



INTELLECTUAL PROPERTY  
OFFICE OF THE PHILIPPINES

**THE PROCTER & GAMBLE COMPANY,**  
*Opposer,*

**-versus-**

**REY B. CONCHA,**  
*Respondent-Applicant.*

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**IPC No. 14-2014-00042**  
Opposition to:

Appln. Serial No. 4-2013-011087  
Date Filed: 13 September 2013

**TM: BOSSING**

X-----X

**NOTICE OF DECISION**

**QUISUMBING TORRES**

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**GREETINGS:**

Please be informed that Decision No. 2017 - 340 dated 26 September 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOP HL 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, 26 September 2017.

**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs



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Application No. 4-2013-011087  
Date Filed: 13 September 2013  
Trademark: "BOSSING "

x-----x

Decision No. 2017- 340

### DECISION

THE PROCTER & GAMBLE COMPANY<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-011087. The application, filed by Rey B. Concha<sup>2</sup> ("Respondent-Applicant"), covers the mark "BOSSING" for use on "liquid, powder and bar detergent for household use, bath soap" under Class 3 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer alleges:

x x x

"1. The Opposer hereby invokes the authority of this Honorable Office to deny the application for the mark sought to be registered by the Respondent-Applicant, the details of which are as follows:

x x x

"2. The Opposer is the first user and rightful owner of the well-known trademark TIDE & BULLSEYE DEVICE and variations thereof, as well as other related trademarks, worldwide.

"3. In the Philippines, the TIDE products are so associated with its celebrity Vic Sotto, commonly known to the majority of the Filipino population as 'BOSSING' Vic. Moreover, most of the 'BOSSING' Vic's various advertisements for the TIDE laundry detergents adopted the famous tagline 'BOSSING SA KAPUTIAN', owing to the TIDE products' superior laundry cleaning and whitening capabilities, among others. The TIDE products, partly because of 'BOSSING' Vic's endorsements, have generated and established valuable goodwill for the Opposer. Allowing a third party to use 'BOSSING' also on laundry detergents would therefore cause damage to the Opposer, its TIDE products and its business. As such, this opposition is filed in accordance with Section 134 of Republic Act NO. 8293, otherwise known as the Intellectual Property Code of the Philippines x x x.

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

<sup>2</sup>With address at 289 Sarmiento Homes, Abangan Norte, Marilao, Bulacan, Philippines.

<sup>3</sup>The 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.

"4. The Philippines and the United States of America, where the Opposer is incorporated, are parties-signatories to the Paris Convention for the Protection of Industrial Property x x x, the Agreement of Trade-Related Aspects of Intellectual Property Rights of the World Trade Organization, and are members of the WTO and the World Intellectual Property Organization, which were all intended, inter alia, for the protection of industrial property.

"5. The Opposer brings the present action pursuant to Section 2, Article II of the Philippine Constitution, which provides that the Phiippines adopts, among others, the generally accepted principles of international law as part of the law of the land and adheres to the policy of peace, equality, justice, freedom, cooperation and unity with all nations. Furthermore, Sections 3 and 160 of the IP Code, grant a right in favor of the Opposer to seek redress before this Honorable Office insofar as it states that:

"6. The foregoing has been confirmed by the Supreme Court in the case of La Chemise Lacoste v. Fernandez.

"7. The TIDE trademarks have been registered and/or applied for registration by the Opposer in various trademark registries worldwide such as China, Colombia, Indonesia, Malaysia, Singapore, Thailand, United States of America, Vietnam in connection with washing and bleaching preparations for laundry use, among others.

"8. TIDE was first introduced in the United States of America in the year 1946 as the brand of the world's first heavy-duty synthetic detergent. Products bearing the TIDE trademarks were officially introduced in the Philippines in 1957.

"9. TIDE is one of the billion-dollar brands of the Opposer. The Opposer has been using the TIDE trademarks in connection with its detergent products in the Philippines and in numerous other countries around the world such as Australia, New Zealand, Canada, United States of America, Hong Kong, Germany, Japan, France, Singapore and China for more than sixty (60) years.

