



SEBAPHARMA GMBH & CO.,
Opposer,

-versus-

CIDORE HOLDING LIMITED,
Respondent- Applicant.

}
}
}
}
}
}
}
}
}

IPC No. 14-2009-00059
Opposition to:
Appln. Serial No. 4-2007-012929
Date Filed: 21 November 2007
TM: "SEWAME PARIS
CHINESE CHARACTERS &
DEVICE"

X-----X

NOTICE OF DECISION

**ORTEGA, DEL CASTILLO, BACORRO
ODULIO, CALMA & CARBONELL**
Counsel for the Opposer
5th & 6th Floor, ALPAP I Building
140 L.P. Leviste St., Salcedo Village
Makati City

NICOLAS & DE VEGA LAW OFFICES
Counsel for Respondent-Applicant
Unit 101, One Primrose Place
No. 663 Boni Avenue, Mandaluyong City

GREETINGS:

Please be informed that Decision No. 2014 - 114 dated April 22, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 22, 2014.

For the Director:

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



SEBAPHARMA GMBH & CO.,
Opposer,

-versus-

CIDORE HOLDING LIMITED,
Respondent-Applicant.

} **IPC NO. 14-2009-00059**

} Opposition to:

}

} Appln. Ser. No. 4-2007-012929

} Date Filed: 21 November 2007

}

} Trademark: **SEWAME PARIS**

} **CHINESE CHARACTERS &**

} **DEVICE**

x-----x } Decision No. 2014- 114

DECISION

SEBAPHARMA GMBH & CO, (Opposer)¹ filed on 21 November 2007 an opposition to Trademark Application Serial No. 4-2007-012929. The application, filed by **CIDORE HOLDING LIMITED**. (Respondent-Applicant)², covers the mark “SEWAME PARIS CHINESE CHARACTERS & DEVICE”, for use on “Bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations; soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, cleaning preparations for skin, facial cleansing milk, facial cleansing soap, facial cleansing cr em, bath liquid, preparations for use in shower bath, preparations for the care and protection of the skin [not for medical use], non-medicated preparation for massage, deodorant preparations for personal use, anti-perspirant for personal use [cosmetics], non-medicated preparations for protection and care of the skin, pore astringent creams, anti-wrinkle creams [cosmetics], preparations for keratosis removal, non-medicated body powder, preparations for age spot reduction, preparations for whitening the skin, skin and body masks, sunscreen and sunblock preparations (cosmetics), body massage oils, body massage creams, preparations for care of bust [cosmetics], bust beautifying and firming cream, care products [cosmetics], aromatic liquid for personal use, products for babies skin care, non-medicated preparations for care of the eyes, eye masks, eye treatment, eye creams for firming skin around eyes, non-medicated acne care preparations, acne removing preparations, cosmetic for eye make-up, essences for cosmetic purposes, lip stick, preparations for care of lips, make-up removers, cosmetic preparations for slimming purposes, cosmetic preparations for skin care, products of make-up, non-medicated preparations for care of hair, hair shampoos, hair cleansing preparations, hair cleansing gels, hair conditioners, oils for the care of hair, oils for the regeneration of hair, scalp treatment preparations, hair preservation

¹ A corporation organized and existing under the laws of Germany with address at D-56154 Boppard, Federal Republic of Germany

² A company incorporated under the laws of China with address at P.O. Box. 957, Offshore Incorporations Centre, Road Town, Tortola, British Virgin islands

preparations, hair preservation for hair waving, preparations for hair colouring, non-medicated preparations for use in oral hygiene, preparations for cleaning teeth, non-medicated preparations for care of hands, hand treatment preparations, cosmetic preparations for nails, anti-bacterial and anti-microbial sterilizing hand wash composition, anti-bacterial hand lotion, anti-bacterial soap, non-medicated preparations for care of foot, hair removal preparations, shave creams, preparations for use before shaving” under Class 3 of the International Classification of Goods³.

The Opposer invokes Sec. 123.1 (d), (e) and (f) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”) which provide:

Sec. 123.1. Registrability. A mark cannot be registered if it:

- (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 with 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 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 and services which are not similar to those with respect to which registration is applied for: *Provided*, that the use of the mark in relation to the 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.”

