



NGO YET TE,
Opposer,

-versus-

THE PROCTER & GAMBLE COMPANY,
Respondent-Applicant.

X-----X

} IPC No. 14-2009-00167
} Opposition to:
} Appln. Serial No. 4-2008-013139
} Date filed: 24 October 2008
} TM: "SOAK-WASHED"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 – 195 dated September 28, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 28, 2012.

For the Director:

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



NGO YET TE,
Opposer,

-versus-

THE PROCTER & GAMBLE COMPANY,
Respondent-Applicant,

X-----X

IPC NO. 14-2009-000167

Opposition to:
App. Ser. No. 4-2008-013139
Date Filed: 24 October 2008
TM: "SOAK-WASHED"

Decision No. 2012- 195

DECISION

NGO YET TE ("Opposer"), Chairman and President of WELLMAN MANUFACTURING, INC.¹, filed on 08 July 2009 an opposition to Trademark Application Serial No. 4-2008-013139. The application, filed by THE PROCTER & GAMBLE COMPANY ("Respondent-Applicant")², covers the mark "SOAK-WASHED" for use on "*washing preparations for laundry use, bleaching preparations for laundry use, detergents for laundry use, fabric softeners for laundry use, soaps*" under Class 03, and "*laundry services, cleaning of clothing, dry cleaning services*" under Class 37 of the International Classification of goods³.

The Opposer alleges that the mark "SOAK-WASHED" applied by the Respondent-Applicant for registration is merely the English translation of the Opposer's registered "BABAD" mark. Thus, the subject application should be rejected under the doctrine of equivalents. The Opposer also claims:

"1. The Opposer, since the year 1981, has been engaged in the manufacturing and selling laundry detergent bars, cleansing and washing detergent bar and powder, detergent powder, laundry soap, bleaching preparations, cleaning preparations, laundry preparations, laundry bleach and washing preparations, fabric conditioners and other laundry products. Among the Opposer's known marks is 'SPEED' and its many variants.

"2. As early as April 2008, the Opposer used the 'BABAD' mark on its products. On April 11, 2008, the Opposer filed an application for registration of BABAD as a trademark for Class 3 for the following products: laundry soap, toilet soap, dishwashing soap, detergent bar, detergent powder, bleaching preparations, cleaning preparations, laundry preparations, laundry bleach, and

¹ A corporation existing and duly incorporated under the laws of the Philippines with principal office address at 32 Engracio Street, Marulas, Valenzuela City, Metro Manila,

² A corporation existing and incorporated under the laws of the State of Ohio, U.S.A. with address at One Procter & Gamble Plaza, Cincinnati, Ohio, U.S.A.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

washing preparations. It was subsequently granted registration on August 25, 2008. 'BABAD' is a Tagalog word which means 'SOAK'.

"3. Since its adoption in the middle of the year 2008 and its continued use in commerce up to the present day, the 'BABAD' trademark has been developed and extensively advertised by the Opposer in the Philippines. One of 'BABAD's' famous endorsers is popular TV and movie actor Piolo Pascual.

"4. The Opposer is filing this Opposition against the registration of the subject mark on the ground that it creates confusion of origin, source and business-causing injury and damage on the 'BABAD' trademark. The Opposer is entitled to the preservation of the valuable link between it and the public that has been created by its adoption and use of the 'BABAD' trademark on its business and products by restraining the use by the Opposer of a confusingly-similar mark."

This Bureau issued on 27 July 2009 a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 19 August 2009. The Respondent-Applicant filed on 14 September 2009 a Motion for Extension (to file Answer) which this Bureau granted per Order No. 2009-1424. The extension notwithstanding, the Respondent-Applicant still failed to file its Answer. Accordingly, this Bureau issued on 24 February 2010 Order No. 2010-286 stating, among other things, that the Respondent-Applicant has waived its right to file the answer and the case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the mark SOAK-WASHED?

Records show that at the time the Respondent-Applicant filed its trademark application on 24 October 2008, the Opposer has an existing trademark registration for the mark BABAD (Reg. No. 4-2008-004143). The goods covered by the Opposer's trademark registration are similar and/or closely related to the goods indicated in the Respondent-Applicant's trademark application.

Obviously, the competing marks are not identical. In this regard, this Bureau noticed that the Opposer did not even cite the provision of the IP Code on which its opposition is based. It simply argues that SOAK-WASHED is the English equivalent or translation of the *tagalog* word "*babad*" and then cites the so-called "Doctrine of Foreign Equivalents" under the "Trademark Manual of Examining Procedure of the United States Patent and Trademark Office". Of course, this Bureau is not bound to follow or to apply the cited foreign doctrine in this case.

The provisions in the IP Code that explicitly state the prohibition against the registration of a mark which constitutes a translation of another mark, are paragraphs (e) and (f) of Sec.123.1 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). These provisions, however, refer to protection accorded to well-known marks. The Opposer does not claim that its mark BABAD is a well-known mark.

Nevertheless, it is emphasized that the fundamental principle and legal basis of trademark registration is that the owner of the trademark has the right to register it. The

essence of trademark registration is to give protection to the owners of trademarks. The function of 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 or 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.⁴ In this regard, Sec. 123.1(d) of the IP Code provides that a mark shall not be registered if 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.

Corollarily, jurisprudence says factors such as sound; appearance; form; style shape; size or format; color, idea, connoted by the mark; the meaning, spelling and pronunciation of the words used; and the setting in which the words appear may be considered, in passing upon the issue of confusing similarity.⁵ Thus, finding commonality on the meaning or ideas conveyed by two marks may well be within the scope of Sec. 123.1(d) of the IP Code.

In this regard, the “street-level” connotation of the word “*babad*” is broad. The word “*babad*” is more than a physical state, for it could mean immersion or devotion. It cannot be denied, however, that technically, the word “soak” is the English translation of the word “*babad*”.⁶ The identity of meaning, concept or idea conveyed by the words, is enhanced when these words are utilized as trademarks for laundry soaps and related products.

Furthermore, it must be emphasized that an opposition proceeding is basically a review of the trademark application in question, precisely, to determine if the requirements under the law are met. Sec. 123.1(j) of the IP Code provides that a trademark shall not be registered if it:

(j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of services, or other characteristics of the goods or services. (Emphasis supplied)

SOAK-WASHED tells the public the purpose of the goods. As indicated in the trademark application, the mark is used for “*washing preparations for laundry use, bleaching preparations for laundry use, detergents for laundry use, fabric softeners for laundry use, soaps*”. One does not need any imaginative thinking about the product bearing the words or mark SOAK-WASHED. “Soak” or “soaking” is the process of becoming softened and saturated as a consequence of being immersed in water or liquid; it is washing something by allowing it to soak.⁷

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filer wrapper of Trademark Application Serial No. 4-2008-013139 be

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

⁵ *Clark v. Manila Candy Co.*, 36 Phil. 100, 106.

⁶ Reference/Source: <http://www.tagalogtranslate.com> and <http://tagaloglang.com>

⁷ Reference/Source: <http://www.thefreedictionary.com>.

returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 28 September 2012.



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