

SEPHORA,
Opposer,

-versus-

LEILA T. CRISTOBAL,
Respondent- Applicant.

x-----x

}
} IPC No. 14-2011-00154
} Opposition to:
} Appln. Serial No. 4-2010-006301
} Date Filed: 11 June 2010
} TM: "SEPHORA NATURALLY
} INGREDIENTS, OPTIONS,
} RESULTS AND LOGO"
}

NOTICE OF DECISION

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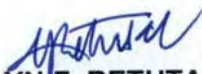
LEILA T. CRISTOBAL

Respondent- Applicant
15 Alliance Street, Village East
Cainta, Rizal

GREETINGS:

Please be informed that Decision No. 2016 - 393 dated October 28, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 28 October 2016.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

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Opposer, } Opposition to:
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-versus- } Appln. Ser. No. 4-2010-006301
 } Date Filed: 11 June 2010
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LEILA T. CRISTOBAL, } Trademark: "SEPHORA NATURALLY
Respondent-Applicant. } INGREDIENTS, OPTIONS, RESULTS
 } AND LOGO"
 }
x-----x } Decision No. 2016- 393

DECISION

SEPHORA, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2010-006301. The application, filed by LEILA T. CRISTOBAL (Respondent-Applicant)², covers the mark "SEPHORA NATURALLY INGREDIENTS, OPTIONS, RESULTS AND LOGO", for use on "food supplements" under Classes 3, 18, 25 and 35 of the International Classification of Goods³.

In support of the opposition, the Opposer alleges, among others, the following:

"2. Opposer is filing the present Opposition under the following laws:

2.1. Section 123. (e) of the Intellectual Property Code (Republic Act 8293) which states that a mark cannot be registered if it:

Is identical with, or confusingly similar to, or constitutes a translation of a mark with which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

¹ A corporation duly organized and existing under the laws of France with address at 65, avenue Edouard Vaillant 92100 Boulogne Billancourt France

² Filipino with address at 15 Alliance Street Village East, Cainta Rizal

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

2.2 Section 123 (f) of the Intellectual Property Code (Republic Act 8293) which states that a mark cannot be registered if it:

Is identical with or confusingly similar to, or constitutes a translation of a mark, considered well known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods and services which are not similar to those with respect to which registration is applied for: Provided, that the use of the mark in relation to the goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, that the interests of the owner of the registered mark are likely to be damaged by such use." xxx

"3. Opposer is the owner of trademark 'SEPHORA & DEVICE' over goods classified under Class 03 (perfumes, perfumery products, essential oils, toilet waters, cosmetics, non-medicated toilet preparations and products and products, beauty products, make-up products, hair lotions, shampoos, moisturizers, lotions and creams for bath and the shower, bath foams, deodorants for personal use) and 35 (retail store services in the field of perfumery products, cosmetic products, beauty products, make-up products, beauty salons, services of consultation and advice in the field of perfumery and beauty).

"4. Opposer acquired ownership over the trademark 'SEPHORA & DEVICE' through creation, prior adoption and earlier use of the said mark in addition to their standing as internationally well-known mark.

"5. Opposer adopted its mark in 1973 in its home country, France and has since then been in active use and promotion of the same in many countries all over the world. Originally branded as Shop 8, Mandonnaud re-named the concept Sephora in 1993 by merging the biblical name Zipporah (Moses' exceptionally beautiful wife), with the ancient Greek word for 'pretty', or sephos.

"6. On the other hand, Respondent only applied for registration of the mark 'SEPHORA NATURALLY' under classes 03, 18, 25 and 35 in June 11, 2010.

Clearly, Opposer has used its trademark prior to the filing of the Respondent-Applicant of its application with this Honorable Office.

"7. Thus, being the creator and prior adopter of the trademark 'SEPHORA & DEVICE' Opposer is, under the Intellectual Property Code, the true owner of the mark and thus, has the right to use the same to the exclusion of all others, including Respondent herein.

"8. Opposer's word mark 'SEPHORA & DEVICE' enjoy global acclaim and is internationally well-known.

"9. Sephora was founded in 1993 in France by Dominique Mandonnaud, who fashioned the store's unique name by blending the Biblical name of Zipporah (Moses' exceptionally beautiful wife) with the ancient Greek term for 'pretty', sephos. Today, Sephora is not only the leading chain of perfume and cosmetics stores in France, it's also a powerful beauty presence in many countries. In the United States alone, there are over 250 Sephora stores and over 200 Sephora inside JCPenney stores.

"10. Owned by Louis Vuitton Moet Hennessy (LVMH), the world's leading luxury goods group, Sephora is highly regarded as a beauty trailblazer, thanks to its unparalleled assortment of prestige products, unbiased service from experts, interactive shopping environment and innovation.

"11. Opposer registered the mark 'SEPHORA & DEVICE' in France, and also used the said word mark in selling its goods.

