



WISDOM TOOTHBRUSHES LTD.,
Opposer,

-versus-

CLOSSET CORPORATION,
Respondent-Applicant.

x-----x

} **IPC No. 14-2015-00082**
} Opposition to:
} Application No.: 4-2013-00011404
} Date filed: 20 September 2013
} **TM: "WISDOM"**

NOTICE OF DECISION

BUCOY POBLADOR & ASSOCIATES
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116 Valero corner Rufino Streets
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CLOSSET CORPORATION
Respondent-Applicant
Unit 457, 4/F Wellington Building
Plaza Lorenzo Ruiz, Binondo
Manila

GREETINGS:

Please be informed that Decision No. 2015 - 166 dated August 20, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 20, 2015.

For the Director:


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



WISDOM TOOTHBRUSHES LTD.,	}	IPC No. 14-2015-00082
Opposer,	}	Opposition to:
	}	
-versus-	}	Application No. 4-2013-00011404
	}	Date Filed: 20 September 2013
CLOSSET CORPORATION,	}	
Respondent-Applicant.	}	Trademark: WISDOM
x-----x		Decision No. 2015 - <u>166</u>

DECISION

WISDOM TOOTHBRUSHES LTD.¹ ("Opposer") filed a Verified Notice of Opposition to Trademark Application No. 4-2013-00011404. The contested application, filed by CLOSSET CORPORATION² ("Respondent-Applicant"), covers the mark WISDOM for use on *"household or kitchen utensils and containers, combs and sponges, brushes (except paint brushes), brush making materials, articles for cleaning purposes, steel wool, unworked or semi-worked glass, (except used in building) glassware, porcelain and earthenware not included in other classes"* under Class 21 of the International Classification of goods³.

The Opposer anchors its opposition on the following grounds:

"1. The mark 'WISDOM' which respondent-applicant seeks to register is identical to Opposer's registered trademark 'WISDOM' which when applied to or used in connection with the goods covered by the application under opposition will likely cause confusion, mistake and deception on the part of the purchasing public.

"2. The registration of the mark 'WISDOM' in the name of respondent-applicant will violate Section 123.1 (d) of Republic Act No. 8293 ("Intellectual Property Code") which categorically provides that "(a) mark cannot be registered if it: x x x

Thus, a mark that is identical with a registered mark belonging to a different person or legal entity should be denied registration in respect of similar or closely related goods, or if the mark applied for registration nearly resembles such registered mark that confusion or deception in the mind of the buying public will likely result.

"3. Respondent-applicant's use and registration of the mark 'WISDOM' will diminish the distinctiveness and dilute the good will of Opposer's registered trademark 'WISDOM'.

"4. The registration of the mark 'WISDOM' in the name of respondent-applicant will violate Articles 15 and 16 (1) of the TRIPS Agreement which the

- 1 A corporation organized and existing under and by virtue of British laws, with business address at The Silk Mill, Haverhill, Suffolk CB9 8DT, England.
- 2 A Philippine entity with business address at Unit 457, 4th Floor Wellington Building, Plaza Lorenzo Ruiz, Binondo, Metro Manila.
- 3 Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

Philippines implemented when the Intellectual Property Code took effect on 01 January 2008 (*sic*). Articles 15 and 16 (1) of the TRIPS Agreement provide as follows: x x x"

In support of the opposition, the Opposer alleges the following:

"1. Opposer is a British corporation principally engaged in the business of manufacturing and distributing toothbrushes and a variety of oral care products classified under International Class 21 of the Nice Classification for many years now.

"2. Opposer is the registered owner in the Philippines of the trademark 'WISDOM' covering goods under International Class 21 of the Nice Classification as evidenced by Certificate of Trademark Registration No. 4-2013-006695 issued on 19 December 2013, x x x

"3. Opposer's aforesaid Philippine Trademark Registration for the mark 'WISDOM' has not been abandoned and is currently in full force and effect.

"4. By virtue of Certificate of Philippine Trademark Registration No. 4-2013-003863, Opposer has acquired ownership over the mark 'WISDOM' to the exclusion of all others.

"5. Opposer's registered trademark 'WISDOM' also is an integral part of its corporate name, trade dress and trade name.

