

PARFUMS CHRISTIAN DIOR,
Opposer,

-versus-

SUYEN CORPORATION,
Respondent- Applicant.

IPC No. 14-2011-00054
Opposition to:
Appln. Serial No. 4-2010-002858
Date Filed: March 15, 2010
TM: "ADORED"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 411 dated November 15, 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, November 16, 2016.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

PARFUMS CHRISTIAN DIOR,
Opposer,

IPC NO. 14 – 2011 - 00054

- versus -

Opposition to:

Appln Serial No. 42010002858
Date filed: 15 March 2010
TM: "ADORED"

SUYEN CORPORATION,
Respondent-Applicant.

DECISION NO. 2016 - 411

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D E C I S I O N

PARFUMS CHRISTIAN DIOR (Opposer)¹, filed an Opposition to Trademark Application Serial No. 4-2011-00054. The application filed, by SUYEN CORPORATION (Respondent-Applicant)², covers the mark "ADORED" for "*body spray, cologne, eau de toilette*" under Class 3 of the International Classification of Goods.³

The Opposer's based its Opposition on the following grounds:

- 1.) Opposer is the prior adopter, user and owner of the internationally well known trademark "J'ADORE";
- 2.) Respondent-Applicant's mark being confusingly similar to that of the Opposer's, Respondent-Applicant's Application should be denied; and
- 3.) Opposer's J'ADORE trademark is internationally well-known and thus entitled to protection.

The pertinent portions of the Opposition are quoted, to wit:

"9. Opposer is the owner of internationally well-known trademark 'J'ADORE' registered in the Philippines with the Intellectual Property Office (IPO) since October 30, 2004, under Certificate of Registration No. 41999002399 for goods under class 03 specifically perfumery products, perfumes, essential oils, cosmetic, hair lotion soaps, dentifrices. x x x

"10. Opposer, a world leader in fashion, fragrance and jewellery is the prior adopter, user and true owner of the mark 'J'ADORE' in the Philippines and

¹ A corporation organized under the laws of France with business address at 33 Avenue Hoche 75008 Paris, France.

² A corporation organized under Philippine law with address at 2214 Tolentino Street, Pasay City

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

elsewhere around the world. It commenced using the said name in 1999 when it launched as one of its perfume brands the 'J'ADORE' perfume by Dior. x x x

"11. 'J'ADORE' is a French word which literally means 'I adore.' It is pronounced as 'zha door', hence, phonetically and aurally similar to the mark ADORED of Respondent-Applicant which mark is a translation and therefore, has a similar meaning of the J'ADORE mark.

"12. Opposer's mark has acquired immense and valuable goodwill as a result of enormous sums of money spent in advertising, promotions and sales worldwide. The total annual worldwide sales of Opposer for products bearing the mark J'ADORE exceeds Euro 20 million x x x

"13. Opposer maintains a website www.dior.com where information about its products, including "J'ADORE" can be viewed and easily accessed worldwide. x x x

"14. Opposer's mark being so well-known, that by simply surfing and clicking the Opposer's well-known mark in the internet, several web pages carrying Opposer's product bearing the mark "J'ADORE" would be shown.
x x x

"15. Respondent-Applicant's trademark is technical and confusingly similar with Opposer's trademark and 'J'ADORE', for which Opposer has already obtained an earlier registration with the IPO, as earlier stated.

"16. The pronunciation of 'J'ADORE' is [zha-door], which sounds like Respondent-Applicant's trademark 'ADORED'. In the case of Prosource International Inc. vs. Horphrag Research Managemnet S.A., the Supreme Court ruled that "nevertheless when two words are pronounced, the sound effects are confusingly similar not to mention that they are both described by their manufacturers as a food supplement and thus, identified as such by their public consumers. And although there were dissimilarities in the trademark due to the type of letters used as well as the size, color and design employed on their individual packages/bottles, still the close relationship of the competing products' name in sounds as they were pronounced, clearly indicates that purchaser could be misled into believing that they are the same and/or originates from a common source and manufacturer.

