



SUYEN CORPORATION,	}	IPC No. 14-2011-00343
Opposer,	}	Opposition to:
	}	
	}	Appln. Serial No. 4-2011-001625
-versus-	}	Date filed: 14 February 2011
	}	
	}	Trademark: "OOHLALICIOUS LOGO"
PRIME COLORS INTERNATIONAL, INC.,	}	
Respondent-Applicant.	}	
X-----X		

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 – 121 dated July 10, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 11 July 2013.

For the Director:


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



SUYEN CORPORATION,
Opposer,

IPC No. 14-2011-00343
Case Filed: 31 August 2011

-versus-

Opposition to:
Appln. Serial No. 4-2011-001625
Date Filed: 14 February 2011

PRIME COLORS INTERNATIONAL, INC.,
Respondent-Applicant.

TM: "OOHLALICIOUS LOGO"

x-----x

Decision No. 2013- 121

DECISION

SUYEN CORPORATION ("Opposer")¹ filed on 31 August 2011 an opposition to Trademark Application Serial No. 4-2011-001625. The application, filed by PRIME COLORS INTERNATIONAL, INC. ("Respondent-Applicant")², covers the mark 'OOHLALICIOUS LOGO' for use on " eye shadow, blush-on, press powder, foundation, mascara, lipstick, lip gloss, perfume, cologne, eau de toilette; deodorants and anti-perspirants for personal use; essential oils; cosmetics; hair lotions; non-medicated toilet preparations; lotions and masks, all for the face, hands and body; make-up; soaps; bath gel, and lip brush; nail polish; nail polish remover; shaving and aftershave preparations; aromatherapy products; dentifrices; bleaching preparations and other substances for laundry" under Class 3 of the International Classification of Goods and Services³.

The Opposer anchors its opposition on the ground that OOHLALICIOUS is confusingly similar to its registered mark "OHHLALA" which is also used for goods under Class 3 of the International Classification of Goods and Services, hence its registration will violate Sec. 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") which provides:

Sec. 123.1 (d) of the IP Code provides that 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

¹ A corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines with office located at 2214 Tolentino Street, Pasay City.

² A corporation organized and existing under Philippine Law, with business address at Warehouse 13-B La Fuerza Compound 2241 Don Chino Roces Avenue, Makati City.

³ 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.

- (ii) closely related goods or services, or
- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion;

In support of its opposition, the Opposer submitted in evidence the following:

1. Exhibit "A" – Affidavit of Kristine Anne C. Lim;
2. Exhibit "B" – Certified copy of Certificate of Reg. No. 4-2010-013790 in the name of SUYEN for the OOH LALA;
3. Exhibits "C", "C-1", to "C-3" – Photographs of SUYEN's OHH LALA products as displayed in stores;
4. Exhibits "D", "D-1" to "D-3" – Copies of advertisements of OHH LALA products published in Chalk Magazine (September 2010) and Mega Magazine (September 2010); and
5. Exhibits "E" and "E-1" – Photographs of billboards containing advertisements of the OHH LALA products put up by SUYEN at Magallanes, Makati City and Bacolod City, respectively.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 21 February 2012. However, no answer was filed, hence the instant opposition is considered submitted for decision based on the evidence and the opposition filed by the Opposer.

Should the Respondent-Applicant's trademark application be allowed?

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 manufacturer against substitution and sale of an inferior and different article as his products⁴.

Records show that at the time the Respondent-Applicant filed its trademark application on 14 February 2011, the Opposer has already an existing Trademark Registration No. 4-2010-013790 issued on 19 May 2011 for the mark "OOH LALA" used on deo-body spray, body lotion, body scrub, shower gel/cream, body mist under Class 3 of the International Classification of Goods and Services.

Also, this Bureau noticed that the goods or services covered by the Opposer's mark are identical/or similar to those indicated in the Respondent-Applicant's trademark application. However, are the two marks confusingly similar to each other?

The competing marks are reproduced for comparison and scrutiny:

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999.

OOH LALA!

oohlalicious

Opposer's Mark

Respondent-Applicant's Mark

Jurisprudence says that a practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of the prospective buyer. The trademark complained should be compared and contrasted with the purchaser's memory of the trademark said to be infringed. Some 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 used; may be considered for indeed, trademark infringement is a form of unfair competition⁵.

The Opposer's mark consists of three (3) syllables and seven (7) letters. The first two (2) syllables of the competing marks "OHH LA" are exactly the same in composition, spelling and pronunciation. It is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered. The first word, prefix or syllable in a mark is always the dominant part. When the marks are pronounced, the sound that will be uttered is the word "OHH LA", hence, the other matter is insignificant. The conclusion created by the use of the same word as the primary element in a trademark is not counteracted by the addition of another term⁶. Further, this Bureau also noticed that the first six (6) letters of the competing marks are identical. Their distinction lies in the last letter which is "A" for the Opposer and "I" for the Respondent-Applicant.

The difference in the other portion or element of the competing marks, such variance is inconsequential because the visual similarity in the dominant feature the word "OOH LA" which is exactly the same in all aspect such as composition, spelling and pronunciation is already sufficient to give rise to confusing similarity. The slight distinction or variance did not diminish the likelihood of the occurrence of mistake, confusion or even deception cannot be avoided. Consumers will likely assume that the Respondent-Applicant's mark is just a variation of or related to the Opposer's and/or the goods and services originate from the same source while in fact it is not. The likelihood of confusion would subsist not only on the purchaser's perception of the goods but on the origins thereof as held by the Supreme Court⁷:

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 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

⁵ Clarke v. Manila Candy Co. 36 Phil. 100, 106, Co Tiong SA v. Director of Patents 95 Phil. 1. 4.

⁶ Ref. Continental Connector Corp. v. Continental Specialties Corp. 207 USPQ 60.

⁷ Converse Rubber Corporation v. Universal Rubber Products, Inc. et.al. G.R. No. L-27906, 08 Jan. 1987.

into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

It is stressed that the determination 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 of likelihood of the purchaser of the older brand mistaking the newer brand for it⁸.

In conclusion, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code").

WHEREFORE, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-001625 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 10 July 2013.


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

/pausi/joanne

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