

PEERLESS LION CORPORATION,
Opposer,

-versus-

MIHO INTERNATIONAL COSMETIC
CO. LTD.,
Respondent- Applicant.

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IPC No. 14-2015-00492
Opposition to:
Appln. Serial No. 4-2015-500747
Date Filed: 11 February 2015
TM: "MISS HANA"

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NOTICE OF DECISION

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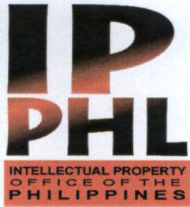
GREETINGS:

Please be informed that Decision No. 2016 - 168 dated June 08, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 08, 2016.

For the Director:

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



PEERLESS LION CORPORATION,

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MIHO INTERNATIONAL COSMETIC
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Respondent-Applicant.

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IPC NO. 14-2015-0 0492

Opposition to:

Appln. Ser. No. 4-2015-500747

Filing Date: 11 February 2015

Trademark: MISS HANA

Decision No. 2016 - 168

DECISION

PEERLESS LION CORPORATION,¹ ("Opposer") filed a Verified Opposition to Trademark Application Serial No. 4-2011-003845. The application, filed by MIHO INTERNATIONAL COSMETIC CO. LTD.² ("Respondent-Applicant") covers the mark **MISS HANA** for use on "*cosmetics; cleansing milk for toilet purposes; essential oils; tissues impregnated with cosmetic lotions; baths (cosmetic preparations for -); cotton wool for cosmetic purposes; pomades for cosmetic purposes; skin care (cosmetic preparations for -); lipsticks; eyelashes (cosmetic preparations for -); depilatory preparations; beauty masks; perfumes; skin whitening creams; sunscreen preparations; astringents for cosmetic purposes; nail polish*" under Class 03 and "*business services, namely, services related to network trading platform; advertising; import-export agencies; sales promotion for others; procurement services for others [purchasing goods and services for other businesses]; commercial administration of the licensing of the goods and services of others; on-line advertising on a computer network; presentation of goods on communication media, for retail purposes; layout services for advertising purposes; business inquiries; marketing; outdoor advertising; business information; distribution of samples; direct mail advertising; publication of publicity texts; television advertising; management (advisory services for business -); radio advertising; demonstration of goods*" under Class 35 of the International Classification of goods³.

The Opposer alleges the following grounds:

"1. Opposer PLC is the first to adopt, use, apply for, and register the 'HANA' trademarks (in the Philippines for goods under class 3. Therefore, it enjoys under Republic Act (R.A.) No. 8293 otherwise known as the "Intellectual Property Code of the Philippines" (IP Code) the right to exclude others from registering or using an identical or confusingly similar mark such as Respondent-Applicant's 'Miss HANA' mark.

"2. PLC's 'HANA' trademarks are well-known in the Philippines, taking into account the

¹ A domestic corporation duly organized, existing and in good standing under the laws of the Republic of the Philippines with address at Airstrip Street, Silangan Industrial Park, Canlubang, Calamba City, Laguna

²A foreign corporation organized and existing under the laws of Taiwan with office address at address at 1F., No. 89 Xizang Rd., Zhongzheng Dist., Taipei City.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

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knowledge of the relevant sector of the public, rather than the public at large, as being trademarks expressly and directly referring to and owned by the PLC.

"3. There is a likelihood of confusion between PLC's 'HANA' trademarks and Respondent-Applicant's 'Miss HANA' mark because the latter's second word "HANA" is identical in sound, spelling, connotation and appearance to the former's 'HANA' trademarks as to likely cause confusion, mistake and deception to the public.

"4. Respondent-Applicant, by adopting the 'Miss HANA' mark for its goods, is likely to cause confusion, or to cause mistake, or to deceive as to affiliation, connection, or association with the PLC, or as to origin, sponsorship, supervision, authorization or approval of its products by the PLC, for which it is liable for false designation of origin, false description or representation under Section 169 of R. A.No.8293.

The Opposer's evidence consists of the following:

1. Notarized Secretary's Certificate;
2. Certified copy of Certificate of Incorporation of Peerless Lion Corporation ;
3. Notarized Affidavit of witness Norman Mier;
4. Certified true copies of Certificates of Registration Nos. 4-2012-00502372 and 4-2014-00500767;
5. Sample actual labels of packaging of "HANA" products;
6. Sample original pictures of "HANA" products and their prices;
7. Sample original pictures of promotional and advertising products of "HANA" trademark;
8. List of establishments where "HANA" products are available; and
9. Originals Sales Invoices from years 2013 to 2015 of "HANA" products marked.

This Bureau issued on 29 January 2016 a Notice to Answer and personally served it to Respondent-Applicant's counsel on 09 February 2016. On 19 May 2016, this Bureau declared Respondent-Applicant in default. Accordingly, pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark "MISS HANA"?

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 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.⁴ Thus, Sec. 123.1 (d) of the 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 nearly resembles such a mark as to be likely to deceive or cause confusion.

⁴See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

The records show that at the time the Respondent-Applicant filed its application for the mark MISS HANA on 11 February 2015, the Opposer already has an existing registration for the trademark HANA issued in 2012 and 2014. Opposer's mark HANA is used in "shampoos, hair conditioner, body wash, hand wash in liquid form and hand wash in foam" under Class 3. Respondent-Applicant also will use its mark Miss Hana on goods belonging to Class 3 and business services under Class 35. As such the goods of the parties are related to each other.

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

HANA Hana

Opposer's Marks

Miss Hana
花娜小姐

Respondent-Applicant's Mark

There is no doubt that Respondent-Applicant's mark is confusingly similar to the Opposer's. Confusion is likely in this instance because of the resemblance of the competing trademarks. Respondent-Applicant's mark contains the word "HANA" which constitutes the Opposer's trademark. While Respondent-Applicant added the word "Miss" before the word "HANA" to produce the mark "Miss HANA", with the Chinese characters below, there is still a likelihood that consumers or the public will be confused, mistaken or deceived that the goods bearing the competing marks are used come from the same source or origin because of the presence of the word "HANA". Aptly, confusing similarity is to be determined on the basis of visual, aural, connotative comparisons and overall impressions engendered by the marks in controversy as they are encountered in the realities of the marketplace.⁵ Also, Opposer has two (2) variations of its HANA mark as depicted above. Thus, it is very likely that the registration of Respondent-Applicant's "Miss HANA" mark would lead the public to believe that it is just one of the variations of Opposer's marks because of its similarity to the latter's mark and considering that the marks are used on similar and/or related goods.

⁵ *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217

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 trade name 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.⁷


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

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

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2015-500747, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City 08 JUN 2016


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

⁶ *Supra*.

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

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