"17. Respondent-Applicant's mark is a word mark composed of six (6) letters: A, D, O, R, E, D. It is readily apparent that Respondent-Applicant's mark has incorporated nearly the entirety of Opposer's registered 'J'ADORE', with the exception of the J. Undoubtedly the portion "ADORE" of the Respondent-Applicant's mark comprising five (5) out of six (6) letters of its mark, is IDENTICAL with Opposer's registered 'J'ADORE' mark, in spelling and in sound.

"18. The dominant feature of Respondent-Applicant's mark is obviously the word "ADORE" since its mark "ADORED" is the past tense of this word-verb. The confusing similarity between Respondent-Applicant's ADORED and Opposer's well known 'J'ADORE' trademarks is highly likely to deceive the purchasers of goods on which the mark is being used as to the origin or source of said goods and as to the nature, character, quality and characteristics of the goods to which it is affixed. Furthermore, the unauthorized use by the others of a trademark similar or identical to Opposer's 'J'ADORE' trademarks will certainly dilute the distinctiveness of

the latter, and adversely affect the function of said trademarks as an indicator of origin, and/or the quality of the product.

"19. Section 123.1(d) of the IP Code is clear in prohibiting the registration of trademark that nearly resemble an already registered mark or a mark with an earlier filing or priority date if it nearly resembles such a mark as to be likely to deceive or cause confusion x x x

"20. The registration of the mark ADORED in the name of the Respondent-Applicant will mislead the public into thinking that the Respondent-Applicant's goods are manufactured and/or distributed by the Opposer, or at the very least, affiliated with the Opposer and/or the Opposer's goods.

"21. The Supreme Court has also ruled in Mirpuri vs. Court of Appeals, Director of Patents and Barbizon Corp. that 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.'

"22. Opposer is engaged in the business of selling fragrances, perfumery, cosmetics and the like. Meanwhile, the goods covered by Respondent-Registrant's registration in Class 03 covering identical or similar goods.

"23. Not only does Respondent-Applicant's trademark sounds identical to that of Opposer, but the classes of goods it sells is also similar, and due to the nature of its products, it is reasonably expected that this would be sold in the same channels of trade, such as department stores, hence, confusion on the mind of the public is certain.

x x x

"26. Opposer's "J'ADORE" trademark is registered all over the world in over one hundred (100) countries and Opposer has over one hundred fifty (150) trademark registrations in said countries, making the same intentionally well-known x x x

"28. The registration of the mark 'ADORED' in the name of Respondent-Applicant violates the exclusive proprietary rights of the Opposer over its own mark and irreparably injures or damages the interest, business reputation and goodwill of the aid mar. The registration of the Respondent-Applicant's mark dilutes the distinctiveness of Petitioner's mark, thereby reducing the economic value. It cannot be denied that Respondent-Applicant's intention is to ride on the popularity of the Opposer's mark, particularly in the perfume business.

"29. Clearly, the registration of the Respondent-Applicant's mark which is confusingly similar to Opposer's mark, not only prejudices the Opposer, but also allows the Respondent-Applicant to unfairly benefit from and get a free ride on the goodwill of Opposer's internationally well known mark 'J'ADORE.'"

To support its Opposition, the Opposer submitted the following:

1. Exhibit "A" – Special Power of Attorney;
2. Exhibit "B" – print out of Certificate of Registration No. 41999002399 from IPOPHL Website;
3. Exhibit "B-1" – print out of the Certificate Registration No. 2-2005-007359 from IPOPHL Website;
4. Exhibit "C" – affidavit – direct testimony of Mr. Riccardo Frediani with Attachments: Annex "A" – list of trademark registration worldwide; and Annex "B" – copies of certificate of registration from different countries; and
5. Exhibit "D" – notarized certification of witness Webster Ngo with Attachment: Annex "A" – print out of key word search on google website; Annex "B-1" to "B-14" – print out of webpages showing the J'ADORE perfume; Annex "C-1" to "C-2" print out of the webpage showing commercial of J'ADORE.

