



**HUGO BOSS TRADE MARK  
MANAGEMENT GMBH & CO. KG.,**  
Opposer,

**-versus-**

**GERALDINE G. ANGGALA,**  
Respondent –Applicant.

X-----X

} **IPC No. 14-2012-00552**  
} **Opposition to:**  
} **Appln. Serial No. 4-2012-006635**  
} **Date Filed: 04 June 2012**  
} **TM: ELEMENTS WITH A**  
} **STYLIZED LETTER "E"**

**NOTICE OF DECISION**

**QUISUMBING TORRES**  
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**GERALDINE G. ANGGALA**  
Respondent-Applicant  
Gaisano Towers, Carlos Palanca St.  
Quiapo, Manila

**GREETINGS:**

Please be informed that Decision No. 2014 - 52 dated February 25, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 25, 2014.

For the Director:

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



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**IPC No. 14-2012-00552**  
Opposition to Trademark  
Application No. 4-2012-006635  
Date Filed: 04 June 2012  
Trademark: **"ELEMENTS WITH  
A STYLIZED LETTER 'E'"**

Decision No. 2014- 52

### DECISION

Hugo Boss Trade Mark Management GMBH & Co. KG<sup>1</sup> ("Opposer") filed on 11 February 2013 an opposition to Trademark Application Serial No. 4-2012-006635. The contested application, filed by Geraldine G. Anggala<sup>2</sup> (Respondent-Applicant), covers the mark "ELEMENTS WITH A STYLIZED LETTER 'E'" for use on "*cosmetics*" under Class 03 of the International Classification of Goods<sup>3</sup>.

Opposer maintains that it is the first user and owner of the well-known marks "ELEMENT", "ELEMENTS" and other trademarks containing the word "ELEMENT" or "ELEMENTS". In the Philippines, its mark "ELEMENT" is registered under Certificate of Registration No. 4-2008-008118 issued on 27 October 2008 for use on "*soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices*" under Class 03. Thus, it avers that the Registration of Respondent-Applicant's mark is contrary to the provisions of Section 123.1 paragraphs (d), (e) and (f) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code")<sup>4</sup>.

<sup>1</sup> A corporation organized under the laws of Germany and now domiciled and having its principal place of business in Dieselstrasse 12, D-72555 Metzingen, Germany.

<sup>2</sup> With address at Gaisano Towers, Carlos Palanca St., Quiapo, Manila, Philippines.

<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.

<sup>4</sup>Section 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

**Republic of the Philippines**

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Opposer further claims that its "ELEMENT" trademarks are well-known and world-famous as its marks have been registered and/or applied for registration in various trademark registries worldwide such as Germany, Colombia, Indonesia, Malaysia, Singapore, Thailand and Vietnam, among others in connection with goods under Class 03. It avers that it first launched its mark globally between February and April 2009. It also asserts that its company and its licensee, Procter & Gamble International Operations SA, have extensively promoted its products. It thus contends that Respondent-Applicant's use of the contested mark will cause the purchasers to believe that the latter's goods are associated with, produced by, emanate from or are under its sponsorship; or at the very least, will take advantage of, dilute the goodwill and diminish the distinctive character or reputation of its marks.

In support of its allegations, the Opposer submitted the Affidavit of its authorized representative, Camile Choppin<sup>5</sup>, with attachments<sup>6</sup>.

This Bureau served a Notice to Answer on 25 March 2013 to Respondent-Applicant. The Respondent-Applicant, however, did not file an Answer prompting the Hearing Officer to issue Order No. 2013-1130 on 13 August 2013 declaring him in default and submitting the case for decision.

The issue to be resolved is whether Respondent-Applicant's mark "ELEMENTS WITH A STYLIZED LETTER 'E'" should be allowed registration.

Prefatorily, it is emphasized that 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.<sup>7</sup>

Records reveal that at the time Respondent-Applicant filed an application for registration of the mark "ELEMENTS WITH A STYLIZED LETTER

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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; X X X"

<sup>5</sup> Marked as Exhibit "D".

<sup>6</sup> Marked as Exhibits "D-1" to "D-6".

<sup>7</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

'E'" on 04 June 2012, Opposer has valid and existing registration its mark "ELEMENT" issued on 27 October 2008.

Now, to determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the competing marks are depicted below for comparison:

**ELEMENT**      **ELEMENTS**

*Opposer's marks*

*Respondent-Applicant's mark*

A perusal of the competing marks will show that they are indeed confusingly similar as both appropriate the word "element". Neither the stylized letter "e" nor the addition of the letter "s" in Respondent-Applicant's mark is sufficient to eradicate the probability of confusion. Visually and aurally, it is easy to mistake one for the other in view of their close resemblance. After all, 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 an ordinary purchaser as to cause him to purchase the one supposing it to be the other.<sup>8</sup> Noteworthy, the Supreme Court held in **Acoje Mining Co., Inc. vs. The Director of Patents**<sup>9</sup> that:

*"In the language of Justice J. B. L. Reyes, who spoke for the Court in American Wire & Cable Co. v. Director of Patents: 'It is clear from the above-quoted provision that the determinative factor in a contest involving registration of trade mark is not whether the challenging mark would actually cause confusion or deception of the purchasers but whether the use of such mark would likely cause confusion or mistake on the part of the buying public. x x x'"*

Moreover, Opposer's registration also covers cosmetics, which are precisely the kind of products in which Respondent-Applicant intends to use its applied mark. Thus, it is highly probable that the purchasers would be led to believe that Respondent-Applicant's mark is a mere variation of or is associated to Opposer's mark. Withal, the protection of trademarks as intellectual property is intended not only to preserve the goodwill and reputation of the business

<sup>8</sup> Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

<sup>9</sup> G.R. No. L-28744, 29 April 1971.

established on the goods bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods.<sup>10</sup>

Succinctly, the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."<sup>11</sup>

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code, which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor with an earlier filing or priority date, with respect to the same or closely related goods or services, or has a resemblance to such mark as to likely deceive or cause confusion.<sup>12</sup>

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-006635 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 25 February 2014.

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

<sup>10</sup> Skechers, USA, Inc. vs. Inter Pacific Industrial Trading Corp., G.R. No. 164321, 23 March 2011.

<sup>11</sup> Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

<sup>12</sup> Great White Shark Enterprises vs. Danilo M. Caralde, Jr., G.R. No. 192294, 21 November 2012.