According to the Opposer, it is the owner of the mark SEBAMED which was registered with the Intellectual Property Office under Certificate of Registration No. 4-

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

2000-002630⁴ dated 16 October 2006, covering goods under classes 3, namely: “cosmetic oils, essential oils, dentrifices, shampoos, cosmetic preparations for cleansing and care of the skin, the hair, the lips, cosmetic preparation for the external application for skin diseases, products for baby care, namely baby cleansing bars, baby foam baths, baby care baths, baby skin creams , skin care oils, tissues impregnated with cosmetic oils, lotions, moist tissues and shampoos for children, preparations for cleansing and care of the body, facial cleansers and facial care products in liquid and solid form, in the form of lotions, creams, gels, aquaeous, alcoholic solutions, deodorants for personal use, bath extracts in the basis of the officinal plants and/or herbs for cosmetic purposes, preparations and skin care in the form of lotions, creams and gels, after sun skin balms, after sun sprays, cosmetic shower oils” and class 4, namely: “Medicines for the treatment of skin diseases, chemical, pharmaceutical and veterinary products for medical, sanitary and hygienic purposes specifically for treatment of skin diseases, pharmaceutical preparations for skin diseases, namely skin cleansers, being a pharmaceutical preparation for skin disease in the form of a special product for seborrhoeic conditions and microbial dermatoses (solid, liquid, as lotion, cream, shampoo), medicinal creams for children, bath extracts on the basis of officinal plants and/or herbs for pharmaceutical purposes.” It alleges that the Respondent-Applicant’s mark is confusingly similar to its SEBAMED mark and is used on closely related goods. The Opposer alleges that it used the SEBAMED mark in the numerous countries and continues to use its mark in the Philippines. It extensively promoted its mark worldwide in various media including television commercials, outdoor advertisements and print publications.

To support its opposition, the Opposer submitted as evidence the following:

1. Verified Opposition dated 16 December 2008;
2. Verification and Certification dated 16 December 2008;
3. Secretary’s certificate authorizing Thomas Maurer to issue a Power of Attorney;
4. Special Power of Attorney;
5. Affidavit of Thomas Maurer;
6. Certified copy of trade name registration and Commercial Register A of County Koblenz of SEBAMED in Germany;
7. Copy of Certificate of Registration of the mark SEBAMED in the following countries namely: Germany, Indonesia, Australia, New Zealand and Singapore;
8. Sample of Invoices of the year 2007, 2008;
9. Estimated sales figures of SEBAMED;
10. Products, catalogs and advertisement of SEBAMED;
11. Invoices from the Philippines for SEBAMED;
12. Notarized Affidavit of Aileen V. Sicat;
13. Copy of Certificate of Registration No. 4-2000-002630 for the mark SEBAMED dated 16 October 2006.⁵

⁴ Exhibit “X”

⁵ Exhibits “A” to “X” inclusive of submarkings

The Respondent-Applicant filed its Answer on 1 July 2009, alleging among other things, the following:

"17. The Opposition should be dismissed since Opposer 1) was unable to show that its mark 'seba med' is confusingly similar with Respondent-Applicant's 'Sewame Paris Chinese Characters & Device' trademark 2) was unable to prove that use by the Respondent-Applicant of its mark will mislead the purchasing public into believing that the Respondent-Applicant's goods are produced by the Opposer 3) was unable to prove that its mark 'seba med' is well-known in the Philippines and worldwide, and assuming *arguendo* that it is well-known, such fact is immaterial because the competing marks are very much different 4) was unable to prove that Respondent-Applicant's use of 'Sewame Paris Chinese Characters & Device' will dilute Opposer's mark 'seba med' 5) was unable to prove that its intellectual property rights are being violated by Respondent-Applicant's use of its mark.

"19. It bears great emphasis that Respondent-Applicant's 'Sewame PARIS Chinese Characters & Device' mark is a composite mark. A mark consisting of a word mark and a device mark is a composite mark. It is respectfully manifested that Respondent-Applicant's mark pertains to a composite mark considering that that it consists of the coined word 'SEWAME', word 'PARIS', Chinese characters, curved rectangular device with white borders and a representation of a mountain tip is covered with snow.

"20. Pertinently, the Respondent-Applicant's mark consists of many elements. Accordingly, this Office Honorable Office should not treat these component elements as separate but should combine and harmonize the same.

"21. A visual examination of Respondent-Applicant's 'Sewame Paris Chinese Characters & Device' and Opposer's 'Seba med' will readily yield to the conclusion that they cannot be confused. Upon a closer look at the Opposer's mark, it can be seen that its mark is descriptive. This Honorable Office through paper No. 5 asked for the disclaimer of the suffix 'med' because it is an abbreviation for medicine and is descriptive of the goods. Consequently, Opposer disclaimed the suffix 'med'. Hence, the Honorable Office should take note that the suffix 'med' in Opposer's mark 'Seba med' is in fact an abbreviation for medicine. Furthermore, in its attached brochure, Opposer made several references to 'sebum or sebaceous glands'. In fact, in its listings of goods under class 5, the Opposer's goods consists of 'medicines for the treatment of skin diseases namely skin cleaners, being a pharmaceutical preparation for skin diseases in the form of a special product for seborrhoeic conditions and microbial dermatoses. Thus, the suffic 'seba' is descriptive or allusive of sebaceous glands or sebum. Consequently, Opposer's mark 'Seba med' is descriptive or allusive to 'medicine for sebaceous glands or sebum'.

