CHANEL SARL., Opposer, **-versus-** **GOLDEN ABC, INC.,** Respondent-Applicant.	}	**IPC No. 14-2009-00234** Opposition to: Appln. Serial No. 4-2007-006611 Filing Date: 26 June 2007 **TM: "LURE"**

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 20 dated January 31, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 31, 2013.

For the Director:

Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs

CHANEL SARL,
Opposer,

- versus -

GOLDEN ABC, INC.,
Respondent-Applicant.
x----------x

IPC No. 14-2009-00234
Opposition to:

Appln. Serial No. 4-2007-006611
(Filing Date: 26 June 2007)
TM: "LURE"

Decision No. 2013- 20

DECISION

CHANEL SARL ("Opposer")[1] filed on 05 October 2009 an opposition to Trademark Application Serial No. 4-2007-006611. The application, filed by GOLDEN ABC, INC. ("Respondent-Applicant")[2], covers the mark "LURE" for use on "*perfumery products namely, perfumes (roll-on and/or spray), colognes, toilet water and toilet lotions, shampoos, soaps, lathering and softening products for use in baths, toothpaste, cosmetics, make-up, lipstick, toilet products against perspiration, hair dyes, hair gels, powder and nail polish*" under Class 3 of the International Classification of goods[3].

The Opposer alleges, among other things, that LURE is confusingly similar to its registered trademark ALLURE which is protected under Sections 123.1 and 147 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code").

On 17 December 2009, the Respondent-Applicant filed its Answer alleging, among other things, that there is no confusing similarity as the two marks are not identical. According to the Respondent-Applicant, ALLURE is always used in conjunction with the main/mother marks "CHANEL" as against LURE which is always used together with the mark "OXYGEN". The Respondent-Applicant also contends that consumers will not be confused because of the disparity between the price ranges of the ALLURE and LURE goods.

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

It is emphasized that the essence of the trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; to secure to him who has been instrumental in bringing into the market a superior article of merchandise; the fruit of hi, 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 article as his product[4].Sec. 123.1 of the IP Code provides thatprovides 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 is nearly resembles such a mark as to be likely to deceive or cause confusion

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1 A corporation organized under the laws of Switzerland with business address at Burgstrasse 26, CH-8750 Glaris, Switzerland

2 A corporation organized and existing under the laws of the Philippines with business address at LPHI Center, No. 880 A.S. Fortuna St., Banilad, Mandaue City, Cebu.

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

Records show that at the time the Respondent-Applicant filed its trademark application on 26 June 2007, the Opposer has an existing registration for the mark ALLURE (Reg. No. 4-1004-93271 issued on 23 June 2000)[5]. The Opposer's registration covers "*soaps, perfumery, essential oils, hair lotions; dentifrices, cosmetics, namely: foundation, powder, blush, rouge, eye shadow, eye liner, eyebrow pencil, mascara, lipstick, lip gloss, lip liner, lip balm, nail polish, nail polish remover*" under Class 3. There is no doubt that these goods are similar and/or closely related to those indicated in the Respondent-Applicant's trademark application.

The issue to be resolved then is: Is LURE closely resembles ALLURE to cause confusion or even deception?

The only difference between the marks is that the Respondent-Applicant removed from ALLURE the first two letters ("AL"). This notwithstanding, the marks are still visually and aurally similar.

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 other[6]. 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 article[7].

Succinctly, because the Respondent-Applicant will use or uses the mark LURE on goods that are similar and/or closely related to those covered by the Opposer's registered trademark, the changes in the spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. ALLURE and LURE produce identical sounds which make it not easy for one to distinguish one mark from the other. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound, however, is practically replicated when one pronounces the Respondent-Applicant's mark.

Moreover, ALLURE as used by the Opposer is a unique and distinctive trademark. ALLURE and LURE, however, practically mean the same, i.e. to attract or entice or tempt[8]. There is the likelihood that information, assessment, perception or impression about LURE products delivered and conveyed through words and sounds and received by the ears may unfairly cast upon or attributed to the ALLURE products and the Opposer, and *vice-versa*.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. 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,

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5 Marked as Exhibit "D" for the Opposer.

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

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

8 Ref.: http://thefreedictionary.com/p/lure citing The American Heritage Dictionary of the English Language Fourth Edition copyright 2000 Updated in 2009 and the Collins English Dictionary-Complete and Unabridged Harper Collins Publishers, 1991, 1994, 1998, 2000, 2003.

that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.[9] The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:[10]

> 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.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2007-006611 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 31 January 2013.

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

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[9] *American Wire and Cable Co. v. Director of Patents et al.*, (31 SCRA 544) G.R. No. L-26557, 18 Feb. 1970.
[10] *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.