



**PROCTER & GAMBLE
MANUFACTURING COLOGNE GMBH,**
Opposer,

-versus-

DAISY V. DIMASACAT,
Respondent-Applicant.

x-----x

IPC No. 14-2012-00394
Opposition to:
Appln. Serial No. 4-2011-008728
Date Filed: 26 July 2011
TM: "DESIREE (Stylized)"

NOTICE OF DECISION

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DAISY V. DIMASACAT
Respondent-Applicant
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Quezon City

GREETINGS:

Please be informed that Decision No. 2015 - 181 dated September 02, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 02, 2015.

For the Director:


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



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IPC No. 14-2012-00394

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Trademark: "**DESIREE (Stylized)**"

Decision No. 2015 - 181

DECISION

PROCTER & GAMBLE MANUFACTURING COLOGNE GMBH ("Opposer"),¹ filed an opposition to Trademark Application Serial No. 4-2011-008728. The application, filed by DAISY V. DIMASACAT ("Respondent-Applicant"),² covers the mark "DESIREE (Stylized)" for use on goods under class³ 03 namely: *soaps, lotion, day and night cream*.

The Opposer alleges that the registration of the mark DESIREE (STYLIZED) in favor of the Respondent-Applicant is contrary to the provisions of Section 123.1 paragraphs (d), (e) and (f) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") which prohibit the registration of a mark. According to the Opposer, the mark DESIREE (STYLIZED) is confusingly similar to its registered DESIRE trademark. The goods on which Respondent-Applicant's mark is sought to be registered in Class 3, are similar and related to the goods covered by the Opposer's trademark registration. Moreover, Opposer avers that its DESIRE trademark is a well-known mark, which enjoys substantial goodwill and recognition in the Philippines and worldwide.

The Opposer's evidence consists of the following:

1. Notice of Opposition;
2. Legalized Certificate and Special Power of Attorney;
3. Legalized Affidavit executed by Camille Choppin;
4. Product packaging bearing the DESIRE trademark;
5. Photographs of products bearing the DESIRE trademark;
6. Table showing the details of Opposer's registration and the pending applications for the DESIRE trademark worldwide;
7. Representative sample of registration documents for the DESIRE trademark worldwide; and,
8. Certificate of Registration No. 4-1998-009225 for DESIRE trademark.

¹ A corporation organized under the laws of Germany with business address at Wilhelm-Mauser-Straße 40, 50827 Köln, Federal Republic of Germany.

² With registered address at Unit 219 Regalia Park Tower A.P. Tuazon, Brgy. Socorro, Cubao, Quezon City, Metro Manila, Philippines.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 15 November 2012. Respondent-Applicant however, did not file an answer. Thus, in Order No. 2013-645 dated 24 April 2013, Respondent-Applicant is declared in default and this case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark DESIREE (Stylized)?

It is emphasized that the essence of trademark registration is to give protection to the owners of 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 out into the market a superior 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.⁴

Records show that at the time Respondent-Applicant filed its application for the trademark "DESIREE (Stylized)" on 26 July 2011, herein Opposer already has existing Registration No. 4-1998-009225 for the trademark "DESIRE" dated 18 June 2007 and which was filed on 17 December 1998⁵, even before the former's application filing date. Opposer likewise show lists of international registrations⁶, and pending applications worldwide,⁷ for its "DESIRE" trademark. In the Philippines, a certificate of registration constitutes a prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.⁸

The competing marks are reproduced below for comparison and scrutiny:

DESIRE

Opposer's Trademark

DESIREE

Respondent-Applicant's Trademark

It appears that six out of seven letters in Respondent-Applicant's mark are identical and even similarly positioned as that of Opposer's mark. The difference consists of the additional letter "E" in the end of the word mark and the font face which does not produce any significant distinction both as to the aural and visual appearance of the marks. Further, the contending marks cover similar and related goods, both falling under 3, which refer to personal use and care. Indeed, these goods are found in the same channels of business and trade and/or cater its products to the same segment of consumers.

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 other.⁹ Colourable imitation does not

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

⁵ Exhibit "C-6" of Opposer.

⁶ Exhibit "C-3" of Opposer.

⁷ Exhibit "C-4" of Opposer.

⁸ Sec. 138, IP Code.

⁹ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 200, 356 SCRA 207, 217.

mean such similitude as amount to identify, nor does it require that all details be literally copied. Colourable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark with that of the other mark or trade name 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 article.¹⁰

Also, considering the similarity or relatedness of goods carried by the contending marks, the consumers will have the impression that these products originate from a single source or origin or they are associated with one another. The likelihood of confusion therefore, would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:¹¹

Cullman 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. Hence, 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.

Thus, Sec. 123.1 (d) of the IP Code provides:

A mark cannot be registered if it:

x x x

(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;

Corollarily, the public interest requires that the two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that the function of 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 product.¹²

In contrast, the Respondent-Applicant despite the opportunity given, failed to explain how it arrived at using the mark "DESIREE" as it failed to file its Answer to the opposition.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-008728 is hereby **SUSTAINED**. Let the file wrapper of the subject trademark application be

¹⁰ Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.

¹¹ Id.

¹² Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 02 September 2015.


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