



HEARST COMMUNICATIONS, INC.,  
Opposer,

-versus-

BARGN FARMACEUTICI PHILS. CO.,  
Respondent- Applicant.

X-----X

IPC No. 14-2009-00034

Opposition to:

Appln. Serial No. 4-2008-008854

Filing Date: 23 July 2008

TM: "ARE YOU COSMO ENOUGH"

### NOTICE OF DECISION

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#### GREETINGS:

Please be informed that Decision No. 2013 - 62 dated April 10, 2013 ( copy enclosed) was promulgated in the above entitled case.

Taguig City, April 10, 2013.

For the Director:

*Edwin A. Daling*  
ATTY. EDWIN DANILO A. DALING  
Director III  
Bureau of Legal Affairs

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Decision No. 2013- 62

## DECISION

HEARST COMMUNICATIONS INC. ("Opposer")<sup>1</sup> filed on 30 January 2009 an opposition to Trademark Application Serial No. 4-2008-008854. The application, filed by BARGN FARMACEUTICI PHILS. CO. ("Respondent-Applicant")<sup>2</sup>, covers the mark "ARE YOU COSMO ENOUGH?" for use on "food supplement" under Class 05 of the International Classification of Goods<sup>3</sup>. The Opposer alleges, among other things, the following:

"1. Opposer is a company primarily engaged in the business of publishing, selling and distribution of magazines and similar publications. Opposer is the first to adopt and use the 'COSMO', 'COSMOPOLITAN' and derivative marks (hereinafter referred to as 'COSMO' trademarks) for its goods under international classes 9, 14, 16, 18, 25, 38 and 41 in the Philippines and other countries worldwide.

"2. There is likelihood of confusion between the Opposer's trademarks 'COSMO' covering goods under international classes 9, 14, 16, 18, 25, 38 and 41 and Respondent-Applicant's trademark 'ARE YOU COSMO ENOUGH?', because the latter is identical to and closely resembles Opposer's trademarks in appearance, spelling, sound, meaning and connotation.

"3. The Opposer's 'COSMO' trademarks are well-known internationally and in the Philippines, taking into account the knowledge of the relevant sector of the public, rather than the public at large, as being trademarks owned by the Opposer. There is no doubt therefore, that the Respondent-Applicant intends to ride on the popularity and goodwill of Opposer's 'COSMO' trademarks in adopting and using the trademark 'ARE YOU COSMO ENOUGH?' as such use would indicate a connection between such goods and those of the Opposer's. Thus, the interests of the Opposer are likely to be damaged by Respondent-Applicant's use of the trademark 'ARE YOU COSMO ENOUGH?'.

"4. The Respondent-Applicant, by using 'ARE YOU COSMO ENOUGH?' as its trademark for goods which are identical and/or related to those of the Opposer's, has given its products the

<sup>1</sup> A corporation organized and existing under the laws of State of Delaware, USA with principal office at 959 Eight Avenue New York 10019, USA.

<sup>2</sup> A partnership organized and existing under the laws of the Philippines with business address at Unit 702, The One Executive Office Bldg. #5 West Avenue, Quezon City.

<sup>3</sup> 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.

general appearance of the products of the Opposer, which would be likely to influence purchasers to believe that the 'ARE YOU COSMO ENOUGH?' products are of the Opposer's, thereby deceiving the public and defrauding the Opposer of its legitimate trade hence, Respondent-Applicant is guilty of unfair competition as provided in Section 168.3 of R.A. No. 8293.

"5. Respondent-Applicant, in adopting the trademark 'ARE YOU COSMO ENOUGH?' for its products is likely to cause confusion, mistake, or deception as regards its affiliation, connection, or association with the Opposer, or as to the origin, sponsorship, or approval of its products by the Opposer, for which it is liable for false designation or origin, false description or representation under Section 169 of R.A. No. 8293."

