



GOLDEN ABC, INC.,
Opposer,

-versus-

AVON PRODUCTS, INC.,
Respondent-Applicant.

}
} IPC No. 14-2012-00133
} Opposition to:
} Application No.: 4-2011-012029
} Date filed: 06 October 2011
} TM: "CITY RUSH"
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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 04 dated January 06, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 06, 2016.

For the Director:


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



GOLDEN ABC, INC.,

Opposer,

-versus-

AVON PRODUCTS, INC.,

Respondent-Applicant.

IPC No. 14-2012-00133

Opposition to:
Application No. 4-2011-012029
Date Filed: 06 October 2011
Trademark: "CITY RUSH"

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Decision No. 2016- 04

DECISION

GOLDEN ABC, INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-012029. The application, filed by Avon Products, Inc.² ("Respondent-Applicant"), covers the mark "CITY RUSH" for use on "fragrance and toiletry products, namely, eau de parfum, eau de toilette, cologne, body spray, body balm, and personal deodorant; bath and body gel, skin moisturizers, hair lotion; make-up for the face and neck" under Class 03 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"DISCUSSION

"'CITY RUSH' is confusingly similar with 'RUSH.'

"7. 'CITY RUSH' is confusingly similar with 'RUSH.' It is obvious that the dominant feature of 'CITY RUSH' is the word 'RUSH.' The word 'CITY' in 'CITY RUSH' simply limits the description of the general word 'RUSH' to the 'RUSH' that one feels when he is in the CITY. Hence, 'CITY RUSH' could also be called 'URBAN RUSH,' 'METROPOLITAN RUSH,' or 'MUNICIPAL RUSH.' In other words, any variation of the word 'CITY' may be interchanged or substituted with the 'CITY' in 'CITY RUSH.' The bottom line therefore is the word 'RUSH,' which is already registered in favor of the Opposer.

"8. The impression that one gets from the word 'RUSH' is one similar to that of an 'adrenaline rush.' 'RUSH' connotes energy and a sense of urgency. Therefore, a 'RUSH' means 'a rush' whether it is a 'city rush' or from someplace else.

"9. In McDONALD'S CORPORATION vs. MACJOY FASTFOOD CORPORATION, G.R. No. 166115, February 2, 2007, it was held: x x x

"10. The ruling in the MACJOY case is applicable to the instant case. As stated above, the similarity between 'CITY RUSH' and 'RUSH' is the dominant word

¹A domestic corporation duly organized and existing under the laws of Philippines, with principal address at No. 880 A.S. Fortuna Street, Banilad, Mandaue City, Cebu.
²A foreign corporation organized and existing under the laws of the United States of America, with address at 1345 Avenue of the Americas, New York, New York 10105-0196. USA.
³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

'RUSH.' As illustrated in paragraph 12 herein, the word 'CITY' in 'CITY RUSH' is but a minor difference. The aural impression created upon hearing the two marks is definitely the word 'RUSH.'

"11. Applying the dominancy test, 'CITY RUSH' and 'RUSH' are confusingly similar with each other such that an ordinary purchaser can conclude an association or relation between the marks.

"12. In the MACJOY case, the Supreme Court cited with approval the IPO's finding: x x x

"13. In the same vein, the differences and variations in the styles and fonts of 'CITY RUSH' and 'RUSH' are but miniscule variations that are overshadowed by the predominant word 'RUSH.'

"14. In the case of SOCIETE DES PRODUITS NESTLE, S.A., et al., vs. COURT OF APPEALS, et al., G.R. No. 112012, April 4, 2001, the Supreme Court also quoted with approval the BPTTT'S finding that:

"15. In the same manner, when one looks at 'CITY RUSH,' one's attention is easily attracted to the word 'RUSH.'

"16. The Opposer has priority over the Respondent because the latter's use and date of registration for the 'RUSH' mark precedes the date of filing of the Respondent's subject trademark application, which was filed only on October 6, 2011. As early as January 28, 2009, the Opposer filed an application for registration of the word 'RUSH' as a trademark for Class 3 and was subsequently granted registration on November 21, 2009.