The Respondent-Applicant filed on 3 August 2011 its Answer denying all the material allegations of the Opposition. Respondent-Applicant further argued, as follows:

1. There is no confusing similarity between the "ADORED" Trademark and the "J'ADORE" trademark of Opposer. There is neither likelihood of confusion between the said trademark nor confusion as to the source of the "ADORED" product.
2. Contrary to the Opposer's claim, "J'ADORE" is not and has not been shown to be well-known trademark and opposer cannot misuse the present proceeding to obtain a declaration that it is a well-known trademark. Opposer's purported evidence to show that its trademark is well-known are either inadmissible or do not prove or support opposer's claim.

The pertinent portions of the Answer are as follows:

- 2.1 Suyen has long been in the business of manufacturing, marketing, advertising, distributing and selling of clothing apparel in the Philippines and in several other countries, under its very popular trademark "BENCH." Suyen has expanded the BENCH portfolio to include fragrances, hair care, cosmetics, accessories, shoes, bags, watches, houseware, furniture, and even snacks, sold in over four hundred (400) boutiques and department stores nationwide. x x x
- 2.2 Suyen adopted and used the trademark "BENCH" and other derivative marks to clearly identify its products and their source. Suyen first used the trademark "BENCH" in 1987, and first registered the same in the Philippines on 30 June 1989. x x x
- 2.3 In January 2006, Suyen launched the "Kris Aquino Scents," a collection of eau de toilette, colognes and body sprays inspired by Kris Aquino. The success of the Kris Aquino Scents in the market paved the way for

other celebrity-inspired scents by Suyen under what is now known as the "BENCH CELEBRITY SCENTS COLLECTION" x x x

- 2.4 On 18 September 2010, Suyen officially launched a sub-collection of six (6) new fragrances called the "BENCH TEEN SCENTS COLLECTION." The Teen Scents, as its name suggests, are fragrances developed to cater to teenagers and tweens." They were inspired and designed by teen idols Kim Chiu, Gerald Anderson, and Jake Cuenca. The Teen Scents Collection includes the fragrances: "ADORED" and "KNOCKOUT" by Gerald Anderson, "STUNNING" and "BECOMING" by Kim Chiu, and "UNDRESS" and "EXPOSED" by Jake Cuenca. The fragrances, which come in body spray application, are available in slim 120ml plastic bottles for the very teen-friendly price of one hundred seventy eight pesos (P178.00), at all BENCH, HERBENCH, BENCHBODY, SUPERBENCH and "BENCH TO GO" stores, as well as authorized retailers, nationwide. The packaging of the bottles includes the mark of the fragrance the name of its teen celebrity endorser, and the trademark "bench", all enclosed in unique and colorful designs. x x x
- 2.5 "ADORED" is a trademark used and developed by Suyen for a body spray for men. The mark "ADORED", for which a trademark application was filed by Suyen on 15 March 2010, was adopted for the Gerald Anderson-inspired fragrance because it captures his fans' regard of him and his pairing with Kim Chiu. The promo poster for "ADORED" tells this story. x x x
- 2.6 Suyen has extensively used and promoted the mark "ADORED" as a trademark of Suyen, associated with its BENCH trademark, and not as a trademark of some other entity. The mark "ADORED" has become an integral part of Suyen's business and as part of its advertising and promotional strategies. Suyen has exerted substantial efforts and has spent tremendous amounts for the promotion of its Teen Scents Collection including the fragrance bearing the mark "ADORED" as its own products and certainly not the products of any other entity, and not as products related to any perfume or fragrance products of other countries. x x x
- 2.7 Clearly, Suyen did not rely or cash-in on any goodwill created by any trademark of other entities, including "J'ADORE" mark claimed by Parfums Christian Dior. Not only is Suyen's trademark "ADORED" very different from the said French phrase, both visually and phonetically. Suyen has also marketed and sold its ADORED products as Suyens products or BENCH-related products and not the products of any other entity.
x x x
- 3.2 There is absolutely no confusing similarity between the "ADORED" trademark of respondent-applicant and the "J'ADORE" mark of opposer.
x x x
- 3.4 Based on both the dominancy and holistic tests, there can be no confusing similarity between the two marks.
- 3.5 The only similarity between the two marks is the letters "A", "D", "O". "R" and "E", which spell out "ADORE." However, these letters are not the dominant or prevalent features in "J'ADORE". The prefix "J" or

