

L'OREAL,
Opposer,

-versus-

LING LING FAN,
Respondent-Applicant.

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IPC No. 14-2016-00214
Opposition to:

Appln. Serial No. 4-2015-012262
Date Filed: 23 October 2015

TM: NAKED4 O.TWO.O

X-----X

NOTICE OF DECISION

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26th Street corner 3rd Avenue
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Taguig City

LING LING FAN
Respondent- Applicant
28K, Tower II, 168 Residence Condominium
No. 918 Soler Street,
Binondo, Manila

GREETINGS:

Please be informed that Decision No. 2017 - 233 dated 20 June 2017 (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 the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 20 June 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

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	}	Opposition to:
-versus-	}	App. Ser. No. 4-2015-012262
	}	Date Filed: 23 October 2015
LING LING FAN,	}	TM: "NAKED4 O.TWO.O"
Respondent-Applicant,	}	
	}	Decision No. 2017 - <u>233</u>
x-----x	}	

DECISION

L'OREAL,¹ ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2015-012262. The application, filed by LING LING FAN² ("Respondent-Applicant") covers the mark **NAKED4 O.TWO.O** for use on "cosmetics, foundation make-up, make-up bases, foundation cream, powders for the face and eyes, liquid face powder, white face powder, pressed powder, blushes, rouges, liquid rouges, cover up creams, makeup, gels, and lotions, make-up removers, facial line erasers; water for cosmetics use, astringents, cleansing milks for cosmetic purposes, cleansing milk for toilet purposes, cosmetic kits, make-up kits, concealers; eye shadows, eye liners, eye pencils, eye treatments in the form of cream, gels and lotions, eye makeup removers, eye makeup remover pads, eyebrow pencils, brow moisturizing cream, gels and lotions, eye creams, eye gels, eye pads for cosmetic purposes; lip creams, lipsticks, lip colours, lip tints, lip glosses, lip glazes, lip pencils, lip liners, lip balms, up shines, up conditioners, lip salves, mascaras, tints, lash enhancers, lash primers; nail care preparations, nail varnishes, nail lacquers, nail polishes and nail creams, nail polish removers, nail enamel removers, hand creams, foot lotions; foot gels, foot creams; non-medicated anti-wrinkle creams, lotions an gels, non-medicated facial skin oil controllers, non-medicated skin blemish preparations, non-medicated skin renewal creams, non-medicated skin repair creams, lotions and gels, skin moisturizers, skin creams, skin lotions, skin cleansers, skin cleansing gels and lotions, skin cleansing scrubs, cleansing pore patches, skin care preparations, antiperspirants, body deodorants, body cleansers, body creams, body exfoliating preparations, body lotions, body scrubs, body toners, body washes, body moisturizers, body powders, fragrant body splash, cleansing lotions, cleansing creams, cleansing gels, facial care products contained in capsules, facial masks, face creams, face gels, face lotions, face masks, facial cleansers, facial emulsions, facial exfoliating preparations, facial exfoliating incense, facial moisturizers, facial soaps, facial toners, skin mask, toners and refreshers, neck creams, facial tonics, massage gels, massage oils, cold cream, skin balancing lotion, skin bronzing sprays, creams, gels and lotions; skin firming preparations, skin brighteners, skin lighteners, skin refreshers;

¹ A corporation organized and existing under the laws of France with address at 14 Rue Royale, Paris, 75008, France.
² A resident of the Philippines with address at 28K, Tower II, 168 Residence Condominium, #918 Soler Street, Binondo, Manila.

soaps, liquid soaps, soaps in gel form, cleansing soaps, bar-shaped soaps for toilet, bar-shaped soaps for cosmetic, bar-shaped soaps for bath, bath salts, bath oils, bathing lotions, sun blocking sticks, tanning sprays, sunscreen sprays, acne creams, acne defense sticks, sun tanning preparations, sunless tanning lotions, sunless tanning preparations, sunscreen lotions, sunscreen creams, sun oil, sunscreens for the body, sunscreens for the face and after-sun soothing and moisturizing preparations" under Class 03 of the International Classification of Goods.³

The Opposer alleges the following grounds:

"The Respondent-Applicant's NAKED4 O.TWO.O trademark is confusingly similar to the Opposer's 'NAKED SKIN' trademark, which are used on various goods manufactured and sold by the Opposer for goods in class 3.