"6. The mark 'WISDOM' which respondent-applicant seeks to register is identical to Opposer's registered trademark 'WISDOM' as likely to cause confusion, mistake and deception to the public as to the source or origin of respondent-applicant's goods.

"7. Opposer has invested a tremendous amount of its resources in the promotion of its 'WISDOM' trademark as a result of which the said trademark has gained popularity and repute not only in the Philippines but also worldwide. Thus, the use by, and registration in favor of, respondent-applicant of the identical mark 'WISDOM' on its goods will enable it to unjustly benefit from Opposer's established reputation and goodwill.

"8. In view of the prior adoption, use and registration of the trademark 'WISDOM' by the Opposer, respondent-applicant is clearly not entitled to register the identical mark 'WISDOM'.

"9. Further, as shown above, Opposer is the lawful and rightful owner of the 'WISDOM' trademark. Respondent-applicant, not being the owner thereof, absolutely has no right whatsoever to apply for the registration of the same.

"10. The registration of the trademark subject of the instant opposition will undoubtedly violate Opposer's rights and interests in its registered trademark 'WISDOM', cause confusion between Opposer's and respondent-applicant's businesses and products, and will most assuredly result in the dilution and loss of distinctiveness of Opposer's registered trademark

'WISDOM!.'

The Opposer's evidence consists of the original authenticated Special Power of Attorney, notarized and authenticated Affidavit executed by Stephen John Larder, certified true copy of Certificate of Philippine Trademark Registration No. 4-2013-006695 issued on 19 December 2013 for the mark WISDOM, and publication of Respondent-Applicant's Trademark Application No. 4-2013-011404 as downloaded from the IPOPHL's official website.⁴

This Bureau issued and served a copy of the Notice to Answer to Respondent-Applicant on 04 May 2015. The Respondent-Applicant, however, failed to file its Answer. Thus, Order No. 2015-1098 was issued on 30 July 2015 declaring the Respondent-Applicant in default and submitting the case for decision on the basis of the opposition and the evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the trademark WISDOM?

Sec. 123.1 (d) of R. A. No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"), relied upon by the Opposer, 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
- (ii) closely related goods or services, or
- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion; x x x

In this regard, the records show that the Respondent-Applicant applied for the registration of the mark WISDOM on 20 September 2013. However, prior thereto, the Opposer has already filed on 10 June 2013 an application for registration of the same mark WISDOM. The Opposer's trademark application ripened into registration (No. 4-2013-00006695)⁵ on 19 December 2013 covering goods under Class 21, namely, "*brushes for oral hygiene purposes, toothbrushes, electric toothbrushes, vibrating toothbrushes, inter dental brushes, interproximal brushes, interspace brushes, denture brushes, floss and tape for dental purposes, dental flossing aids, toothpicks and toothpick holders, cleaning instruments for oral hygiene purposes, boxes and baths for dentures and artificial teeth, tooth polishing appliances for personal use*".

Now, the question is, do the marks resemble each other such that confusion or even deception is likely to occur?

The marks, as shown below, are identical:

WISDOM

Opposer's Mark

WISDOM

Respondent-Applicant's Mark

⁴ Marked as Exhibits "A" to "D".

⁵ Exhibit "C".

Even the manner of their display or presentation is the same. In this regard, the Opposer adopted the mark WISDOM for its toothbrushes and other tooth polishing appliances. WISDOM, therefore, as applied to Opposer's goods is a fanciful mark and therefore highly distinctive since it bears no logical relation to the actual characteristics of the product it represents. Thus, the use by the Respondent-Applicant of the mark WISDOM for goods similar and/or related to those covered by the Opposer's trademark registration, like brushes and articles for cleaning purposes under Class 21, will create the impression that the Respondent-Applicant's goods originate from or are sponsored by the Opposer when in fact they are not. The consumers might reasonably assume that there is some connection between the marks and/or between the parties themselves.

As held by the Supreme Court in *Converse Rubber Corporation v. Universal Rubber Products, Inc., et. al.*⁶


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.

This Bureau, therefore, finds that the Respondent-Applicant's trademark application is proscribed by Section 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-00011404 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 20 August 2015.


Atty. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs

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⁶ G.R. No. L-27906, 08 Jan. 1987.