

1222
1222
1222

1-PA / 12-21
2-5

SUYEN CORPORATION,
Opposer,

-versus-

GOLDEN ABC, INC.,
Respondent-Applicant.

IPC No. 14-2013-00281
Opposition to:

Appln. Serial No. 4-2012-015326
Date of Filed: 20 December 2012

TM: M INSPIRE

X-----X

NOTICE OF DECISION

✓ 2 **MIGALLOS AND LUNA LAW OFFICES**
Counsel for Opposer
7th Floor, The Phinma Plaza
16 39 Plaza Drive, Rockwell Center, Makati City

MIGALLOS & LUNA
Law Office
Date: JAN 17 2017
Time: 9:41 AM
By: glenn nys

1 **OFFICE OF BAGAY VILLAMOR AND FABIOSA**
Counsel for Respondent- Applicant
Unit 2013 Strata 100 Building, Don Francisco
Ortigas, Jr. St., Ortigas Center, Brgy. San Antonio,
Pasig City

GREETINGS:

Please be informed that Decision No. 2016 - 474 dated 16 December 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, 16 December 2016.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

Revised
R2 R24
25



INTELLECTUAL PROPERTY
OFFICE OF THE
PHILIPPINES

SUYEN CORPORATION,
Opposer,

-versus-

GOLDEN ABC, INC.,
Respondent-Applicant.

X-----X

}
}
}
}
}
}
}
}

IPC No. 14-2013-00281
Opposition to:

Appln. Serial No. 4-2012-015326
Date of Filed: 20 December 2012

TM: M INSPIRE

NOTICE OF DECISION

MIGALLOS AND LUNA LAW OFFICES

Counsel for Opposer
7th Floor, The Phinma Plaza
39 Plaza Drive, Rockwell Center, Makati City

OFFICE OF BAGAY VILLAMOR AND FABIOSA

Counsel for Respondent- Applicant
Unit 2013 Strata 100 Building, Don Francisco
Ortigas, Jr. St., Ortigas Center, Brgy. San Antonio,
Pasig City

OFFICE OF BAGAY-VILLAMOR & FABIOSA
JAN 03 2017
BY: [Signature] TIME:

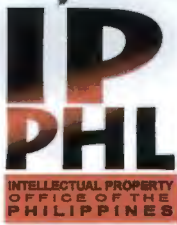
GREETINGS:

Please be informed that Decision No. 2016 - 474 dated 16 December 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, 16 December 2016.

[Signature]
MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



SUYEN CORPORATION,
Opposer,

-versus-

GOLDEN ABC, INC.,
Respondent-Applicant.

IPC NO. 14-2013-00281

Opposition to:
App.Serial No. 4-2012-015326
Date Filed: 20 December 2012
TM: "M INSPIRE"

X-----X

Decision No. 2016- 474

DECISION

SUYEN CORPORATION ¹ ("Opposer"), filed an opposition to Trademark Application Serial No. 4-2012-015326. The application, filed by GOLDEN ABC, INC.² ("Respondent-Applicant"), covers the mark "M INSPIRE" for use on *"perfumery products namely, perfumes (roll-on, in-spray, in cake and/or spray), colognes, toilet water, edt; skin products namely lotions, moisturizers, oils, astringents, toners, soaps; lathering and softening products for use in bath namely shaving skin lotions, bath and body gel, body wax, soaps, liquid soaps, bar soaps, shampoos, and shaving creams and, toothpaste; cosmetics; make-up; face powder; foundation; lipstick; lip gloss; lip shimmer; lip liner; blush-on; cheek tint; eye shadow; eye liner; eye brow pencil; toilet products against perspiration namely deodorants (roll-on, body spray, and/or cake form), talcum powder, baby powder, powder with cornstarch; hair care products namely hair dyes, hair gels, hair colors, henna, and hair wax; powder; eye cream, concealer, mascara and nail polish" under Class 03 of the International Classification of Goods.*³

The Opposer alleges, among others that the registration of the mark "M INSPIRE" is contrary to the provisions of Section 123.1 of the Intellectual Property Code, as amended. Opposer submits that the "M INSPIRE" mark of Respondent-Applicant is confusingly similar with its own "INSPIRE" mark that ordinary purchasers may be misled into the belief that Respondent-Applicant's product are among its products or connected with or is under its sponsorship. According to Opposer, it is the registered owner and first user of the INSPIRE mark such that the registration of Respondent-Applicant's "M INSPIRE" mark will cause damage and injury to it. Opposer also contends that there is likelihood of confusion of business because Respondent-Applicant's "M INSPIRE" mark is used on similar goods or goods that compete with each other.

The Opposer's evidence consists of the following:

- 1. Exhibit "A" - Affidavit of Mr. Gerald G. Dela Cruz;

¹ A corporation organized and existing under the laws of the Philippines with address at Bench Tower, 30th Street corner Rizal Drive, Crescent Park, West 5, Bonifacio Global City, Taguig.
² A domestic corporation with address at LHPI Center, No. 880 A.S. Fortuna Street, Banilad, Mandaue City, Cebu 6000.
³ The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

2. Exhibits "B" copy of Certificate of Registration No. 4-2008-011621 for the mark "FAITH Scents for Life";
3. Exhibits "C" - copy of Certificate of Registration No. 4-2008-011614 for the mark "INSPIRE Scents for Life";
4. Exhibits "D" - photograph of FAITH Scents for Life product;
5. Exhibits "E" - photograph of INSPIRE Scents for Life product;
6. Exhibit "F" to "F-10"- print-outs from www.pep.ph of the article "Bench introduces new Scents for Life", showing photos of the event;
7. Exhibits "G" - print-outs from www.pep.ph of the article "Bench unveils its "Scents for Life";
8. Exhibits "H" - - print-outs of the relevant pages from the site Pink for Life;
9. Exhibits "I" to "K" - Scanned copies of articles regarding the launching of the "Scents for Life" published Philippine Star and Manila Bulletin;
10. Exhibits "L" - scanned copy of the promotional poster for the Scents for Life Collection
11. Exhibits "M" - print-out of relevant pages of Bench website showing the Scents for Life Collection;
12. Exhibit "N" - copy of the demand letter dated 30 January 2013.

This Bureau issued, on 18 September 2013, a Notice to Answer and served a copy thereof to the Respondent-Applicant on 27 September 2013. However, despite receipt of Notice, Respondent-Applicant failed to file the Answer. On 06 January 2014, this Bureau issued an Order declaring Respondent-Applicant in default. Hence, this case is submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended.

Should the Respondent-Applicant be allowed to register the mark **M INSPIRE**?

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

Sec. 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides:

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

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

iii. If it nearly resembles such a mark as to be likely to deceive or cause confusion;

Records show that at the time the Respondent-Applicant filed its trademark application on 20 December 2012, Opposer already has an existing trademark registration for the mark INSPIRE SCENTS FOR LIFE issued on 18 March 2010. Opposer's INSPIRE SCENTS FOR LIFE mark is used on "*cologne and fragrances*" under Class 03 while Respondent-Applicant's mark will be used on "*perfumery products namely, perfumes (roll-on, in-spray, in cake and/or spray), colognes, toilet water, edt*", among others, also under Class 03. Thus, Opposer's and Respondent-Applicant's marks are used on similar or closely related or competing goods.

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

Inspire
SCENTS FOR LIFE

Opposer's Mark



Respondent-Applicant's Mark

A comparison of the marks of the parties show that both marks adopted the word "INSPIRE" in their respective marks. The word "INSPIRE" in both marks have the same exact spelling and pronunciation. Aside from the similarity in the adoption of the word "INSPIRE" it can also be observed that the competing marks contain elements that differ from each other. Opposer's marks is a word mark. Aside from the word "INSPIRE", its mark also contain the words "Scents for Life" written below the word "Inspire. On the other hand, Respondent-Applicant's mark is a composite mark. It is composed of the "M" logo in upper case letter and written inside a black rectangle, and below the logo us the word "inspire" written in lower case letters. However, despite the differences between the two marks, what sticks to the mind of the public is the word "INSPIRE" which is predominantly displayed in Respondent-Applicant's marks. The word "INSPIRE" is easily recalled by consumers. Especially if advertised in radio, what catches the listeners attention is the word "INSPIRE" so that one would not be able to distinguish which one is Opposer's or Respondent-Applicant's. As such, there is likelihood that the public will be confused, mistaken or deceived that the mark of the Respondent-Applicant is just a variation of the Opposer's or that the marks of Opposer and Respondent-Applicant is one and the same.

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 other⁵. 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

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

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 article⁶.

Further, 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.⁷

Moreover, as earlier noted, the goods of the parties are also competing and related which will add all the more to the possibility of confusion or deception on the part of the public.

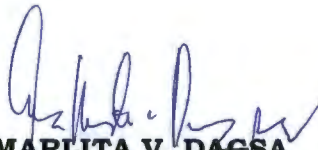
It has been held time and again that in cases of grave doubt between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favour with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.⁸

Accordingly, this Bureau finds that the registration of Respondent-Applicant's M INSPIRE mark 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. 4-2012-015326, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, T6 DEC 2016


MARLITA V. DAGOSA
Adjudication Officer
Bureau of Legal Affairs

⁶ See *Emerald Garment Manufacturing Corp. v. Court of Appeals*, G.R. No. 100098, 29 Dec. 1995.

⁷ See *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

⁸ See *Del Monte Corporation et. al. v. Court of Appeals*, GR No. 78325, 25 Jan. 1990.