

TOTAL S.A.,

Opposer,
- versus -

IPC 14-2007-00074

Opposition to:
TM Application No. 4-2004-003869
(Filing Date: 29 April 2004)

COMET OIL PHILIPPINES, INC.,
Respondent-Applicant.

TM: "LUNAR"

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Decision No. 2007 – 77

DECISION

This is an opposition to the registration of the mark "LUNAR" bearing Serial No. 4-220-003869 filed on April 29, 2004 covering the goods "lubricants oils and greases" falling under class 4 the international Classification of goods which application was posted on the Intellectual Property Philippines (IPP) E Gazette officially released on November 17, 2006.

The Opposer in the instant opposition proceeding is "TOTAL S.A." a corporation duly organized under the law of France, with principal office at 2, Place de la Couple, la Defense 6, 92400, Courbevoie, France .

On the another hand , Respondent-Applicant is "COMET OIL PHILIPPINES INC." with address at Ground Floor Richbelt Tower, 17 Annapolis St., Greenhills Subdivision, San Juan, Metro Manila.

The grounds for the opposition are as follows:

1. Opposer is the registered of the trademark LUNARIA for goods in Class 4, in the Philippines under Certificate of Registration No. 045777 issued by the Intellectual Property Philippines (IPP) way back on July 14, 1989. Opposer is the first user of the trademark LUNARIA for its goods in Class 4 in France since 1976 and in the Philippines and any other countries long before Respondent-Applicant appropriated the similar mark LUNAR for its own products also in Class 4.
2. Respondent-Applicant's trademark LUNAR so resembles Opposer's LUNARIA mark as to be likely, when applied to or used in connecting with a goods of Respondent Applicant, to cause confusion, mistake and deception on the part of the purchasing public by misleading them into thinking that Respondent-Applicant's goods either come from or sponsored or licensed by it.
3. The registration and the by the Respondent-Applicant of the trademark LUNAR will diminish the distinctiveness and dilute the goodwill of Opposer's LUNARIA mark, which is arbitrary trademark when applied to Opposer's products.
4. Respondent-Applicant adopted the trademark LUNAR on its own goods with obvious intention of misleading the public into believing that its goods bearing the trademark originate from, r are licensed or sponsored by Opposer, which has been identified in the trade and by the consumers as a source of goods bearing the confusingly similar LUNAR mark.
5. The approval of Respondent-Applicant's trademark LUNAR is based on the representation that it is originator, true owner and first user of the trademark, which was merely derived from Opposer's LUNARIA mark.

6. Opposer is the first user of the trademark LUNARIA in the Philippines commerce and elsewhere, having utilized the same extensively for over 7 years in the Philippines. Opposer's LUNARIA mark has come to be associated with several products including oils, greases and lubricants in Class 4 of the finest quality. Respondent-Applicant's use of a confusingly similar mark as the brand name for its own products is likely to cause consumer confusion as to the origin of said goods.
7. Respondent-Applicant's use of the trademark LUNAR infringes upon Opposer's exclusive right to use the LUNARIA mark, which is well-known trademark protected under Section 147 and 123.1 (d), (e) and (f) of the Intellectual Property Code ("IP Code"), Article 6bis of the Paris Convention and Article 16 of the Agreement on Trade Related Aspect of Intellectual Property Rights to which the Philippines and United States of America adhere.
8. In appropriating LUNAR as a mark, Respondent-Applicant betrayed its awareness of Opposer's existence and the prior use and renown of its LUNARIA mark. This Office must implement the provisions of the Paris Convention and the IP Code by confirming Opposer's rightful ownership of its LUNARIA mark.
9. The registration of the trademark LUNAR in the name of the Respondent-Applicant is contrary to other provisions of the IP Code.

