

ANTONIO AMMADO and  
ANNIE PINET,  
Opposer,

- versus -

HARRY HONG,  
Respondent-Applicant.  
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IPC No. 14-2009-00184  
Case Filed on: 24 July 2009  
Opposition to:

Appln. Serial No.: 4-2008-010654  
Date filed : September 03, 2008  
Trademark : REMINISCE”

Decision No. 2010-38

## DECISION

Antonio Ammado and Annie Pinet (“Opposers”) with business address at 39 Avenue de Cannes, 06160 Juan Les Pins, France, filed on 24 July 2009 an opposition to Trademark Application Serial No. 4-2008-010654. The trademark application filed by Harry Hong (“Respondent-Applicant”), with address at 60 Apo Street, Quezon City on 03 September 2008, covers “*perfumes, roll-on, spray, colognes, cosmetics, eye liner, lip liners, eye pencils, soaps, deodorant*” under Class 3 of the International Classification of goods,<sup>1</sup> and was published in the Intellectual Property Office of the Philippines E-Gazette issued on 27 March 2009.

The Opposer alleges the following:

“1. The mark REMINISCE, which Respondent seeks to register so resembles OPPOSER’S well-known trademark REMINISCENCE, which when applied to or used in connection with the goods covered by the application under opposition will likely cause confusion, mistake and deception on the part of the purchasing public.

“2. OPPOSER has adopted and continuously used the trademarks REMINISCENCE in actual trade and international commerce for a long period of time and had acquired goodwill and international consumer recognition.

“3. It had registered the marks and used it in many countries that are members of the Paris Convention.

“4. The registration of RESPONDENT’S trademark will violate Rule 101 (e) in relation to Rule 102 of the Implementing Rules of Republic Act 8293 (The New Philippine Intellectual Property Code).

“5. The registration of RESPONDENT’S trademark contravenes the provisions of Article 6bis of the Paris Convention on the Protection of Industrial Property and the TRIPS Agreement.

“In support of the instant opposition, Opposer will rely principally on the following facts:

“1. OPPOSER, through its authorized licensee, has filed an application for the mark REMINISCENCE in classes 3 and 14 at the Philippine Intellectual Property Office.

“2. OPPOSER’S trademark is well-known throughout the world.

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<sup>1</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademarks and servicemarks, 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 the Registration of Marks concluded in 1957.

“3. OPPOSER has invested tremendous amount of resources in, improvement, marketing and distribution of its mark REMINISCENCE and the registration of any identical, confusingly similar or even a translation of this well-known mark in the name of the RESPONDENT would cause grave and irreparable loss, injury and damages to OPPOSER.

“4. The registration of the trademark subject of the instant opposition will undoubtedly violate OPPOSER’S rights and interests to its trademark, cause confusion between OPPOSER’S and RESPONDENT’S businesses and products, and will most assuredly result in the dilution and loss of distinctiveness of OPPOSER’S trademark.

“5. The registration of RESPONDENTS application would take advantage of the popularity and goodwill generated by OPPOSER’S mark. There are limitless names available, yet RESPONDENT chose to adopt a confusingly similar mark, undoubtedly to confuse, mislead, or deceive purchasers into believing that his products are that of the OPPOSER. “

The Opposer’s evidence consists of the following:

1. Exhibit “A” - Extract of formation of company REMINISCENCE Diffusion International on 22 Feb 1983;
2. Exhibit “B” - Extract of formation of Company EQUATEUR CELESTE on 28 Oct 1986;
3. Exhibits “C and C-1” - Status of company named “CELESTE ASIA”, where Reminiscence Diffusion International is a shareholder;
4. Exhibit “D”- 1 box Eau de Toilette Noir de Reminiscence ... 100ml;
5. Exhibit “E” - 1 box gel paillete corps Etoile de Rem ... 100ml;
6. Exhibit “F” - 1 box Eau de Toilette Etoile de Rem ...100ml;
7. Exhibit “G” - 1 box Eau de Toilette Rem ...100ml;
8. Exhibit “H” - 1 box Eau de Toilette Reminiscence for men ...100ml;
9. Exhibit “I” - 1 box Eau de Toilette Ambre from REMINISCENCE ...100ml;
10. Exhibit “J” - 1 box Eau de Parfum Elixir de Patchouli ...100ml;
11. Exhibit “K” - 1 box Eau de Toilette Patchouli from REMINISCENCE ...100ML;
12. Exhibit “L” - 1 box Creme corps Elixir de Patchouli ...200ml;
13. Exhibit “M”- 1 box Eau de Toilette Patchouli Men ...100ml;
14. Exhibit “N” - 1 box Eau de Toilette Eau de Rem ...100ml;
15. Exhibit “O” - 1 box Eau de Toilette Musc ...100ml;
16. Exhibit “P” - Brochure of Reminiscence;
17. Exhibit “Q”- Catalog of Reminiscence Parfums;
18. Exhibit “R” - Various Reminiscence pas materials;

