



TOTAL SA,
Opposer,

-versus-

PILIPINAS TOTAL GAS, INC.,
Respondent-Applicant.

X-----X

} IPC No. 14-2011-00322
} Opposition to:
} Appln. Serial No. 4-2010-012496
} Date filed: 19 November 2010
} TM: "PILIPINAS TOTAL GAS, INC."

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 194 dated October 09, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 09, 2013.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



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PILIPINAS TOTAL GAS, INC.,

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IPC No. 14-2011-00322

Opposition to:

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TM: "PILIPINAS TOTAL GAS, INC."

Decision No. 2013- 194

DECISION

TOTAL SA, ("Opposer")¹ filed on 31 August 2011 an opposition to Trademark Application Serial No. 4-2010-012496. The application, filed by PILIPINAS TOTAL GAS, INC. ("Respondent-Applicant")², covers the mark "PILIPINAS TOTAL GAS, INC." for use on "chemicals used in industry, science and agriculture consisting of liquid nitrogen, liquid oxygen, liquid argon, liquid carbon dioxide, hydrogen, lacer gas and other special gases" under Class 1 of the International Classification of Goods and Services³.

The Opposer anchors its opposition on the ground that the registration of the PILIPINAS TOTAL GAS, INC. mark in the name of the Respondent-Applicant is contrary to Sections 123.1 (d) and 165.1 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 following:

1. Annex "A" – Verified and duly authenticated Notice of Opposition;
2. Annex "B" – Notarized and duly authenticated Evidentiary Affidavit of Fabienne Piccard and the attachments thereto⁴, to wit:
 - a. TOTAL SA's Articles of Incorporation;
 - b. TOTAL SA's Annual Report;
 - c. TOTAL SA's commercial invoices showing sale goods in the Philippines;
 - d. TOTAL SA's promotional samples in the Philippines;
 - e. TOTAL SA's promotional samples worldwide;
 - f. Certified true copies of TOTAL mark registrations in foreign jurisdictions;
 - g. List of registered TOTAL marks worldwide;
 - h. TOTAL SA's Philippine Certificate of Reg. No. 4-2003-005196; and
 - i. Declaration of Actual Use of trademark TOTAL under Trademark Reg. No. 4-2003-005196;

¹ A corporation duly organized under the laws of France, with principal office at 2 Place Jean Millier, La Defense 6, 92400 Courbevoie, France.

² With address at G/F Sec. D MDDI21 East Science Avenue, Laguna Technopark, Biñan, Laguna.

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

⁴ Marked as Exhibits "B-1" to "B-9".

3. Annex "C" – Notarized and duly authenticated Special Power of Attorney; and
4. Annex "D" – The filing fee paid by the Opposer on 17 August 2011.

The Respondent-Applicant filed on 16 December 2011 its answer denying all the material allegations of the opposition. It argues that there can be no likelihood of confusion because the Opposer has set of goods that are different from the Respondent-Applicant's. The Respondent-Applicant's evidence consists of the following⁵:

1. Copy of the certificate from the Security and Exchange Commission approving the Respondent-Applicant's Articles of Incorporation;
2. Copy of the Respondent-Applicant's Articles of Incorporation;
3. Affidavit of Pascualito L. Reyes; and
4. List of trademarks using the word TOTAL in conjunction with other words.

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.⁶

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 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 19 November 2010, the Opposer already has an existing trademark registration (No. 4-2003-005196, issued on 22 January 2007) for the mark "TOTAL" for use on "chemical used in industry and science, as well as in agriculture, horticulture, forestry and aquaculture; unprocessed plastics in any form; rubber in liquid form; artificial and synthetic resins, polymers used in industry, adhesives used in industry; detergents for industrial purposes, chemical additives for motor fuel, lubricants and fuels; chemical additives for insecticides, herbicides and fungicides; solvents included in this class; anti-freeze, fluids for hydraulic and transmission circuits; brake fluids, substances for absorbing petroleum, oils and greases; oil dispersants", under classes 1, 4, 5, 17, 19, 35, 36, 37, 39, 40, 42 and 43.⁷ Likewise the Opposer's mark was registered in the United States Patent and Trademark Office bearing Reg. No. 2,999,615 registered for a term of 10 years from 25 September 2005 under Classes 1, 4, 17, 19, 35, 39, 40, 42 and 43⁸. Also, the Opposer's mark has been registered in a broad range of goods or classes all over the world⁹. The

⁵ Marked as Exhibit "1" to "3".

⁶ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999

⁷ Exhibit "B-8".

⁸ Exhibit "B-6".

⁹ Exhibits "B-6" and "B-7".

goods indicated in the Respondent-Applicant's trademark application therefore, are similar and/or closely related to those covered by the Opposer's trademark registration.

But are the competing marks, as shown below, confusingly similar?



Opposer' Mark

**PILIPINAS
TOTAL GAS,
INC.**

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 competition.¹⁰

In this regard, the feature that is common to the competing marks is the word TOTAL. The Opposer's mark has a device while the Respondent-Applicant's mark contains the words "PILIPINAS", "GAS", and "INC." The word TOTAL, however, is the part that confers distinctive property. The word immediately draws the eyes and the ears and the component that leaves impression about the goods in the consumers' minds or consciousness.

The Respondent-Applicant will use or uses the mark it applied for registration on goods that are similar and/or closely related to those covered by the Opposer's mark. Hence, there is the likelihood for the consumers to assume that the Respondent-Applicant's mark is just a variation of or related to the Opposer's, and/or the goods or services originate or provided by one party alone, or the parties themselves are connected or associated with one another, which in fact there is none. The likelihood of confusion would subsist not only on the purchaser's perception of the goods but on the origin thereof as held by the Supreme Court¹¹.

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 he 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

¹⁰ Clarke v. Manila Candy Co. 36 Phil. 100, 106; Co Tiong SA v. Director of Patents 95 Phil. 1, 4.

¹¹ Converse Rubber Corporation v. Universal Rubber Products, Inc., et.al. G.R. No. L-27906, 08 Jan. 1987.

A handwritten signature in blue ink, appearing to be initials or a name, located in the bottom right corner of the page.

the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

Succinctly, 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, 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 it¹².

This Bureau also noticed that the word TOTAL practically comprises the Opposer's corporate name. The trade name of its subsidiary in the Philippines is "TOTAL (PHILIPPINES) CORPORATION, as can be gleaned from the Articles of Incorporation approved by the Securities and Exchange Commission. Sec. 165 (2) of the IP Code provides that:

- (a) Notwithstanding any laws or regulations providing for any obligation to register tradenames, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.
- (b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public shall be deemed unlawful.

In fact, the mark PILIPINAS TOTAL GAS, INC. is almost identical to the trade name TOTAL (PHILIPPINES) CORPORATION. There is no doubt that the adoption and use by the Respondent-Applicant of the mark PILIPINAS TOTAL GAS, INC. is likely to mislead the public as to the source of the goods involved or as to the Respondent-Applicant's identity viz-a-viz the Opposer. Under Sec. 165.2, such adoption and use is deemed unlawful. Consequently, the registration of the mark in favor of the Respondent-Applicant must not be allowed.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-012496 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 09 October 2013.


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

¹² See American Wire and Cable Co. v. Director of Patents et.al. (SCRA 544) G.R. No. L-26557, 08 Jan. 1987.