

CONSOLIDATED ARTISTS B.V.,
Opposer,

-versus-

THE FACESHOP CO., LTD.,
Respondent-Applicant.

X-----X

IPC No. 14-2013-00251

Opposition to:

Appln. Serial No. 4-2013-00000693

Date Filed: 22 January 2013

TM: MANGO SEED

NOTICE OF DECISION

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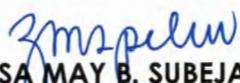
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GREETINGS:

Please be informed that Decision No. 2016 - 315 dated 20 September 2016
(copy enclosed) was promulgated in the above entitled case.

Taguig City, 20 September 2016.


Atty. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

CONSOLIDATED ARTISTS B.V.,

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-versus-

THE FACESHOP CO., LTD.,

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IPC No. 14-2013-00251

Opposition to Trademark

Application No. 4-2013-000693

Date Filed: 22 January 2013

Trademark: **"MANGO SEED"**

Decision No. 2016- 315

DECISION

Consolidated Artists B.V.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-000693. The contested application, filed by The Faceshop Co., Ltd.² ("Respondent-Applicant"), covers the mark "MANGO SEED" for use on *"cosmetics, skin lotions; moisturizing skin lotions; non-medicated skin astringents for cosmetic purposes; facial concentrated emulsion; after shave lotions; skin conditioners; blusher; perfumes; colognes; skin cleansing creams; make-up foundation in the form of powder; concealers; lipsticks; toilet water; eye shadow; eyebrow pencils; eye liners; nail polish; nail polish remover; beauty mask; sunblock skin creams; hair shampoo; hair rinse; hair spray; toilet soaps; bath soaps; body cleansers; fragrance mist for personal use; tonic mist for personal use; body gel; bath gel; body cream scrub; shampoos, soap; toothpaste"* under Class 03 of the International Classification of Goods³.

The Opposer maintains that it is the owner and prior registrant of the mark "MANGO", which it has allegedly used since 1997. It contends that the presence of the word "SEED" does not render the Respondent-Applicant's mark significantly different from its own mark as the word "MANGO" catches the immediate attention of the public while "SEED" is merely a minor addition. It points out that the competing marks deal with the same goods under Class 03. According to the Opposer, its mark "MANGO" has become well-known. At present, it has two thousand four hundred fifteen (2,415) shops worldwide and twenty-three (23) in the Philippines. It also has registrations and/or pending registrations in various countries. In addition, it has spent considerable sums of money in advertisements. In support of its Opposition, the Opposer submitted the affidavit of Miguel dela Capilla, with annexes.⁴

¹ A corporation with address at 68 3012 EP Rotterdam, Netherlands.

² With address at 92 Sinmundo 2-GA, Jongno-Gu, Seoul, Republic of Korea.

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

⁴ Marked as Exhibits "A" to "A-10".

The Respondent-Applicant filed its Verified Answer on 11 November 2013 denying that the mark "MANGO SEED" is confusingly similar to the Opposer's "MANGO" mark. It argues that the Opposer cannot claim exclusive use of the word "MANGO" for being generic. It asserts that its "MANGO SEED" line is not the only cosmetic or skincare products flavored mango or bearing the said word. The Respondent-Applicant's evidence consists the following:⁵

1. printouts of its "MANGO SEED" skincare and cleansing products;
2. printouts of Body Shop mango products;
3. decision in Consolidated Artists B.V. vs. Camille Beckman Corporation; and,
4. sworn statement of its Chief Executive Officer Suk-Yong Cha.

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. The parties, however, refused to mediate. Accordingly, the Hearing Officer conducted a preliminary conference and the same was terminated on 14 October 2014. Thereat, the parties were directed to submit their respective position papers. After which, the case is deemed submitted for decision.

The issue to be resolved in this case is whether the Respondent-Applicant's trademark "MANGO SEED" should be allowed.

Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), provides that:

"Section 123. Registrability. - 123.1. 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; x x x"

Records reveal that at the time the Respondent-Applicant filed the contested application for the mark "MANGO SEED", the Opposer has valid and existing registration for the mark "MANGO" issued as early as 12 March 2007.

But, are the competing marks, as shown hereafter, confusingly similar?

⁵ Marked as Exhibits "1" to "4", inclusive.

MANGO

**MANGO
SEED**

Opposer's Mark

Respondent-Applicant's mark

The contending marks both appropriate the word "MANGO". This, however, is a common English word pertaining to a fruit. Especially when applied to skincare products, the said word suggests the scent and/or ingredient of the goods. What will therefore determine whether the marks are confusingly similar are the words and/or figures that accompany the same. In this case, the Respondent-Applicant's mark is composed of two words "MANGO" and "SEED" while that of the the Opposer merely consists of the single word "MANGO". Overall, they are different in presentation and impression such that despite of their similar appropriation of "MANGO", there is no likelihood of confusion and/or deception that may be caused to the consumers.

Moreover, the use of the word "MANGO" as a trademark or as a part of a mark has not been exclusive to the Opposer's. The Trademark Registry of this Office, which this Bureau may take judicial notice, has registered other marks appropriating the word "MANGO", either alone or accompanied by other words and/or devices, also for goods under Classes 03. These marks are "MANGO MASSAGE" under Certificate of Registration No. 4-2013-503020 and "MERRY MANGO MEDLEY" under Certificate of Registration No. 4-2012-012385, both belonging to different proprietors.

Finally, 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 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 The Bureau finds the Respondent-Applicant's trademark to have substantially met this requirement.

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

Finding no confusing similarity between the two marks, there is no necessity for a determination whether the Opposer's mark "MANGO" is well-known.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-000693 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 20 SEP 2016 .


ATTY. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs