

THE PROCTER AND GAMBLE CO.,
Opposer,

-versus-

FH COLORS & COATING CORPORATION,
Respondent-Applicant.

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IPC No. 14-2016-00021
Opposition to:
Appln. Serial No. 4-2015-006580
Date Filed: 17 June 2015

TM: PINK OLAY

X-----X

NOTICE OF DECISION

CESAR C. CRUZ AND PARTNERS

Counsel for Opposer
3001 Ayala Life-FGU Center
6811 Ayala Avenue, Makati City

FH COLORS & COATING CORPORATION

c/o HELEN T. SO
Respondent- Applicant's Representative
B3 L6 Greenway Business Park, Governor Drive
Bulihan, Silang, Cavite 4118

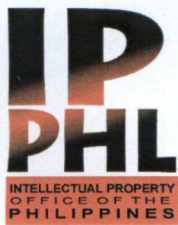
GREETINGS:

Please be informed that Decision No. 2017 - 298 dated 07 July 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, 10 July 2017.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



THE PROCTER AND GAMBLE CO.,
Opposer,

-versus-

IPC NO. 14-2016-00021

Opposition to:
Appl. Serial No. 4-2015-006580
Date Filed: 17 June 2015

FH COLORS & COATING CORP.,
Respondent-Applicant.

Trademark: **"PINK OLAY"**

X-----X

Decision No. 2017- 298

DECISION

The Procter and Gamble Company,¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2015-006580. The application, filed by FH Colors & Coating Corporation ("Respondent-Applicant")², covers the mark "PINK OLAY" for use on "*paints*" under Class 02 of the International Classification of goods and services³.

The Opposer anchors its opposition on Section 123.1 (d) and (f) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It alleges, among others, that it is the owner of the mark "OLAY", which it registered in various countries. It registered the mark "OLAY" as early as 1963. It has openly and continuously used the same around the world since then. Aside from extensively promoting and selling products bearing the "OLAY" mark, it maintains a website and a Facebook page where information about its company and products can be seen by consumers all over the world. It contends that the Respondent-Applicant identical with its own trademark and trade name as to likely cause confusion, mistake and deception the part of the purchasing public. In support of its opposition, the Opposer submitted the affidavit of its Assistant Secretary, Tara Rosnell, with annexes.⁴

A Notice to Answer was issued and served upon the Respondent-Applicant on 12 March 2016. The latter, however, did not file an Answer. Thus, the Adjudication Officer issued Order No. 2016-1965 on 25 November 2016 declaring the Respondent-Applicant on default and the case submitted for decision.

¹ A corporation duly organized and existing under the laws of the United States of America with business address at One Procter & Gamble Plaza, Cincinnati, Ohio 45202, United States of America.

² With known address at B3 L6 Greenway Business Park, Gov. Driver, Bulihan, Silang, Cavite, Philippines.

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. 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 Exhibit "B", inclusive.

The issue to be resolved is whether the trademark "PINK OLAY" may be registered in favor of the Respondent-Applicant.

Records reveal that at the time the Respondent-Applicant filed its application on 17 June 2015, the Opposer has valid and existing registrations of its "OLAY" marks issued as early as 22 September 2008.

To determine whether there is confusing similarity, the competing marks are reproduced as follows:

Opposer's marks:

OLAY
natural white



OLAY

Respondent-Applicant's mark

PINK OLAY

Looking at the Opposer's marks, what is impressed in the eyes and mind is the word "OLAY". The Respondent-Applicant's mark, on the other hand, similarly appropriates the word "OLAY". There is no doubt that the two marks are identical in spelling and pronunciation notwithstanding the additional word "PINK" in the Respondent-Applicant's mark. 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.⁵

While it is true that the Opposer's "OLAY" marks cover skin care preparations while that of the Respondent-Applicant's pertains to paints, it is highly possible that purchasers will be confused, mistaken or deceived that the goods of the Respondent-Applicant is connected to, sponsored by or affiliated to the Opposer's. This is especially true since the word "OLAY" has no dictionary meaning but is simply a coined word and, therefore, highly distinctive. Of course, as in all other cases of colorable imitations, the unanswered riddle is why, of the millions of terms and combinations of letters and designs available, the Respondent-Applicant had to choose those so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark.⁶ Noteworthy, the Respondent-Applicant was given ample opportunity how it came up with the applied mark and yet, did not file an Answer.

Corollarily, Section 123.1 (d) of Republic Act No. 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 (Emphasis supplied.)

Succinctly, 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."⁷

⁵ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁶ American Wire & Cable Company vs. Director of Patents, G.R. No. L-26557, 18 February 1970.

⁷ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.




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.⁸ The Respondent-Applicant's mark 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.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2015-006580 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **07 JUL 2017**


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

⁸ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.