



THE PROCTER AND GAMBLE COMPANY,	}	IPC No. 14-2011-00270
Opposer,	}	Opposition to:
	}	Appln. Serial No.: 4-2011-000368
-versus-	}	Date filed: 12 January 2011
	}	
	}	
ACS MANUFACTURING CORPORATION,	}	Trademark: "SMOOTH"
Respondent-Applicant.	}	
X-----X		

### NOTICE OF DECISION

#### QUISUMBING TORRES

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Taguig City

#### ACS MANUFACTURING CORPORATION


c/o MAILINE R. SUPETLAN  
For Respondent-Registrant  
Unit 1108 Antel Global Corporate Center  
No. 3 Julia Vargas Avenue, Ortigas Center  
Pasig City

#### GREETINGS:

Please be informed that Decision No. 2013 – 123 dated July 11, 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



THE PROCTER AND GAMBLE COMPANY,  
*Opposer,*

IPC No. 14-2011-00270  
Case Filed: 10 August 2011

-versus-

Opposition to:  
Appln. Serial No. : 4-2011-000368  
Date Filed: 12 January 2011

ACS MANUFACTURING CORPORATION,  
*Respondent-Applicant.*

TM: "SMOOTH"

x-----x

Decision No. 2013- 123

### DECISION

THE PROCTER AND GAMBLE COMPANY ("Opposer")<sup>1</sup> filed on 10 August 2011 an opposition to Trademark Application Serial No. 4-2011-000368. The application, filed by ACS MANUFACTURING CORPORATION ("Respondent-Applicant")<sup>2</sup>, covers the mark "SMOOTH" for use on "soaps, toilet soap, anti-bacterial soap, cosmetics, deodorants, personal use" under Class 3 of the International Classification of Goods and Services<sup>3</sup>.

The Opposer alleges among other things, the following:

1. The Opposer is a leading manufacturer of household and personal care products which are distributed in numerous countries worldwide, including the Philippines. The Opposer's products include personal care goods in Class 3 such as, but not limited to, soaps, facial creams, lotions, cosmetics, deodorants and perfumes.
2. The registration of the SMOOTH trademark subject of this opposition will be contrary to the provisions of Sections 123.1 (i) and (i) of Republic Act No. 8293, as amended, which prohibit the registration of a mark that:
  - “(i) Consists exclusively of signs or of indications that have become customary or usual to designate the goods or services in everyday language or in bona fide and established trade practice;

<sup>1</sup> A company organized under the laws of Ohio, United States of America, having its principal place of business at One Procter & Gamble Plaza, Cincinnati, Ohio 45202, United States of America.

<sup>2</sup> With address at Unit 1108 Antel Global Corporate Center No. 3 Julia Vargas Avenue, 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.

- (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 the services, or other characteristics of the goods or services; and
3. Even assuming that the word SMOOTH is not descriptive and therefore capable of exclusive appropriation, the registration of the SMOOTH trademark in the Respondent-Applicant's name will be contrary to the provisions of Sections 123.1 (d) of Republic Act No. 8293, as amended, which prohibit the registration of a mark that:
- “(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;”

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

1. Exhibit "A" – Verified Notice of Opposition;
2. Exhibit "B" – Affidavit of Tara M. Rosnell;
3. Exhibit "C" – Examples of foreign trademark registrations in Class 3 wherein the element "SMOOTH" was disclaimed;
4. Exhibit "D" – List of trademark registrations in Class 3 under the Opposer's name and Opposer's affiliates worldwide bearing the element "SMOOTH"; and
5. Exhibit "E" – Secretary's certificate and Special Power of Attorney.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 31 August 2011. However, no answer was filed, hence the Respondent-Applicant have been declared to have waived its right to file the same and this case was considered submitted for decision based on the evidence and 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 products<sup>4</sup>.

