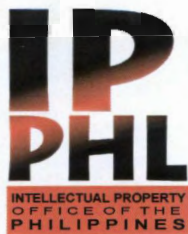


Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio,
Taguig City 1634 Philippines • www.ipophil.gov.ph
T: +632-2386300 • F: +632-5539480 • mail@ipophil.gov.ph



GOLDEN ABC, INC.,
Opposer,

- versus -

THE GILLETTE COMPANY,
Respondent-Applicant.
X-----X

IPC No. 14-2011-00533

Opposition to:

Appln. Serial No. 4-2011-009947
Date filed: 19 August 2011
Trademark: **"POWER RUSH"**

Decision No. 2016 - 57 -

DECISION

GOLDEN ABC, INC., ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2011-009947. The application, filed by THE GILLETTE COMPANY ("Respondent-Applicant")², covers the mark "POWER RUSH" for use on goods under class 03³ namely: *soaps, perfumes, non-medicated toilet preparations, hair lotion, shaving preparations, namely, shaving creams, shaving lotions, and shaving gels, after-shave lotions, balms, and gels, pre-shave facial washes and scrubs, mositurisers, and eau de toilette, and anti-perspirants, deodorants, deodorants for personal use.*

The Opposer alleges that Respondent-Applicant's applied mark 'Power Rush' is most likely to cause confusion among the consuming public with regard to the Opposer's registered marks, namely: (1) **POWER** with Registration No. 4-2008-008699 issued on 16 March 2009, covering class 03 for perfumery products namely, perfumes {roll-on and/or spray}, toilet water and toilet lotions, shampoos, lathering and softening products for use in bath, toothpaste, cosmetics, lipsticks, make-up, toilet products against perspiration, hair dyes, hair gels, powder and nail polish; and (2) **rush** (written in lower case letters) with Registration No. 4-2009-000904 issued on 28 January 2009, covering class 03 for perfumery products namely, perfumes {roll-on and/or spray}, colognes, toilet water and toilet lotions, shampoos, soaps, lathering and softening products for use in bath, toothpaste, cosmetics, make-up, lipstick, toilet products against perspiration, hair dyes, hair gels, powder and nail polish.

Opposer further alleged that considering that the subject mark is merely a combination of the foregoing trademarks of the Opposer, the same will most likely cause confusion of origin vis-a-vis the Opposer's marks. The consuming public will be misled into believing that the products covered by the subject mark belong to the Opposer as they carry the Opposer's registered marks. Moreover, the subject mark is for the same goods bearing the Opposer's marks.

¹ A corporation organized and existing under the laws of the Philippines with principal address at 880 A. S. Fortuna Street, Banilad, Mandaue City, Cebu.

² With address at One Gillette Park, Boston MA 02127, United States of America.

³ 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.

The Opposer's evidence consists of the following:

1. Copy of Trademark Registration No. 4-2008-008699 for the trademark POWER; and,
2. Copy of Trademark Registration No. 4-2009-000904 for the trademark RUSH.

On 18 May 2012, Respondent-Applicant filed its Answer alleging the following averments and defenses: First of all, the competing marks are substantially different in spelling and sound. The marks can be readily set apart from each other because Opposer's marks are both composed of a single word each, while Respondent-Applicant's mark consists of two distinct word elements. The first word POWER in Respondent-Applicant's mark sufficiently distinguishes Respondent-Applicant's mark POWER RUSH from Opposer's mark RUSH in terms of appearance and sound, as well as meaning and connotation. Likewise, the second word RUSH in Respondent-Applicant's marks sufficiently distinguishes Respondent-Applicant's mark POWER RUSH from Opposer's mark POWER in terms of appearance and sound, as well as meaning and connotation. Second, there exist numerous other 'POWER' marks under Class 3, apart from Opposer's mark POWER that were registered and/or allowed for publication by the Intellectual Property Office. Also, there exist numerous other 'RUSH' under Class 3, apart from Opposer's mark RUSH, that were registered and/or allowed for publication by the IPO. Third, Respondent-Applicant's mark POWER RUSH, when taken as a whole, is not confusingly similar with Opposer's mark POWER, nor is it confusingly similar with Opposer's other mark RUSH. The two marks of Opposer should be considered as they are registered, i.e. separately, and not as a combined word mark. Opposer cannot rely on the 'conjoint use rule'. Fourth, Opposer's reliance on several US cases is misplaced. These cases are not specifically in point as discussed in the Admissions and Denials. Fifth, it is noteworthy that Respondent-Applicant applied for registration of the distinct mark POWER RUSH in the Philippines as a natural expansion of its business abroad for products bearing said mark. The mark POWER RUSH was first applied for registration in United States of America in September 2002 and was registered under Certificate of Registration No. 2,856,829. It was also filed and registered in countries around the world in the name of Respondent-Applicant, even before Opposer adopted and filed its application for registration of the marks POWER and RUSH on 21 July 2008 and 28 January 2009, respectively.

