



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

**BEVI BEAUTY ELEMENTS,
VENTURES, INC.,**

Opposer,

-versus-

ERNEST JACKSON LIM,
Respondent-Applicant.

X-----X
**BEVI BEAUTY ELEMENTS
VENTURES, INC.,**

Opposer,

-versus-

ERNEST JACKSON LIM,
Respondent-Applicant.

X-----X
**BEVI BEAUTY ELEMENTS
VENTURES, INC.,**

Opposer,

-versus-

ERNEST JACKSON LIM,
Respondent-Applicant.

X-----X

IPC No. 14-2016-00449

Opposition to:
Appln. Serial No. 4-2016-0007047
Date Filed: 21 June 2016



TM:

IPC No. 14-2016-00494

Opposition to:
Appln. Serial No. 4-2016-0007049
Date Filed: 21 June 2016



TM:

IPC No. 14-2016-00495

Opposition to:
Appln. Serial No. 4-2016-0007048
Date Filed: 21 June 2016



TM:

NOTICE OF DECISION

ZAMORA POBLADOR VASQUEZ & BRETANA

Counsel for Opposer

5th Flr., Montepino Bldg., #138 Amorsolo Street,
Legaspi Village, Makati City 1229

ATTY. ESTRELLITA BELTRAN-ABELARDO

Counsel for Respondent-Applicant

Blk 22 Lot 13, Singkil Street
Lagro Subdivision
Novaliches, Quezon City

GREETINGS:

Please be informed that Decision No. 2017 - 366 dated 09 November 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 November 2017.



MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



BEVI BEAUTY ELEMENTS VENTURES, INC., } IPC No. 14-2016-00449
 Opposer, } Appln. No. 4-2016-0007047
 } Date filed: 21 June 2016

-versus- } Trademark: 

ERNEST JACKSON LIM, }
 Respondent-Applicant. }

x-----x }

BEVI BEAUTY ELEMENTS VENTURES, INC., } IPC No. 14-2016-00494
 Opposer, } Appln. No. 4-2016-0007049
 } Date filed: 21 June 2016

-versus- } Trademark: "UNI KOJIC
 } PREMIUM WHITE"

ERNEST JACKSON LIM, }
 Respondent-Applicant. }

x-----x }

BEVI BEAUTY ELEMENTS VENTURES, INC., } IPC No. 14-2016-00495
 Opposer, } Appln. No. 4-2016-0007048
 } Date filed: 21 June 2016


-versus- } Trademark: "UNI KOJIC
 } PREMIUM WHITE
 } AND DEVICE"


ERNEST JACKSON LIM, }
 Respondent-Applicant. }


x-----x } Decision No. 2017- 366

DECISION

BEVI BEAUTY ELEMENTS VENTURES, INC. ("Opposer")¹ filed on 17 August 2016, Inter Partes Case ("IPC") No. 14-2016-00449, an opposition to Application No. 4-2016-0007047; on 7 September 2016, IPC No. 14-2016-00494, an opposition to Application No. 4-2016-0007049; and IPC No. 14-2016-00495, an opposition to Application No. 4-2016-0007048. The applications, in the name of ERNEST JACKSON LIM ("Respondent-Applicant")², covers the following marks :

 ; UNI KOJIC PREMIUM WHITE AND DEVICE

 and UNI KOJIC PREMIUM WHITE AND DEVICE

 ; for use on "personal care products namely: cosmetics, beauty soap,

¹ A domestic corporation organized and existing under the laws of the Republic of the Philippines, with office at 1262 Batangas corner Honduras Streets, Barangay, San Isidro, Makati

² Of legal age with address at 13 Juliana Street, Potrero, Malabon City

1 *Am*

lotions, pearl cream, face cream, whitening soap, kojic acid soap” under Class 3 of the International Classification of Goods³.

The Opposer anchors its oppositions on the ground that: The marks in application nos. 4-2016-007047; 4-2016-0007048; 4-2016-0007049, cannot be registered trademarks under the Intellectual Property Code because they are identical with and confusingly similar to the ‘kojie.san’ registered trademark and device and is used for the same goods.

