



MANDOM CORPORATION,  
Opposer,

-versus-

MARIBEL A. GALINDEZ,  
Respondent-Applicant.

X-----X

} IPC No. 14-2008-00154  
} Opposition to:  
} Appln. Serial No. 4-2006-012508  
} Date Filed: 20 November 2006  
} Trademark: "LUCIDA-DS"

### NOTICE OF DECISION

#### E.B. ASTUDILLO & ASSOCIATES

Counsel for Opposer  
10<sup>th</sup> Floor, Citibank Center  
8741 Paseo de Roxas Avenue  
Makati City

#### PADLAN SALVADOR COLOMA & ASSOCIATES


Counsel for Respondent-Applicant  
Suite 307, 3<sup>rd</sup> Floor, ITC Building  
337 Sen. Gil Puyat Avenue  
Makati City

#### GREETINGS:

Please be informed that Decision No. 2012 - 163 dated August 31, 2012 ( copy enclosed) was promulgated in the above entitled case.

Taguig City, August 31, 2012.

For the Director:

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



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TM: "LUCIDA - DS"

Decision No. 2012- 163

## DECISION

MANDOM CORPORATION ("Opposer")<sup>1</sup>, filed on 24 March 2008 an Opposition to Trademark Application No. 4-2006-012308. The application filed by MARIBEL A. GALINDEZ ("Respondent-Applicant")<sup>2</sup>, covers the mark "LUCIDA-DS" for use on "*real white cream, foaming gel, toner, sunblock, anti-oxidant, cosmetics and food supplement*" under Class 30 of the International Classification of goods<sup>3</sup>. The Opposer alleges the following:

"1. Opposer is the owner of and/or registrant of and/or applicant in many trademark registrations and/or applications of the trademark LUCIDO-L around the world under International Class 3.

"2. In the Philippines, Opposer was previously an owner/registrant of the trademark LUCIDO-L, as follows:

|                |   |
|----------------|---|
| Trademark      | : LUCIDO-L                                    |
| Certificate of |   |
| Regn. No.      | : 4-2003-000271                               |
| Date Issued    | : November 30, 2005                           |
| Registrant     | : Mandom Corporation                          |
| Goods          | : soaps, perfumery, cosmetics and dentrifices |
| Class          | : 3   |

"3. Opposer is also an applicant for registration of the trademark LUCIDO-L, as follows:

|                |   |
|----------------|---|
| Trademark      | : LUCIDO-L  |
| Certificate of |   |
| Regn. No.      | : 4-2006-007782   |
| Date Filed     | : July 18, 2006   |
| Registrant     | : Mandom Corporation  |
| Goods          | : perfumes, aromatics, air freshener, cosmetics, namely, eau de cologne, essential oils, deodorants, hair remover, pomade, hair lotion, hair conditioner, hair setting foam and gel, hair color preparations, hair bleaches, face wash foam, skin lotion, skin milk, skin cream, lipstick and lip color preparations, antiperspirant, shampoo, soaps, dentrifices; non-medicated bath |

<sup>1</sup> A corporation organized and existing under the laws of Japan with business address at 5-12, Juniken-cho, Chuo-ku, Osaka, Japan.

<sup>2</sup> A Filipino with business address at United Shelter Health Products, Unit 903-A West Tower, Tektite Exchange Road, Ortigas Center, Pasig 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.

preparations, namely, bath liquid, bath gel, bath powder, bath salt and bath tablet.

Class : 3

"4. By virtue of Opposer's prior registration and application of the trademark LUCIDO-L in the Philippines and its prior application and/or registration and ownership of this trademark around the world, said trademark has therefore become distinctive of Opposer's goods and business.