"22. On the other hand, Respondent-Applicant's mark consists of many elements. As to the first word 'SEWAME', it must be stressed that it is the transliteration of the 3 Chinese characters Xue Wan Mei appearing in the mark

which means 'SNOW PERFECTION' in English. Clearly, by no stretch of imagination can it be similar to the descriptive mark 'seba med'.

"23. On the other hand, non-Chinese will not likely perceive that 'SEWAME' evokes any meaning. As a result, if the widely used term 'med' is associated by the consumers to mean 'medicine', the competing marks are dissimilar since one of them, namely 'SEWAME', has no meaning."

The Respondent-Applicant submitted as evidence, the following:

1. Authenticated and notarized Special Power of Attorney of Poon Sang Yu dated 17 June 2009;
2. Secretary's Certificate dated 17 June 2009;
3. Authenticated and notarized Affidavit of Poon Sang Yu;
4. Copy of Paper No. 5 dated 21 March 2006 issued by the Bureau of Trademarks;
5. Affidavits of Margie Rey Feliciano, Jaymie Lou Dela Cruz, Ofelia Bugay, Jordan Pongan, Luigi Loren De Jesus, Dionell Foronda, Elsa Erasmo, Maricar Salamat, Irish Aster Amorin, Gladys Cabarubias dated 27 May 2009;
6. Copies of newspaper and/or print advertising of Sewame PARIS Chinese Characters & Device; and
7. Print-out of internet advertising of Sewame PARIS Chinese Characters & Device.⁶

The Hearing Officer issued on 5 July 2009 a notice setting the Preliminary Conference on 1 September 2009. On 5 November 2009, the Preliminary Conference was terminated, thereafter, the Hearing Officer issued on 8 December 2009 Order No. 2009-1791 directing both parties to file their respective position papers. The Opposer and the Respondent-Applicant filed their position papers on 14 January 2010 and 22 January 2010 respectively.

Should the Respondent-Applicant be allowed to register the trademark SEWAME PARIS CHINESE CHARACTERS & DEVICE?

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.⁷ Thus, Sec. 123.1 (d) of R. A. 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

⁶ Exhibits "1" to "15" inclusive of submarkings

⁷ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.

services or closely related goods or services or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant applied for registration of the mark "SEWAME PARIS CHINESE CHARACTERS & DEVICE", the Opposer had already registered the mark SEBAMED (Certificate of Registration No. 4-2000-002630). The goods covered by the Opposer's trademark registration are similar and/or closely related to those indicated in the Respondent-Applicant's trademark application.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

The competing marks are reproduced below:

Opposer's mark



Respondent-Applicant's mark



The marks are similar with respect to the first syllable "SE" and two letters in its suffix, "ME". Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur. The consumers can easily see the differences between the two marks. The Respondent-Applicant's mark employs several creative elements such as the background consisting of a curved flag-like rectangular device with white borders. Inside the device are the words SEWAME and Paris against a background consisting of a figure which looks like a mountain whose top is covered in snow, and Chinese characters in black against a white background. As to sound and context, the two marks are different. To consumers in the Philippines, the syllables "seba" sounds clearly distinct from "sewa". This Bureau finds merit in the Respondent-Applicant's argument:

"A visual examination of Respondent-Applicant's 'Sewame Paris Chinese Characters & Device and Opposer's 'Seba med' will readily yield to the conclusion that they cannot be confused. Upon a closer look at the Opposer's mark, it can be seen that its mark is descriptive. This Honorable Office through paper No. 5 asked for the disclaimer of the suffix 'med' because it is an abbreviation for medicine and is descriptive of the goods. Consequently, Opposer disclaimed the suffix 'med'. Hence, the Honorable Office should take note that the suffix 'med' in Opposer's mark 'Seba med' is in fact an abbreviation for medicine. Furthermore, in its attached brochure, Opposer made several

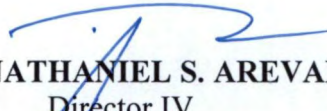
references to 'sebum or sebaceous glands'. In fact, in its listings of goods under class 5, the Opposer's goods consists of 'medicines for the treatment of skin diseases namely skin cleaners, being a pharmaceutical preparation for skin diseases in the form of a special product for seborrhoeic conditions and microbial dermatoses. Thus, the suffix 'seba' is descriptive or allusive of sebaceous glands or sebum. Consequently, Opposer's mark 'Seba med' is descriptive or allusive to 'medicine for sebaceous glands or sebum'.⁸

In fact, the Opposer disclaimed the suffix "MED" when it applied for registration of the mark SEBAMED. While the combination of "SEBA" and "MED" may have resulted in a mark that possesses distinctive quality which rendered it registrable, such mark is considered only as a suggestive mark. It is a weak mark if ranged against another mark which, while bearing some resemblance, are endowed with other distinguishing features and characteristics.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2007-012929 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 22 April 2014.


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

⁸ Respondent-Applicant's Verified Answer, par. 21, p. 7