The Opposer alleges, among other things, the following facts, in all the oppositions:

“1. BEVI is a personal care company with a wide range of products varying from soaps, lotions, facial creams, sunblocks, cleansers and toners. The product that started it all for BEVI is its ‘kojie.san’ kojic acid soap which began marketing and distributing as early as 2006.

“1.1. In 2006, BEVI President, Ms. Jasmin C. Burila (hereinafter, ‘Ms. Burila’), learned that kojic acid, a chelation agent, possessed skin whitening properties. Realizing its commercial potential, BEVI developed a kojic acid soap bar.

“1.2. Ms. Burila, a marketing expert, knew that the soap market was and remains a highly competitive one; that, thus, any soap product must not only be unique, it must also be packaged in such a way that it will stand out in stores shelves and convey its skin-whitening qualities. Since Japanese women were known for their fair and smooth complexion, Ms. Burila came up with the idea of using a stylized drawing of the head of a Japanese geisha as a device and adopted a Japanese-sounding name, that is, ‘kojie.san’, to reinforce the perception that the ‘kojie.san’ kojic acid soap can whiten skin.

“2. The trademark ‘kojie.san’ and device was thereafter registered with this Honorable Office on 11 July 2008 with Registration No. 4-2006-004700 in the name of Mr. Reginald Verlie I. Burila, BEVI’s Vice President. In 2012, Mr. Burila transferred ownership of the ‘kojie.san’ trademark and device to BEVI.

“2.1. The ‘kojie.san’ device consists of a stylized drawing of a Japanese geisha with black hair and red lips. The geisha’s left eye is open while the right eye is closed. The words ‘kojie’ and ‘san’ are printed in lower case letters using the ‘Arial’ font and are separated by a red dot (.).

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the World Intellectual Property Office (WIPO), called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

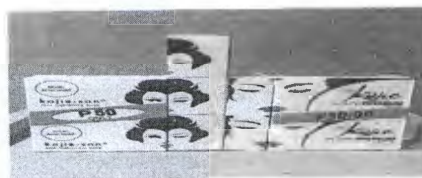


“3. ‘kжие.san’ kojic acid soap products bearing the ‘kжие.san’ trademark and device are being sold and distributed nationwide in retail establishments like Puregold, Ever Gotesco Supermarket, Shopwise, SM Supermarkets, Mercury Drug Stores, Watsons, and other retailers nationwide.

“4. In addition to using the ‘kжие.san’ trademark and device in soap boxes, packagings, and labels, the ‘kжие.san’ trademarks and device was also used in advertising materials for ‘kжие.san’ kojic acid soap products.

“5. The use of a stylized drawing of a Japanese geisha head in a soap package was the first of its kind in the Philippine market. Because of its unique trademark and device, packaging and superior quality, ‘kжие.san’ kojic acid soap became a huge marketing success and the leading brand for kojic acid soaps. From 2010 to 2016, ‘kжие.san’ kojic acid soap was awarded ‘Bath Soap Brand of the Year’ by Watsons. In 2014, ‘kжие.san’ was awarded by SM as one of its ‘Best of 2014 Top Choices’. All these evince the goodwill built by BEVI for the trademark ‘kжие.san’ and device, as well as the products bearing the same.

“6. Sometime in 2015, BEVI’s Channel Manager, Ms. Kathleen Grace A. Cruz, in the course of inspecting retail stores in Metro Manila, discovered that a company named Uni Elements Enterprises (hereinafter, ‘Uni Elements’) was selling kojic acid soap with the brand name ‘Uni Kojic Premium White’ alongside BEVI’s ‘kжие.san’ kojic acid soap.



“6.1. Uni Elements is owned by Steven John See Lim, the brother of herein respondent-applicant Ernest Jackson Lim who, in turn, is the General Manager thereof.

“7. On 14 and 27 January 2016, BEVI, through counsel, sent cease and desist letters to Uni Elements and to respondent-applicant Lim, informing

them that BEVI is the registered owner of the 'kojie.san' trademark and device, and that the device used in the 'Uni kojic Premium White' soap packaging infringes upon BEVI's 'kojie.san' trademark and device. BEVI demanded that Uni Elements and respondent-applicant Lim cease and desist from selling and distributing 'Uni Kojic Premium White' soap products bearing the infringing mark and withdraw all stocks thereof from all retail establishments.

