



SUYEN CORPORATION,

Opposer,

-versus-

CNN GENERICS DISTRIBUTION INC.,

Respondent-Applicant.

IPC No. 14-2011-00111

Opposition to:
Application No. 4-2010-000368
Date Filed: 12 January 2010
Trademark: "BENCHLOR"

X-----X

NOTICE OF DECISION

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CNN GENERICS

Respondent-Applicant
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GREETINGS:

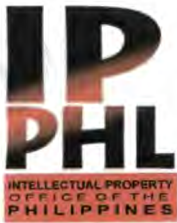
Please be informed that Decision No. 2016- 300 dated 05 September 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 05 September 2016.


Atty. JOSEPHINE C. ALON
Adjudication Officer
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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<i>Opposer,</i>	}	
-versus-	}	Opposition to:
	}	Application No. 4-2010-000368
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x-----x		Decision No. 2016- <u>300</u>

DECISION

SUYEN CORPORATION¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2010-000368. The application, filed by CNN Generics Distribution Inc.² ("Respondent-Applicant"), covers the mark "BENCHLOR" for use on "pharmaceutical preparations" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x
"III.
"GROUNDS FOR OPPOSITION"
x x x

"3.1 'A mark cannot be registered if it x xx [I]s 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 x xx"

"3.2 There is no question that the mark covered by the application of respondent-applicant, i.e. 'BENCHLOR,' incorporates the word 'BENCH.' The BENCH trademark of Suyen is in fact the dominant word or feature of the BENCHLOR mark of respondent-applicant.

"3.3 Indeed, all of the BENCH Trademarks of Suyen are based on and uses the word 'BENCH.' Most of opposer's products, marketing and promotional activities bear and are hinged on the 'BENCH' trademark.

"3.4 Under the dominancy Test, there is infringement and likelihood of confusion in the market when there is similarity in the prevalent features of the competing trademarks (Amigo Manufacturing, Inc. v. Cluett Peabody Co., Inc., 354

¹A domestic corporation duly organized and existing under Philippine law with offices located at 2214 Tolentino Street, Pasay City.
²A domestic corporation with business address at 2nd Floor LC Bldg., 459 Quezon Avenue, Quezon City, Philippines.
³The Nice Classification is a classification of goods and services for the purpose of registering trademark 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.

SCRA 434 [2001]). It is applied when the trademark sought to be registered contains the main, essential and dominant features of the earlier registered trademark, and confusion or deception is likely to result. Duplication or imitation is not even required; neither is it necessary that the label of the applied mark for registration should suggest an effort to imitate. The important issue is whether the use of the marks involved would likely cause confusion or mistake in the mind of or deceive the ordinary purchaser, or one who is accustomed to buy, and therefore to some extent familiar with, the goods in question xxx

"3.5 Infringement based on the test of dominancy is explicitly recognized in the IP Code, Section 155.1 of which provides: x x x

"3.6 Respondent-applicant's mark is identical to and confusingly similar with Suyen's registered BENCH Trademarks. Respondent-applicant's mark incorporates the dominant word 'Bench' as its main or dominant feature.

"3.7 The presence or addition of the letters 'LOR' in respondent-applicant's mark is insignificant and does not negate or avoid confusion with the BENCH Trademarks. The use by respondent-applicant of the word BENCHLOR will certainly result in a common perception among the consuming public that respondent-applicant's products are those of Suyen or a result of further expansion or diversification of business of Suyen using the BENCH Trademarks.

"3.8 Even under the Holistic Test, where the entirety of marks as they appear on the products, including the labels and packaging are considered, the use of respondent-applicant's BENCHLOR mark will amount to confusion and infringement of opposer's BENCH Trademarks. The appearance alone of the word 'BENCHLOR' on a label, even if this is set against a distinctive background or design, will cause confusion with and infringement of the BENCH Trademarks.

"3.9 The registration and use of the 'BENCHLOR' mark of respondent-applicant will mislead the public into believing that respondent-applicant's products or goods originated from or are sponsored by Suyen or that its business is affiliated or associated with that of opposer.

"3.10 That the BENCHLOR mark is sought to be registered under Class 05 for pharmaceutical products, is of no moment. Suyen's products under Class 03 are closely related to Class 05 products. Further, Suyen has expanded its business into so many other products using the BENCH Trademarks such that it will be common and expected for the public to believe that a pharmaceutical product bearing the BENCHLOR mark is a product of Suyen under its BENCH Trademarks.

