

CORLISON PTE LTD.,
Petitioner,

-versus-

MINA LIM,
Respondent- Registrant.

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}
} **IPC No. 14-2011-00558**
} **Petition for Cancellation:**
} **Reg. No. 4-2008-002158**
} **Date Issued: 11 August 2008**
} **TM: "PEARL WHITE & DEVICE"**

NOTICE OF DECISION

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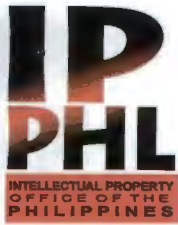
GREETINGS:

Please be informed that Decision No. 2016 - 486 dated December 23, 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, December 23, 2016.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



CORLISON PTE LTD,
 Petitioner,
 -versus-

MILA LIM,
 Respondent-Registrant.
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 } Reg. Date: 11 August 2008
 } Mark: "PEARL WHITE
 } & DEVICE"
 }
 } Decision No. 2016- 486

DECISION

CORLISON PTE LTD, (Petitioner)¹ filed a Petition for Cancellation of Registration No. 4-2008-002158. The registration, in the name of MILA LIM (Respondent-Registrant)², covers the mark "PEARL WHITE & DEVICE", for use on "cosmetics and skin care products, namely whitening soap, slimming soap, foundation, concealer, mascara, eye shadow, eye and/or brow liners, lipstick, lip liner, lip balm, face powder, spot removing, whitening, slimming essence, milk, bronzer, blusher, moisturizers, make-up remover, non-medicated body powder, skin soaps, bath gel, bath oil, bath salts, bath beads, and bath fizzies, balm oil, balm oil, non-medicated skin preparations, namely lotions, creams, cleaners, scrubs, masks and toners, hair care and hair styling preparations, namely shampoos, conditioners, finishing sprays and gels, personal deodorants, sun tanning preparations, sunscreen oils and lotion, shaving preparations, dentrifices, perfumes, eau de toilette, essential oils for personal use, perfume oils, nail care preparations, nail enamel, pumice stone, cotton sticks and wool swabs for non-medicated purposes, all for use in the body, scented room fragrances, incense sticks, potpourri, sachets and scented wood ornaments, powdered cosmetic tissues, tissues impregnated with lotions, kit and gift sets containing skin and/or hair care preparations, hair colorants, massage preparations, bath additives not for medical purposes, toilet napkins of cellulose wadding impregnated with cosmetics, beauty tonics for application to the body, mouth wash preparations (non-medicated) for oral hygiene purposes, tablets for oral use for disclosing dental plaque, tooth cleaning preparations, tooth pastes, footcare preparations (non-medicated), tape nipple, oil and essential embrocation, menthol cone" under Class 3, "pharmaceutical products for the treatment of cough etc." under Class 5 and "tea and tea based beverages" under Class 30 of the International Classification of Goods³.

The Petitioner anchors its petition on the following grounds:

"I. Petitioner is entitled to the exclusive use of the mark PEARLIE WHITE in view of its prior actual and continuous commercial use of the

¹ A foreign corporation duly organized and existing under the laws of Singapore with address at 7030 Ang Mo Kio Avenue 5 #0636/39, Northstar@AMK Singapore 569880

² Chinese citizen with address at 19B City Plaza Tower, No. 439 Plaza Del Conde Street, Binondo, Manila

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.

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mark over the registered mark PEARL WHITE & DEVICE of the Respondent. That Petitioner is damaged by the registration of Respondent's mark. That Petitioner, pursuant to section 151 of the Intellectual Property Code has within five (5) years from Registration of Respondent's mark file a petition for cancellation.

"II. Respondent's prima facie ownership of the mark PEARL WHITE & DEVICE has been overcome by Petitioner's prior, actual and continuous commercial use of the mark.

"III. Petitioner has likewise obtained an exclusive right to the use of the mark PEARLIE WHITE by virtue of acquisitive prescription.

"IV. Petitioner's mark has a protected goodwill over Respondent's mark.