To support its opposition, the Opposer submitted as evidence<sup>4</sup> copies of certificates of trademark registration in the Philippines, list of registrations of its marks in different countries worldwide, sales of products bearing its marks by country covering the period from 1996-2002 and 2007, representative samples of its promotional and advertising materials, copies of foreign decisions pertaining to marks, list of magazines international editions, actual labels, receipts/invoices, and a compact disc containing sample foreign certificates of registration and data on use worldwide of marks.

The Respondent-Applicant filed its Answer on 16 July 2009, alleging among other things, the following:

"14. Opposer has neither legal nor factual basis for its claim that it will be damaged by the approval of the trademark application for the mark ARE YOU COSMO ENOUGH? bearing Application Serial No. 4-2008008854 filed on 23 July 2008.

"15. On 26 February 2008 the Articles of Partnership of Bargn Farmaceutici Phils. Inc., herein respondent, were duly registered with the Securities and Exchange Commission with the primary purpose to: engage in, conduct and carry on the business of buying, selling, distributing, marketing at wholesale/retail insofar as may be permitted by law, all kinds of goods, commodities, wares and merchandise of every kind and description such as but not limited to pharmaceuticals; to act as manufacturers, representative, commission merchant, factors or agents, relative thereto.

"16. Respondent's partners conceptualized the subject mark COSMO from the Greek word 'kosmo', meaning a combining form, meaning 'world', or 'universe'. Respondent as a manufacturer of food supplements among them glutathione, L-Carnitine, green tea extract and grape seed extract products (food supplement, among others) directs and caters its beautifying and age defying products to the women of the world and to all the missus of the universe. Thus, the phrase/question ARE YOU COSMO ENOUGH? trademark was born, asking the modern woman if she is one of the 'missus' of the universe ever mindful of the beautifying products available today.

"17. The goods of the respondent – food supplements – were already part of the primary purposes when respondent Bargn Farmaceutici was established.

"18. As above stated, food supplements are goods listed under Class 05 for which opposer has no certificate of registration for the mark Cosmopolitan. Opposer's Cosmopolitan trademarks are registered under different Classes, namely: Classes 9, 14, 16, 18, 24, 25, 36 and 38. Even assuming that the dominant syllable of the opposer's mark is COSMO, and therefore dominantly the same as that of the respondent, this Honorable Office should be guided by the allowance of parallel registration of the same mark, as time and again held by the Supreme Court in many cases,

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<sup>4</sup> Exhibits "A" to "H" of the Verified Notice of Opposition.



among them:

"19. In Shell company of the Philippines vs. Court of Appeals (G.R. No. L-49145, 21 May 1979), x x x.

"20. In Esso Standard Eastern, Inc. vs. Court of Appeals (116 SCRA 336 (1982)), x x x.

"21. In Canon Kabushiki Kaisha vs. Court of Appeals and NSR Rubber Corporation (336 SCRA 266 (200)), x x x.

"22. To emphasize, opposer's cosmopolitan trademarks is registered under Classes 9, 14, 16, 18, 24, 25, 36 and 38 while respondent seeks registration of the ARE YOU COSMO ENOUGH trademark for food supplements under Class 05. Thus, opposer's exclusive right to use its Cosmopolitan trademarks is limited to goods and services falling under Classes 9, 14, 16, 18, 24, 25, 36 and 38 as specified in its Certificates of Registration as well as to goods or services that are related thereto, which DO NOT include respondent's applied goods (food supplements).

"23. The fact that opposer's trademark is registered for products under a different Class cannot be used as prohibition for applicant to use it for an entirely different products/goods because Section 147 of the Intellectual Property Code is very clear on what rights are conferred during the registration by stating that the owner of a registered mark shall have exclusive right to prevent all third parties not having the consent from using in the course of trade identical and similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion shall be presumed.

"24. Even assuming that respondent's ARE YOU COSMO ENOUGH? mark is similar to that of opposer's Cosmopolitan trademarks, a relevant question begs for an answer: Are the goods related? We respectfully submit in the negative.

