



**INNOVITELLE, INC.,**  
Opposer,

-versus-

**ACS MANUFACTURING CORP.,**  
Respondent-Applicant.

X-----X

} **IPC No. 14-2011-00425**  
} Opposition to:  
} Appln. Serial No. 4-2011-005131  
} Date filed: 05 May 2011  
} **TM: "WISH"**

### NOTICE OF DECISION

**OCHAVE & ESCALONA**  
Counsel for the Opposer  
No. 66 United Street  
Mandaluyong City

**ACS MANUFACTURING CORPORATION**  
Respondent-Applicant  
Unit 1108 Antel Global Corporate Center  
No. 3 Julia Vargas Ave., Ortigas Center  
Pasig City

#### GREETINGS:

Please be informed that Decision No. 2012 - 69 dated April 17, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 17, 2012.

For the Director:

A handwritten signature in black ink, appearing to read "Atty. PAUSI U. SAPAK", written over a horizontal line.

**Atty. PAUSI U. SAPAK**  
Hearing Officer, BLA



INNOVITELLE, INC.,  
*Opposer,*

- versus -

ACS MANUFACTURING CORP.,  
*Respondent-Applicant.*

x-----x

IPC No. 14-2011-00425  
Opposition to:  
Appln. Serial No. 4-2011-005131  
Date Filed: 05 May 2011  
TM: "WISH"

Decision No. 2012- 69

## DECISION

INNOVITELLE, INC., ("Opposer")<sup>1</sup> filed on 14 September 2011 an opposition to Trademark Application Serial No. 4-2011-005131. The application, filed by ACS MANUFACTURING CORP., ("Respondent-Applicant")<sup>2</sup>, covers the mark "WISH" used on "*soap; anti-bacterial soap; cosmetics; deodorants for personal use*" under Class 3 of the International Classification of Goods.<sup>3</sup>

The Opposer alleges among other things that the registration of the mark "WISH" so resembles the registered trademark SWISH owned by Opposer and will violate Sec. 123 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). According to the Opposer, the mark "WISH" will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark "WISH" is applied for the same class and goods as that of Opposer's trademark SWISH, i. e. Class 3 of the International Classification of Goods.

The Opposer's evidence consists of copies of the pages of the IPO E-Gazette, dated 15 August 2011, showing the publication for opposition of the Respondent-Applicant's application, certified true copy of the Cert. of Reg. No. 4-2008-002922 for the mark "SWISH"; certified true copy of the Declaration of Actual Use of the mark "SWISH" filed on 09 March 2011, sample product label bearing the mark "SWISH", and a certified true copy of the Notification of Cosmetic Product filed with the Food and Drug Administration.<sup>4</sup>

This Office issued a Notice to Answer and served upon a copy thereof to the Respondent-Applicant on 11 October 2011. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the mark "WISH"?

It is emphasized that the essence of the trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or

<sup>1</sup> Is a domestic corporation duly organized and existing under the laws of the Philippines, with principal business address at 2<sup>nd</sup> Floor Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.

<sup>2</sup> A domestic corporation with principal business address at Unit 1108 Antel Global Corporate Center No. 3 Julia Vargas Avenue, Ortigas Center, Pasig City, Philippines.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement concerning the International Classification of Goods and Services for the purpose of the Registration of Marks concluded in 1957.

<sup>4</sup> Marked as Exhibits "A" to "E".

ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market 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; to protect the manufacturer against and sale of inferior and different articles as his products<sup>5</sup>.

Thus, Section 123.1 (d) of R.A. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”) provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services of if it nearly resembles such mark as to be likely to deceived or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application in 2011, the Opposer has an existing trademark registration for the mark SWISH (Cert. of Reg. No. 4-2008-002922). The registration, dated 20 October 2008, covers “*non-antiseptic mouthwash, mouth rinse, breathe fresheners, cosmetic tooth whiteners, tooth whitening strips, breathe freshening dissolving strips and toothpaste*” under Class 3 and “*medicated mouthwash, antiseptic and medicated mouth rinse*”. These goods are closely related to those indicated in the Respondent-Applicant’s application. Both parties deal in products for personal hygiene, household goods which flow in the same channels of trade.

Succinctly, scrutinizing the competing marks, as shown below:

**Swish**

*Opposer’s mark*

**WISH**

*Respondent-Applicant’s mark*

this Bureau finds them confusingly similar. The only difference between the two is the letter “S”, which is inconsequential because the marks still obviously look and sound alike. When the Respondent-Applicant’s applied mark is pronounced, there is practically no difference as to the sound it makes from that of the Opposer’s.

In this regard, it is stressed that confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other<sup>6</sup>. Colorable imitation does not mean such similitude as amounts to identity, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in the form, content, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the others mark or tradename in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing genuine article<sup>7</sup>.

“SWISH” for products for personal hygiene is a unique and distinctive mark, in the

<sup>5</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114509, 19 Nov. 1999.

<sup>6</sup> *Societe Des Produits Nestle, S.A. v. Court of Appeals*, G.R. No. 112012, 4 April 2001, 356 SCRA 207, 217.

<sup>7</sup> *Emerald Garment Manufacturing Corp. v. Court of Appeals*, G.R.No. 1,000098, 29 Dec. 1995.

category of an arbitrary mark, such that it is highly improbable for another person to come up with an identical or nearly identical mark for use on the same or related goods purely by coincidence. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the answered riddle is why, of the millions of terms and combination of letters and available, the Respondent-Applicant had come up with a mark identical or so clearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark<sup>8</sup>. Being in the same line of business with the Opposer, the Respondent-Applicant could not have possibly been unaware of the existence of the Opposer's products under the brand name or mark "SWISH".

As brand names or marks attached to common household items that are readily available in groceries and retail stores, the similarity between the competing marks, especially in sound, is crucial in the recall factor, if not of the products themselves, then on the reputation thereof. The consumers will also likely have the impression that these products originate from a single source or the origin thereof are connected or associated with one another. The likelihood of confusion therefore, would subsist not only on the purchaser's perception of the goods but on the origin thereof<sup>9</sup>. Moreover, because of the similarity of the competing marks in look and in sound, the Respondent-Application attempt to secure exclusive use of the word "WISH" as a trademark could shackle the Opposer's logical expansion of its business to other products related to personal hygiene.

WHEREFORE, premises considered, the instant opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2011-005131 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 17 April 2012.

  
ATTY. NATHANIEL S. AREVALO  
Director IV  
Bureau of Legal Affairs



---

<sup>8</sup> *American Wire and Cable Co. v. Director of Patents et. al* (SCRA 544), G.R. No. L-26557, 18 Feb. 1970.  
<sup>9</sup> *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.