

THE PROCTER & GAMBLE COMPANY,
Opposer,

-versus-

INVIVO NSA.,
Respondent-Applicant.

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IPC No. 14-2013-00419
Opposition to:
Appln. Serial No. 4-2013-005753
Date Filed: 20 May 2013

TM: PURLITE

NOTICE OF DECISION

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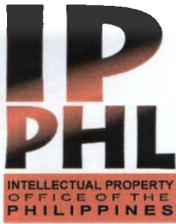
GREETINGS:

Please be informed that Decision No. 2017 - 97 dated 29 March 2017 (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, 29 March 2017.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



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IPC No. 14-2013-00419
 Opposition to:
 Application No. 4-2013-005753
 Date Filed: 20 May 2013
 Trademark: "PURLITE"
 Decision No. 2017- 97

DECISION

THE PROCTER & GAMBLE COMPANY¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-005753. The application, filed by INVIVO NSA² ("Respondent-Applicant"), covers the mark "PURLITE" for use on "deodorising preparations" under Class 03, "veterinary preparations for the care of farm animals, sanitary preparations for farm animals, cleansing preparations, namely disinfectants for animals" under Class 05 and "animal litter products, drying products for litter for farm animals" under Class 31 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x
 IV.

GROUND IN SUPPORT OF THIS OPPOSITION

"11. The Respondent-Applicant's application for registration of the mark PURLITE should not be given due course by this Honorable Office because its registration is contrary to Section 123.1 (d) and Section 123.1 (f) of the Intellectual Property Code, which prohibit the registration of a mark under the following circumstances:

x x x

"12. The act of the Respondent-Applicant in attempting to register its mark PURLITE for its products in Classes 3, 5 and 11 is clearly an attempt to trade unfairly on the goodwill, reputation and awareness of the Opposer's well-known AMBI PUR marks that were previously applied for registration before this Honorable Office and in many other countries, resulting in the diminution of the value of the trademark AMBI PUR.

¹With address on record at One Procter & Gamble Plaza, Cincinnati, Ohio 45202, United States of America.

²With address at Talhouet, 56250 Saint-Nolff, France.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

"13. The Opposer first filed its registration for the AMBI PUR marks in the Philippines in 1997. Today, there are five (5) AMBI PUR trademarks registered with the Philippine Intellectual Property Office.

"14. The Opposer's AMBI PUR trademarks, being the more senior marks, clearly enjoy protection. Jurisprudence has granted protection to trademarks that have prior, or a more senior registration. As elucidated in the case of Berris Agricultural Co. Inc., vs. Norvy Abyadang,

x x x

"As the Court held, ownership and protection of a mark is granted from its registration and actual use. The Opposer's products have been available to the public since as far back as 1958 and as such, the marks have been used in commerce for more than 50 years. Moreover, the Opposer is undoubtedly the more senior registrant, being first issued a Certificate of Registration in the Philippines in 1997. The Court also held that registration of the mark also grants the registrant exclusive right to use the trademark, thereby precluding the Respondent-Applicant, the more junior applicant, from appropriating and using the same.

"15. The Respondent-Applicant's mark is identical to, or closely resembles, the Opposer's AMBI PUR marks that were previously registered in the Philippines and elsewhere in the world, such that confusion is likely to result. Hence, the registration of said mark violates Section 123.1 (d) of the Intellectual Property Code.

"16.1. It cannot be gainsaid that the mark used by the Opposer, that is the AMBI PUR mark has attained sufficient notoriety as an internationally well-known mark and that the same has become distinctive for the Opposer's goods.

"16.2. It is undeniable that the Opposer has extensively used the mark AMBI PUR for some time and that the Opposer has expended enormous sum of money to make the AMBI PUR mark distinctive for its goods. It is without question that the Opposer's internationally well known AMBI PUR mark is a distinct mark worldwide and nationwide. Further, use of the word 'PUR' in connection with its AMBI PUR mark is a dominant element of the Opposer's internationally well-known mark. Allowing the same word 'PUR' to be used by the Respondent-Applicant would inevitably lead to diluting and diminishing the distinctiveness of the well known mark.

"17. The resemblance of the Opposer's and the Respondent-Applicant's respective marks is most evident upon a juxtaposition of the said marks, to wit:

x x x

"A mere perusal of the Respondent-Applicant's mark will illustrate a poor attempt at reproducing the Opposer's well-known AMBI PUR trademark, clearly showing an intent to imitate the mark that is so closely associated with the Opposer's products.

"18. If the word 'PUR' is used by the Respondent-Applicant on cleaning and air deodorizing products, it will undoubtedly create a false business relationship and/or association to the detriment of the Opposer. Thus, if allowed, the Respondent-Applicant will definitely 'ride on' the popularity and exposure of the Opposer's mark in the field of cleaning and air deodorizing products.

"19. The Respondent-Applicant's unauthorized use of the word 'PUR', a word already associated with the AMBI PUR marks owned by the Opposer, as well as the Respondent-Applicant's passing off of its own products as those made by the Opposer, is likely to cause confusion in the minds of the consumers. It cannot be denied that consumers nowadays are familiar with products that have 'light' or 'lite' counterparts. These 'light' or 'lite' counterparts of products usually contain lesser fat, lesser calories, or lesser chemicals. The 'light' or 'lite' counterparts are available for virtually any product in the market, whether it be a 'light' or 'lite' version of food, drink, or cleaning product. It is clear that consumers are likely to conclude that 'PURLITE' is a 'light' or 'lite' version of the Respondent-Applicant's products being sold using the AMBI PUR mark.