"25. Respondent's goods are food supplements, specifically, glutathione, L-Carnitine, green tea extract and grape seed extract products while that of opposer's main goods are magazines and/or publications. Food supplements are, to repeat, under Class 05 while magazines and publications are under Class 16, thus, by way of Nice Classification alone, the goods are not related. The non-relatedness of the parties' goods can be further shown by the fact that the goods are sold in different portions of a store or mall. Food supplements being sold in the drug or pharmacy/medicine area while magazines are sold in the office or school section.

"26. Parallel registration of the same mark is even allowed by the Supreme Court in goods falling under the same Class as long as the subject goods are not related.

"27. In Acoje Mining Co., Inc., vs. Director of Patents (38 SCRA 480), x x x.

"28. In Philippine Refining Co., Inc., vs. Ng Sam and Director of Patents (115 SCRA 472 (1982)), x x x.

"29. In Hickok Manufacturing Co., Inc. vs. Court of Appeals and Santos Lim Bun Liong (116 SCRA 388 (1982)), x x x.

"30. In view of the non-relatedness of respondent's goods to that of opposer, such imagined likelihood of confusion (whether as to the origin/source or upon the public) have no factual basis. Otherwise, the ARE YOU COSMO ENOUGH? mark should not have passed the examination stage and allowed publication if relatedness of the goods were found.

"31. The validity of the above jurisprudence can be shown by the issuance of the BOT-IPO of at least nine (9) Certificates of Registration for the mark COSMO either alone or in combination

with another word, as detailed in the attached Affidavit herein.

"32. In Esso (supra), Supreme Court ruled that: x x x

"33. There is no truth to the claim that opposer's Cosmo trademarks are well-known internationally and in the Philippines for the simple reason that opposer's mark is NOT COSMO but rather Cosmopolitan, Cosmopolitan Channel, Cosmogirl and Cosmopolitan Television. The evidence of the opposer is the best evidence for this statement. There is no 'COSMO' trademark listed in Exhibits A and series of the opposer. In the Exhibit B and series of the opposer referring to international registrations, only six (6) Certificates of Registration appear to list COSMO as the registered mark in as much countries, the other forty nine (49) certificates clearly states Cosmopolitan NOT COSMO.

"34. How can the opposer validly claim international notoriety for six (6) international registrations? Or as a locally well-known mark for ZERO registration of the mark COSMO?

"35. Exhibit C and series of the opposer are summary sales reports of opposer's magazines which only proves international notoriety at most, for Class 16 (publications/magazines) and not in any other Classes. On the other hand, Exhibit D and series are representative samples of opposer's publications as well as promotional items which again only proves international notoriety, at most, in the area of the publishing world.

"36. Opposer will not be damaged by the subject trademark application because of the following elementary rule: principle that Certificate of Registration confers upon the trademark owner the exclusive right to use its own symbol only to those goods or services as specified in the certificate, and those that are related thereto.

"37. The goods of the respondent are not related to the opposer's goods, hence, the favorable foreign decisions (Exhibit E and series) obtained by the opposer in another jurisdiction referring to goods and services related to that of opposer's goods and services cannot apply before this Honorable Office.

"38. The Affidavit (as well as its Exhibits) of Mr. Nino Bautista, Managing Partner of the respondent is herein attached to prove the foregoing allegations."

The Respondent-Applicant's evidence consists of the Affidavit of the Respondent-Applicant's "Managing Partner" Nino Bautista and the attachments thereto:

1. Articles of Partnership the Respondent-Applicant with the Securities and Exchange Commission;
2. certificates of product registration issued by the Bureau of Food and Drugs;
3. representative samples of labeled boxes and packaging;
4. sales invoices;
5. photographs of booths and kiosks in malls;
6. various advertisements in different media;
7. photographs of promotional activities; and
8. copies of registrations in the Philippines for the marks "COSMO" and "COSMOS" in favor of other proprietors.<sup>5</sup>

A preliminary conference was conducted and eventually terminated on 18 February 2010. Then after, the Opposer filed its position paper on 05 April 2010 while the Respondent-Applicant did so on 16 April 2010.

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<sup>5</sup> Marked as Exhibit "1" to "78".