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| BEECHAM GROUP PLC, | } | IPC No. 14-2004-00167 |
| Opposer, | } | Opposition to: |
| | } | App. Ser. No. 4-1997-118305 |
| | } | Date Filed: Feb. 27, 1997 |
| -versus- | } | |
| | } | TM: "SPECKLED TOOTHPASTE |
| | } | IN COLORS WHITE, VARIOUS |
| UNILEVER N.V., | } | SHADES OF RED AND BLUE" |
| Respondent-Applicant, | } | |
| x-----x | } | DECISION NO. 2006-55 |

DECISION

For Decision is the Opposition filed against the application for registration of the mark "SPECKLED TOOTHPASTE IN COLORS WHITE, VARIOUS SHADES OF RED AND BLUE" used for "dentifrices and non-medicated mouthwashes" under Class 3 of the International classification of goods, bearing Application Serial no. 4-1997-118305 which was published in the Intellectual Property Office Official Gazette, Volume VII, No. 6, page 19 released on September 29, 2004.

Opposer, BEECHAM GROUP PLC, is a corporation duly registered and existing under the laws of United Kingdom, with principal address at Glaxo Wellcome House, Berkeley Avenue, Greenford Middlesex, UB6 ONN England, represented by Jairus Ignatius H. Abiera, with postal address at Suite 910 West, Philippine Stock Exchange Bldg., Exchange Road, Ortigas Center, 1605 Pasig City. Respondent-Applicant, on the other hand, is UNILEVER, N.V., existing and incorporated under laws of the Netherlands with address at Weena 455, 3013 AI Rotterdam, Nederland.

The grounds for Opposition to the registration of the mark are as follows:

"1. [T]he application is in violation of Section 4(e) of republic Act No. 166 (now Section 123.1 (h) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines);

"2. From the publication made, it is patently clear and without doubt that the subject trademark application consists of a sign which is generic for the goods which applicant seeks to identify, particularly dentifrices and non-medicated mouthwashes.

"3. In addition, the generic or descriptive nature of the trademark cannot be rendered registrable merely by the claim of color. The law is very clear, whether the descriptive mark is colored or not, generic or descriptive mark cannot be registered. The defect of descriptiveness is not cured by merely or claiming color to the trademark.

"4. There is no indication in the application that respondent applicant's trademark has become distinctive, through use in connection with the applicant's goods or services in commerce in the Philippines for five (5) years prior to its claim of distinctiveness.

The Opposer relied on the following facts to support its allegations on this Opposition:

"A. The Oppositor is a corporation engaged, among others, in the distribution of dentifrices and non-medicated mouthwashes, and the registration

of the subject generic and descriptive trademark will cause damage to the oppositor.

“B. The trademark “speckled toothpaste in colors white, various shades of blue and red” has the appearance of the head of a toothbrush containing toothpaste on top of the brush. The said trademark is intended to cover dentifrices and non-medicated mouthwashes.

“C. From its mere appearance, it is clear that the said mark is intended to identify goods such as toothpaste and toothbrushes, among others. With respect to mouthwashes, it is clear that the purpose of toothpaste, in addition to its primary purpose of cleaning and protecting the gums, is also intended to eliminate bad breath by eliminating odor-causing germs. Mouthwashes have the same purpose as toothpaste. The only difference is that mouthwashes are in the liquid form while toothpastes are not.”

A Notice to Answer the Verified Notice of Opposition dated January 11, 2005 was sent to the herein Respondent-Applicant. On January 28, 2005 respondent-applicant filed the Answer, stating as its Affirmative and Special Defenses, the following:

“5. Opposer has no right over the speckled toothpaste in colors white, various shades of blue, red or a white toothpaste with 2 colours blue speckles applied for by respondent-applicant.

“6. Opposer may claim use to a slug device for toothpaste, not for the respondent-applicant’s speckled toothpaste device, which is glaringly different and distinct from one another.