"5. The mark LUCIDA-DS is confusingly similar to Opposer's mark LUCIDO-L for the following reasons:

a.) Both marks have common five letters, L-U-C-I-D. The different sixth letter, i.e., O for opposer's mark and "A for Respondent-Applicant's mark, does not sufficiently create a distinction. As the word LUCIDO is the dominant feature in Opposer's mark LUCIDO-L, the presence of the word LUCIDA in the mark LUCIDA-DS results in confusion or deception.

b.) Under the dominancy test applied in Philippine trademark cases to determine confusing similarity, confusion is presumed when the prevalent, essential or dominant features of a mark is copied or duplicated. Clearly, the presence of the word LUCIDA in the mark LUCIDA-DS is a reproduction of the dominant feature of the mark LUCIDO-L which results in confusion or deception.

c.) Moreover, both marks contain hyphen (-) after the main word followed by an additional letter or letters. Hence, there is more chance that the consuming public will confuse the mark LUCIDO-L with LUCIDA-DS. The two (2) marks are therefore practically similar in pronunciation, sound and appearance such that the public will almost surely confuse one with the other.

d.) Significantly, both marks cover similar or related goods such that confusion is likely to arise as to the source of goods of each respective mark. The mark LUCIDO-L covers goods under International Class 3 while the mark LUCIDA-DS also covers goods under International Class 3.

Opposer's mark covers:

*Perfumes, aromatics, air freshener, cosmetics, namely, eau de cologne, essential oils, deodorants, hair remover, pomade, hair lotion, hair conditioner, hair setting foam and gel, hair color preparations, hair bleaches, face wash foam, skin lotion, skin milk, skin cream, lipstick and lip color preparations, antiperspirant, shampoo, soaps, dentrifices; non-medicated bath preparations, namely, bath liquid, bath gel, bath powder, bath salt and bath tablet.*

While the Respondent-Applicant's mark covers:

*Real white cream, foaming gel, toner, sunblock, anti-oxidant, cosmetics.*

Hence, the potential confusion on the consuming public is greater.

e.) The goods bearing both marks being found and sold in the same channels of business and trade, an ordinary and/or casual purchaser buying under normal prevalent conditions in trade is not expected to exercise a careful scrutiny between two (2) products bearing confusingly similar trademarks as in Opposer's trademark LUCIDO-L vis-à-vis Respondent-Applicant's trademark LUCIDA-DS and will most likely be confused and deceived to buy one product for the other.

"6. By adopting the confusingly similar mark LUCIDA-DS for exactly the same goods that Mandom Corporation is internationally known for it, it is obvious that Respondent-Applicant's intention is to 'ride-on' the goodwill of Mandom Corporation and "pass-off" its as those of Mandom Corporation.

"7. A boundless choice of words, phrases and symbols are available to a person who wishes to have a trademark sufficient unto itself to distinguish his product from those of others. There is no reasonable explanation therefore for Respondent-Applicant to choose the mark LUCIDA-DS especially to include the word LUCIDA to designate exactly the same kind of goods for which Opposer's trademark LUCIDO-L is

already known for, when the field for its selection is so broad. Respondent-Applicant obviously intends to trade and is trading on Opposer's goodwill.

"8. The registration and use of the trademark LUCIDA-DS by Respondent-Applicant will deceive and/or confuse purchasers into believing that Respondent-Applicant's goods and/or products bearing the trademark LUCIDA-DS emanate from or are under the sponsorship of Opposer Mandom Corporation, owner/registrant of the trademark LUCIDO-L. This will therefore diminish the distinctiveness and dilute the goodwill of opposer's trademark.

"9. The allowance of Application Serial No. 4-2006-012508 in the name of Respondent-Applicant will be in violation of the treaty obligations of the Philippines under the Paris Convention for the Protection of Industrial Property, to which the Philippines and Japan are member-states."

The Opposer's evidence consists of the following:

1. Affidavit-Testimony of the witness, Motonobu Nishimura;
2. signature of witness, Motonobu Nishimura;
3. certified copies of Japanese trademark registrations for LUCIDO and variations thereof (Nos. 2361470, 4436263, 465108 and 4810012), and for LUCIDO-L and variation thereof (Nos. 4836995 and 5096044);
4. certified copies of registration for the mark LUCIDO-L in South Korea (No. 0576937), Singapore (No. T02/17492B), Hong Kong (No. 1997B1607), Thailand (No. Kor188889), Vietnam (No. 52144), and United States of America (No. 2866127);
5. copies of registration certificates from U.A.E, Brunei, Brazil, China, France, Hongkong, Iran, Italy, South Korea, Malaysia, Philippines, Paraguay, Romania, Russia, Singapore, Thailand, Turkey, U.S.A., Uruguay and Vietnam for the marks LUCIDO and LUCIDO-L;
6. annual Sales Figure in Japan, Sales Figure and Advertisement Expenditure (Overseas), and Sales Volume (Overseas) from 1993-2004 for LUCIDO-L products;
7. copies of invoices showing export of LUCIDO-L products to Thailand;
8. copies of pages of advertisements of LUCIDO-L in several international magazines; and
9. copies of the its Annual reports for the years 2005, 2006 and 2007 and 2008<sup>4</sup>.

