



WELLA GMBH,
Opposer,

-versus-

RISHI N. MIRANI,
Respondent-Applicant.

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}
} IPC No. 14-2012-00443
} Opposition to:
} Appln Serial No. 4-2010-013397
} Date Filed: 09 December 2010
} TM: "KOTON"
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NOTICE OF DECISION

QUISUMBING TORRES
Counsel for the Opposer
12th Floor, Net One Center
26th Street corner 3rd Avenue
Crescent Park West, Bonifacio Global City
Taguig City

RISHI N. MIRANI
Respondent-Applicant
Kampri Building
2254 Don Chino Roces Avenue
Makati City

GREETINGS:

Please be informed that Decision No. 2015 - 180 dated September 08, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 08, 2015.

For the Director:

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



WELLA GMBH,
Opposer,

IPC No. 14-2012-00443
Opposition to:

- versus -

Appln. No. 4-2010-013397
Date Filed: 09 December 2010
Trademark : "KOTON"

RISHI N. MIRANI,
Respondent-Applicant.

x----- x

Decision No. 2015 - 180

DECISION

WELLA GMBH, ("Opposer")¹ filed a verified opposition to Trademark Application Serial No. 4-2010-13397. The application, filed by RISHI N. MIRANI ("Respondent-Applicant")², covers the mark "KOTON" for use on goods under the following classes³ namely: **03** - soaps for body and face, hair lotions, cosmetics preparations for the bath, bath salts, bath gels, cotton sticks for cosmetics purposes, skin whitening creams and powders, foundation preparations, hair colorants, hairdressing products, cosmetics preparation for eyelashes, adhesives for false eyelashes, decorative transfers for cosmetic purposes, cosmetic pencils, cosmetic creams, paper guides for eye make-up, blush essential oils for personal use, milk for cosmetic purposes, nail varnishes, lotions for cosmetic purposes, make-up preparations, beauty masks, cosmetic kits, nail care preparation, false nails, cotton wool for cosmetic purposes, perfumery, namely: perfumes, toilet oil, scented water, eau de cologne, pomades for cosmetic purposes, make-up powder, lipsticks, cosmetic preparations for skin care, eyebrow cosmetics, eyebrow pencils, cosmetics dyes, toilet water oils for toilet purposes, toiletries, varnishing removing preparations, make-up brushes and make up kit; **09** - sunglasses, frames; **14** - jewelry, watches; and, **26** - hair accessories, specifically headband, ribbon, hair pins, hair clips, ponytail, hair stick, hair claw, hair barrette, 3 pong hair forls, hair clamps, bobby pins, banana pins, bun holder, ponytail holder and point pints.

The Opposer alleges the following:

"1. Opposer, as the first user and rightful owner of the trademark KOLESTON, respectfully invokes the authority of this Honourable Office to deny the application of a mark sought to be registered by Respondent-Applicant.

x x x

"5. The registration of the mark KOTON is contrary to the provision of Section 123.1 (d) of the IP Code.

"6. Opposer is the owner of and has exclusive rights over the KOLESTON trademark registered with the Philippine Intellectual Property Office.

"7. Respondent-Applicant's mark KOTON is confusingly similar to the Opposer's registered KOLESTON trademark as to be likely to deceive or cause confusion in the minds of the relevant

¹ A corporation organized under the laws of Germany with business address at Sulzbacher, StraBe 40, 65824 Schwalbach am Taunus, Germany.

² A Filipino citizen with given address at #15 San Antonio St., San Francisco Del Monte, Quezon City.

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.

sector of the purchasing public. The presence of the second syllable LES in Opposer's mark is insufficient to eliminate any likelihood of confusion vis-a-vis Respondent-Applicant's mark.

x x x

"10. The KOLESTON trademark has been registered by Opposer in various trademark registries worldwide such as China, Indonesia, Malaysia, Thailand, Vietnam, and many other countries as mentioned in connection with personal care products in Class 3. There are also pending applications for the KOLESTON trademark in other trademark registries worldwide such as Albania, Belarus and Libya.

"11. Products bearing the KOLESTON trademark were first registered globally in Germany on April 12, 1951 and in the Philippines on May 6, 2010.

"12. Since its introduction, Opposer has been continuously using the KOLESTON trademark in connection with hair products in the Philippines and in numerous other countries around the world such as Germany, European Union, China, Honduras, Latin America, South Korea and others.

"13. Through Opposer's long, continuous and extensive use of its KOLESTON trademark, the same has become so popular throughout the Philippines and around the world such that a mere mention of or a mere look at the word 'KOLESTON' would immediately cause the purchasing public to associate said word with Oppose and its products. Thus, Respondent-Applicant's use of the letters K-O-T-O-N also on personal care products would cause purchasers to believe that the goods he is offering are produced by, emanate from, or are sponsored by Opposer, an established name in the industry."

The Opposer's evidence consists of the following:

1. Legalized verified Notice of Opposition;
2. Legalized Certificate and Special Power of Attorney;
3. Legalized Joint Affidavit executed by Use Hirsch and Brigitte Grab;
4. List of countries where KOLESTON trademark is registered and products are sold and marketed;
5. Product packaging, labels and photographs bearing the KOLESTON trademark;
6. Screenshots of popover's website www.wella.com showing use of KOLESTON trademark;
7. Various international promotional items, materials and advertisements used by Oppose for its KOLESTON products, and list of awards obtained worldwide;
8. Table showing Popover's pending applications for KOLESTON trademarks;
9. Representative sample of registration documents for KOLESTON trademarks; and,
10. Certificate of Registration No. 4-2009-011737 for KOLESTON trademark.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 14 January 2013. Respondent-Applicant however, did not file an answer. Thus, in Order No. 2015-1042 dated 21 July 2015, Respondent-Applicant is declared in default and this case is deemed submitted for decision.

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

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 "KOTON" on 09 December 2010, herein Opposer already has existing Registration No. 4-2009-011737 for the trademark "KOLESTON" which was filed on 16 November 2009⁵, even before the former's application filing date. Opposer likewise show various international registrations⁶, and pending applications worldwide,⁷ for its "KOLESTON" 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:

KOLESTON

Popover's Trademark

KOTON

Respondent-Applicant's Trademark

It appears that the first and last syllable of Opposer's "KOLESTON" trademark, "KO" and "TON", form exactly as the trademark applied for registration by the Respondent-Applicant. What the Respondent-Applicant did is just to remove the syllable "LES". In this regard, the Opposer's mark "KOLESTON" is unique and highly distinctive with respect to the goods to which the mark is applied. As such, it look as if the "KOTON" trademark is just an abbreviated version of the "KOLESTON" trademark. Further, the contending marks cover similar and related goods which refer to personal use and care of hair and hair accessories. 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 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

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-7" of Opposer.

⁶ Exhibit "C-6" of Opposer.

⁷ Exhibit "C-5" 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.

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

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.

Sec. 123.1 (d) R.A. No. 8293, otherwise known as the Intellectual Property Code ("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;

The public interest, therefore, 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 "KOTON" as it failed to file a Verified Answer.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-013397 is hereby **SUSTAINED**. Let the file wrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taugig City, 08 September 2015.


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

¹¹

Id.

¹²

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