



PADI'S POINT, INC.,
Opposer,

-versus-

JOHNSON & JOHNSON,
Respondent-Applicant.

X-----X

IPC No. 14-2011-00473
Opposition to:
Appln. Serial No. 4-2011-005149
Date filed: 05 May 2011
TM: "TARA NA, MAGBIYAHE TAYO"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 - 197 dated October 11, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 11, 2012.

For the Director:

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



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Decision No. 2012- 197

DECISION

PADI'S POINT, INC. ("Opposer")¹ filed on 19 December 2011 an opposition to Trademark Application Serial No. 4-2011-00473. The application, filed by JOHNSON & JOHNSON ("Respondent-Applicant")² covers the mark "TARA NA, MAGBIYAHE TAYO" for use on "*advertisement, slogan, tagline*", under Class 35 of the International Classification³.

The Opposer anchors its opposition on the ground that TARA NA, MAGBIYAHE TAYO is confusingly similar to its registered mark "TARA NA". According to the Opposer, the registration of the mark TARA NA, MAGBIYAHE TAYO is proscribed by Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). To support its opposition, the Opposer submitted the affidavit of its President Vicente A. Padilla, Jr., a certified copy of Cert. of Reg. No. 4-2001-007398 for the mark TARA NA, and a summary of photographs of recent merchandising items bearing the mark TARA NA.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 17 January 2012. However, the Respondent-Applicant did not file an Answer. Thus, the Hearing Officer issued Order No. 2012-941 declaring the Respondent-Applicant in default and the case deemed submitted for decision.

It is emphasized that the essence of trademark registration is to give protection to the owner of the 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 manufacture against and sale of an inferior and different article of his products.⁵ Thus, Sec. 123.1 (d) of the IP Code provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a

¹ A corporation organized and existing under the laws of the Philippines, with business address at 291 P. Guevarra Avenue, San Juan, Metro Manila.

² A corporation organized and existing under the laws of the United States of America (U.S.A.) with business address at One Johnson & Johnson Plaza, New Brunswick, New Jersey 08933, 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.

⁴ Marked as Exhibits "A" to "C", inclusive.

⁵ See *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114509, 19 Nov. 1999.

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.

Records show that at the time the Respondent-Applicant filed its trademark application on 05 May 2011 the Opposer has an existing registration for the mark TARA NA under Reg. No. 4-2001-007398 issued on 05 August 2004. This registration covers various goods and services under classes 16, 18, 25, 28, 29, 30, 32, 33, 41 and 42.

In this regard, this Bureau finds merit in the Opposer's assertions, to wit:

"29. It maybe argued that no confusing similarity can arise because the classes of goods in connection with which the contending marks are used, are different, i.e., Class35 for the subject TARA NA, MAGBIYAHE TAYO; and Classes 16, 18, 25, 28, 29, 30, 32, 33, 41 and 42 for TARA NA.

"30. However, the dissimilarity is more imagined than real.

"31. Class 35 essentially covers advertising, meaning, Respondent-Applicant will use TARA NA, MAGBIYAHE TAYO in promotional and advertising materials, which clearly is entirely similar to the essence of TARA NA of Opposer as a tagline trademark.

"32. It must be underscored that Opposer's TARA NA is a tagline trademark, the essence of which is precisely to advertise and entice customers to try Opposer's PADI's POINT restaurant. Indeed, the history of TARA NA is that it is catchy tagline that successfully advertised the business of Mr. Padilla.

"33. This is underscored by the fact that TARA NA has since been used by Opposer in several advertising media like streamers, tarpaulins, banners, flyers, signages, markers and has also been heard on the radio. It also appears on the internet, which undoubtedly, is a huge medium for advertising. Evidence proving the use of TARA NA in advertising will be attached to an Affidavit that will be submitted together with this Verified Notice of Opposition.

"34. Indeed, the contending trademarks will be used for the same activity or services, in this case, the advertising and promotion of the contending parties' goods and services."⁶

On whether a mark utilized by one party as advertisement, slogan or tagline is confusingly similar to a mark used by another party also as a tagline, it is important to determine or establish the goods or services involved. Aptly, confusion is likely if the goods or services advertised or promoted by one party are similar or related to those belonging to the other party.

In this instance, the Opposer's trademark registration covers various goods, products, merchandise and services. The Respondent-Applicant's trademark application, on the other hand, does not indicate or specify the goods or services on which TARA NA, MAGBIYAHE TAYO will be used as a tagline. It must be emphasized that the Respondent-Applicant was given the opportunity to defend its trademark application and explain its side. However, the Respondent-Applicant did not file an Answer to the opposition.

Thus, without explicit limitation in respect of goods or services, the Respondent-Applicant, if allowed to register TARA NA, MAGBIYAHE TAYO will be able to use the mark as a tagline on any goods or services. If it uses the mark on goods or services covered by the Opposer's trademark registration, the likelihood of confusion therefore arises.

⁶ Verified Notice of Opposition, pp. 12-13.

Comparing the mark applied for registration by the Respondent Applicant to the registered mark of the Opposer's, the only difference between the two are the words "MAGBIYAHE TAYO". These additional words in the Respondent-Applicant's applied mark, however, fail to give the mark a character visual and aural character or properties that are sufficiently distinct from the Opposer's. Consumers may even assume that one mark is just a variation of the other and/or there is a connection between the two and/or the parties themselves, when in fact there is none. The use of only one of the words comprising a trademark may be sufficient to constitute an infringement, and it is unnecessary to this end that all the words of the composite mark be appropriated.

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 other⁷. 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, 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.⁸

Accordingly, this Bureau finds that the registration of the mark TARA NA, MAGBIYAHE TAYO in favor of the Respondent-Applicant is within the prohibition imposed 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. 4-2011-005149 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 11 October 2012.


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

⁷ See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 April 2001, 356 SCRA 207, 217.

⁸ See *American Wire and Cable Co. v. Director of Patents et al.*, (31 SCRA 544) G.R. No. 1-26557, 18 Feb. 1970.