"8. Despite receipt of the aforementioned demand letter, Uni Elements and respondent-applicant Lim refused to heed the same and continued infringing upon BEVI's 'kojie.san' trademark and device, BEVI filed a complaint with application for injunctive relief (hereinafter, the 'IPV case') against Uni Elements with this Honorable Office on 14 April 2016. The IPV Case was raffled to Atty. Ginalyn Badiola, Hearing Officer.

"10. On 4 May 2016, this Honorable Office issued a Temporary Restraining Order ('TRO') against Uni Elements. This Honorable Office held that based on the sampling of evidence presented and without precipitating pre-judgment, BEVI was able to prove the existence of an imminent and persistent need for the issuance of a TRO in order to prevent a threatened continuous irreparable injury.

"11. In contravention of Rule 5 & 4 of the IPV Rules, Uni Elements filed a motion for reconsideration in the guise of a 'motion to dissolve a temporary restraining order.'

"12. In an Order dated 19 May 2016, Acting Hearing Officer Marlita Dagsa, with grave abuse of discretion, dissolved the TRO on the ground that BEVI allegedly would not sustain irreparable damage, in glaring contradiction of the earlier finding of Atty. Ginalyn Badiola.

"13. On 6 June 2016, BEVI timely filed a motion for reconsideration in respect of the Order dated 19 May 2016.

"14. Despite the pendency of the IPV Case, respondent-applicant, with malice or in gross and evident bad faith, filed the assailed application along with two other trademark applications all involving the marks subject of the IPV Case.

"14.1. The two other applications are Applications Nos. 4-2016-00007048 and 4-2016-000070489. Said applications were published by this Honorable Office in its e-Gazette only on 8 August 2016. Thus, BEVI has until 7 September 2016 within which to file its opposition thereto.

x x x

“15. On 18 July 2016, this Honorable Office published the assailed application in its Official Gazette. Hence, BEVI has until 17 August 2016 within which to file its opposition to the assailed application.

The Opposer submitted as evidence, the following:

1. Print-out of IPO trademark database of Application No. 4-2016-007047;
2. Copy of Articles of Incorporation of Bevi Beauty Elements Ventures, Inc.;
3. Copy of Certificate of Registration No. 4-2006-004700 for the mark “kojie.san” and device;
4. Copy of Amended Judicial Affidavit of Veronica Gregorio dated 30 June 2016;
5. Copies of the pictures of trophies awarded by Watsons to kojie.san from 2010 to 2016;
6. Copies of clipping from the Philippine Star dated 26 October 2014;
7. Copy of Amended Judicial Affidavit of Kathleen Cruz dated 1 July 2016;
8. Copies of demand letters;
9. Copy of Complaint in IPV Case No. 10-2016-00005 dated 13 April 2016;
10. Copy of Order dated 4 May 2016 in IPV Case No. 10-2016-00005;
11. Copy of Motion for Reconsideration dated 6 June 2016 in IPV Case No. 10-2016-00005;
12. Copy of pertinent pages of e-gazette for national applications dated 18 July 2016;
13. Judicial Affidavit of Kyle Gozo; and
14. Judicial Affidavit of Jenny Jabeguero Gozo⁴

The Respondent-Applicant filed his Verified Answers on 5 December 2016; and 10 January 2017, alleging, among other things, the following special affirmative allegations and defenses:

“32. Respondent would like to emphasize at this point that it never used Opposer’s KOJIE SAN trademark but uses its own UNI KOJIC PREMIUM WHITE SOAP as trademark, hence it is quite obvious that both parties use two different word marks i.e. Kojie San for Opposer and Uni Kojic Premium White for Respondent. It is common practice that when WHEN CUSTOMERS BUY PRODUCTS, THEY CALL THE PRODUCT BY NAME AND NOT BY THEIR DEVICE hence, there is no possibility that they will be confused into buying UNI KOJIC PREMIUM WHITE IF THEY TELL THE SALESMAN THAT THEY ARE BUYING KOJIE SAN. Nor will they be confused should the products bear a different name i.e. UNI KOJIC PREMIUM WHITE OR KOJIE SAN for that matter.

“33. Moreover, Opposer insists that respondent uses a device which it claims to be confusingly similar or identical to its Device but which respondent claims to be very different, distinctive and neither confusingly similar nor identical to Opposer’s device.

