



PADI'S POINT, INC.,  
Opposer,

-versus-

JOHNSON & JOHNSON,  
Respondent-Applicant.

X-----X

}  
} IPC No. 14-2012-00089  
} Opposition to:  
} Appln. Serial No. 4-2011-005150  
} Date filed: 05 May 2011  
} TM: "TARA NA"

**NOTICE OF DECISION**

**FEDERIS & ASSOCIATES LAW OFFICES**  
Counsel for the Opposer  
2004 and 2005, 88 Corporate Center  
141 Valero corner Sedeno Streets  
Salcedo Village, Makati City

**ROMULO MABANTA BUENAVENTURA SAYOC  
AND DELOS ANGELES**  
Counsel for Respondent-Applicant  
20 & 21<sup>st</sup> Floor, Philamlife Tower  
8767 Paseo de Roxas Street  
Makati City

**GREETINGS:**

Please be informed that Decision No. 2012 - 198 dated October 11, 2012 ( copy enclosed) was promulgated in the above entitled case.

Taguig City, October 11, 2012.

For the Director:

  
Atty. EDWIN DANILO A. DATING  
Director III  
Bureau of Legal Affairs



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- versus -

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Opposition to:

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(Filing Date: 05 May 2011)

TM: "TARA NA"

Decision No. 2012- 198

## DECISION

PADI'S POINT, INC. ("Opposer")<sup>1</sup> filed on 22 February 2012 an opposition to Trademark Application Serial No. 4-2011-005150. The application, filed by JOHNSON & JOHNSON ("Respondent-Applicant")<sup>2</sup> covers the mark "TARA NA" for use on "advertisement, slogan, tagline", under Class 35 of the International Classification.<sup>3</sup>

The Opposer anchors its opposition on the ground that TARA NA is confusingly similar to its registered mark "TARA NA". According to the Opposer, the registration of the mark TARA NA is proscribed by Sec. 123.I(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). To support its opposition, the Opposer submitted the affidavit of its President Vicente A. Padilla, Jr., a certified copy of Cert. of Reg. No. 4-2001-007398 for the mark TARA NA, and advertising materials for the mark TARA NA<sup>4</sup>.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 12 March 2012. However, the Respondent-Applicant did not file an Answer. Thus, the Hearing Officer issued on 10 July 2012 Order No. 2012-932 declaring the Respondent-Applicant in default and the case deemed submitted for decision.

It is emphasized that the essence of trademark registration is to give protection to the owner of the 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 manufacture against and sale of an inferior and different article of his products.<sup>5</sup> Thus, Sec. 123.I (d) of the 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

<sup>1</sup> A corporation organized and existing under the laws of the Philippines, with business address at 291 P. Guevarra Avenue, San Juan, Metro Manila.

<sup>2</sup> A corporation organized and existing under the laws of the United States of America (U.S.A.) with business address at One Johnson & Johnson Plaza, New Brunswick, New Jersey 08933, U.S.A.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademarks 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.

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

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

related goods or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application on 05 May 2011 the Opposer has an existing registration for the mark TARA NA under Reg. No. 4-2001-007398 issued on 05 August 2004. This registration covers various goods and services under classes 16, 18, 25, 28, 29, 30, 32, 33, 41 and 42.

In this regard, this Bureau finds merit in the Opposer's assertions, to wit:

"20. It is conceded that copycats may elude this conclusion of confusing similarity by arguing that the goods covered by the contending trademarks are different. In this case, there is an appearance of dissimilarity in goods, i.e., Class 35 for the subject mark; and Classes 16, 18, 25, 28, 29, 30, 32, 33, 41 and 42 for TARA NA.

"21. However, the dissimilarity is more imagined than real.

"22. Class 35 essentially covers 'advertising', meaning, Respondent-Applicant will use TARA NA, in promotional and advertising materials - which clearly is entirely similar to the essence of TARA NA of Opposer as a tagline trademark.

"23. It must be underscored that Opposer's TARA NA is a tagline trademark, the essence of which is precisely to advertise and entice customers to try Opposer's PADI's POINT restaurant. Indeed, the history of TARA NA is that it is a catchy tagline that successfully advertised the business of Mr. Padilla.

"24. This is underscored by the fact that TARA NA has since been used by Opposer in several advertising media like streamers, tarpaulins, banners, flyers, signages, markers and has also been heard on the radio. It also appears on the internet, which undoubtedly, is a huge medium for advertising. Evidence proving the use of TARA NA in advertising will be attached to an Affidavit that will be submitted together with this Verified Notice of Opposition.

"34. Indeed, the contending trademarks will be used for the same activity or services, in this case, the advertising and promotion of the contending parties' goods and services."<sup>6</sup>

On whether a mark utilized by a party as advertisement, slogan or tagline is confusingly similar to another mark used by another party also as a tagline, it is important to determine or establish the goods or services involved. Aptly, confusion is likely if the goods or services advertised or promoted by one party are similar or related to those belonging to the other party.

In this instance, the Opposer's trademark registration covers various goods, products, merchandise and services. The Respondent-Applicant's trademark application, on the other hand, does not indicate or specify the goods or services on which TARA NA will be used as a tagline. It must be emphasized that the Respondent-Applicant was given the opportunity to defend its trademark application and explain its side. However, the Respondent-Applicant did not file an Answer to the opposition.

Thus, without explicit limitation in respect of goods or services, the Respondent-Applicant, if allowed to register the mark TARA NA, will be able to use the mark as a tagline on any goods or services. If it uses the mark on goods or services covered by the Opposer's trademark registration, the likelihood of confusion therefore arises.

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<sup>6</sup> Verified Notice of Opposition, p. 7.

Accordingly, this Bureau finds that the registration of the mark TARA NA in favor of the Respondent-Applicant is within the prohibition imposed by Sec. 123.1(d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-005150 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City. 11 October 2012.

  
Atty. **NATHANIEL S. AREVALO**  
Director *W*, Bureau of Legal Affairs