

BEECHAM COSMETICS, INC.	}	INTER PARTES CASE NO. 1960
Petitioner,	}	Petition for Cancellation
	}	
	}	Regn. No. : 34515
-versus-	}	Date Issued : 20 June 1985
	}	Trademark : "JOVAN"
	}	
MANUEL C. MORENO	}	
Respondent-Registrant	}	DECISION NO. 2000-01
X-----X	}	

DECISION

On November 21, 1985, BEECHAM COSMETICS, INC., a corporation duly organized under the laws of the State of Illinois, United States of America, and doing business at 980 North Michigan Avenue, Chicago, Illinois, U.S.A., filed its Verified Petition for Cancellation of Registration No. 34515 for the trademark "JOVAN" for cosmetics and perfume falling under Class 8 of the International Classification of Goods, which registration was issued on June 20, 1985 to Manuel C. Moreno of 22 Laong Laan Street, Quezon City and doing business at 537 Rizal Avenue, Metro Manila.

The grounds for Cancellation of the said Registration are as follows:

- "1. Trademark "JOVAN" of Respondent-Registrant is confusingly similar to the internationally-known trademark "JOVAN" which Petitioner owns and has not abandoned;
- "2. The Petitioner suffered and will continue to suffer damage by the registration of the trademark "JOVAN" in favor of respondent-registrant and its business reputation and goodwill shall surely suffer great and irreparable injury;
- "3. Respondent-Registrant's use of said trademark "JOVAN", which is exactly the same as the trademark used by petitioner, constitutes an unlawful appropriation of a mark previously used in the Philippines and not abandoned and therefore contrary to Section 4 (d) of Republic Act No. 166, as amended;
- "4. The registration of Respondent's mark is contrary to the Trademark Law (Rep. Act No. 166, as amended);
- "5. The above-registration was obtained fraudulently and/or the cancellation thereof is authorized by other provisions of the Trademark Law and the Revised Rules of Practice in Trademark Cases."

In support of the Petition for Cancellation, Petitioner will prove and rely upon the following facts, among others:

- "1. Petitioner has used and adopted the mark "JOVAN" prior to respondent-registrant;
- "2. Petitioner's trademark is used for perfume, cologne, toilet soap, skin lotion, shaving cream and bath oil, among others, since August 5, 1968;
- "3. Petitioner's mark "JOVAN" is well known throughout the world and in the Philippines and has been granted various trademark registrations around the world;

"4. Petitioner's goods have excellent reputation for their high and superior quality;

"5. Petitioner's products using the trademark "JOVAN" have been widely advertised in the Philippines and throughout the world;

"6. Petitioner has used and adopted the trademark "JOVAN" prior to that alleged by respondent-registrant;

"7. The registration of Respondent-Registrant is contrary to the Memorandum of the Minister of Trade and Industry dated November 20, 1983; the validity of said Memorandum was recently affirmed by the Supreme Court in the case of "Gobindram Hemandad Sujinani vs. Honorable Roberto V. Ongpin," G.R. No. 65659, promulgated on May 21, 1984;

"8. Respondent knew or ought to know that he is not entitled to register the mark "JOVAN" in his name, not being the originator or true and lawful appropriator of said mark;

"9. The issuance and continued existence of the registration certificate in question has damaged and will continue to damage the petitioner; by falsely representing that he is the true and lawful originator of the subject mark, respondent was able to have the same fraudulently registered in the Philippine Patent Office and such fraudulent registration is a hindrance to the registration of the mark in petitioner's name.

On December 3, 1985, a Notice to Answer was sent to Respondent-Registrant. An extension of fifteen (15) days within which to file Answer was requested, and granted by this Office in its Order No. 86-01 dated January 3, 1986.

In his Answer filed on 13 January 1986, the Respondent-Applicant objected to the above petition citing therein, among others, that his Certificate of Registration has been issued in accordance with law.

The issues having been joined, this Office called this case for Pre-Trial on February 18, 1986 and was reset to February 27, 1986 where the Petitioner submitted its Pre-Trial Brief while the Respondent-Applicant submitted the same only on April 3, 1986. For failure to reach an amicable settlement, trial on the merits proceeded.

On February 23, 1989, herein Petitioner, through counsel, filed its Formal Offer of Evidence consisting of Exhibits "A" to "JJ" which are all ADMITTED in evidence for the Petitioner, and the Respondent-Applicant have been deemed to have waived its right to file Comments or Objections to the petitioners exhibits, as per this Office Order No. 89-205 dated March 20, 1989.

Due to the inconsistency between the allegations in the pleading and the testimony of the herein Respondent-Registrant Counsel, who took the witness stand on January 28, 1991, said witness was impeached and his entire testimony is stricken off the record, in accordance with Sec. 11, Rule 132 of the Revised Rules of Court, upon motion of the herein Opposer, and granted per this Office Order No. 93-283 dated 27 April 1993.

For failure of the Respondent-Registrant to appear at the scheduled hearing for the reception of his evidence, the Petitioner at the hearing held on May 18, 1993 moved that the former be declared to have waived his right to present evidence, thereby submitting the case for decision on the basis of the evidence on record, which was granted by this Office per Order No. 93-346 dated May 24, 1993 and both parties were required to file their respective MEMORANDA.

Petitioner filed its MEMORANDUM on August 23, 1993 while the Respondent-Registrant was deemed to have waived the right to submit the same for non-compliance to the above Order, per this Office Order No. 97- 573 dated 04 November 1997.