⁴ Exhibit “A” to “O”, inclusive of submarkings.

“33.1. Respondent’s device marked as Exhibit ‘8’, is described as a Human Face with black hair, two eyes closed, red lips but without a nose, which is the subject matter of this Notice of Opposition -



“35.1. Respondent’s mark submitted as Exhibit “8”, is UNI KOJIC PREMIUM WHITE AND DEVICE described as a Half Face of a Woman with black hair, eyes closed, red lips but without nose, which is the subject matter of this Notice of Opposition-⁵



“36. Respondent’s device submitted as Exhibit “8”, is UNI KOJIC PREMIUM WHITE AND DEVICE described as a HUMAN FACE WITH BLACK HAIR, TWO EYES CLOSED, RED LIPS BUT WITHOUT A NOSE, which is the subject matter of this Notice of Opposition is shown below-⁶



“33.2. On the other hand, Kojie san’s device consist of ‘A STYLIZED DRAWING OF A JAPANESE GEISHA HEAD WITH BLACK HAIR AND RED LIPS WITH RIGHT EYE OPEN AND LEFT EYE SHUT, marked as Exhibit ‘9’, is shown below-



⁵ Verified Answer, page 23, IPC No. 14-2016-00494

⁶ Verified Answer, page 23, IPC No. 14-2016-00495

“34. Opposer claims that in terms of appearance, the Device subject of this Opposition is confusingly similar to and an infringement of the device of kojie san whereas Respondent maintains that there is a very clear distinction between the two devices in terms of appearance. A simple glance of the two devices will reveal that there is no confusing similarity between the two devices as-

“34.1. Respondent’s device employs a plain representation of a human face as opposed to Opposer’s head of geisha;

“34.2. The face of the Respondent’s device is visibly bigger;

“34.3. There is no nose in the device of Respondent as opposed to Opposer’s device;

“34.4. Both eyes are closed in Respondent’s device whereas one eye is open and one eye is closed in Opposer’s device.

“34.5. Even the brow shape is different. As can be seen from the device, the eyebrow of Respondent’s human face is thick while the eyebrow in Opposer’s head is very thin and fine.

“34.6. There is no obvious hair style in Respondent’s device whereas Opposer’s head of a geisha has a shemada of hair;

“3.5. Equally important is the fact that the factors that are used in determining confusing similarity proceeds not only from the goods themselves but also from other characteristics of the segment of the public which usually deals with these products. Here, the products involved are unlike ordinary soaps. Their purpose is not merely for cleansing but likewise for whitening the skin and overall beautification. In fact, they are more expensive and are double or triple and even quadruple compared to the price of ordinary soaps available in the market.

“35.1. Being high priced and specialized household items, the products are usually bought or purchased by adults who are discerning enough to know the product they are buying.

“35.2. As such, the pronouncement of the Supreme Court in Del Monte Corporation vs. Court of Appeals, G.R. No. 78325, 25 January 1990 is in point. There, the Supreme Court held that in determining the likelihood of confusion, due regard must be given to the nature of the product and the characteristics of the buying public who usually purchase the product. Thus it was held that: x x x

‘Expensive and valuable items are normally bought only after deliberate, comparative and analytical investigation. But mass products, low priced articles in wide use, and matters of everyday purchase requiring frequent replacement are bought by the casual consumer without great care.’

“36. For purposes of comparison, the two devices are shown below to prove that they are clearly and distinctly different from each other:

x x x

“36.1. A comparison of both devices show that they are distinct and different from each other. The only similarity between the two devices is that they both use the color red as the color of the lips and black as the color of the hair. The reason for this is obvious. Human lips and hair are naturally represented in the colors red and black respectively.

“37. Moreover, Respondent-applicant’s device marked and submitted as ‘Exhibit ‘8’, which is the subject matter of this instant Opposition, is a continuation with the other trademarks of Respondent-Applicant registered since 2012 onwards, which trademarks and device were all approved and registered by the Bureau of Trademarks despite the alleged registration of Opposer’s kojie san and device, prior to the filing of this instant Notice of Opposition, and they are as follows:

“37.1. UNI KOJIC ACID BEAUTY SOAP LABEL under Certificate of Registration 4-2010-008561 marked as Exhibit ‘2’;

“37.2. UNI KOJIC WITH GLUTA WHITENING BEAUTY SOAP AND DESIGN under Certificate of Registration 4-2012-002241 issued on August 30, 2012, shown below, marked and submitted as Exhibit ‘3’.