“7. Opposer has no existing trademark applications or registrations with respect to its slug device it may claim use for toothpaste in the Philippines.

“8. Respondent-Applicant has filed the trademark application under R.A. No. 166, as amended, based on the Home Registration under Sec. 37 thereof. The Benelux Trademarks Office registered last 02-05-1996 respondent-applicant’s trademark.

“9. Respondent-Applicant is the registrant of their speckled toothpaste device in many countries all over the world.

“10. Respondent-Applicant’s speckled toothpaste device consists of speckles, which in itself is an arbitrary device with a distinctive form and design and clearly not generic or descriptive of the goods which applicant seeks to identify. This is allowed under Section 123.1 (I) of R.A. 8293 or Intellectual Property Code.

“11. Respondent-Applicant’s trademark is an arbitrary and distinctive device mark. It clearly depicts the distinctiveness of its toothpaste. Respondent-Applicant’s toothpaste is speckled in colors white various shades of blue, red or a white toothpaste with 2 colours of blue speckles.

“12. With such clear distinction, the public will not likely be confused. The registration of the respondent-applicant’s mark will not cause great and irreparable damage and injury to Opposer’s mark.

“13. Opposer’s slug device for toothpaste and respondent-applicant’s distinctive speckled toothpaste device are quite glaringly different and distinct

from each other. Being totally different and distinct from each other, no dilution of Opposer's goodwill to its mark could occur.

"14. The registration of respondent-applicant's mark is consistent with the provisions of the Trademark Law and the Intellectual Property Code.

"15. Respondent-Applicant has vested rights under the Paris Convention and the TRIPS Agreement to seek the registration and protection of this trademark device applied for registration in the Philippines."

On February 15, 2005, Opposer filed its Reply. On March 14, 2005, this Office issued a Notice of Pre-Trial conference with Invitation to Mediate. On April 6, 2005, Respondent-Applicant filed its Pre-Trial Brief while Opposer submitted its Pre-Trial Brief on April 25, 2005. The scheduled pre-trial on April 27, 2005 was reset in view of the manifestation of Respondent-Applicant's counsel that they will file a motion with respect to some documents submitted by Opposer. On 5 May 2005, Respondent-Applicant filed an Omnibus Motion to Expunge and Dismiss the Verified Notice of Opposition and to Dismiss the case for Failure to Prosecute. Opposer filed its Comment to the motion on May 19, 2005. The parties also filed a Reply, Rejoinder and Sur-Rejoinder. On 15 September 2005, this Office issued Order No. 2005-726 denying the Omnibus Motion. Meanwhile, the Summary Procedure in Inter Partes Cases took effect already on September 1, 2005. On October 13, 2005, Opposer and Respondent-Applicant was directed to submit all its evidence in accordance with Section 7 and subsection 7.1 and Section 8 and 8.1 Office Order No. 79. Respondent-Applicant submitted its Compliance on November 21, 2005 attaching therewith as its evidence Exhibits "1" to "8" while Opposer filed its Compliance on December 16, 2005 attaching thereto Exhibits "A" and "B". A Notice of Preliminary Conference was issued on January 12, 2006. At the Preliminary Conference the parties manifested that they will explore the possibility of an amicable settlement, however, the same failed and the preliminary conference was terminated. The parties were then requires to submit their respective position papers under Order No. 2006-479 dated March 24, 2006. On April 5, 2006, Respondent-Applicant filed its Position Paper while Opposer filed its Position Paper on April 6, 2006. Hence, this Decision.

The main issue to be resolved in this case is: WHETHER OR NOT RESPONDENT-APPLICANT'S MARK IS UNREGISTRABLE FOR BEING GENERIC OR MERELY DESCRIPTIVE OF THE GOODS OR SERVICES WHICH IT SEEKS TO IDENTIFY.