Opposer relied on the following facts to support its opposition:

- "1. Opposer adopted and has been using the LUNARIA mark for its goods industrial oil and greases, lubricants, long before Respondent-Applicant's unauthorized usage of the confusingly similar trademark LUNAR. Opposer has been commercially using trademark LUNARIA in the Philippines for almost 7 years before the filing of the application for the registration of the trademark LUNAR by Respondent-Applicant.
- "2. Opposer is the first user and rightful owner of the LUNARIA mark. Opposer has also used and registered or applied for the registration of the LUNARIA mark in many other countries worldwide.
- "3. Opposer's LUNARIA mark is an arbitrary trademark and is entitled to broad legal protection against unauthorized users like Respondent-Applicant who has appropriated the deceptively similar trademark LUNAR for its own goods.
- "4. Opposer is the first user of the LUNARIA mark for the above-mentioned goods. Respondent-Applicant has appropriated the trademark LUNAR for the obvious purpose of capitalizing upon the renown of Opposer's self-promoting trademark by misleading the public into believing that its goods originate from, or are licensed or sponsored by Opposer.
- "5. The registration and use of a confusingly similar trademark by the Respondent-Applicant will tend to deceive and/or confuse purchaser into believing that respondent-Applicant's products emanate from or are under the sponsorship of Opposer and damage Opposer's interest for the following reasons:
 - (i) The trademarks are confusingly or deceptively similar.
 - (ii) Respondent-Applicant's unauthorized appropriation and use of the trademark LUNAR will dilute Opposer's reputation and goodwill among consumers.

- (iii) Respondent-Applicant used the trademark LUNAR on its own products through its association with Opposer's popular LUNARIA mark, which has attained international renown as a mark for several products including industrial oil greases and lubricants in Class 4 of the fine quality.
- (iv) The goods on which the trademarks (i.e., lubricants, oils and greases) are used are identical and are advertised to consumers through the same channels of trade.
- (v) Respondent-Applicants intend to trade, and is trading on Opposer's goodwill.

"6. The registration and use of an identical trademark by respondent-Applicants will diminish the distinctiveness and dilute the goodwill of Opposer's LUNARIA mark.

The Bureau of Legal Affairs issued a Notice to answer which was personally delivered to its counsel of record April 24, 2007.

Despite receipt of the notice to answer, Respondent-Applicant did not file the required Answer, together with the affidavit of its witness and another documents in support of its Application, hence the same is considered WAIVED.

If the applicant changed its address, it is its duty and obligation to inform this office of any change of address.

Rule 602 of the Rules and Regulation on the trademark case provides:

"Rule 602. Applicant supposed to look after his own interest. The Office, represented by the examiner, is not supposed to look after the interest of an applicant. The examiner is in charge with the protection of the interests of the public and hence must be vigilant to see that no registration issues for a mark contrary to law and these regulations."

Section 11 of the Summary Rules (Office Order No. 79, Series of 2005) provides:

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

The Opposer submitted the following as its evidence.

Exhibit	Description
Exhibit "A"	Certified True Copy of Philippines Registration Certificate No. 045777
Exhibit "B"	Commercial Invoice for the mark LUNARIA to different outlets in different parts of the Philippines.
Exhibit "C"	Brochure of TOTAL Industrial lubricant range, which includes those sold under the LUNARIA trademark
Exhibit "D"	List of countries where trademark LUNARIA is registered, or where applications to register the same have been filed and are pending
Exhibit "E"	Registration Certificate No. 82/8935 issued by South Africa Patent and trademark Office on April 13, 1984 for the mark LUNARIA
Exhibit "F"	Registration Certificate No. 1370732 issued by Argentina Trademark Office on December 22, 1989 for the mark LUNARIA
Exhibit "G"	Registration Certificate No. A383809 issued by Australia Trademark Office on January 31, 1985 for the mark LUNARIA
Exhibit "H"	Registration Certificate No. 245268 issued by Chinese Trademark Office on

