

SUYEN CORPORATION,
Opposer,

-versus-

SPLASH CORPORATION,
Respondent- Applicant.

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}
} IPC No. 14-2013-00201
} Opposition to:
} Appln. Serial No. 4-2012-014351
} Date Filed: 23 November 20212
} TM: "PROFIX"
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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 341 dated September 29, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 29, 2016.

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

SUYEN COPORATION,

Opposer,

-versus-

SPLASH CORPORATION,

Respondent-Applicant.

X ----- X

IPC No. 14-2013-00201

Opposition to Trademark

Application No. 4-2012-014351

Date Filed: 23 November 2012

Trademark: **"PROFIX"**

Decision No. 2016- 341

DECISION

Suyen Corporation¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-014351. The contested application, filed by Splash Corporation² ("Respondent-Applicant"), covers the mark "PROFIX" for use on "*hair care products for cleansing, nourishing, damage repair and hair coloring*" under Class 03 of the International Classification of Goods³.

According to the Opposer, it was incorporated in 1985 as manufacturing company dealing in clothing apparel, garments and accessories. At present, it is in the business of manufacturing, marketing, advertising, distributing and selling apparel and lifestyle products carrying different brands and trademarks, including "BENCH". Among others, it has penetrated the service industry particularly beauty salon services under the name "FIX BENCH SALON, which is operated by B Cut, Inc., its sister company. Even before it opened its first salon in 2001, it has already manufactured, advertised, distributed and sold hair products under its "FIX" trademark.

The Opposer maintains that the mark "FIX" was issued registration on 01 July 2004. It likewise claims to have registered the marks "FIX BENCH SALON", "I-FIX & Device of letter I" and "Bench/FIX PROFESSIONAL". It thus contends that the Respondent-Applicant's mark is identical or confusingly similar to its own "FIX" trademarks. In support of their Opposition, the Opposer submitted the affidavit of Kristine Anne C. Lim, with annexes.⁴

The Respondent-Applicant filed its Answer on 14 October 2013 alleging, among others, that its company was established in 1985 and has engaged in the

¹ A corporation organized and existing under the laws of the Republic of the Philippines with office address at Bench Tower, 30th Street corner Rizal Drive, Crescent Park West 5, Bonifacio Global City, Taguig 1634.

² A domestic corporation with office address at 5F W Building, Bonifacio Global City, Taguig City.

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 "P", inclusive.

business of personal care manufacturing and marketing, international distribution, and recently, health and wellness products development and marketing. It has marketed various personal care products such as Extraderm, Maxi-Peel, Skin White, Biolink and Profix. The "PROFIX" mark was coined from the phrase "PROPER FIX", which is how the incorporators envisioned its hair products to be.

According to the Respondent-Applicant, it first applied for registration of the mark "PROFIX" in 2002. Since 2004, it used the mark through appearance in trade shows, exhibition and other promotional activities. It denies that the Opposer's mark "FIX" is confusingly similar with its applied mark "PROFIX". The Respondent-Applicant's evidence consists of the following:⁵

1. copy of Application No. 4-2002-6730;
2. affidavit of Grace D. Del Rosario;
3. printout of marks containing the word "FIX"; and
4. affidavit of Rachelle M. Layam, with annexes.

Pursuant to Office Order No. 154, s. 2010, the case was referred to mediation. The parties, however, failed to settle their dispute through mediation. Accordingly, the Hearing Officer conducted a preliminary conference and the same was terminated on 03 June 2014. Thereafter, the parties submitted 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 application for "PROFIX" should be allowed.

Section 123.1 (d) of RA 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that:

"123.1. A mark cannot be registered if it:

(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;

xxx."

Records reveal that at the time the Respondent-Applicant filed its application for registration of the contested mark on 23 November 2012, the Opposer has

⁵ Marked as Exhibits "2" to "5", inclusive.

already registered the mark "FIX" under Certificate of Registration No. 4-2000-00133 issued on 01 July 2004 for "hair lotion, hair gel, hair crème, hair polish, hair shampoo, hair conditioner" under Class 03.⁶ The Opposer likewise holds registration for the marks "FIX BENCH SALON", "I-FIX & Device OF LETTER I" and "BENCH/FIX PROFESSIONAL" issued on 07 February 2004, 16 July 2006 and 18 September 2006, respectively.⁷

But are the marks, as shown below, confusingly similar?

Opposer's Marks

FIX **FIX***
BENCH SALON



Respondent-Applicant's Mark

PROFIX

The Opposer's marks consist of the word "FIX" alone or in conjunction with other words. Although the word "FIX" is also incorporated in the Respondent-Applicant's applied mark, the same cannot be considered as the prevalent and/or highlighted element thereof. Be that as it may, this Bureau finds that the probability that the consumers will be confused, mistaken or deceived still subsists. Perusing the Respondent-Applicant's mark "PROFIX", the same looks like a derivative of the Opposer's mark "BENCH/FIX PROFESSIONAL". It appears that the first syllable "PRO" in the word "PROFESSIONAL" was merely combined with the word "FIX".

⁶ Exhibit "B".

⁷ Exhibits "C", "D" and "E".

Succinctly, 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 purchasers as to cause him to purchase the one supposing it to be the other.⁸

Moreover, since the Respondent-Applicant will also use or uses the mark on goods also falling under Class 03, the slight differences in the competing marks will not diminish the likelihood of the occurrence of confusion, mistake and/or deception. After all, the determinative factor in a contest involving registration of trade mark is not whether the challenged mark would *actually* cause confusion or deception of the purchasers but whether the use of such mark would *likely* cause confusion or mistake on the part of the buying public.⁹

Furthermore, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. Callman 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*: "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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."¹⁰

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.¹¹ Based on the above discussion, Respondent-Applicant's trademark failed to meet this function.

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

⁸ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁹ American Wire & Cable Company vs. Director of Patents, G.R. No. L-26557, 18 February 1970.


¹⁰ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

¹¹ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-014351 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 29 SEP 2016


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