It should be noted that the trademark application subject of the opposition was filed on February 27, 1997. Thus, the applicable law in this case is Republic Act No. 166, as amended, particularly Section 4 (e), which provides:

"Section 4, Registration of trademarks, trade names and service marks on the principal register. There is hereby established a register of trademarks, trade names and service marks which shall be known as the principal register. the owner of a trademark, trade name or service mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register unless it:

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(e) Consist of a mark or trade name which, when applied to or used in connection with the goods, business or services of the applicant is merely descriptive or deceptively misdescriptive of them, or when applied to or used in connection with the goods, business or services of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, or is primarily merely a surname."

At the outset, it must be pointed out that Respondent-Applicant is the registrant of the speckled toothpaste device in colors white, various shades of blue, red or a white toothpaste with 2 shades blue speckles in the Benelux Trademark Office under Registration No. 0590159, which was issued on May 2, 1996 [Exhibit "6" as well as in several countries all over the world [Exhibits "8"]. Respondent-Applicant's speckled toothpaste device (red toothpaste gel with red speckles) under Application Serial No. 4-1997-118298 was also allowed registration (Exhibit "5"). Likewise, this Bureau under Order No. 2005-88 dated July 26, 2005 gave due course to the application for registration of its mark "toothpaste slug & toothbrush device [red/white/blue]" (Exhibit "4").

Going now to the sole issue of whether the respondent-applicant's mark is generic or descriptive, a mark is considered "descriptive" if it is descriptive of: the intended purpose, function or use of the goods, of the size of the goods, of the class of users of the goods, of a desirable characteristics of the goods, or of the end effect of the user. Descriptive marks cannot be protected unless secondary meaning is proven. On the other hand, a mark is "suggestive" if, it requires imagination thought and perception to reach a conclusion as to the nature of the goods.

The records would show that Respondent-Applicant's speckled toothpaste device consists of speckles in colors white various shades of blue, red is in itself not descriptive but merely suggestive in connection with the goods which respondent-applicant seeks to identify. Being merely suggestive, the same can be registered without any proof of secondary meaning.

Incidentally, respondent-applicant has already disclaimed the toothpaste slug and the toothbrush as appearing on the mark. However, the disclaimer does not mean that respondent-applicant's mark is descriptive contrary to the contention of Opposer. The purpose of the disclaimer is only to make of record that a significant element of the mark is not being exclusively appropriated by itself apart from the mark as shown. A disclaimer only shows that the applicant is not making a claim to exclusive appropriation of the disclaimed matter except in the precise relation and association in which it appears in the drawing and description. The disclaimer does not have the effect of removing from the mark the matter disclaimed. It claims only any exclusive right in those disclaimed words or symbols per se. that is, the applicant is merely stating that he is claiming only the whole composite mark as his property, and makes no claim to those particular portions disclaimed.

Lastly, the Opposer failed to prove that he would be damaged by the registration of respondent-applicant. Aside from the general allegation in the opposition, no iota of evidence was submitted or presented to show that the registration of the mark would cause damage to opposer. Allegations must be proven by sufficient evidence, mere allegation is not evidence, and is not equivalent to proof. This requirement of damage is also provided for under Section 8 of Republic Act No. 166 in order that a person may file an Opposition to an application for registration.

WHEREFORE, premises considered, the Notice of Verified Opposition filed by Opposer, BEECHAM GROUP PLC against respondent-applicant UNILEVER N.V. is, as it is hereby DENIED. Consequently, the trademark application of respondent-applicant for the device "speckled toothpaste in colors white various shades of red and blue" bearing Serial No. 4-1997-118305 filed on 27 February 1997 for dentifrices and non-medicated mouthwashes under Class 3 of the international classification of goods is, as it is hereby, GIVEN DUE COURSE.

Let the filewrapper of "speckled toothpaste in colors white various shades of red and blue" be forwarded to the Bureau of Trademarks (BOT) for appropriate action in accordance with this DECISION.

SO ORDERED.

Makati City, 11 July 2006.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office