The issues to be resolved are the following:

1. WHETHER OR NOT the trademark of Respondent-Registrant JOVAN used on cologne, lotion and perfume is confusingly similar to that of the Petitioner's mark JOVAN used on perfume, cologne, toilet soap, skin lotion, shaving cream and bath oil.
2. WHETHER OR NOT the Petitioner has acquired priority of registration and goodwill over the mark "JOVAN" to the exclusion of use/registration of the same by all others.

Based on the evidence submitted, Respondent-Registrant's "JOVAN" is confusingly similar to Petitioner's mark "JOVAN" as both are identical in spelling, sound and composition. This is compounded by the fact that the goods of both parties where said trademarks are being used belong to the same Class 3, i.e., perfume, cologne, soaps, skin lotion, and oil.

The Supreme Court has ruled thus"

"In determining whether two trademarks are confusingly similar, the test is not simply to take their words and compare the spelling and pronunciation of said words. Rather, it is to consider the two marks in their entirety, as they appear in the respective labels, in relation to the goods to which they are attached." (Mead Johnson and Co. vs. N.V.J., Van Dorp, Ltd., 7 SCRA 768) (underscoring ours)

Likewise, in connection with the use of a confusingly similar or identical mark, the Supreme Court has ruled that:

"Those who desire to distinguish their goods from the goods of another have a broad field from which to select a trademark for their wares and there is no such poverty in the English Language or paucity of signs, symbols, numerals etc. as to justify one who really wishes to distinguish his products from those of all others entering the twilight zone of a field already appropriated by another. (Weco Products Co. Milton Ray Co., 143 F. 2d, 985, 32 C.C.P.A. Patents 1214)."

"Why of the million of terms and combinations of letters and designs available, the appellee had to choose those so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark. (American Wire & Cable Co. vs. Director of Patents, 31 SCRA 544)"

"xxx Why with all the birds in the air, and all the fishes in the sea, and all the animals on the face of the earth to choose from, the defendant company (Manila Candy Co.) selected two roosters ad its trademark, although its directors and managers must have been well aware of the long-continued use of a rooster by the plaintiff with the sale and achievement of its goods? xxx a cat, a dog, a carabao, a shark or an eagle stamped upon the container in which candies are sold would serve as well as a rooster for the product of defendant's factory. Why did defendant select two roosters as its trademark? (Clarke vs. Manila Candy Co., 36 Phil. 100)"

In the case at bar, there is no doubt that Respondent-Registrant's "JOVAN" is indeed confusingly similar to Petitioner's trademark "JOVAN" and that there is a clear indication that the herein Respondent merely adopted said trademark "JOVAN" from the Petitioner. Hence, the inescapable conclusion is that he is merely riding on the reputation of the Petitioner's mark, for, in the unlimited field of choice, what could have been Respondent's purpose in selecting "JOVAN" if not for its fame?

Having resolved the issue of confusing similarity, the next issue to be resolved, then, is WHO BETWEEN THE PARTIES IS THE PRIOR USER AND OWNER OF THE TRADEMARK "JOVAN"?

As established by the evidence on record, Petitioner has adopted the mark "JOVAN" on August 5, 1968 (Exh. "A-2") long before the Respondent-Registrant's date of first use on April 1, 1973 (Certificate of Registration No. 34515 issued on June 20, 1985), and Petitioner's mark had been registered in most countries of the world such as Japan, New Zealand, Sweden, Britain, Australia, Benelux, Netherlands, France, Germany, Hong Kong, Israel, Kuwait, Finland, Ireland, Bahrain, South Africa, United States of America, Taiwan and Kenya (Exhibits "A" – "N-1" and Exhibits "CC" to "JJ") as well as Exhibits "P", copies of advertisement/brochure bearing the mark "JOVAN".

From the evidences presented, Opposer has established that it is indeed an internationally well-known mark entitled to protection under Art. 6 bis of the Paris Convention which provides in part that:

"Article 6bis

"(1) The countries of the Union undertake, either administratively if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration and to prohibit the use of a trademark which constitutes a reproduction, imitation or translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well-known in that country as being already the mark of a person entitled to the benefits of the present Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known marks or an imitation liable to create confusion therewith."
(Underscoring provided)

Moreover, the herein Respondent failed to file a Motion to Lift the Order declaring him as having waived his right to present evidence and the non-submission of Memorandum which signifies lack of concern or interest to protect his right.

Indeed, this Office cannot but notice the lack of concern that Respondent had shown in protecting his right over the mark subject to this litigation, contrary to the disputable presumption that, "a person takes ordinary care of his concerns" enunciated in Sec. 3(d), Rule 131 of the Revised Rules of Court.

WHEREFORE, this Petition for Cancellation is, as it is hereby GRANTED. Consequently, Certificate of Registration No. 34515 for the trademark JOVAN issued to Respondent-Registrant, MANUEL C. MORENO, is, as it is hereby, CANCELLED.

Let the filewrapper of trademark JOVAN subject matter in this case be forwarded to the Administrative Financial and Human Resource Development Bureau for appropriate action in accordance with this Decision with a copy to be furnished the Bureau of Trademarks for information and update of its records.

SO ORDERED.

Makati City, January 31, 2000

ESTRELLITA BELTRAN-ABELARDO
Director