"10. The Opposer has extensively promoted its products bearing the TIDE trademarks worldwide. Over the years, the Opposer has obtained significant exposure for its detergent products which bear the TIDE trademarks in various media, including television commercials, advertisements, internationally well-known print publications, the internet and in other promotional events.

"11. Through the Opposer's long, continuous and extensive use, promotion and advertising of its TIDE trademarks, the same have become so popular throughout the Philippines and around the world such that a mere mention of, or a mere look at the word 'TIDE' and its iconic bulls-eye device, would immediately cause the purchasing public to associate said word and logo with the Opposer and its detergent products.

"12. In the Philippines, the Opposer's past advertisements and its current advertisement for TIDE involve the famous celebrity Vic Sotto, who is popularly known to the public as 'BOSSING'. The 'BOSSING' element is integral to the Opposer's advertising campaign which has been ongoing for the past four (4) years. Accordingly, the Respondent-Applicant's use of the word 'BOSSING' would likely cause purchasers to believe that the goods he is offering are produced by, emanate from, are sponsored by or connected with the Opposer and endorsed by 'BOSSING' Vic.

"13. Since 'BOSSING' Vic's first advertisement appeared on television in September 2009, the public has come to associate the products bearing the TIDE trademarks and the tagline 'BOSSING SA KAPUTIAN' with the celebrity endorser 'BOSSING' Vic. Clearly, a strong connection between the Opposer's TIDE products and 'BOSSING' Vic has been formed in the minds of the purchasing public. The Respondent-Applicant's use of the word 'BOSSING' will therefore likely create confusion or mistake in the minds of the purchasing public.

"14. In the case of *Societe des Produits Nestle v. Court of Appeals, et al.*, the Supreme Court held:

x x x

"15. Indeed, it is surprising to note that notwithstanding a boundless choice of words, phrases, symbols and designs available to the Respondent-Applicant, he chose a word that is very strongly identified with the Opposer and its TIDE products and, worse, proposes to use them for exactly the same goods. As held in *American Wire & Cable Co. v. Director of Patents*:

x x x

"16. Given the use of the same 'BOSSING' word on exactly the same goods, one would inevitably be led to conclude that there is a deliberate attempt on the part of the Respondent-Applicant to ride on the goodwill the Opposer has created through the years of continuous and extensive use. This act should not be allowed by this Honorable Office.

"17. Moreover, the Opposer's goodwill on its TIDE products is a property right protected under Philippine law, and a violation thereof amounts to unfair competition, which is proscribed under Article 10bis of the Paris Convention, Article 28 of the Civil Code of the Philippines and Section 168 of the IP Code.

x x x

"18. If allowed to proceed to registration, the consequent use of the mark BOSSING by the Respondent-Applicant will amount to unfair competition against the Opposer's famous TIDE trademarks and products.

"19. Further, the Respondent-Applicant's consequent use of the mark BOSSING, which is highly associated with the Opposer and its TIDE products, also amounts to a violation of Section 169 of the IP Code, which provides:

x x x

"20. The use by the Respondent-Applicant of the mark BOSSING in relation to his goods, which are the same as and directly competes with the Opposer's own goods, will take unfair advantage of, dilute the goodwill, and diminish the distinctive character or reputation of the TIDE trademarks, which are valued assets of the Opposer, and will clearly result in irreparable damage to the Opposer's business and reputation.

"21. Clearly, the Opposer has no control over the Respondent-Applicant's business. Consequently, the Opposer has no control over the quality of the Respondent-Applicant's goods that would be marketed and distributed under the mark BOSSING. Thus, potential damage to the Opposer will also likely be caused as a result of this

inability to control the quality of the goods offered or put on the market by the Respondent-Applicant.