“37.3. UNI KOJIC WITH MILK WHITENING BEAUTY SOAP under Certificate of Registration 4-2012-00012998 issued on 24 October 2013, shown below, marked and submitted as Exhibit ‘4’.

“37.4. UNI KOJIC WHITENING BEAUTY SOAP under Certificate of Registration 4-201200012999 issued on 24 October 2013, shown below, marked and submitted as Exhibit ‘5’.

“37.5. UNI KOJIC WITH PEARL under Certificate of Registration 4-2014-00002224 issued on 11 September 2014, shown below, marked and submitted as Exhibit ‘6’.



“37.6. UNI KOJIC WITH PAPAYA under Certificate of Registration 4-2014-00002225 issued on September 11, 2014, shown below, marked and submitted as Exhibit ‘7’.



“38. For the information of this Honorable Office the word kojic acid is a by-product of the fermentation process for Japanese rice wine or sake and was formally discovered as early as the 1980’s in Japan and has been used for skin whitening products ever since, hence, the word ‘kojic’ is a generic word ‘kojic’ is a generic word which nobody can exclusively appropriate. xxx”

The Respondent-Applicant submitted as evidence the following:

1. Judicial Affidavit of Ernest Jackson Lim;
2. Copy of UNI KOJIC ACID BEAUTY SOAP LABEL under Certificate of Registration 4-2010-008561 issued in 19 January 2012;
3. Copy of UNI KOJIC WITH GLUTA WHITENING BEAUTY SOAP AND DESIGN under Certificate of Registration 4-2012-002241 dated 30 August 2012 ;
4. Copy of UNI KOJIC WITH MILK WHITENING BEAUTY SOAP under Certificate of Registration 4-2012-00012998 issued 24 October 2013;
5. Copy of UNI KOJIC WHITENING BEAUTY SOAP under Certificate of Registration 4-201200012999 issued 24 October 2014;
6. Copy of UNI KOJIC WITH PEARL under Certificate of Registration 4-2014-00002224 issued 11 September 2014;
7. Copy of UNI KOJIC WITH PAPAYA under Certificate of Registration 4-2014-00002225 issued 11 September 2014;
8. Copy of Respondent’s Device and Opposer’s device;
9. Copy of UNI under Certificate of Registration No. 4-2010-008560; and
10. Copy of UNI ELEMENTS AND DESIGN under Certificate of Registration No. 4-2010-008562 and Certificate of Registration No. 4-2010-008560, both issued on 18 August 2011.⁷

⁷ Exhibits “1” to “11”inclusive of submarkings.

11. Packaging of ALL BEAUTI Kojic Acid whitening soap; 1st HEALTH Kojic skin whitening soap; KINIS Kojic Acid skin whitening soap; MIKAELA; and AKOTO Kojic Acid soap.⁸

Upon motion by the Opposer, with comment/opposition by the Respondent-Applicant, the three cases were consolidated under Order No. 2017-1575 issued on 31 July 2017; Order No. 2017-1519 issued on 18 July 2017 and Order No. 2017-1518 issued on 14 July 2017 and thereafter, forwarded to the Adjudication Officer of IPC No. 14-2016-00449. After the termination of the preliminary conference, the parties were directed to submit their respective position papers. Both parties filed their position papers on 10 October 2017.

Should the Respondent-Applicant's marks, namely: (NO VERBAL ELEMENTS) Human face with black hair, two eyes closed, red lips but without a nose under Application No. 4-2016-0000747; and UNI KOJIC PREMIUM WHITE AND DEVICE under Application No. 4-2016-0000749 and Application No. 4-2016-0000748. be registered? The issues will be discussed simultaneously.

Records show that at the time Respondent-Applicant applied for registration of its three marks for goods under class 3, namely: "personal care products namely: cosmetics, beauty soap, lotions, pearl cream, face cream, whitening soap, kojic acid soap", the Opposer already registered the mark "kojie.san and device" under Certificate of Registration No. 4-2006-004700⁹. The goods covered by the Opposer's trademark registration are identical, similar or closely related, specifically "personal care products, namely: facial creams, whitening soap, lotion".