"V. Petitioner's mark is well-known internationally and in the Philippines and has acquired distinctiveness that requires protection

Petitioner relies on the following facts:

"1. Petitioner manufactures and sells goods as *cosmetics oral care products* in Class 3 under the trademark PEARLIE WHITE. It exports and sells its products to the Philippines, Brunei, Cambodia, Indonesia, Malaysia, Myanmar, Nepal, Seychelles, Singapore, Taiwan and Vietnam, Hongkong, Kuwait, Laos, New Zealand, Australia, Bahrain, Switzerland, China, Egypt, European Union, Korea, Oman, Russian Federation, Turkey and United States of America.

"2. Petitioner has been exporting its products and in continuous commercial use of its trademark PEARLIE WHITE in the Philippines as early as January 2002 through its distributor Philippine International Commercial Corporation as evidenced by the following:

- a. Non-disclosure Confidentiality Agreement, dated 1 January 2002 with Petitioner's distributor Philippines Brands International Commercial Corporation which attest that PEARLIE WHITE Oral Care products were already being marketed and supplied in the Philippines in year 2002.
- b. Sales Reports of Brands International Commercial Corporation for sales of PEARLIE WHITE products in the Philippines for the years 2003 to 2009.
- c. Report of purchases by Brands International Commercial Corporation of PEARLIE WHITE Oral Care products for the year 2003 to 2005.

- d. Sales invoices for the purchase of PEARLIE WHITE Oral Care products from the petitioner to Brands International Commercial Corporation from 2004-2009.
- e. Product Information Sheets of PEARLIE WHITE Oral Care Products supplied by petitioner to its Philippine distributor in its correspondence, dated 18 September 2003.
- f. Correspondence between Ms. Daisy Yu, Category Manager of Watsons with Brands International Commercial Corporation in 2007 confirming PEARLIE WHITE Oral Care products to be sold at Watson Outlets in the Philippines.
- g. Overall Export Pricelist for 2007 and 2008 showing the PEARLIE WHITE Oral Care Products being sold by Brands International Commercial Corporation in the Philippines.
- h. Corlison Credit Note J2007 dated 31 December 2007 to Brands International Commercial Corporation for SD\$16,800.00, representing 10% advertising and promotion support based on 2007 sales of SD\$168,002.00 of PEARLIE WHITE Oral Care products and Watsons HWB Awards 2007, featuring PEARLIE WHITE Oral Care Products and Export Price List for Brands International Philippines.
- i. Terms and Conditions for the year 2008 for new PEARLIE WHITE Oral Care products listed with Chain Outlets such as Shopwise/Rustans, SM Hypermarket, SM Supermarket and Watsons.
- j. Brands International Commercial Corporation letter, dated 20 August 2008, providing a summary report of all deductions made by Watsons for the period 1 January to 12 August 2008 for PEARLIE WHITE Oral Care products.
- k. Pictures of PEARLIE WHITE Oral Care display at the 96th Philippine Dental Association Convention & Scientific Meeting & Exhibition held in 2004 where the products were sold to dentists.
- l. Articles on PEARLIE WHITE Oral Care products found on the Watson website in 2008.
- m. Reports of Brands International Commercial Corporation on various consumer promotions with Watsons in 2007.
- n. E-mail of herein petitioner dated 11 March 2008, funding support and sample support for the 100th Philippine Dental Association Exhibition in 2008.

- o. E-mails of Brands International Corporation in 2008, attaching advertising contracts, dated 5 March 2008, for PEARLIE WHITE Oral Care products and signed Philippine Dental Association Application/Contract Confirmation for Booth Reservation dated 17 March 2008, with official receipts.
- p. E-mails dated 9 July 2008 from Watsons buyer and confirmation dated 14 July 2008 regarding participation in the Watsons August theme promotion.
- q. Letter of Brands International Commercial Corporation dated 20 August 2008, showing sales of consumer price-off promotion of PEARLIE WHITE Oral Care products sold in Watsons for the period December 2007 to January 2008.