"17. Since 'CITY RUSH' covers the following Class 3 goods: 'FRAGRANCE AND TOILETRY PRODUCTS, NAMELY, EAU DE PARFUM, EAU DE TOILETTE, COLOGNE, BODY SPRAY, BODY BALM, AND PERSONAL DEODORANT; BATH AND BODY GEL, SKIN MOISTURIZERS, HAIR LOTION; MAKE-UP FOR THE FACE AND NECK,' there will be trademark infringement through confusion of goods as these are also the same products for which the Opposer's 'RUSH' is also registered (Class 3). Moreover, there will also be trademark infringement through confusion of business as both parties are engaged in the business of selling Class 3 products.

"18. Moreover, the Respondent's proposed mark will dilute the strength of the Opposer's registered 'RUSH' as a unique indicator of the source of the Opposer's goods. The Respondent's proposed mark will lessen the capacity of the Opposer's distinctive 'RUSH' marks to distinguish and identify the Opposer's goods from those of others, thereby diluting the distinctive quality of the 'RUSH' mark. Dilution of the marks is the damage that this opposition seeks to obviate.

"19. Where the goods or services are identical or virtually identical, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. x x x

"20. In examining likelihood of confusion of marks, the issue is not whether the respective marks themselves, or the goods or services offered under the marks, are likely to be confused but, rather, whether there is a likelihood of confusion as to the source or sponsorship of the goods or services because of the marks used thereon. x x x

"21. The erroneous commercial impression that would result is that the goods under 'CITY RUSH' are improved or limited versions of the goods under the Opposer's trademark 'RUSH.'

"22. The bottomline is that consumers will be likely led to believe that 'CITY RUSH' and 'RUSH' have a single source - the Opposer. This will happen if the subject mark is allowed registration.

"23. It is important to note that the modern view now as to the function of a trademark is that: a trademark indicates a single, albeit anonymous, source, which in the book of McCarthy was explained as: x x x

"In sum, the subject trademark is confusingly similar to the Opposer's 'RUSH' and the same would also dilute the goodwill of the Opposer's said mark.

The Opposer's evidence consists of a copy of the Opposer's trademark "RUSH" with Trademark Registration No. 4-2009-000904.⁴

This Bureau issued a Notice to Answer and sent a copy thereof upon Respondent-Applicant on 28 May 2012. The Respondent-Applicant filed their Answer on 28 August 2012 and avers the following:

x x x

"Affirmative Defenses

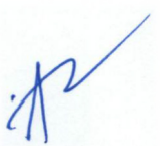
"18. Contrary to the self-serving claims of the Opposer, the word CITY in the Respondent-Applicant's mark 'CITY RUSH' is not intended as a description of the word 'RUSH'. It is in fact an integral part of the singular and composite mark CITY RUSH used by the Respondent-Applicant to identify its products as shown below. x x x

"19. A perusal of the 'CITY RUSH' marks as used in its products clearly shows that the word 'CITY' is intended to be used in conjunction with the word 'RUSH', rather than a mere 'description' as self-servingly suggested by Opposer.

"20. Moreover, even assuming that the dominance test, as suggested by the Opposer is applied in order to determine the existence of similarity, a review of the product and its packaging unequivocally shows that as between the words 'CITY' and 'RUSH' the dominant feature would clearly be the word 'CITY, the letter 'C' of 'CITY' having also been used in a stylistic manner to further create distinctiveness of the brand.

"21. Consequently, even under the dominance test, there is no confusing similarity between the said marks.

⁴Marked as Exhibit "A".



"22. Furthermore, under the Holistic Test, a standard used by the courts in determining the existence of confusing similarity, the entirety of the competing marks is considered in order to determine the existence of confusing similarity between goods.

"23. According to jurisprudence, when a trademark consists of several words, the mere fact that one of those words is identical or nearly identical to the trademark of another is not enough to conclude that confusing similarity exists. To illustrate, the court has ruled that in the absence of other factors rendering the goods confusingly similar, the contemporaneous use of the following words are permissible: TIGER SHARK and TIGER for watches, and CRYSTAL CREEK and CRISTAL for wine.

"24. In fact in Asia Brewery Inc. vs. CA, the Supreme Court found that the similarity of two words found in the opposing parties' trademarks was not sufficient to conclude that confusing similarity exist thus: x x x

"25. The same can be said of Opposer's mark 'RUSH' and Respondent-Applicant's separate and distinguishable mark 'CITY RUSH'. The mere fact that one of those words is identical or nearly identical to the trademark of another is not enough to conclude that confusing similarity exists. The possibility of confusion is more imagined than it is real.