The competing marks, are depicted below:



Opposer's mark



Respondent-Applicant's mark
Application No. 4-2016-0000747

⁸ Exhibits "12" to "16" inclusive of submarkings (IPC No. 14-2016-00494 and IPC No. 14-2016-00494)

⁹ Exhibit "C"

Respondent-Applicant's marks



Application No. 4-2016-0000749



Application No. 4-2016-0000748

Section 123.1 (d) of Rep.Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), provides that 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.

UNI KOJIC PREMIUM WHITE AND DEVICE and (NO VERBAL ELEMENTS) Human Face with black hair, two eyes closed, red lips but without a nose under Application No. 4-2016-0000747 resemble Opposer's KOJIE SAN AND DEVICE in looks and commercial presentation. The resemblance between the marks is sufficient to cause the likelihood of confusion, or even deception. The determination of whether the marks are the same or not is best appreciated as they appear side by side for comparison. Both marks with the face of a geisha or Japanese woman have the same illustration of the stark white face, slanted eyes, arch of the eyebrow and proportion of the lips. The Respondent-applicant also copied the devils peak hairline of Japanese woman's face in the Opposer's mark. The Respondent-Applicant contends that his marks are different because the face has no nose, both eyes are closed and he uses the name "UNI KOJIC PREMIUM WHITE" and not "Kojie.san". Besides, he argues that the depiction of a Japanese woman is always with the same facial features with slanted eyes, hairstyle and lips that are commonly red. The Bureau is convinced that any perceived difference is insignificant.

While, there is no monopoly in utilizing a woman's face or Japanese women, who are known to have fair and white skin as a mark, it is undeniable that Respondent-Applicant's rendition was done in a way that captures the dominant and essential features of the Opposer's mark. The drawing of the geisha face, adopting the same close eye, proportion of the facial and hair features were appropriated in Respondent-Applicant's mark. Likewise, when evaluated by the holistic test, the arrangement of the mark and its elements, as they are attached to the goods were copied by the Respondent-Applicant. The faces are positioned on the side of the packaging with the black hair framing the

package. The Supreme Court in *UFC Philippines v. Barrio Fiesta Manufacturing Corporation*¹⁰ held:

“There are two tests used in jurisprudence to determine likelihood of confusion, namely the dominancy test used by the IPO, and the holistic test adopted by the Court of Appeals. In *Skechers, U.S.A., Inc. v. Inter Pacific Industrial Trading Corp.*, we held:

The essential element of infringement under R.A. No. 8293 is that the infringing mark is likely to cause confusion. In determining similarity and likelihood of confusion, jurisprudence has developed tests - the Dominancy Test and the Holistic or Totality Test. The Dominancy Test focuses on the similarity of the prevalent or dominant features of the competing trademarks that might cause confusion, mistake, and deception in the mind of the purchasing public. Duplication or imitation is not necessary; neither is it required that the mark sought to be registered suggests an effort to imitate. Given more consideration are the aural and visual impressions created by the marks on the buyers of goods, giving little weight to factors like prices, quality, sales outlets, and market segments.

x x x x

Applying the Dominancy Test to the case at bar, this Court finds that the use of the stylized "S" by respondent in its Strong rubber shoes infringes on the mark already registered by petitioner with the IPO. While it is undisputed that petitioner's stylized "S" is within an oval design, to this Court's mind, the dominant feature of the trademark is the stylized "S," as it is precisely the stylized "S" which catches the eye of the purchaser. Thus, even if respondent did not use an oval design, the mere fact that it used the same stylized "S", the same being the dominant feature of petitioner's trademark, already constitutes infringement under the Dominancy Test.

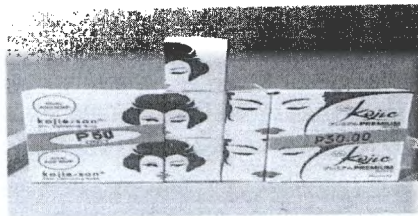
This Court cannot agree with the observation of the CA that the use of the letter "S" could hardly be considered as highly identifiable to the products of petitioner alone. The CA even supported its conclusion by stating that the letter "S" has been used in so many existing trademarks, the most popular of which is the trademark "S" enclosed by an inverted triangle, which the CA says is identifiable to Superman. Such reasoning, however, misses the entire point, which is that respondent had used a stylized "S," which is the same stylized "S" which petitioner has a registered trademark for. The letter "S" used in the Superman logo, on the other hand, has a block-like tip on the upper portion and a round elongated tip on the lower portion. Accordingly, the comparison made by the CA of the letter "S" used in the Superman trademark with petitioner's stylized "S" is not appropriate to the case at bar.