“3. On 8 January 2010, petitioner lodged a trademark application under Class 3 which was docketed as follows:

Application No. : 4-2010-000291
 Filing Date : 8 January 2010
 Mark : PEARLIE WHITE (Class 3)
 Description of Goods : Cosmetics oral care products

“4. On 20 May 2010, the esteemed examiner in-charge issued a registrability report stating that the petitioner’s trademark cannot be registered because it nearly resembles the following marks with earlier filing date or priority date, pursuant to Section 123.1 (d) (ii) of the Intellectual Property Code. xxx

“8. Petitioner’s PEARLIE WHITE oral care products have been sold in the Philippine market since 2002 through petitioner’s local distributor Brand International Commercial Corporation. In fact, it has through its local distributor, entered into contracts with the Philippine Dental Association, Watsons, SM and other retailers in order to enhance the distribution and sale of said products since 2003. To date, products sold under PEARLIE WHITE continue to obtain popularity in the local market through the local distributors and retailers. In consideration thereof, the products under the PEARLIE WHITE has obtained goodwill and business so identified with it through its prolonged commercial use of said mark in the Philippines, and irrespective of the filing of any trademark application, petitioner is entitled to protection afforded by the IP Code under Section 168.1.

“9. On 12 August 2010, the esteemed examiner issued an office action designated as Paper No. 5, stating:

‘The issue on the petitioner’s mark nearly resembles a registered mark (PEARL WHITE & DEVICE Reg. No. 4-2008-002158, issued on 11 August 2008) with

an earlier filing date and the resemblance is likely to deceive or cause confusion; hence proscribed under Sec. 123.1 (d) of R.A. 8293 is hereby reiterated because the examiner is not convinced of the reasoning of the applicant. A slight difference in the spelling of the mark is so miniscule as to remove it from causing confusion as to source and origin. Moreover, both marks cover similar goods. This is without prejudice of filing cancellation of the applicant against the cited mark.'

"10. On 5 October 2010, petitioner requested for extension of time to file its response to the office action, designated as Paper No. 5. Said request for extension until 9 December 2010 was granted by the esteemed examiner.

"11. On 30 November 2010, petitioner requested for suspension of action on its trademark application for PEARLIE WHITE, and paid for the prescribed fee, because it is intended to file a petition for cancellation of the cited mark PEARL WHITE & DEVICE Reg. No. 4-2008-002158.

"12. On 5 January 2011, the esteemed examiner granted the request for the suspension of action by petitioner, and issued a Provisional Allowance pursuant to Rule 618 of the Trademarks Regulation. Petitioner was given twelve months or until 9 December 2011 to submit the required response to Paper No. 5 pending resolution of the petition for cancellation to be filed by it with the Bureau of Legal Affairs. Xxx"

To support its petition, the Petitioner submitted as evidence the following: Non-disclosure Confidentiality Agreements; Sales Reports of Brands International; Reports of Purchases of Brands International Commercial Corporation; Sales invoices; Product Information Sheets; Correspondence between Daisy Yu and Watsons dated 2007; Export Price lists; Terms and Conditions for oral products; photographs of PEARLIE WHITE products; Articles of PEARLIE WHITE products; various e-mails on advertising, funding, participation at promotional activities; copy of Petitioner's trademark application for PEARLIE WHITE; print-out of trademark details of Respondent; copy of Declaration of Actual Use filed Respondent.⁴

This Bureau served upon the Respondent-Registrant a "Notice to Answer" on 31 January 2012 but the same was not received by Respondent-Applicant because she already transferred as attested to by the process server in his Affidavit of Personal Service dated 9 February 2012.

The records show that the Respondent-Registrant filed her application for the trademark PEARL WHITE AND DEVICE on 28 February 2008 for goods under classes 3, 5 and 30 and on 11 August 2008, Certificate of Registration No. 4-2008-002158 was issued. The Petitioner's goods, namely "cosmetics oral care products" are similar and/or closely related to those covered by the Respondent-Registrant's trademark registration, which flow through the same channels of trade.