Records show that at the time the Respondent-Applicant filed its trademark application on 12 January 2011, the Opposer and its subsidiaries/affiliates have registered with the Intellectual Property Office of the Philippines, trademarks which contain the word "SMOOTH", as follows:

- |    |           |   |                       |
|----|-----------|---|-----------------------|
| 1. | Reg. No.  | - | 4-2007-010373         |
|    | Issued On | - | 17 March 2008         |
|    | Mark      | - | SMOOTH BLAST          |
|    | Goods     | - | Class 3               |
| 2. | Reg. No.  | - | 4-2010-005360         |
|    | Issued on | - | 01 October 2010       |
|    | Mark      | - | SMOOTH EFFECT         |
|    | Goods     | - | Class 3               |
| 3. | Reg. No.  | - | 4-2010-005769         |
|    | Issued on | - | 28 May 2010           |
|    | Mark      | - | SMOOTHATION           |
|    | Goods     | - | Class 3               |
| 4. | Reg. No.  | - | 4-2005-000049         |
|    | Issued on | - | 16 July 2006          |
|    | Mark      | - | SMOOTHPLEX            |
|    | Goods     | - | Class 3               |
| 5. | Reg. No.  | - | 4-2007-010930         |
|    | Issued on | - | 07 April 2008         |
|    | Mark      | - | SMOOTHING REFLECTIVES |
|    | Goods     | - | Class 3               |

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 (not in juxtaposition) of the trademark said to be infringed. Some factors such as sound; 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 for indeed, trademark infringement is a form of unfair competition<sup>5</sup>.

In this regard, the word "SMOOTH" has a common meaning and significance that describes goods falling under Class 3 of the International Classification of Goods and Services.

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

<sup>5</sup> Clarke v. Manila Cnady Co. Phil. 100, Co Tiong S.A. v. Director of Patents, 95 Phil. 1, 4.

The fact that the Opposer's marks have been registered in other countries including the Philippines is solely because the word "SMOOTH" has been disclaimed and that it is accompanied by and/or in combination with other terms or element, hence, acquiring distinctiveness.

That the word "SMOOTH" is a descriptive term in relation to goods in Class 3 is confirmed by the fact that in this jurisdiction, the disclaimer of the word "SMOOTH" appearing in certain marks registered in Class 3 and other related classes, is required, to wit:

- |    |          |   |   |
|----|----------|---|---|
| 1. | Reg. No. | - | 4-2001-003832   |
|    | Mark     | - | MAYBELLINE LIP SMOOTH                                   |
| 2. | Reg. No. | - | 4-2005-003360   |
|    | Mark     | - | COLORSTAY SOFT & SMOOTH                                 |
| 3. | Reg. No. | - | 4-2007-003208   |
|    | Mark     | - | EXTRADERM WHITE & SMOOTH DEVICE                         |
| 4. | Reg. No. | - | 4-2005-010465   |
|    | Mark     | - | ETERNALLY SMOOTH  |
| 5. | Reg. No. | - | 4-2005-010464   |
|    | Mark     | - | CARESSABLY SMOOTH                                       |
| 6. | Reg. No. | - | 4-2010-001052   |
|    | Mark     | - | KIDDIE CARE BLISS & DEVICE AND FOR SMOOTH AND SOFT SKIN |
| 7. | Reg. No. | - | 4-2004-006547   |
|    | Mark     | - | VELA SMOOTH   |
| 8. | Reg. No. | - | 4-2005-008011   |
|    | Mark     | - | KOTEX SOFT & SMOOTH                                     |

Considering therefore that the word "SMOOTH" is descriptive in relation to goods in Class 3, hence not capable of exclusive appropriation, the Respondent-Applicant's trademark application is proscribed under Sections 123.1 (i) and (j) of the IP Code.

Even assuming that the word "SMOOTH" is not descriptive and therefore capable of exclusive appropriation, the Respondent-Applicant's trademark application is likewise contrary to the provisions of Section 123.1 (d) of the IP Code.

It is stressed that the Respondent-Applicant was given opportunity to explain its side and defend its trademark application. However, it failed or chose not to do so.

**WHEREFORE**, premises considered that the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-000368 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 11 July 2013.



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

*/pausi/joanne*