



UNILEVER N.V.,
Opposer,

-versus-

INTERCOS SAL (HOLDING),
Respondent-Applicant.

X-----X

} IPC No. 14-2012-00380
} Opposition to:
} Appln. Serial No. 4-2012-500892
} Filing Date: 12 April 2012
} TM: "MAGICLEAR"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 133 dated August 15, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 15, 2013.

For the Director:


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



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IPC NO. 14-2012-00380

Opposition to:
Appln. Serial No: 4-2012-500892
(Filing Date: 12 April 2012)

TM: "MAGICLEAR"

Decision No. 2013 - 173

DECISION

UNILEVER N.V. ("Opposer")¹ filed on 14 September 2012 an opposition to Trademark Application Serial No. 4-2012-500892. The application, filed by INTERCOS SAL (HOLDING) ("Respondent-Applicant")² on 12 April 2012, covers the mark "MAGICLEAR" for use on "*cosmetic, grooming, beauty, skin care and tanning products in the form of creams, milks, balms, gels, salts, oils, lotions, serums, and/ or packs (masks), for day and night use, for coloring, moisturizing, conditioning, slimming, cleansing, peeling and deep cleaning, for whitening treatment, for the bath and shower*" under Class 3 of the International Classification of Goods and Services³.

The Opposer alleges, among other things, that the mark MAGICLEAR is confusingly similar to its mark "CLEAR" which is already registered in the Philippines long before the Respondent-Applicant filed its trademark application. To support its opposition, the Opposer submitted as evidence the affidavit executed on 14 September 2012 by Unilever Phil. Inc.'s General Counsel Ma. Leah Jose-Sebastian, actual product labels showing the CLEAR marks, use and promotion of the CLEAR marks in the Philippines, affidavit executed on 14 September 2012 by Bienvenido A. Marquez III, and representative samples of various trademark registrations secured in the name of Opposer for CLEAR and derivative marks.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 05 November 2012. The Respondent-Applicant however, did not file an answer.

Should the Respondent-Applicant be allowed to register the mark MAGICLEAR in its favor?

It is emphasized that the essence of the trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out

¹ A corporation organized and existing under the laws of the Netherlands, with principal address at Weena 455, Rotterdam 3013 AL, The Netherlands.

² With address at Fosch Avenue, 53 Jaafar Al Sadek Street, Marfaa Sector 14, Building 231, 2nd Floor, Beirut, Lebanon.

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 "C" to "G", inclusive.

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 hi, 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 article as his product.⁵ Thus, Sec. 123.1(d) of Rep. Act 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 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

In this regard, records show that at the time the Respondent-Applicant filed its trademark application, the Opposer already has registrations for the mark CLEAR and its variations in the Philippines:

1. TM : CLEAR
 Reg. No. : 4-2005-000695
 Issued on : 21 May 2007
 Class : 3 - HAIR CARE PRODUCTS NAMELY HAIR COLOURANTS, HAIR DYES, HAIR LOTIONS, HAIR WAVING PREPARATIONS, SHAMPOO CONDITIONERS, HAIR SPRAYS, HAIR POWDER, HAIR DRESSING, HAIR LACQUERS, HAIR MOUSSES, HAIR GLAZES, HAIR GELS, HAIR MOISTURISERS, HAIR LIQUID, HAIR OILS, HAIR TONIC AND HAIR CREAMS

2. TM : CLEAR ICE COOL
 Reg. No. : 4-2005-012299
 Issued on : 06 August 2007
 Class : 3-SOAPS; CLEANING PREPARATIONS, HAIR CARE PRODUCTS, HAIR COLORANTS, HAIR DYES, HAIR LOTIONS, HAIR WAVING PREPARATIONS, SHAMPOOS, CONDITIONERS, HAIR SPRAYS, HAIR POWDER, HAIR DRESSINGS, HAIR LACQUERS, HAIR MOUSSES, HAIR GLAZES, HAIR GELS, HAIR MOISTURIZERS, HAIR LIQUID, HAIR OILS, HAIR TONIC, HAIR CREAMS, PREPARATIONS FOR THE BATH AND/OR SHOWER, DEODORANTS, ANTI-PERSPIRANTS.

3. TM : CLEAR DEVICE
 Reg. No. : 4-2006-011130
 Issued on : 14 April 2008
 Class : 3-SOAPS, CLEANING PREPARATIONS, HAIR CARE PRODUCTS, AIR COLOURANTS, HAIR DYES, HAIR LOTIONS, HAIR WAVING PREPARATIONS, SHAMPOOS, CONDITIONERS, HAIR SPRAYS, HAIR POWDER, HAIR DRESSINGS, HAIR LACQUERS, HAIR MOUSSES, HAIR GLAZES, HAIR GELS, HAIR

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No.114508, 19 Nov. 1999.

MOISTURIZERS, HAIR LIQUID, HAIR OILS, HAIR TONIC, HAIR CREAMS, PREPARATIONS FOR THE BATH AND/OR SHOWER, DEODORANTS, ANTI-PERSPIRANTS.

These registrations cover goods that are similar and/or closely related to those indicated in the Respondent-Applicant's trademark application.

But does the Respondent-Applicant's mark resemble the Opposer's such that confusion, even deception, is likely to occur?

The Respondent-Applicant appropriated the word CLEAR which constitutes the Opposer's mark. While the Respondent-Applicant may have added the prefix "MAGI", this did not result in conferring upon the Respondent-Applicant's mark a character that would make it clearly dissimilar or distinguishable from the Opposer's. In looking the mark MAGICLEAR, while one can see the word "MAGIC", the word CLEAR however, is still conspicuous. Likewise, the word CLEAR is clearly audible.

In this regard, confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other⁶. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article⁷.

Succinctly, because 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 registered marks, the changes in the spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. There is therefore the likelihood that information, assessment, perception or impression about Respondent-Applicant's products may be unfairly cast upon or attributed to the Opposer, and *vice-versa*.

It is stressed that 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 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 or likelihood of the purchaser of the older brand mistaking the newer brand for it.⁸ The likelihood of confusion would subsist not

⁶ *Societe Des Produits Nestle , S.A v. Court of Appeals*, G.R. No.112012, 4 April 2001, 356 SCRA 207, 217.

⁷ *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

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

only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:⁹

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 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.

Accordingly, this Bureau finds and concludes that the registration of the mark CLEAR in favor of the Respondent-Applicant is proscribed by Sec. 123.1(d) of the IP Code.

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

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-500892 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 15 August 2013.


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

⁹ *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.