"20. The Respondent-Applicant's attempt to register and the mark PURLITE in connection with its cleaning and air deodorizing products will take advantage of the worldwide and nationwide reputation of the Opposer, gained by ingenious and persistent marketing, and expenditure of large sums of money. Allowing the registration of the mark PURLITE by the Respondent-Applicant will indubitably lead to confusion and will mislead the trade and members of the public that the Respondent-Applicant's products originate from or are sponsored by the Opposer, or, at least, originate from economically linked undertakings creating an inappropriate trade connection or association.

"21. If the products of the Respondent-Applicant are inferior in quality, there will be further irreparable injury to the Opposer's valuable goodwill and its internationally well-known AMBI PUR mark will suffer from an unfavorable connotation created by the association of the Respondent-Applicant's mark to the AMBI PUR mark. Furthermore, the Opposer believes the use and registration of the Respondent-Applicant's PURLITE mark will dilute the distinctive character of the Opposer's internationally well-known AMBI PUR and marks.

"22. The Respondent-Applicant seeks to register the mark PURLITE which is confusingly similar to Opposer's AMBI PUR mark, so as to be likely when applied to the goods of the Respondent-Applicant to cause confusion, mistake or deception to the public as to the source of goods, and will inevitably falsely suggest a trade connection between the Opposer and the Respondent-Applicant.

"23. The Supreme Court discussed these two types of trademark confusion in *Mighty Corporation, et. al. vs. E. & J. Gallo Winery, et. al.*, G.R. No. 154342, July 14, 2004, 434 SCRA 473, 504, thus:

x x x

"Allowing Respondent-Applicant to use the mark 'PURLITE' in its goods under International Classes 3, 5, and 11 would not only allow it to take a free ride and reap the advantages of the goodwill and reputation of the Opposer's mark, but it would also confuse the consuming public who would be led to believe that the products sold by the Respondent-Applicant are produced and manufactured by the Opposer, or at very least, a variant of the Opposer's products. Clearly, the risk of damage is not limited to a possible confusion of goods but also includes confusion of reputation if the general purchasing public could reasonably be misled into believing that the goods of the parties originated from one and the same source.

"24. In the case of Societe Des Produits Nestle, S.A. vs. Dy, Jr., the Supreme Court held that:

x x x

"25. Moreover, in the case of McDonald's Corporation vs. L.C. Big Mak Burger, Inc., et. al., the Supreme Court had occasion to rule that 'while proof of actual confusion is the best evidence of infringement, its absence is inconsequential'.

"26. Thus, the denial of Trademark Application No. 4-2012-014796 for the mark PURLITE by this Honorable Office is authorized under the provisions of the Intellectual Property Code.

The Opposer's evidence consists of the Special Power of Attorney executed by the Opposer in favor of Cesar C. Cruz and Partners Law Offices; and the Affidavit of Tara M. Rosnell, Assistant Secretary of The Procter & Gamble Company.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 10 January 2014. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark PURLITE?

The Opposer anchors its opposition on the following provisions of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

Sec. 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;"

- (f) 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 or service which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those 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;

⁴Marked as Annexes "A" and "B".

Records show that at the time the Respondent-Applicant filed its trademark application on 20 May 2013, the Opposer has existing trademark registrations for the mark AMBI PUR under Reg. Nos. 4-2002-6377, 4-2012-8199, 4-2005-2673, 4-2013-13888, 4-2014-505341. These registrations cover goods under Class 03, 05 and 11. This Bureau noticed that the goods indicated in the Respondent-Applicant's trademark application, which are cleaning and deodorizing products are similar and/or closely-related to the Opposer's.

The marks are shown below:



Opposer's trademark



Respondent-Applicant's mark

This Bureau finds that confusion or deception is unlikely to occur at this instance. Although the contending marks have the same prefix or word PUR, the visual and aural properties in respect of the Respondent-Applicant's mark has rendered said mark a character that is distinct from the Opposer's. The use of the prefix or word PUR do not create for or confer upon Opposer the right to exclusively appropriate the prefix PUR. No one has exclusive use to it. The use of the prefix or word PUR may constitute a valid trademark particularly in combination with another word and/or logo, and for as long as it can individualize the goods of a trader from the goods of its competitors, as it was in this case. Respondent-Applicant's PURlite mark is written inside the top part of a square with rounded corners. The square is split into two sections - in the top section the background is blue and the word element "PURlite" is written in white, and in the bottom section the background is white and 7 farm animals are shown in blue.

Moreover, in the Trademark Registry, the contents of which the Bureau can take cognizance of via judicial notice, there are several trademarks carrying the prefix or word PUR, printed and stylized in different ways that are registered under Classes 03 and 05, such as TD-PUR (Reg. No. 42015507014), ROUGE PUR COUTURE SLIM (Reg. 

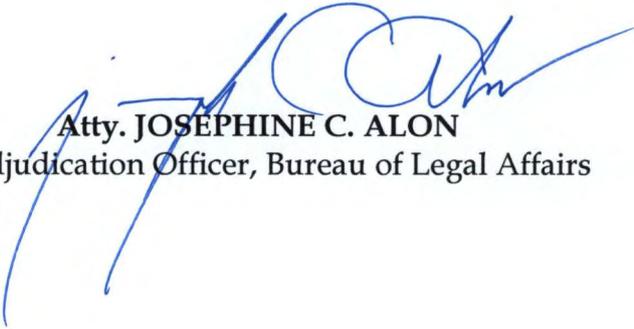
No. 41993429745), PUR WHITE (Reg. No. 4200310517), PUR INSPIRATION (Reg. No. 420049274), which are owned by entities other than the Opposer.

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.⁵ This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2013-005753 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 29 MAR 2017.


Atty. JOSEPHINE C. ALON
Adjudication Officer, Bureau of Legal Affairs

⁵ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.