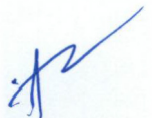
"26. That the Opposer's trademark 'RUSH' is not confusingly similar with other 'Composite Marks' bearing the same word is further supported by the existence of numerous registered composite marks bearing the word 'RUSH' and under the same Class 3, some of which have been registered even prior to opposer's mark. Below is a list of some of these marks. x x x

"27. The existence of the above marks, all of which fall under the same class as opposer's mark, and have existed prior to opposer's registration of its own mark clearly negates its claim that it has the exclusive right to use the word 'RUSH'.

"28. In fact if the argument of Opposer is to be given credence, then its registration of the mark 'RUSH' should have been denied because of the existence of the previously registered marks 'MOUNTAIN RUSH', 'BEAUTY RUSH', 'GUCCI RUSH', 'ICY RUSH' ('Previous Registrants'), but it was not refused. The truth being that the use of the word 'RUSH' by the Previous Registrants as part of their composite marks is not and will not cause confusion in the minds of the ordinary purchaser when compared to Opposer's singular mark 'RUSH'.

"29. In the same vein, the subsequent registration by the Respondent-Applicant of the mark 'CITY RUSH' will not cause confusion as to the source of the goods.

"30. Thus, while the contending marks cover the same class, the obvious dissimilarities in their presentation far outweigh and dispel any gratuitous pretension of similitude. More importantly the existence of numerous marks prior to and after the registration of Opposer's mark 'RUSH' points to the plain fact that the use of the word 'RUSH' in and of itself as part of another composite mark did not and will not result any confusion.



The Respondent-Applicant's evidence consists of copies of some of the application certificates of registrations of the trademarks of "CITY RUSH" and "AVON" trademarks; copies of representative certificates of registration of the above-named registrations.⁵

Should the Respondent-Applicant be allowed to register the trademark CITY RUSH?

It is emphasized that 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 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.⁶

Thus, Sec. 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides:

- (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;"

Records show that at the time the Respondent-Applicant filed its trademark application on 06 October 2011, the Opposer already owns trademark registration for RUSH under Trademark Registration No. 4-2009-000904 issued on 21 November 2009. The registration covers "perfumery products namely, perfumes (roll-on and/or spray), colognes, toilet water and toilet lotions, shampoos, soaps, lathering and softening products for use in bath, toothpaste, cosmetics, make-up, lipstick, toilet products against perspiration, hair dyes, hair gels, powder and nail polish" in Class 03. This Bureau noticed that the goods indicated in the Respondent-Applicant's trademark application, i.e. fragrance and toiletry products, namely, eau de parfum, eau de toilette, cologne, body spray, body balm, and personal deodorant; bath and body gel, skin moisturizers, hair lotion; make-up for the face and neck in Class 03, are similar and/or closely-related to the Opposer's.

But, are the competing marks, as shown below, resemble each other such that confusion, or even deception is likely to occur?

⁵Marked as Exhibits "A" and "C", inclusive.

⁶ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepe v. Director of Patents, supra. Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

rush

Opposer's trademark

CITY RUSH

Respondent-Applicant's mark

The Respondent-Applicant's mark CITY RUSH is confusingly similar to Opposer's trademark RUSH. Even with the accompanying word CITY, to the Bureau's mind, top of the mind recall would be the word RUSH. Both marks bear the word RUSH. Respondent-Applicant's mark CITY RUSH covers perfumery and toiletries in Class 03, goods which the Opposer deals in under the mark RUSH. It is likely therefore, that a consumer who wishes to buy perfumery and toiletries and is confronted with the mark CITY RUSH, will think or assume that the mark or brand is just a variation of RUSH or is affiliated with the Opposer's.

The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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.⁷

In conclusion, the Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) (iii) of the IP Code.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-012029 is hereby SUSTAINED. Let the filewrapper 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.

Taguig City, 06 January 2016.


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

⁷ *Converse Rubber Corp. v. Universal Rubber Products, Inc. et. al.*, G.R. No. L-27906, 08 Jan. 1987.