Furthermore, respondent did not simply use the letter "S," but it appears to this Court that based on the font and the size of the lettering, the stylized "S" utilized by respondent is the very same stylized "S" used by petitioner; a stylized "S" which is unique and distinguishes petitioner's trademark. Indubitably, the likelihood of confusion is present as purchasers will associate the respondent's

¹⁰ G.R. No. 198889, 20 January 2016

use of the stylized "S" as having been authorized by petitioner or that respondent's product is connected with petitioner's business. x x x x"

That the similitude between the marks is likely to cause confusion is underscored by the fact that the Respondent-Applicant will his marks on personal care products which are sold in department stores, cosmetic section of shops and flow through the same channels of trade. Undeniably, at an instant glance, the portrayal of a Japanese woman's white face with jet black hair, red lips, eye closed is strikingly the same as Opposer's mark and is a colorable imitation thereof. All the more, if one puts his or her hand to cover half of the Japanese woman's face on Opposer's mark, the obvious result is that image approximates the Respondent-Applicant's mark. Equally important to mention is that Opposer's products are packaged in unique way wherein the face is presented in half, as if divided, wherein one part covers the front package and the other, its flaps. When joined, a whole face appears. When arranged in display in store shelves, and store counters, the full face of the Japanese woman may be viewed by positioning the soaps obliquely or by an angle. This imagery, style and positioning was copied by Respondent-Applicant's marks. As such, in the manner of display, the commercial impressions generated by the marks are confusingly similar. The Supreme Court in *Etepha v. Director of Patents*¹¹ held: "that a practical approach to the problem of similarity or dissimilarity is to go into the *whole* of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as 'sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear' may be considered." The side by side presentation of the parties' marks as they appear on their labels/packaging are seen below:



The phrase "colorable imitation" denotes such a "close or ingenious imitation as to be calculated to deceive ordinary persons, or such a resemblance to the original as to deceive an ordinary purchaser, giving such attention as a purchaser usually gives, and to cause him to purchase the one supposing it to be the other."¹² In the assessment of the marks, when the competing labels are placed together or sold separately, the marks are

¹¹ G.R. L. No. 20635, 31 March 1966

¹² Ibid.

confusingly similar such that a prospective purchaser, who is guided by his or her recollection of the Opposer's mark would easily be confused, mistaken or even deceived into buying the Respondent-Applicant's goods because the styling is remarkably the same. The Bureau concludes that (NO VERBAL ELEMENTS) Human Face with black hair, two eyes closed, red lips but without a nose under Application No. 4-2016-0000747; and UNI KOJIC PREMIUM WHITE AND DEVICE under Application No. 4-2016-0000749 and Application No. 4-2016-0000748, are but mere colorable imitations of the Opposer's KOJIE SAN AND DEVICE mark in terms of sight, connotation and meaning as to be likely, when applied to or used in connection with the goods of Respondent-Applicant under class 3, causes confusion, mistake and deception on the part of the purchasing public.

The Supreme Court in *In McDonald's Corporation v. L.C Big Mak Burger, Inc.*¹³, this Court held:

Withal, the protection of trademarks as intellectual property is intended not only to preserve the goodwill and reputation of the business established on the goods bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods. While respondent's shoes contain some dissimilarities with petitioner's shoes, this Court cannot close its eye to the fact that for all intents and purpose, respondent had deliberately attempted to copy petitioner's mark and overall design and features of the shoes. Let it be remembered, that defendants in cases of infringement do not normally copy but only make colorable changes. The most successful form of copying is to employ enough points of similarity to confuse the public, with enough points of difference to confuse the courts.