"J'A" (pronounced as "zha") in opposer's mark "J'ADORE" is the dominant feature for the said mark, in the same way that prefixes "Mc" and "Mac" were held by the Supreme Court to be the features that visually and aurally catches the attention of the consuming public in the marks "McDonald's" and "MACJOY" (McDonald's Corporation v. MacJoy Fastfood Corp, supra) As stated from the Court's ruling in Etepha, A.G. v. Director of Patents (G.R. No. L-20635, March 31, 1966) citing The Upjohn Co. v. Schwartz, etc. (246 F[2d], pp. 254, 262), this is so because "...in a word combination, the part of that comes first is the most pronounced." Thus, it cannot be said that there is any similarity, confusing or otherwise, in the prevalent features of "J'ADORE" and "ADORED" the latter being simply prefixed by the single vowel "A" pronounced as "ə".

- 3.6 Indeed, it can be said that the prefix "J" or J'A" is what makes the mark "J'ADORE" distinctly French, and thus, distinctly "Christian Dior." In fact, without or "J'A", the trademark of Opposer will be meaningless to, and unidentifiable or unrecognizable by the consuming public because the opposer neither has exclusive rights or goodwill on the words "ADORE" or "DORE" separately from the mark "J'ADORE". To be sure, opposer has not alleged or presented in its Opposition and exhibits any separate claims or registrations for the words "ADORE" or "DORE".
- 3.7. On the other hand, the suffix of the mark "ADORED", which is the letter "D", has equal prominence with the rest of the letters comprising the mark. Indeed letters "A", "D", "O", "R" and "E", while spelling out the root word of the mark "ADORED", cannot be said to be the dominant features of the said mark because nothing separates it aurally or visually from the suffix "D."
- 3.8. From the foregoing, it is clear that there can be no confusing similarity between the prevalent features of "J'ADORE" and "ADORED". Indeed, "J" or "JA" cannot be anymore different from "ADORED" and "J'ADORE" cannot be confused with "ADORED."
- 3.9. Similarly, opposer's contention that ADORED is phonetically and aurally similar to "J'ADORE" is absolutely incorrect. There is no phonetic similarity whatsoever between the two marks. Under the principle of idem sonans, two names are said to be similar only "...if the attentive ear finds difficulty in distinguishing them when pronounced." (Blue Bell, Inc. v. Venancion Sambar, IPO Decision No. 90-31, [TM], August 2, 1990; cf Manebo v. Acosta, G.R. No. 169554, October 28, 2009 citing People vs. Salas, G.R. No. 115192) As mentioned above, the prefix of opposer's mark, "J" or "JA" read as "zha" is pronounced very differently from the prefix "A" pronounced as "ə".
- 3.10 Indeed, in the comparable Etepha case cited above, the Supreme Court found no phonetic similarity between the marks "Pertussin" and "Atussin" x x x
- 3.11 Similarly, in the present case, the pronunciation of the prefix "J" or "JA", which includes the combination of the letters "z", "h" and "e" or "z". "h" and "a" appeals very differently to the ear when compared to the single vowel "A". The phonetic distinctiveness of the "ADORED" mark from opposer's mark is further highlighted by its last letter "D" which is not shared by the mark "J'ADORE." In fact, it is not uncommon for the ordinary Filipino purchaser to mistakenly pronounced with the suffix "reh". In such a case, which just might be the norm, the phonetic

disimilarities of the marks are more pronounced, thus: "J'ADORE" (zha-door-reh) vis-à-vis "ADORED" (ə-dord).