The Respondent-Applicant's evidence consists of the following:

1. Original authenticated Verified Answer;
2. Original authenticated Certificate and Special Power of Attorney executed by Tara M. Rosnell;
3. Original authenticated Affidavit executed by Tara M. Rosnell;
4. Table showing the details of Respondent-Applicant's applications and registrations for the mark POWER RUSH worldwide;
5. Certificates of Registration for the mark POWER RUSH from the United States of America, New Zealand, Office for Harmonization in the Internal Market (OHIM) for European Union, China and Australia; and,
6. Printed advertisement featuring POWER RUSH.

Should the Respondent-Applicant be allowed to register the trademark POWER RUSH?

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 out into the market a superior

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.⁴

Sec. 123.1 (d) R.A. No. 8293, also known as the Intellectual Property Code ("IP Code") provides:

A mark cannot be registered if it:

x x x

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

- (i) The same goods or services, or
- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

Records show that at the time Respondent-Applicant filed its application for the trademark "POWER RUSH" on 19 August 2011, herein Opposer showed the following registrations for the trademarks "POWER" with Certificate of Registration No. 4-2008-008699 dated 16 March 2009⁵; and "RUSH" Certificate of Registration No. 4-2009-000904 dated 28 January 2009.⁶

The following marks are hereby reproduced for comparison:

POWER **rush**

Petitioner's Trademarks

POWER RUSH

Respondent-Applicant Trademarks

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

⁵ Exhibit "A" of Opposer.

⁶ Exhibit "B" of Opposer.

"sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear" may be considered.⁷ Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

The eyes can easily see that the marks are different. The Respondent-Applicant's mark consists of two words, "POWER RUSH". The Opposer on the other hand, has shown two (2) registrations for the two (2) different marks, "POWER" and "RUSH". The subject mark manifests no substantial similarity with Opposer's trademarks "POWER" and "RUSH" which should be considered separately, as they are registered independent of each other.

The word "POWER" is a common word used in various classes of goods. The word is widely used as a trademark or part thereof. In fact, the Trademark Registry, the contents of which this Bureau can take cognizance of via judicial notice, shows registered marks that consist of the word "POWER" for goods covering the same or related class, such as: **POWER FRESH** (Reg. No. 1227573); **POWER** (Reg. No. 42005009297); **POWER** (Reg. No. 42000002962); and, **M POWER** (Reg. No. 42015006460).⁸ These marks are owned by entities other than the Opposer.

Similarly, the word "RUSH" appears to be a common word used as a trademark or part thereof. The following contents are available in the Trademark Registry, showing the word "RUSH" for goods covering the same or related class, such as: **EXTREME RUSH** (Reg. No. 42013013561); **ENERGY RUSH** (Reg. No. 42011013088); **MORNING RUSH** (Reg. No. 42010005485); **RUSH** (Reg. No. 42000000746); and, **A.RUSH** (Reg. No. 42014012936).⁹ These marks are also owned by entities other than the Opposer.

Moreover, the Respondent-Applicant was able to show that it has prior application, registration and use of its mark "POWER RUSH" in various countries, particularly in the United States of America, China and Colombia.¹⁰ It likewise show details of its applications and registrations in other countries worldwide.¹¹

Corollarily, the enunciation of the Supreme Court in the case of *Mighty Corporation vs. E. & J. Gallo Winery*¹² aptly states that:

"A very important circumstance though is whether there exists likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the source of the goods in question. The 'purchaser' is not the 'completely unwary consumer' but is the 'ordinarily intelligent buyer' considering the type of product involved. he is 'accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The situation, in order to be objectionable, must be such as

⁷ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

⁸ IPOPHL Trademarks Database, available at <http://www.wipo.int/branddb/ph/en/> (last access 22 February 2016).

⁹ Id.

¹⁰ Exhibit "3-A" of Opposer.

¹¹ Exhibits "3-B" to "3-F" of Opposer.

¹² G.R. No. 154342, 14 July 2004.


appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

Finally, 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 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 as his product.¹³ This Bureau finds that the Respondent-Applicant's mark meets this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-009947 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 22 February 2016.


Atty. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs

¹³ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.