"22. Furthermore, considering the substantial investment incurred by the Opposer in promoting its goods and identifying itself throughout the Philippines through its TIDE trademarks and various advertisements featuring 'BOSSING' Vic, it is clear that the Respondent-Applicant's deceitful conduct in securing the registration of the opposed mark and in exploiting the same is aimed towards unduly enriching himself at the expense of the Opposer and towards capitalizing on a very popular endorsement/promotional partnership between the Opposer and 'BOSSING' Vic.

"23. Likewise, the Respondent-Applicant is trying to pass off his detergent products as those which are endorsed by the actor Vic Sotto, who is commonly known as 'BOSSING' Vic. The purchasing public will therefore likely associate BOSSING with Vic Sotto and the Opposer's TIDE products that he is endorsing. Clearly, the resulting consumer confusion should not be allowed.

"24. As held by the Supreme Court in American Chicle Co. v. Topps Chewing Gum, Inc., to wit:

x x x

"25. The foregoing discussion indubitably shows that the Respondent-Applicant has no right to register the mark BOSSING in his name for being violative of the Opposer's rights and goodwill over the same. The subject application should therefore be denied in accordance with the provisions of the IP Code, as well as the Paris Convention to which the Philippines is contractually and legally bound.

The Opposer's evidence consists of the Notice of Opposition; a copy of the Special Power of Attorney executed by the Opposer dated 3 December 2013; the Affidavit of Tara M. Rosnell, Assistant Secretary of Procter & Gamble Company; the Affidavit of Marvic Sotto; a copy of Trademark Registration No. 4-1999-002516 for the mark TIDE & BULLSEYE DEVICE; a copy of Trademark Registration No. 4-2009-007236 for the mark TIDE (Bull's Eye Device 05 colour); a copy of Trademark Registration No. 4-1999-002515 for the mark TIDE (IN STYLIZED FONT); a copy of Trademark Registration No. 4-2001-005359 for the mark TIDE NATURE FRESH & Device; a copy of Trademark Registration 000766 for the mark TIDE; a copy of Trademark Registration No. 4-1999-002514 for the mark TIDE; and a copy of Trademark Application No. 4-2013-005302 for the mark TIDE filed on 8 May 2013.<sup>4</sup>

This Bureau issued a Notice to Answer and sent a copy thereof upon Respondent-Applicant on 30 May 2014. The Respondent-Applicant filed its Answer on 27 August 2014 and avers the following:

x x x

"IV.

AFFIRMATIVE AND/OR SPECIAL DEFENSES

<sup>4</sup> Marked as Exhibits "A" to "K", inclusive.

"5. Respondent pleads the allegations in the foregoing paragraphs as part of his Affirmative and/or Special Defenses, and in addition, he respectfully states:

"6. Respondent's Application SN 4-2013-011087 is not proscribed by Section 123.1(d) of the IP Code.

"6.1. Section 123.1(d) of the IP Code provides:

x x x

"6.2. Respondent's opposed mark BOSSING is neither identical nor confusingly similar to any of the opposer's registered TIDE marks.

"6.2.1. A side-by-side comparison between respondent's opposed mark vis-à-vis opposer's various registered marks (herein reproduced from photocopies of the certificates of registration marked and submitted by opposer), will show the literal, visual, as well as the aural differences between them, negating any likelihood of confusion.

x x x

"6.2.2. Interestingly, the word BOSSING does not appear in any of opposer's various registered marks.

"6.2.3. In allowing respondent's application and approving its publication for opposition (Exhibits '12' and '13'), the Bureau of Trademarks must have concluded that respondent's opposed mark does not nearly resemble any of opposer's existing registrations.

"6.3. Respondent's registered label and actual label (herewith marked and attached as Exhibit '14'), are likewise neither identical nor confusingly similar to opposer's label herewith marked and attached as Exhibit '15'.

"6.3.1. A side-by-side comparison between the parties' labels will show that respondent's registered label (Exhibit '8') and actual label marked as Exhibit '14' do not nearly resemble opposer's actual labels (Exhibits '15' and 'C-1'). The visual and aural differences between them are clearly discernible.

x x x

"7. Neither opposer nor Marvic Sottor has the exclusive right to use the word 'BOSSING'. Opposer has not shown that it has the exclusive intellectual property right to the word 'BOSSING'.