Furthermore, the evidence show that the Opposer's use and registration of its marks pre-date Respondent-Applicant's use and registration of its marks. The Respondent-Applicant's registrations were issued only in 19 January 2012; 24 October 2014; 11 September 2014; and 18 August 2011.¹⁴ On the other hand, Opposer's application for registration was filed as early as 4 May 2006 and granted on 11 August 2008. In the Judicial Affidavit of Veronica Gregorio¹⁵ dated 30 June 2016, she testified that Opposer has in its portfolio various products bearing the KOJIE SAN AND DEVICE marks, some are reproduced below:



¹³ G.R. 143993, 18 August 2004

¹⁴ Exhibits "2" to "11"

¹⁵ Exhibit "D"

AD



She attested to the marketing, advertising and promotional activities of the kojie san kojic acid soap way back in 2013. The immense popularity of the Opposer's products bearing the KOJIE SAN AND DEVICE mark, garnered accolage in the form of awards for being the "SM's Best Top Choices in 2014" and "Bath Soap Brand of the Year" from 2009 to 2014, not to mention it being featured in numerous magazines, publications and articles. The pictures¹⁶ evidencing the trophies received by the Opposer from Watson as "Bath soap of the year" show they were awarded in 2010, 2011 and 2012. These are prior to Respondent-Applicant's trademark applications. Thus, the Opposer's mark has attained a degree of name or image recall or familiarity with the buying public. Being mere items of soap of minimal value, consumers would be less cautious in buying, hence, minor modifications in the Respondent-Applicant's mark do not obviate confusion. The Supreme Court in *Emerald Garment Manufacturing v. Court of Appeals*¹⁷ held:

First, the products involved in the case at bar are, in the main, various kinds of jeans. These are not your ordinary household items like catsup, soysauce or soap which are of minimal cost. Maong pants or jeans are not inexpensive. Accordingly, the casual buyer is predisposed to be more cautious and discriminating in and would prefer to mull over his purchase. Confusion and deception, then, is less likely. In *Del Monte Corporation v. Court of Appeals*, we noted that:

. . . Among these, what essentially determines the attitudes of the purchaser, specifically his inclination to be cautious, is the cost of the goods. To be sure, a person who buys a box of candies will not exercise as much care as one who buys an expensive watch. As a general rule, an ordinary buyer does not exercise as much prudence in buying an article for which he pays a few centavos as he does in purchasing a more valuable thing. Expensive and valuable items are normally bought only after deliberate, comparative and analytical investigation. But mass products, low priced articles in wide use, and matters of everyday purchase requiring frequent replacement are bought by the casual consumer without great care. . . .

Succinctly, because the Respondent-Applicant uses his mark on goods that are similar or closely related to the Opposer's it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or

¹⁶ Exhibit "E"

¹⁷ G.R. No. 100098, 29 December 1995

mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.¹⁸

The public interest, therefore, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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.¹⁹

Finally, the Respondent-Applicant argues that presence of other packages or labels with Japanese faces or geishas in their marks. A perusal of the labels, particularly, MIKAELA kojic acid glutathione²⁰ has the color pink. It has a drawing of a girl in full pink kimono dress and cherry blossoms on the package. ALL BEAUTI kojic acid whitening soap²¹ has a depiction of a Japanese woman's face half covered by an open fan with pink cherry blossom flowers on its border. KINIS kojic skin whitening soap package²² depicted the face of a woman by red line bordering the chin up to the head, red eyebrows and closed eyes with big eyelids. These samples do not have the same essential or dominant features of the Opposer's mark.

Thus, the slight differentiating features employed by the Respondent-Applicant in its marks, such as the word UNI, are negligible and insignificant in view of the glaring visual identicalness and confusing similarity of the style, prevalent and central features of the marks, that create confusion doubt among prospective customers.

WHEREFORE, premises considered, the instant oppositions to (NO VERBAL ELEMENTS) Human Face with black hair, two eyes closed, red lips but without a nose

¹⁸*Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

¹⁹*Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

²⁰ Exhibit "15"


²¹ Exhibit "12"

²² Exhibit "14"

under Application No. 4-2016-0007047; and UNI KOJIC PREMIUM WHITE AND DEVICE under Application No. 4-2016-0007049 and Application No. 4-2016-0007048. are hereby **SUSTAINED**. Let the filewrappers of the subject trademark registration and application, be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 09 NOV 2017


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