"3.11 Even from a public health and safety perception, it would be a violation of Suyen's rights to confuse the public into believing that, contrary to the truth, Suyen is or will be manufacturing or selling pharmaceutical products with the BENCHLOR mark.

"3.12 There will be: (1) confusion of goods (product confusion), where the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other; and (2) confusion of business (source or origin confusion), where a product might reasonably be assumed to originate with the registrant of an earlier product, and the public would then be deceived either into that belief or into the belief that there is some connection between the two parties, though inexistnt x x x

"3.13 As stated above, opposer Suyen's BENCH Trademarks are associated with a variety of goods and services. Suyen has also used the word 'BENCH' together or in association with other words. Allowing the registration of the respondent-applicant's BENCHLOR mark would curtail the right of Suyen to expand its BENCH trademark and Suyen's use thereof. In Dermaline, Inc. vs. Myra Pharmaceuticals, Inc., supra, the Supreme Court held: xxx

"3.14 Registration of respondent-applicant's mark will result in substantial and irrevocable damages to opposer, who has exerted substantial efforts and incurred considerable expense to conceptualize, promote and use its BENCH Trademarks.

"3.15 The registration of respondent-applicant's BENCHLOR mark will undoubtedly violate opposer's rights to and interest in its BENCH Trademarks and will most assuredly result in the dilution and loss of distinctiveness of the BENCH Trademarks. Suyen will suffer substantial and irreparable damage from such registration.

The Opposer's evidence consists of the affidavit of Suyen's General Manager, Mr. Jude W. Ong dated 29 March 2011; copies of the certificates of registration for the BENCH Trademark in different classes; a list of registrations and applications of derivative BENCH Trademarks; a list of BENCH Trademarks registrations and applications in several countries worldwide; photographs of some Suyen's stores using the BENCH Trademarks; photographs of the various products bearing the BENCH Trademarks; a list of Suyen's products bearing the BENCH Trademarks; photos of the various products of Suyen bearing the BENCH Trademarks sold in the market; sample print advertisements of the BENCH Trademarks; photographs of various billboards bearing the BENCH Trademarks located at different places in Metro Manila and other provinces; and, printouts of web pages of Suyen's website.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant, on 28 April 2011. Said Respondent-Applicant, however, did not file an Answer.

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

The Opposer anchors its opposition on the following provisions of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

Sec. 123.Registrability. - 123.1. 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 :

⁴Marked as Exhibits "A" to "K", inclusive.

- (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;"

Sec. 155. *Remedies; Infringement.* - Any person who shall, without the consent of the owner of the registered mark:

155.1. Use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark or the same container or a dominant feature thereof in connection with the sale, offering for sale, distribution, advertising of any goods or services including other preparatory steps necessary to carry out the sale of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

x x x

Records show that at the time the Respondent-Applicant filed its trademark application on 12 January 2010, the Opposer already owns trademark registrations for "BENCH" in different classes. The first BENCH mark under Registration No. 62267 issued on 09 January 1996 covers "towels, bed sheets, bed covers, pillow cases, handkerchief" in Class 24.

Hence, the question, does BENCHLOR resemble BENCH such that confusion or deception is likely to occur? The marks are shown below:

BENCH

Opposer's trademark

BENCHLOR

Respondent-Applicant's mark

This Bureau finds that confusion or deception is unlikely to occur at this instance. Although both marks have the same word "BENCH", Opposer cannot exclusively appropriate the word. "BENCH" is a common word found in the dictionary. No one has exclusive use to it. To determine whether two marks that contain the word "BENCH" are confusingly similar, there is a need to examine the other letters or components of the trademarks. In this regard, when the syllable "LOR" is appended to the word "BENCH", the resulting mark when pronounced can be distinguished from Opposer's mark BENCH. Likewise, Opposer's clothing, bags, accessories, footwear and fragrances and Respondent-Applicant's pharmaceutical preparations are unrelated. Additionally, there is no indication that Respondent-Applicant's non-competing products attempt to free ride on Opposer's goodwill or reputation.

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.⁵ This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2010-000368 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 05 SEP 2016.


Atty. JOSEPHINE C. ALON
Adjudication Officer, Bureau of Legal Affairs

⁵ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.