The Respondent-Applicant filed its Answer on 05 January 2009, alleging among other things, the following:

#### SPECIAL AND AFFIRMATIVE DEFENSES

"4. Opposer has no valid cause of action against the respondent.

"5. The mark LUCIDA-DS of the herein respondent is **visually and phonetically different** from the LUCIDO-L mark of the opposer. The adoption of the letters **A** and **DS** in respondent's LUCIDA-DS mark makes the respondent's mark distinctive/substantially dissimilar from the opposer's LUCIDO-L mark.

"6. Respondent submits that the letter **O** in opposer's mark and the letter **A** in the respondent's mark create a substantial dissimilarity in the meaning and character of the contending marks. The **dissimilarity** created by the adoption of these two letters in the parties' respective marks is such that it renders the "dominancy" test invoked by the opposer inapplicable.

"7. The mark LUCIDA was derived from the Latin term LUCIDUS which means, clear, sane, luminous, transparent or translucent. Respondent adopted the word LUCIDA instead of LUCIDUS to highlight the kind of the products for which the subject marks is to be used, i.e., whitening products and the intended users thereof which are women. Since the intended products are whitening products and the target users are

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<sup>4</sup> Exhibits "A" to "Q", inclusive.

women, respondent found it suitable and appealing to use LUCIDA to give a feminine character of the mark.

“8. Even assuming that LUCIDA implies the **masculine gender** of the term **lucid** or simply a name of a man and that LUCIDA implies the **feminine gender** of the term **lucid** or simply a name of a woman, these facts alone are more than sufficient to justify respondent’s claim that her mark is highly distinctive from the opposer’s mark since any ordinary buyer can readily distinguish a male from a female gender.

“9. Opposer cannot claim that the mark LUCIDA is the feminine version of its LUCIDO mark because by its own admission opposer came out with the LUCIDO-L as its trademark for LUCIDO feminine cosmetic products.

“10. The **DS** component in the respondent’s mark and the **L** component in the opposer’s mark certainly add distinctiveness to the parties’ respective mark.

“11. The registrability of the respondent’s LUCIDA-DS mark has been resolved by no less than the Bureau of Trademarks when the latter after conducting substantive examination allowed the application. The records of respondent’s LUCIDA-DS application show that during its substantive examination the Honorable Bureau did not even bother to cite the existing registrations of opposer’s LUCIDO-L mark notwithstanding that parties’ marks belong to the same Class 3 goods. This only officially confirms that respondent’s LUCIDA-DS mark and opposer’s LUCIDO-L mark are not confusingly similar.

“12. Opposer cannot claim protection under Section 123.1 (d) of R.A. 8293 (the Intellectual Property Code of the Philippines) on the ground that respondent’s mark is not identical of confusingly similar with the opposer’s mark.

“13. Opposer likewise cannot claim protection under Section 123.1 (e) on the ground that respondent’s LUCIDO-L mark is not an internationally well-known mark. The documentary evidence presented by the opposer consisting of foreign registrations, advertisements materials, sales and promotional figures are insufficient to prove that LUCIDO-L is an internationally known mark. As a matter of fact how can opposer claim that its LUCIDO-L mark is known internationally if by its own evidence (Exhibits ‘M’ and ‘N’) it had long abandoned the use of the mark LUCIDO in the Philippines since 2003 or for more than five (5) years now and that from 2004 up to the present opposer had sold and advertised its LUCIDO products only in Singapore, Taiwan, Hongkong, South Korea, Malaysia, Thailand and China.

“14. Further, opposer cannot claim protection under 6bis of the Convention of Paris for the Protection of Industrial Property on the grounds that respondent’s mark is not identical nor confusingly similar with the opposer’s mark and that opposer’s mark is not a well-known mark.