	June 15, 1992 for the mark LUNARIA
Exhibit "I"	Registration Certificate No.133165 issued by Costa Rica Trademark Office on May 7, 2002 for the mark LUNARIA
Exhibit "J"	Registration Certificate No. 73306 issued by the Greek on November 09, 1992 for the mark LUNARIA
Exhibit "K"	Registration Certificate No. 2738/1982 issued by the Japanese Trademark Office on April 30, 1997 for the mark LUNARIA
Exhibit "L"	Registration Certificate No. 1947110 issued by the Japanese Trademark Office on April 30, 1997 for the mark LUNARIA
Exhibit "M"	Registration Certificate No. 447898 issued by the Mexican Trademark Office on May 17, 1993 for the mark LUNARIA
Exhibit "N"	Registration Certificate No. 701735 issued by the New Zealander Trademark Office on March 18, 2004 for the mark LUNARIA
Exhibit "O"	Registration Certificate No.74662 issued by the Polish Trademark on February 24, 1994 for the mark LUNARIA
Exhibit "P"	Registration Certificate No. 1184767 issued by the United Kingdom Trademark Office on January 24, 1985 for the mark LUNARIA
Exhibit "Q"	Registration Certificate No. 644/84 issued by the Singapore Trademark Office on February 11, 1984 for the mark LUNARIA
Exhibit "R"	Registration Certificate No. Kor160942 issued by the Thai Trademark Office on June 4, 2002 for the mark LUNARIA

Annex	Description
Annex "A"	Authentication issued by the Philippines Embassy in Paris, France for Opposer's Notice of Opposition
Annex "B"	Authentication issued by the Philippine Embassy in Paris, France for the affidavit of Stephanie Polselli with attachments
Annex "C"	Certification issued by Intellectual Property Philippines (IPP) on March 5, 2007 for the trademark LUNARIA Registration No. 45777
Annex "D"	Authentication issued by the Philippines Embassy in Paris, France for the Special Power of Attorney.

On the other hand, Respondent-Applicant failed to file the required Answer and so with the affidavits of its witnesses and the documents in support of its application subject of the instant opposition.

The ultimate issue to be resolved in this particular case is:

WHETHER OR NOT THE RESPONDENT-APPLICANT IS ENTITLED TO THE REGISTRATION OF THE MARK "LUNAR".

The applicable provision of the law is, Section 123 (d) of republic Act No.8293, which provides:

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

(d) Is identical with a registered mark belonging to a different proprietor or mark with an earlier filing or priority date, in respect of:

In order to arrive at a just and fair conclusion as to whether the contending marks are confusingly similar, both are reproduced below for comparison and scrutiny.



Opposer's mark



Respondent-Applicant mark

Records will show that the Opposer's mark "LUNARIA" has been registered in the Philippines or with the Bureau of Patents, Trademark and Technology Transfer way back on July 14, 1989 under Certificate of Registration No. 45777 for the goods "industrial oils and greases" (other than edible oils or fats or essential oils), lubricants, falling under Class 4 of the International Classification of goods. (Exhibit "A")

Opposer has likewise commercially used it trademark on its goods through its different outlets in different parts of the Philippines as shown by the sales invoices it submitted. (Exhibits "B" and "C")

Likewise Opposer has also registered and/or applied for the registration of the mark "LUNARIA" in almost sixty (60) countries around the world. (Exhibit "D")

Some of the countries where Opposer's mark "LUNARIA" has been registered are as follows:

Country	Registration No.
South Africa	Registration Certificate No.82/8935 issued by South Africa Patent and Trademark Office on April 13, 1984 (Exhibit "E")
Argentina	Registration Certificate No.1370732 issued by Argentina Trademark Office on December 22, 1989 (Exhibit "F")
Australia	Registration Certificate No. A383809 issued by Australia Trademark Office on January 31, 1985 (Exhibit "G")
China	Registration Certificate No. 245268 issued by Chinese Trademark Office on June 15, 1992 (Exhibit "H")
Costa Rica	Registration Certificate No. 133165 issued by Costa Rica Trademark Office on May 7, 2002 (Exhibit "I")
Greece	Registration Certificate No. 73306 issued by the Greek Trademark Office November 09, 1992 (Exhibit "J")
Hong Kong	Registration Certificate No. 2738/1982 issued by the Hong Kong Trademark Office on November 29, 1982 (Exhibit "K")
Japan	Registration Certificate No. 1947110 issued by the Japanese Trademark Office on April 30, 1997 (Exhibit "L")
Mexico	Registration Certificate No. 447898 issued by the Mexican Trademark Office on May 17, 1993 (Exhibit "M")
New Zealand	Registration Certificate No. Registration Certificate No. 701735 issued by the New Zealander Trademark Office on March 18, 2004 (Exhibit "N")
Poland	Registration Certificate No. 74662 issued by the Polish Trademark on February 24, 1994 (Exhibit "O")
United Kingdom	Registration Certificate No. 1884767 issued by the United Kingdom Trademark Office on January 24, 1985 (Exhibit "P")
Singapore	Registration Certificate No. 644/84 issued by the Singaporean Trademark Office on February 11, 1984 (Exhibit "Q")
Thailand	Registration Certificate No. Kor160942 issued by the Thai Trademark Office on June 4, 2002 (Exhibit "R")

One vital point to be taken into consideration is the fact that the Opposer's mark "LUNARIA" is a registered mark with the Bureau of Patents, Trademarks and technology Transfer. (Exhibit "A")

In trademark registration cases, the certificate of registration is *prima facie* evidence of the validity of registration, the registrant's the ownership of the mark and the exclusive right to use the same in connection with the goods or services ant those that are related thereto specified in the certificate (Levi Strauss & co., vs Clinton Apparelle, Inc., 470 SCRA, 253-254 (2005)).

Section 147 of Republic Act No. 8293, Provides:

Section 147. – Right Conferred – Section 147.1 The owner of the registered mark shall have the exclusive right to prevent all third parties not having that owner's consent from using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion x x x.

In ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, two kinds of test have been developed, the *dominancy test* and the *holistic test*.

The question of infringement of trademark is to be determined by the test of dominancy. The dissimilarity in size, from and color of the label and the place where applied are not conclusive. Duplication or exact imitation is not necessary that the infringing label should suggest an effort to imitate. [Trademark: NABISCO and AMBISCO, both for biscuits.]

As its title implies, the test of dominancy focuses on the similarity of the prevalent essential or dominant features of the competing trademarks which might cause confusion or deception. On the other side of the spectrum, the holistic test mandates that the entirety of the mark in question must be considered in determining confusing similarity.

It is observed that the dominant feature of the Opposer's mark "LUNARIA" is the word "LUNAR" which is exactly the same with the mark of the Respondent-Applicant "LUNAR".

When the competing marks are pronounced, they are almost exactly the same. Their distinction lies only with a presence of the letter "I" and "A" in the Opposer's mark but the presence of the said letters would not in anyway avoid confusing similarity.

In the instant case, the Respondent-Applicant appropriated or copied the dominant feature of the Opposer's mark only eliminating the two (2) letters "I" and "A".

Moreover, the goods/products covered by the competing trademark belong to the same Class 4 of the International Classification of goods and are actually the same kind of products, hence the trademark LUNAR of Respondent-Applicant for use on goods under Class 4 cannot be allowed registration, it being confusingly similar with Opposer's LUNARIA likewise used for goods under Class 4 of the International Classification of goods.

WITH ALL THE FOREGOING, the opposition is, as it is hereby SUSTAINED. Consequently, Application bearing Serial No. 4-2004-003869 filed on April 29, 2004 for the registration of the mark "LUNAR" covering the goods, lubricants, oils and greases is, as it is hereby, REJECTED.

Let the filewrapper of the trademark "LUNAR" subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 28 June 2007

ESTRELLITA BELTRAN-ABELADO
Director, Bureau of Legal Affairs
Intellectual Property Office