- 3.12. The Prosource International Inc. v. Hophrag Research Management S.A. case (G.R. 180073, November 25, 2009) cited by opposer does not apply because in that case, the marks under consideration – "PYCNOGENOL" and "PCO-GENOL" – were prefixed by the similar sounding "PYCNO" (pic-no) and "PCO" (pi-co). This is not the case here.
- 3.13. Moreover, contrary to opposer's allegation, "ADORED" is not a translation of the mark "J'ADORE" within the meaning of Section 123.1 (e) and (f) of the IP Code. Under Rule 415 of the Rules and Regulations implementing the IP Code, translation is "an act, process or instance of translating as rendering from one language or representational system to another." As discussed above, and as expressly admitted to by opposer, "J'ADORE" is a French word which literally means 'I adore.' "ADORED", on the other hand, means: to be worshipped or honored as a diety or as a divine" or to be regarded with loving admiration and devotion" Therefore, "ADORED" cannot be a translation of "J'ADORE" because the former is not synonymous with phrase "I adore."
- 3.14. Confusion between the two marks, especially as they appear on labels, is also remote if not impossible. The label, packaging and bottle of "ADORED" product x x x cannot be anymore different from the label, packaging and bottle of "J'ADORE" x x x. Moreover, the label and promotional materials for ADORED always indicate its origin by bearing the mark "bench", for which respondent-applicant has several registrations and has enormous goodwill. x x x.
- 3.15. Confusion, whether confusion of goods or confusion of business, is very remote if not completely absent, especially if this Honorable Office considers the following:
 - a. "J'ADORE" by Christian Dior and "ADORED" by Suyen are not sold in the same "channels of trade" as opposer would have this Honorable Office believe. As mentioned above, "ADORED" is available exclusively in Suyen-owned or franchised BENCH, HERBENCH, BENCHBODY, SUPREBENCH and BENCH TO GO stores, and in authorized retailers where "J'ADORE" is not available. Meanwhile, "J'ADORE" is distributed by Rustans Commercial Corporation (Rustan hereafter) in Rustans department stores, where none of Suyen's products including "ADORED" are available. Thus there is not even an opportunity for purchasers to be confused, contrary to claim of opposer. Indeed, Suyen has so identified its "BENCH" stores and products in the mind of the consuming public that no one, whether or not an ordinary purchaser, will go to a BENCH store to buy anything other than BENCH products, much less products of Christian Dior. Conversely, Rustans has also so identified in the public the kind of products that are sold in its department stores that no one in his right mind will look for a BENCH body spray in Rustans.
 - b. "ADORED" is marketed for male teenagers and tweens, and is thus inspired, designed and endorsed by local teen idol Gerald Anderson. x x x "ADORED" comes in body spray application and is available for the teen-friendly price of Php 178.00 or for \$7.00 (USD) online, at 120ml. "J'ADORE" on the other hand, is a perfume for women, most recently endorsed by world-renowned movie star Charlize

Theron. x x x Further, upon inquiry in a Rustans department store, Suyen is informed and thus alleges that a 100ml (3.4 ounces) bottle of "J'ADORE" eau de parfum costs a prohibitive Php 7,450 or \$77.43 to \$95.00 (USD) online, or Php 5,150, or \$72.90 to \$75.00 (USD) online for a 50ml (1.7 ounces) bottle. x x x "J'ADORE" perfume cannot be mistaken as "ADORED" body spray for male teens. "J'ADORE" perfumes are expensive and are for women.