19. Exhibit "S" - Copy of French registration "REMINISCENCE" in class 3, of 3 September 1982 n 1212281;
20. Exhibit "T" - Copy of French registration REMINISCENCE classes 3, 14, 16, 18, 20 of 17 November 1989, renewed on 30 September 1999 n 1 561493;
21. Exhibit "U" - Copy of International registration, Madrid Agreement and Protocol (W.I.P.O.) 16 March 1994 n 615795 for classes 3, 14, 18;
22. Exhibit "V" - Copy of Registration for Canada filed on 08 December 2003, reg 4 November 2005, Reg n TMA 652,292 for perfumes and jewels;
23. Exhibit "W" - Copy of Community trademark registration (27 countries in European Union) a.H.LM., 10 January 2005, reg n 004235909 in classes 3, 14,25;
24. Exhibit "X" - Copy of South African registration, 06 November 2007 n 2007/25630 (classes 3, 14) filed in the name of REMINISCENCE DIFFUSION INTERNATIONALE;
25. Exhibit "Y" - Copy of South Korean registration;
26. Exhibit "Z" - Copy of Emirates registration;
27. Exhibit "AA" - Copy of Kuwait and Lebanese registrations;
28. Exhibit "BB" - Copy of Hong Kong registration;
29. Exhibit "CC" - Copy of Taiwanese registration;
30. Exhibit "DD" - Copy of advertising figures for Reminiscence;
31. Exhibit "EE" - Copy of Advertising figures for Reminiscence in Asia;
32. Exhibit "FF" - Copy of turnover figures for export, perfumes and jewels;
33. Exhibits "GG" - 1 document with Reminiscence export turnover 2007-2009 area, by country;
34. Exhibit "HH" - Copy of turnover figures for perfume;
35. Exhibit "II" - Copy of sales invoices in Korea;
36. Exhibit "JJ" - Copy of sales invoices in Hong Kong;
37. Exhibit "KK" - Copy of sales invoices in Australia;
38. Exhibit "LL" - Copy of sales invoices in Taiwan;
39. Exhibit "MM" - Purchase invoices from the Philippines;
40. Exhibit "NN" - Extract of Licensee Agreements with Equator Celeste;
41. Exhibit "OO" - Extract of License Agreement between Equator Celeste and Diffusion Internationale;

This Bureau issued and served a Notice to Answer upon the Respondent-Applicant on 08 September 2009. The Respondent-Applicant however, did not file his Answer. Hence, Rule 2, Section 11 of the Regulations on Inter Partes Proceedings, as amended, provides:

Section 11. *Effect of failure to file an Answer.* -In case the Respondent-Applicant fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the Petition or Opposition, the affidavit of the witnesses and documentary evidence submitted by the Petitioner or Opposer.

The issues to be resolved in this case are the following:

1. Whether the Opposer's mark is a well-known mark, and
2. Whether the Respondent-Applicant should be allowed to register the mark "REMINISCE" in his favor.

On the first issue, Rule 102 of the Trademark Regulations sets forth the criteria in determining whether a mark is considered to be well-known, to wit:

Rule 102. *Criteria for determining whether a mark is well-known.* In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.

Records show that the Opposer's mark has an international registration by Madrid Agreement and Protocol<sup>2</sup>, World Intellectual Property Office (W.L.P.O.) and Community Trademark Registration, Office for Harmonization of Internal Market (O.H.L.M.) 10 January 2005 Registration No. 004235909<sup>3</sup> in classes 3, 14, 25.

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<sup>2</sup> Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

<sup>3</sup> Exhibit "WW":

Also, the Opposer submitted evidence of the sales of perfumes in connection with the mark REMINISCENCE<sup>4</sup> and the extensive level of its advertising and promotions worldwide. The evidence submitted by the Opposer constitute at least a combination of the criteria under Rule 102 of the Trademark Regulations. Hence, the Opposer's mark could be considered as well-known.

Going now to the second issue, it is emphasized that the essence of trademark registration is to give protection to the owner of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the article to which it is affixed, to secure to him, who has been instrumental in bringing into a 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 of products<sup>5</sup>.

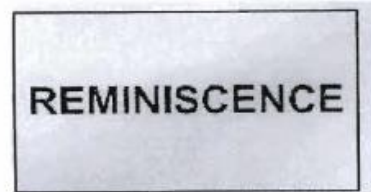
As discussed above, the Opposer submitted evidence to show that its mark is well-known under Rule 102 of the Trademark Regulations. The evidence also shows that the Opposer has:

1. used the mark for goods that are similar or closely related to the goods on which the Respondent-Applicant will use his mark, and
2. appropriated and used the mark long before the Respondent Applicant filed his trademark application.

The question now is: Are the competing marks as shown below are identical or confusingly similar?



Respondent-Applicant's mark



Opposer's mark

The determinative factor in a contest involving registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark would likely cause confusion or mistake on the part of the buying public. In short, 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.<sup>6</sup>

Even if the competing marks are presented in different fonts, they still look similar to each other. The Opposer's mark which is the word REMINISCENCE is a noun. The word in its verb form becomes REMINISCE. Thus, essentially, the marks are the same, in appearance, in sound and meaning; they convey the same concept or idea, that is the state of mind specially remembering and recollecting.

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<sup>4</sup> Exhibit "DD", "HH" to "GG":

<sup>5</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents*, 16 SCRA 495

<sup>6</sup> *American Wire and Cable Co. vs. Director of Patents et.al.* [31SCRA544] [G.R.No.L-26557, Feb18, 1970.

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

Sec. 123. Registrability -123.1. A mark cannot be registered if it:

“(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;”

In *Chuanchow Soy & Canning Co., vs. Director of Patents and Rosario Villapania*<sup>7</sup> the Supreme Court held that:

“When one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark, this not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill.”

It is stressed that the law on trademarks and trade names is based on the principle of business integrity and common justice. The law, both in letter and spirit, is laid upon the premise that, while it encourages fair trade in every way and aims to foster, and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing others business by fraud, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another<sup>8</sup>.

WHEREFORE, premises considered, the opposition is hereby SUSTAINED.

Let the filewrapper of the Trademark Application Serial No. 4-2008-010654 be returned, together with a copy of this DECISION, to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 12 July 2010.

Atty. NATHANIEL S. AREVALO  
Director, Bureau of Legal Affairs  
Intellectual Property Office

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<sup>7</sup> G.R. No. L-13947, 30 June 1960

<sup>8</sup> *Baltimore v. Moses*, 182 MD229, 34A (2d) 338