"7.1. Opposer has not presented substantial evidence to show that it and/or its product endorser, Marvic Sotto, created the word BOSSING.

"7.1.1. Opposer did not present any evidence showing that the word 'BOSSING' was created and is duly copyrighted in its favor and/or in favor of Marvic Sotto. Even in his affidavit (Exhibit 'C', submitted only last August 11, 2014, much later than the filing of the Notice of Opposition way back on April 7, 2014), Mr. Sotto does not

claim to be the one who created the word BOSSING; nor does he claim the exclusive right to use said word.

"7.1.2. In fact, opposer has not presented any evidence showing that it and/or Marvic Sotto is the first and only entity/person using the word BOSSING.

"7.1.3. On the contrary, there is substantial evidence showing that many prominent personalities and successful professionals and businessmen have been recognized and are addressed as 'BOSSING'. x  
x x

"7.2. Opposer has not presented any evidence to show that it has registered and/or applied for the registration of the word 'BOSSING' as its mark or the dominant feature of its mark.

"7.2.1. Opposer's registrations marked as Exhibits 'E' to 'K', clearly show that none of them carry or include the word BOSSING as the mark and/or the dominant feature of the mark registered thereunder.

"7.3. Opposer is not the only entity using the word BOSSING and its advertisement. In fact, Marvic Sotto has also endorsed other products other than opposer's TIDE.

"7.3.1. Marvic Sotto has also endorsed DAVIES Paint as 'Ang BOSSING sa Elastomeric Paint'; and AKARI as 'BOSSING ng LED', as shown in the attached newspaper advertisements marked as Exhibits '17' and '17-A';

"7.3.2. Aside from opposer, other entities have used the word BOSSING in their advertisement in billboards and broadsheets, as shown in the attached advertisements marked as Exhibits '18', '18-A' and '18-B'.

"7.4. Contrary to opposer's claim to the exclusive use of the word BOSSING, other entities have applied for the registration of marks with the word BOSSING as the dominant feature thereof, such as Frabelle Fishing Corporation and Davies Paint Philippines, Inc., as shown in the attached printouts from the e-Gazette, showing the publication for opposition of their applications, marked as Exhibits '19', '19-A' and '19-B'.

x x x

"8. Respondent's opposed mark being neither identical nor confusingly similar to opposer's 'TIDE' trademarks, its registration does not violate the Constitution, the Civil Code, the Paris Convention, WTO and WIPO agreements, and other provisions of the IP Code, as well as established jurisprudence.

"9. The following exhibits of opposer are neither originals nor certified copies but are mere photocopies and/or computer printouts, namely: Exhibits 'C-1', 'C-2', 'C-3', 'C-4', 'C-5', 'C-6', and 'C-7', 'E', 'F', 'G', 'H', 'I', 'J', and 'K', and

therefore, they are inadmissible under Office Order No. 99, as well as under the Rules on Electronic Evidence.

"Based on the evidence on record and pursuant to the provisions of the IP Code, respondent is entitled to register the mark BOSSING in his favor.

