



THE GILLETTE COMPANY,  
Opposer,

-versus-

JIAN ZONG ZHANG,  
Respondent-Applicant.

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IPC No. 14-2012-00279  
Opposition to:  
Appln. Serial No. 4-2011-013399  
Date Filed: 9 November 2011  
TM: "GILERE"

### NOTICE OF DECISION

**QUISUMBING TORRES**  
Counsel for Opposer  
12<sup>th</sup> Floor, Net One Center  
26<sup>th</sup> Street corner 3<sup>rd</sup> Avenue  
Crescent Park West, Bonifacio Global City  
Taguig City

**JIAN ZONG ZHANG**  
Respondent-Applicant  
Rm. 6B No. 705 Elcano Tower II Bldg.  
Elcano Street, Binondo Manila

#### GREETINGS:

Please be informed that Decision No. 2014 - 03 dated January 07, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 07, 2014.

For the Director:

*Edwin Danilo A. Daming*  
Atty. EDWIN DANILO A. DAMING  
Director III  
Bureau of Legal Affairs



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 Date Filed : 9 November 2011  
 Trademark: "GILERE"  
 Decision No. 2014 - 03

**DECISION**

THE GILLETTE COMPANY (Opposer<sup>1</sup>), filed an opposition to Trademark Application No. 4-2011-013399. The application, filed by JIAN ZONG ZHANG (Respondent-Applicant<sup>2</sup>), covers the mark "GILERE" for use on electric shavers and non-electric shavers<sup>3</sup> under class 8<sup>4</sup>.

The Opposer interposes the following grounds for opposition:

"1. Opposer is the first user and owner of the well-known trademark GILLETTE and other trademarks containing the dominant word GILLETTE.

"2. The Philippines and the United States of America, where Opposer is incorporated are parties-signatories to the Paris Convention for the Protection of Industrial Property (the Paris Convention), the Agreement on Trade-Related Aspects of Intellectual Property Rights of the World Trade Organization, and are members of the WTO and the World Intellectual Property Organization, which were all intended, inter alia, for the protection of industrial property.

"3. Section 2, Article II of the Philippine Constitution, which provides that the Philippine adopts, among others, the generally accepted principles of international law as part of the law of the land and adheres to the policy of peace, equality, justice, freedom, cooperation and unity with all nations. Furthermore, Section 3 and 160 of Republic Act No. 8293, otherwise known as the Intellectual Property Code, grants a right in favour of Opposer to seek redress before this Honorable Office. x x x

"4. The foregoing has been confirmed by the Supreme Court in La Chemise Lacoste vs. Fernandez.

"5. The details of Respondent-Applicant's application that is subject of the instant opposition are, as follows:

<sup>1</sup> A corporation organized under the laws of Delaware, United States of America, now domiciled and having its business address at One Gillette Park, Boston, Massachusetts 02127, United States of America.  
<sup>2</sup> A domestic corporation with principal business address at Rm. 6B No. 705 Elcano Tower II Bldg., Elcano Street, Binondo, Manila.  
<sup>3</sup> The application was published in the Intellectual Property Office Official Gazette, officially released for circulation on 14 May 2012.  
<sup>4</sup> The Nice Classification of goods and services is for registering trademark and service marks, based on a multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

Trademark: **GILERE**  
Application No: 4-20111-013399  
Application Date: 9 November 2011  
Goods: Electric shavers & non-electric shavers  
Class: 8

“6. The registration of the mark GILERE is contrary to the provisions of Sections 123.1 (d), (e) and (f) which prohibit the registration of the mark. x x x

“7. Opposer is the owner of and has exclusive rights over the GILLETTE Trademarks registered with the Philippine Intellectual Property Office (‘IPO’) in connection with razors/shavers and shaving creams, among others, in Classes 3 and 8. x x x

“8. Respondent-Applicant’s mark GILERE is confusingly similar to the Opposer’s registered GILLETTE Trademarks as to be likely to deceive or cause confusion in the minds of the relevant sector of the purchasing public.”

The Opposer’s evidence consists of the following

1. Exhibit “A” - Verified Notice of Opposition;
2. Exhibit “B” - Certificate and Special Power of Attorney executed by Tara M. Rosnell;
3. Exhibit “C” - Affidavit executed by Tara M. Rosnell with attachments;
4. Exhibit “C-1” - Product packaging and labels bearing GILLETTE trademarks;
5. Exhibit “C-2” - Screenshots of GILLETTE brand website, [www.gillette.com](http://www.gillette.com);
6. Exhibit “C-3” - Screenshot of website of Opposer’s parent company, The Procter & Gamble Company (P&G), [www.pg.com](http://www.pg.com);
7. Exhibit “C-4” - Screenshots of P&G Philippines website, [www.pg.com/en\\_PH/products](http://www.pg.com/en_PH/products);
8. Exhibit “C-5” - Details of Opposer’s registrations for GILLETTE trademarks;
9. Exhibit “C-6” - Representative samples of Opposer’s worldwide certificates of registration for GILLETTE trademarks;
10. Exhibit “C-7” - Opposer’s Philippine certificates of registration issued by IPO;
11. Exhibit “D” - Affidavit of Raymond Christopher Castillo with attachments;
12. Exhibit “D-1” - Actual labels of products showing GILLETTE trademarks sold in Philippines; and,
13. Exhibit “D-2” - Promotional materials of GILLETTE trademarks in Philippines.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 12 September 2012. Respondent-Applicant however, did not file an answer. Thus, the Respondent-Applicant was declared in default and the case deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark GILERE?

It is emphasized that the essence of trademark registration is to give protection to the owners of 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 or 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.<sup>5</sup>

Thus, Section 123.1 paragraph (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 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 or if it nearly resembles such mark as to be likely to deceive or cause confusion.

The records and evidence show that at the time the Respondent-Applicant filed the subject trademark application on 09 November 2011, the Opposer has already an existing Philippine trademark registrations for the mark GILLETTE and its variations covering goods under classes 3 and 8.<sup>6</sup> The Opposer has also registered the mark GILLETTE on the same classes in other countries some of which were issued prior to the filing date of the Respondent-Applicant's application.<sup>7</sup>

But are the contending marks depicted below, resemble each other such that confusion, even deception, is likely to occur?

**GILLETTE**

Opposer's Trademark

**Gilere**

Respondent-Applicant's Trademark

The competing marks bear resemblance to each other due to the presence and positions of letters G, I, L, and E. The marks are visually and phonetically similar because of the beginning syllables "GIL-LE" and "GI-LE".

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>8</sup> Colorable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their

<sup>5</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

<sup>6</sup> Exhibit "C-7" of Opposer.

<sup>7</sup> Exhibit "C-6" of Opposer.

<sup>8</sup> Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

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 the genuine article.<sup>9</sup>

Moreover, the contending marks are used in goods which flow on the same channels of trade belonging to the same classification or Class 3 and 8. Thus, it is likely that the consumers will have the impression that these goods or products originate from a single source or origin. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:<sup>10</sup>

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily 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. Hence, 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.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. 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>11</sup>

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the file wrapper of Trademark Application Serial No. 4-2011-013399 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 07 January 2014.

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

<sup>9</sup> Emerald Garment Manufacturing Corp. V. Court of Appeals, G.R. No. 100098, 29 December 1995.

<sup>10</sup> Converse Rubber Corporation v. Universal Rubber Products Inc., et al., G.R. No. L-27906, 08 Jan. 1987.

<sup>11</sup> American Wire and Cable Co. v. Director of Patents, et al., (31 SCRA 544) G.R. No. L-26557, 18 February 1970.