“15. Respondent has been using the trademark LUCIDA-DS openly, extensively, and continuously for food supplement, particularly for glutathione preparations and for whitening soap, lotion, cream and gel from October 2004 up to the present. She has tremendously promoting the LUCIDA-DS product in television, print and broadcast media, magazines, giant billboards, internet and by sponsorships. Through out the said period of use/sales and with all the promotions made, respondent never received nor heard even a single complain or comment from the buying public of any incident of actual or possible confusion between the LUCIDO-L and the LUCIDA-DS trademarks. Thus, opposer’s claim that respondent’s use of the trademark LUCIDA-DS is likely to deceive or cause confusion is more of opposer’s imagination than for real.

“16. Respondent adopted in good faith the trademark LUCIDA-DS without any reference to the LUCIDO-L trademark of the opposer nor does respondent had the slightest to ride on the alleged goodwill or popularity of the opposer’s mark when It decided to adopt LUCIDA-DS as her trademark.”

The Respondent-Applicant’s evidence consists of the following:

1. Affidavit of Maribel A. Galindez;
2. Certificate of Business Name Registration of United Shelter Health Products;
3. BFAD License to Operate as Food Distributor, Importer and Exporter LTO No. RDI-MM FE/E-2264;
4. BFAD Cert. of Product Registration for LUCIDA-DS (No. FR-59456);
5. sample of LUCIDA –DS Glutathione packaging material;

6. sample of LUCIDA-DS Glutathione Grapeseed Oil Extract packaging material;
7. samples of LUCIDA-DS Glutathione soap packaging materials;
8. samples of Glutathione toner and creams bearing the trademark LUCIDA;
9. a copy of page G-FOUR of the 09 Oct. 2004 publication of the Manila Bulletin;
10. copies of United Shelter Invoices showing sales of LUCIDA-DS products to Mercury drug and Watsons drug stores;
11. samples of LUCIDA-DS advertisements in newspapers, magazines, products brochures, roving billboards, sponsorships, posters, tarpaulins, gondolas and products jingles/songs;
12. list of LUCIDA-DS cable/television shows and CD and copies of the shows; and
13. lists and pictures of LUCIDA-DS giant billboards displayed in Luzon, Visayas and Mindanao<sup>5</sup>

Should the Respondent-Applicant be allowed to register the mark LUCIDA-DS?

It is emphasized that the essence of 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 his industry and skill; to assure to 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 products.<sup>6</sup> Thus, Sec. 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("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.

In this regard, the records show that at the time the Respondent-Applicant filed her application for the registration of the mark LUCIDA-DS on 20 November 2006, the Opposer has an existing application for the registration of the mark LUCIDO-L (No.4-2006-007782). The said application was allowed and a certificate of registration was issued in favor of the Opposer on 30 July 2007. While the competing marks, as shown below, are not exactly identical, their resemblance to each other is likely to deceive or cause confusion or mistake:

**LUCIDO-L**

*Opposer's mark*

*Lucida-DS*

*Respondent-Applicant's mark*

The goods covered by the Opposer's trademark registration and/or application are similar and/or closely related to those indicated in the Respondent-Applicant's, and which reach or are accessible to the consumers through the same or common market channels.

<sup>5</sup> Exhibits "1" to "10", inclusive.

<sup>6</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 115508, 19 Nov. 1999.

Because of this, the differences in the font styles and in the letters after "LUCID" have become of no consequence. Aptly, 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 ingenious imitation as to be calculated to deceive ordinary persons, or such resemblance to original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.<sup>7</sup>

To this Bureau, changing "O - L" to "A - DS" (after "LUCID") failed to eliminate the likelihood of confusion or even deception. Aside from the fact that both marks start with and are substantially comprised of the word "LUCID", the "construction" of the mark LUCIDA - DS followed that of LUCIDO - L, i.e. a six-letter word followed by a hyphen and additional letter(s). Thus, it is likely that the consumers will have the impression that one mark is just a variation of the other. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:<sup>8</sup>

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 instant Opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2006-012508 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

**SO ORDERED.**

Taguig City, 31 August 2012.

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

<sup>7</sup> *Societe Des Produits Nestle, S.A. v. Court of Appeals*, G.R. 112012, 4 April 2011, SCRA 207, 217.

<sup>8</sup> *Converse Rubber Corporation v. Universal Products Inc. et. al.*, G.R. No. L-27906, 08 Jan. 1987.