The Respondent-Applicant's evidence consists of Certificate of Business Name Registration No. 01564278 for BOSSING POWER MARKETING issued on December 14, 2011 by the Department of Trade and Industry in favor of Respondent-Applicant; copy of Application SN 4-2011-013040 for the mark BOSSING filed on October 28, 2011; copy of the Notice of Allowance of Application SN 4-2011-013040; printout of the e-Gazette released on May 21, 2012 showing the publication of Application SN 4-2011-013040; copy of the withdrawal of Application SN 4-2011-013040 filed on September 27, 2013; copy of Application SN 4-2012-014475 for the mark BOSSING filed last November 28, 2012; print-out of e-Gazette released on May 6, 2013 showing the publication of Application SN 4-2012-014475; copy of Certificate of Registration No. 4-2012-014475 for the mark BOSSING issued on June 6, 2012; copy of Application SN 4-2013-011087 for the word mark BOSSING filed last October 13, 2013; copy of registrability report bearing mailing date October 11, 2013 for Application SN 4-2013-011087; copy of the response to registrability report dated October 21, 2013; copy of Notice of Allowance for Application SN 4-2012-011087 bearing mailing date December 12, 2013; printout of the e-Gazette released January 6, 2014 showing the publication of Application SN 4-2012-011087; Respondent's actual label; Opposer's actual label; printout from the website [www.pldtsme-nation.com.ph/bossings/](http://www.pldtsme-nation.com.ph/bossings/); copies of the newspaper advertisements of DAVIES Paint as "Ang BOSSING sa Elastomeric Paint"; and AKARI as "BOSSING ng LED"; copies of the advertisements in billboards and broadsheets showing the word BOSSING; printouts of the e-Gazette showing the publication for opposition of the applications of Frabelle Fishing Corporation for "FRABELLE FOODS BOSSING" and Davies Paint Philippines, Inc. for "BOSSING NG ELASTOMERIC PAINT" and "BOSSING NG PINTURA" and the Affidavit of Respondent-Applicant Rey. B. Concha.<sup>5</sup>

On 18 August 2015, the Preliminary Conference was terminated and the parties were directed to file their respective position paper/s. Thereafter, the case was deemed submitted for resolution.

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

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. 168. *Unfair Competition, Rights, Regulation and Remedies.* – 168.1. A person who has identified in the mind of the public the goods he manufactures or deals in, his business or



<sup>5</sup> Marked as Exhibits "1" to "20", inclusive.

services from those of others, whether or not a registered mark is employed, has a property right in the goodwill of the said goods, business or services so identified, which will be protected in the same manner as other property rights.

168.2. Any person who shall employ deception or any other means contrary to good faith by which he shall pass off the goods manufactured by him or in which he deals, or his business, or services for those of the one having established such goodwill, or who shall commit any acts calculated to produce said result, shall be guilty of unfair competition, and shall be subject to an action therefor.

Sec. 169. *False Designations of Origin; False Description or Representation.* - 169.1. Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which:

(a) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.

A comparison of the competing marks reproduced below:



shows that both are used on detergents and soaps. Opposer's marks used the word TIDE. Opposer's previous and recent registered marks do not carry and/or include the word BOSSING but the word TIDE. TIDE is overwhelmingly visually and aurally different from the word BOSSING. Hence, this Bureau finds that confusion or deception is unlikely to occur at this instance. This Bureau cannot sustain the opposition solely on the ground that Respondent-Applicant's mark contain the word BOSSING, allegedly referring to BOSSING Vic, Marvic Sotto, Opposer's celebrity endorser for its TIDE products. To do so would have the unintended effect of giving the Opposer exclusive right over the word "BOSSING" for detergents and soaps. The word BOSSING is a Tagalog slang word and is used in Filipino to mean BOSS, a person who exercises

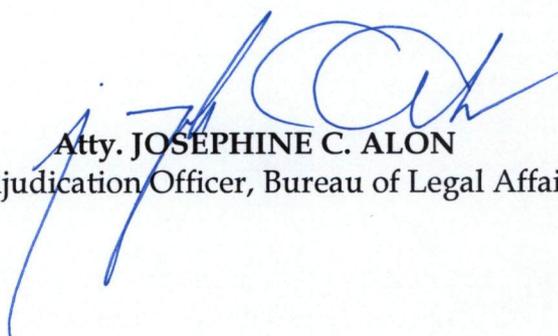
control or authority.<sup>6</sup> The distinctive feature of the Opposer's mark is the word TIDE. Respondent-Applicant's mark does not include or none of Respondent-Applicant's marks contain the word TIDE. Respondent-Applicant's mark used the word BOSSING on its detergents and soap products to distinguish itself from others.

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.<sup>7</sup> 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. 4-2013-011087 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

**SO ORDERED.**

Taguig City, 26 SEP 2017.

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

<sup>6</sup> Merriam-Webster definition of BOSS.

<sup>7</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.