- c. Perfumes and body sprays are not your ordinary household items like catsup, soysauce or soap of minimal cost. As illustrated above, perfumes – especially those of Christian Dior – are not inexpensive. Accordingly, casual buyer is predisposed to be more cautious and discriminating in and would prefer to mull over his purchase. Confusion and deception, then, is less likely. x x x Ordinary purchasers of perfumes of scents and fragrances could never be confused that "ADORED" is the same as "J'ADORE" or that the former is manufactured by Christian Dior. The ordinary purchaser is not the "completely unwary consumer" but is the "ordinarily intelligent buyer" considering the type of product involved. x x x
- 3.16. Opposer's use of Section 123.1(e) and (f) of the IP Code and 6bis of the Paris Convention is misplaced and unavailing, the said provision require that the mark be "considered by the competent authority of the Philippines to be well-known." Respondent-applicant is informed and hereby alleges that this Honorable Office has not declared that "J'ADORE" trademark as well-known trademark. x x x
- 3.19. In any event, Christian Dior has not discharge the heavy burden of proving that "J'ADORE" is a well-known trademark. x x x
- 3.21. None of the Exhibits of opposer attached in its Opposition proves that "J'ADORE" is a well known mark under the above listed factors or criteria. x x x
- 3.22. It is thus clear that none of the exhibits presented by opposer show, or is capable of showing, that the criteria for having "J'ADORE" be considered a well-known trademark have been satisfied.
- 3.23. In sum, it must be stressed that the registration of "ADORED" based on the Opposition, may be prevented only if this is confusingly similar to "J'ADORE". As discussed above, there is absolutely no confusing similarity between the trademarks of Opposer and respondent-applicant.
- 3.24. Suyen did not adopt its "ADORED" mark to ride on the any goodwill of opposer's "J'ADORE" trademark. As discussed above, "ADORED" was adopted and used for the Gerald Anderson –inspired product. Suyen has exerted substantial efforts and has spent tremendous amounts for the promotion of it's Teen Scents Collection including the fragrance bearing the mark "ADORED" as its own products and certainly not as products of any other entity, or as products related to any perfume or fragrance products of other entities. Suyen's products are immensely popular on their own due to Suyen's own efforts. x x x.

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

1. Exhibit "1" – Affidavit of Suyen's Group Brand, Mr. Dale Gerald G. Dela Cruz;
2. Exhibit "2" – copy of the Certificate of Registration No. 45545 covering the first "BENCH" trademark;
3. Exhibit "3" – a list of derivative "BENCH" registration owned by the Respondent-Applicant;
4. Exhibit "4" – list of the celebrity endorsers and their corresponding perfume;
5. Exhibit "5" to "5-L" – copies of promo posters for selected scents under Suyen's Celebrity Scents Collection;
6. Exhibit "6" to "6-A" – photocopies of print ads and press releases promoting the launch event in SM City North Edsa;
7. Exhibit "7" to "7-E" photographs of wall displays in selected BENCH stores;
8. Exhibit "8" to "8-G" – photographs of the Teen Scents bottles;
9. Exhibit "9" – is the promo posters of Suyen for "ADORED";
10. Exhibit "10" – photograph of the "ADORED" billboard;
11. Exhibit "10-A" to "10-F" are photographs of the billboard for other fragrances under the Teen Scents Collection;
12. Exhibit "11" to "11-F" – photocopies of ad placements and press releases of Suyen for the Teen Scents Collection including "ADORED";
13. Exhibit "12" to "12-A" snapshot of "ADORED" promo poster; and
14. Exhibit "13" – print out of webpages on google search engine for J'ADORE.

On 18 August 2011, the Opposer filed a Reply reiterating its earlier arguments in its Opposition.

The Preliminary Conference was conducted and terminated on 9 November 2011. The parties then filed their respective Position Papers. Consequently, this case was submitted for decision.

The issue to be resolved in the instant case is whether Respondent-Applicant's trademark ADORED for perfume (*body spray, cologne, eau de toilette*) should be allowed for registration.

Our Intellectual Property Code under Section 123.1 specifically 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 with respect to the same goods or services or closely related goods or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

Records show that the Opposer has an existing trademark registration for "J'ADORE" mark for *perfumery products, perfumes*,

essential oils, cosmetics, hair lotions, soaps and dentifrices, under Class 3 of the International Classification of Goods, when the Respondent-Applicant filed his application for the trademark "ADORED" to be used for the similar perfumery goods.

The question to be resolved is whether the marks as shown below resemble each other such that likelihood of confusion would occur.

J'ADORE

ADORED

Opposer's Trademark

Respondent-Applicant's Trademark

This Bureau answers the above question in the affirmative.

The Opposition is anchored on Section 123.1 pars. (d), (e) and (f) of Republic Act No. 8293, also known as, the Intellectual Property Code of the Philippines ("IP Code") which provide, as follows:

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:

- (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;

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, that use of the mark in relation to those goods or services would indicate a connection between those goods or

services, and the owner of the registered mark: Provided further,
That the interests of the owner of the registered mark are likely
to be damaged by such use;

(g) is likely to mislead the public, particularly as to the
nature, quality, characteristics or geographical origin of the goods
or services;

x x x

An examination of the two competing trademarks shows that both mark shared a common root word, which is "adore." The Opposer's mark, "J'ADORE", is a French phrase, which means "I adore." On the other hand, the Respondent-Applicant's mark "ADORED" is the past tense of "adore." Also, the word "adore" alone already comprises five out of the six letters of each wordmark.