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

Should the Respondent-Registrant's trademark registration PEARL WHITE AND DEVICE be cancelled?

Section 151 of the IP Code provides:

Section 151. Cancellation – 151.1. A petition to cancel a registration of a mark under this Act may be filed with the Bureau of Legal Affairs by any person who believes that he is or will be damaged by the registration of a mark under this Act as follows:

- (a) Within five (5) years from the date of registration of the mark under this Act.
- (b) At any time if the registered mark becomes the generic name for the goods or services or a portion thereof, for which it is registered or has been abandoned, or its registration obtained fraudulently, or contrary to the provisions of this Act, or if the registered mark is used by, or with the permission of the registrant so as to misrepresent the source of the goods or services or in connection with which the mark is used.

But do the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?



Petitioner's mark

PEARL WHITE



Respondent-Registrant's mark

The marks are similar with respect to the word component PEARL and WHITE, differing only in that the Petitioner's mark includes additional letters "IE", hence "PEARLIE". Aurally, the marks are similar. However, the Respondent-Registrant appropriated a design of a woman posing inside a circle. This design is centrally placed underneath the word component PEARL WHITE. The style and presentation of the Petitioner's mark PEARLIE WHITE with sparkles on top of the letter "i" differentiate the contending marks. As a result, the marks portrayed have unique and distinct commercial impressions.

Records show that Petitioner appropriated and used the mark PEARLIE WHITE on oral care products, i.e. tooth paste, as early as 2002, as shown by Confidentiality Agreements⁵ between the Petitioner and its Philippine distributor. The Petitioner has shown sales reports and representative invoices⁶ invariably dated between 2004 to 2009, before the Respondent-Registrant filed its application for the mark PEARL WHITE. Yet, on account of the dissimilarities in the over-all presentation of the marks and the variety of other goods under class 3, other than "oral care products", such as: "cosmetics and skin care products, namely whitening soap, slimming soap, foundation, concealer,

⁵ Exhibit "A"

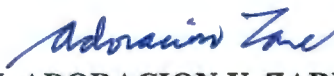
⁶ Exhibits "B" to "E"

mascara, eye shadow, eye and/or brow liners, lipstick, lip liner, lip balm, face powder, spot removing, whitening, slimming essence, milk, bronzer, blusher, moisturizers, make-up remover, non-medicated body powder, skin soaps, bath gel, bath oil, bath salts, bath beads, and bath fizzies, balm oil, balm oil, non-medicated skin preparations, namely lotions, creams, cleaners, scrubs, masks and toners, hair care and hair styling preparations, namely shampoos, conditioners, finishing sprays and gels, personal deodorants, sun tanning preparations, sunscreen oils and lotion, shaving preparations, dentrifices, perfumes, eau de toilette, essential oils for personal use, perfume oils, nail care preparations, nail enamel, pumice stone, cotton sticks and wool swabs for non-medicated purposes, all for use in the body, scented room fragrances, incense sticks, potpourri, sachets and scented wood ornaments, powdered cosmetic tissues, tissues impregnated with lotions, kit and gift sets containing skin and/or hair care preparations, hair colorants, massage preparations, bath additives not for medical purposes, toilet napkins of cellulose wadding impregnated with cosmetics, beauty tonics for application to the body, footcare preparations (non-medicated), tape nipple, oil and essential embrocation, menthol cone" registered under Trademark Registration No. 4-2008-002158 for the mark PEARL WHITE AND DEVICE, confusion is unlikely. Because the nature, descriptive properties and characteristics of these products are different from oral care products, there is no likelihood of confusion occasioned by the use of Respondent-Registrant's mark PEARL WHITE AND DEVICE on the aforementioned products. Moreover, as earlier discussed, the marks are dissimilar in their feature and components.

WHEREFORE, premises considered, the instant Petition for Cancellation of Trademark Registration No. 4-2008-002158 is **DISMISSED**. Let the filewrapper of the subject trademark registration be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **23 DEC 2016**


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