumers will likely assume that the Respondent-Registrant's mark is just a variation of the Petitioner's and/or the goods and services originate or provided by one party alone, or the parties are connected or associated with one another which in fact there is none. The likelihood of confusion subsists not only on the purchaser's perception of the goods but on the origin thereof as held by the Supreme Court¹¹.

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

In this regard, the records and evidence points to the Petitioner as the one, as between the parties, who first filed a trademark application and obtained trademark registration. The Petitioner filed the application on 27 January 2009 while the Respondent-Registrant was able to do so only on 06 March 2009. Also, the Petitioner secured registration on 23 July 2009, four months ahead of the Respondent-Registrant (26 November 2009). The Respondent-Registrant's mark therefore, being confusingly similar to the Petitioner, should not have been registered pursuant to Sec. 123.1(d) of the IP Code.

WHEREFORE, premises considered, the instant Petition for Cancellation is hereby **GRANTED**. Let the filewrapper of Trademark Registration No. 4-2009-002384 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 10 September 2013.


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

¹¹ *Converse Rubber Corp. v. Universal Rubber Products, Inc. et.al.* G.R. No. L-27906, 08 Jan. 1987.