Contrary to the contention of the Respondent-Applicant, it is the word "adore" which is the dominant feature of the two trademarks. The prefix "J" or "J'A" on the Opposer's mark and the suffix "D" in the Respondent-Applicant's mark did not provide any separate or distinct identity from their root word. The word "adore," being the term with the immediate meaning, will be the one easily remembered by the consumers and the one to be associated with the products. It is the one that will leave an impression to the buying public. In fact, the idea of the celebrity endorser being "adored" by his fans was the inspiration of the Respondent-Applicant in the formulation of its trademark.⁴

Even phonetically, the pronunciations of the marks are almost identical. Both are composed of two syllables. The French J'ADORE pronounced as "zha-door," is aurally similar to "ə-dord" for the word ADORED. Our Court has consistently held that *idem sonans* or phonetical similarities between competing marks constitute confusing similarity.⁵ The similarities with the sound of the subject trademarks in the present case is more akin to the cases of *Duraflex vis-à-vis Dynaflex*,⁶ *Lusolin vis-à-vis Sapolin*,⁷ *Salonpas vis-à-vis Lionpas*,⁸ and *FREEMAN vis-à-vis FREEDOM*⁹ where the Supreme Court held that the competing marks were confusingly similar. In the *Pertussin vis-à-vis Atussin*¹⁰ case cited by the Respondent-Applicant, the Court took cognizance of the fact that the products therein were pharmaceutical drugs and normally dispensed upon medical prescription, which is not the same in the instant case.

⁴ Page 8 of the Respondent's Answer dated 3 August 2011 and Page 5 of the Respondent's Position Paper dated 18 November 2011

⁵ *Marvex Commercial Co., Inc. vs. Petra Hawpia and Co*, G.R. No. L-19297, 22 December 1966

⁶ *American Wire & Cable Company vs. Director of Patents and Central Banahaw Industries*, G.R. L-26557 18 February 1970

⁷ *Sapolin Co. vs. Balmaceda*, 67 Phil 795

⁸ *Marvex Commercial Co., Inc. vs. Petra Hawpia and Co*, G.R. No. L-19297, 22 December 1966

⁹ *Co Tiong vs. Director of Patents*, 95 Phil 1

¹⁰ *Etepha, A. G. vs. Director of Patents et. al.*, G.R. No. L20635, 31 March 1966

Verily, the trademarks "J'ADORE" and "ADORED" are confusingly similar taking in consideration their common dominant feature and the close resemblance of their phonetical composition.

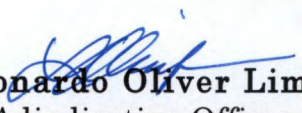
Our intellectual property laws do not require that the competing trademarks be so identical as to produce actual error or mistake. It would be sufficient that the similarity between the two labels is such that there is a possibility or likelihood that the purchaser of the older brand would be mistaking the newer brand for it.¹¹ Thus, our laws do not require actual confusion, a mere likelihood of confusion is enough.¹²

Moreover, since the Respondent-Applicant will use his mark on the same or similar perfumery products of that of the Opposer, it is not far-fetched that the consumer would likely to assume that the Respondent-Applicant's goods originate or sponsored by the Opposer, or at the very least, believe that there is a connection between these goods. Definitely, the likelihood of confusion would subsist not only on the purchaser's perception of goods but also on its origin or its source.¹³

WHEREFORE, premises considered the instant Opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-002858 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, **15 NOV 2016**


Leonardo Oliver Limbo
Adjudication Officer
Bureau of Legal Affairs

¹¹ American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

¹² Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992

¹³ Converse Rubber Corporation vs. Universal Rubber-Products, Inc. et. al. G.R. No. L27906, January 8, 1987