



TOTAL SA,  
Opposer,

-versus-

PILIPINAS TOTAL GAS, INC.,  
Respondent-Applicant.

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IPC No. 14-2011-00323  
Opposition to:  
Application No. 4-2010-012498  
Date filed: 19 November 2010  
TM: "PILIPINAS TOTAL GAS,  
INC. AND DEVICE"

### NOTICE OF DECISION

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#### GREETINGS:

Please be informed that Decision No. 2014 - 168 dated June 24, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 24, 2014.

For the Director:

  
Atty. JOSEPHINE C. ALON  
Bureau of Legal Affairs



TOTAL SA,

Opposer,

- versus -

PILIPINAS TOTAL GAS, INC,  
Respondent-Applicant.

**IPC NO. 14 - 2011- 00323**

Case Filed on: 31 August 2011

Opposition to:

Appln Serial No. 42010012498

Date filed: 19 November 2010

**TM: "PILIPINAS TOTAL GAS,  
INC. AND DEVICE"**

x-----x

**DECISION NO. 2014 - 168**

## DECISION

TOTAL SA (Opposer)<sup>1</sup>, filed an opposition to Trademark Application No. 4-2010-012498 on 31 August 2011. The application filed by PILIPINAS TOTAL GAS, INC. (Respondent-Applicant)<sup>2</sup>, covers the mark "PILIPINAS TOTAL GAS, INC. AND DEVICE" for "*chemicals used in industry, science and agriculture consisting of liquid nitrogen, liquid oxygen, liquid argon, liquid carbon dioxide, hydrogen, laser gas and other special gases*" under Class 01 of the International Classification of Goods.<sup>3</sup>

The Opposer's based its opposition on the following grounds:

- 1.) The word TOTAL is a suggestive term that is entitled to exclusive appropriation and protection as a mark;
- 2.) Respondent's PILIPINAS TOTAL GAS, INC. AND DEVICE is confusingly similar to Opposer's prior TOTAL mark;
- 3.) Opposer's TOTAL mark is a well-known mark entitled to broad protection;
- 4.) Opposer's TOTAL mark is a well-known mark entitled to broad protection;
- 5.) Opposer's TOTAL mark is also entitled to protection as a trade name;
- 6.) Respondent's use of PILIPINAS TOTAL GAS INC. AND DEVICE will prejudice Opposer;

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 attachments, as follows:

<sup>1</sup> A corporation organized under the laws of France with office 2 Place Jean Millier, La Defence 6, 92400 Courbevoie, France.

<sup>2</sup> A corporation organized and existing under Philippine law with address at G/F SEC D MDD121 East Science Ave., Laguna Technopark, Binan, Laguna.

<sup>3</sup> 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.

- a. Exhibit "B - 1" - Total (Philippines) Corporation's Article of Incorporation;
  - b. Exhibit "B - 2" - TOTAL SA's Annual Report;
  - c. Exhibit "B - 3" - TOTAL SA's commercial invoices showing sale of goods in the Philippines;
  - d. Exhibit "B - 4" - TOTAL SA's promotional samples in the Philippines;
  - e. Exhibit "B - 5" - TOTAL SA's promotional samples worldwide;
  - f. Exhibit "B - 6" - Certified True Copies of TOTAL mark registrations in foreign jurisdictions.
  - g. Exhibit "B - 7" - List of registered TOTAL marks worldwide;
  - h. Exhibit "B - 8" - TOTAL SA's Philippine Certificate of Registration No. 4-2003-005196
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. Respondent-Applicant further argued, as follows:

1. The word TOTAL is a generic and descriptive term used in conjunction with other words and cannot be appropriated exclusively.
2. There can be no likelihood of confusion since Opposer and Respondent-Applicant has different set of goods.
3. The Opposer failed to prove that the trademark "TOTAL" is well known.

The Respondent-Applicant's evidence consist of the following:

1. Exhibit "1" - Copy of the Certificate from 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.

The issue to be resolved in the instant case is whether Respondent-Applicant's trademark PILIPINAS TOTAL GAS, INC AND DEVICE should be allowed for registration.

Our Intellectual Property Code under Section 123.1 specifically 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 with respect to 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 the Opposer has a prior and existing trademark registration when the Respondent-Applicant filed his trademark application.

Also, the Respondent-Applicant's trademark is being applied for the used on "chemicals used in industry, science and agriculture consisting of liquid nitrogen, liquid oxygen, liquid argon, liquid carbon dioxide, hydrogen, laser gas and other special gases," while the Opposer's trademark is registered to be used on "chemicals 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 fuel; chemical additives for insecticides, herbicides and fungicides; solvents included in this class; anti-freeze; fluids for hydraulic and transmission circuits; brake fluids; substances for ansorbing petroleum, oils and greases; oil dispersants; petroleum (crude or refined); liquid, solid and gaseus fuels; motor fuel, fuel and lubricants." Based on the above enumerations, there is no doubt that the competing marks are being used on similar /or related goods since both are used in chemical products in similar industries.

The question now is, do the marks as shown below resemble each other such that mistake or confusion or even deception is likely to occur?



Opposer's Trademark

Pilipinas Total Gos. Inc.



Respondent-Applicant's Trademark

This Bureau answers the above question in the affirmative.

This is not the first time this Bureau passed upon an Inter Partes Trademark dispute involving the herein parties. In a previous case docketed as IPC No. 14-2011-00322, this Bureau did not allow the registration of the word mark "PILIPINAS TOTAL GAS, INC." for being confusingly similar with the "TOTAL" mark of the Opposer.

While it is true that in the instant case, the Respondent's mark has additional devices included in its design, the word mark "PILIPINAS TOTAL GAS, INC." is still the most prominent and distinctive feature in the Respondent-Applicant's mark as shown above. Also, the word "TOTAL" on both the competing marks remains to be the one that will leave an impression on the buying public. Hence, the attempt of Respondent-Applicant to add embellishments or ornaments on its word mark is not sufficient to distinguish its mark from that of the Opposer.

In addition, the word "TOTAL" is not a generic nor a descriptive mark but merely a suggestive mark with respect to the goods involved and is therefore eligible as a trademark. Thus, the Opposer, being the original owner and prior registrant, deserves protection against the confusingly similar mark being applied by the Respondent-Applicant.

It has been consistently held in our jurisdiction that 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.<sup>4</sup> Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.<sup>5</sup> Because the Respondent-Applicant will use his mark on goods that are similar and/or closely related to the Opposer's, the consumer is likely to assume that the Respondent-Applicant's goods originate from or sponsored by the Opposer or believe that there is a connection between them, as in a trademark licensing agreement. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:<sup>6</sup>

It is emphasized that the essence of the 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 applied; 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.<sup>7</sup> The mark applied for registration by the Respondent-Applicant does not serve this function.

**WHEREFORE**, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-012498 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

**SO ORDERED.**

Taguig City, 24 June 2014

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

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<sup>4</sup> American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

<sup>5</sup> Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992

<sup>6</sup> Converse Rubber Corporation vs. Universal Rubber-Products, Inc. et. al. G.R. No. L27906, January 8, 1987

<sup>7</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, November 19, 1999