"12. Opposer's goods bearing the trademark 'SEPHORA & DEVICE' enjoys international reputation and goodwill for their quality. Apart from France, Opposer's goods which use the trademark 'SEPHORA & DEVICE' are also sold and distributed worldwide for many years after its inception in 1993, such as but not limited to: Italy, Spain, Portugal, Poland, Turkey, Netherlands, Greece, Romania, Croatia, Serbia, Russia, United States, Canada, Puerto Rico, UAE, Kuwait, Oman, China, Malaysia and Singapore.

"13. Opposer extensively and continuously advertises its products, trademarks and name in print and broadcast media, worldwide. Proof of which are its numerous commercials and endorsements by famous celebrities such as Jeniifer Aniston, Kate Walsh and the popular television series, GLEE.

"14. Opposer's 'SEPHORA & DEVICE' products likewise have a prevalent online presence as a search of the word 'Activia' on popular search engines such as Google or Yahoo yields article and image results pertaining to the Opposer and its goods. Opposer also features its 'SEPHORA & DEVICE' products in its website, <http://www.sephora.com/>. Launched in October 1999, Sephora.com offers the largest and diverse selection of beauty products on the internet: from classic hard to find brands to Opposer's own private label, SEPHORA BRAND.

"15. From the foregoing, it is evident that Opposer's trademark is well known in the world over and should be recognized as a 'well-known mark' as defined and qualified under Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers.

"16. Naturally, use of the mark 'SEPHORA NATURALLY' results in likelihood of confusion. xxx"

To support its opposition, the Opposer submitted as evidence the following:

1. Certified copies of certificates of trademark registration in other jurisdictions;
2. Copies of vouchers, invoices and receipts with the word "SEPHORA";
3. Pages from magazines and articles showing advertising and publicity of "SEPHORA" products;
4. Table showing sales of products;
5. Special Power of Attorney dated 14 June 2011; and
6. Legalized and authenticated Secretary's Certificate dated 4 July 2011.⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 14 July 2011. The Respondent-Applicant, however, did not file an Answer. Records show a Respondent's Position Paper On 2 November 2011, Order No. 2011-1526 was issued declaring the Respondent-Applicant to have waived her right to file an answer.

Should the Respondent-Applicant be allowed to register the trademark "SEPHORA NATURALLY INGREDIENTS, OPTIONS, RESULTS AND LOGO"?

The competing marks, depicted below, are identical:



Opposer's mark



Respondent-Applicant's mark

The marks are identical both in the spelling or word component of the mark, SEPHORA and the logo or device which consists of a vertical curved line. The insignificant differences in Respondent-Applicant's mark is that the word SEPHORA is stylized and the device is accompanied by an oval background. But these modifications are trivial, minor and insignificant and do not differentiate it from Opposer's mark.

The Opposer explained that the word SEPHORA originated from blending the Biblical name of Zipporah (Moses' exceptionally beautiful wife) with the ancient Greek term for 'pretty', sephos. The Opposer presented various registrations of its mark, SEPHORA⁵ abroad and advertising of its product in magazines and various publications.⁶ In contrast, the Respondent-Registrant despite the opportunity given, did not file an Answer to defend its trademark registration and to explain how he arrived at using the mark SEPHORA, which is the

⁴ Exhibits "A" to "G" inclusive of submarkings

⁵ Exhibit "B" series

⁶ Exhibit "D" series

same as the Opposer's. The Opposer's mark is unique and highly distinctive. It is incredible for the Respondent-Applicant to have come up with exactly the same mark, a copycat of Opposer's mark, for use on similar goods by pure coincidence.

In this regard, This Bureau emphasizes that it is not the application or the registration that confers ownership of a mark, but it is ownership of the mark that confers the right to registration. The Philippines implemented the World Trade Organization Agreement "TRIPS Agreement" when the IP Code took into force and effect on 1 January 1998.⁷

The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.

Significantly, Sec. 121.1 of the IP Code adopted the definition of the mark under the old law on Trademarks (Rep. Act. No. 166), to wit:

121.1 "Mark" means any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods; (Sec. 38, R.A. No. 166a)

Sec. 122 of the IP Code also states:

Sec.122. How Marks Are acquired.- The rights in a mark shall be acquired through registration made validly in accordance with the provision of this law.

There is nothing in Sec.122 which says that registration confers ownership of the mark. What the provision speaks of is that the rights in the mark shall be acquired through registration, which must be made validly in accordance with the provision of the law. Clearly, it is not the application or the registration that confers ownership of a mark, but it is the ownership of the mark that confers the right of registration.

Succinctly, the public interest, requires that 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. The confusion or mistake would subsist not only 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

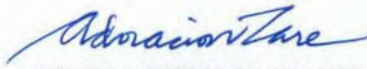
⁷ See Sec. 2: Trademarks, Art. 15 (Protectable Subject Matter)

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.⁸

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-006301 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 28 OCT 2016.


Atty. **ADORACION U. ZARE, LL.M.**
Adjudication Officer
Bureau of Legal Affairs

⁸*Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.