The Respondent-Applicant's application for the trademark NAKED4 O.TWO.O, which has a filing date of 23 October 2015, which date is later than the filing date of the Opposer's 'NAKED SKIN' trademark (*i.e.* 17 September 2015), cannot be registered by virtue of Section 123.1 (d) of the Republic Act No. 8293 ("IP Code")"

Opposer's evidence consists of the following:

1. Authenticated Special Power of Attorney;
2. Affidavit of Neonette E. Pascual;
3. Certified copy of Trademark Application File No. M/0000/01269901 filed on 17 September 2015; and
4. Printout from Opposer's Urban Decay online store that features NAKED SKIN products.

On 07 July 2016, a Notice to Answer was issued by this Bureau and served personally to Respondent-Applicant's address on 28 July 2016. However, despite the receipt of the Notice, Respondent-Applicant failed to file the answer. On 03 March 2017, the Respondent-Applicant was declared in default. Accordingly, the case is now submitted for resolution of the basis of the opposition, affidavit of witness, if any, and other documentary evidence submitted by the Opposer.

Should Respondent-Applicant be allowed to register the mark NAKED4 O.TWO.O ?

To determine the registrability of a mark, Section 123. 1 (d) of R.A. No. 8293 also known as the Intellectual Property Code of the Philippines ("IP Code"), as amended, provides:

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on the 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 Purpose of the Registration of Marks concluded in 1957.

SEC. 123. Registrability. - 123.1 A mark cannot be registered if it:

x 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.

Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, said mark cannot be registered.

Records will show that at the time Respondent-Applicant applied for registration of its mark "NAKED4 O.TWO.O" on 23 October 2015, Opposer already has a pending application filed on 17 September 2015. As such, it enjoys priority in terms of application or it is a prior filer than Respondent-Applicant.

But are the marks of the parties confusingly similar as to likely cause confusion, mistake or deception on the part of the buying public?

The marks of the parties are hereunder reproduced for comparison:

NAKED SKIN

Opposer's Mark

NAKED4
O.TWO.O

Respondent-Applicant's Mark

3 

Opposer's mark consists of the words "NAKED SKIN" written in a plain upper case letters. On the other hand, Respondent-Applicant's mark consists of the words "NAKED4 in bold stylized font, and below it is the word "O.TWO.O" written in smaller solid uppercase letter. Clearly, Opposer's and Respondent-Applicant's mark are similar because of the presence of the word "NAKED". Although, there are other elements present in the Respondent-Applicant's marks when compared to that of Opposer, such other elements are inconsequential because what sticks to the minds of the consumers is the word "naked" such that when they see the Respondent-Applicant's mark, the word "naked" is the prominent element that they will most likely remember or recall. Thus, to allow the continued use and registration of the Respondent-Applicant's mark would likely cause confusion on the part of the public that Respondent-Applicant's mark is also a variation of Opposer's NAKED marks especially that Opposer has also used marks such as NAKED2 and NAKED3 in its products.

Confusion cannot be avoided by merely adding, removing or changing the words or 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 other⁴. Colorable imitation does not mean such similitude as amounts 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 trade name with that of the other mark or trade name in their 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 article⁵.

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.⁶

Moreover, the goods upon which Respondent-Applicant's mark is being applied for is covered by the goods of the Opposer. As such, the likelihood of the occurrence of mistake, confusion, or even deception is even greater. There is the likelihood that information, assessment, perception or impression about Respondent-Applicant's goods unfairly cast upon or attributed to the NAKED SKIN products of the Opposer.

⁴ *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No. 112012, 4 Apr. 2001, 356 SCRA 207, 217.

⁵ *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

⁶ *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.




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.⁷

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application No. 4-2015-012262 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 20 JUN 2017.


MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs

⁷See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.