

CHANNEL SARL,	}	IPC NO. 14-2007-00290
Opposer,	}	Opposition to:
	}	Application Serial No. 4-2006-013327
-versus-	}	Date Filed: 13 December 2006
	}	Trademark: COCOVIBE
TUPPERWARE PRODUCTS, S.A.,	}	
Respondent-Applicant.	}	Decision No. 2009-08
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DECISION

For decision is the Notice of Opposition filed by Channel Sarl, (Opposer), a corporation duly organized and existing under the laws of Switzerland, with office at Burgstrasse 26, CH-8750 Glaris, Switzerland against Application Serial No. 4-2006-013327 for the mark COCOVIBE covering goods under Class 3, namely: "soaps, liquid soaps, shower and bath gel, shower and bath foams; perfumes, fragrances; cosmetics; essential oils; hair care preparations; hair creams, hair gel, brilliantines, hair shampoo, hair lotions, hair conditioners, hair dyes, hair tonics, hair dressings, hair moisturizers, dandruff creams, dandruff lotions, dandruff tonics; dentifrices; toilet water, eau de cologne; non-medicated showers, and other non-medicated additives for use in bath and in showers; creams, lotions, milks, oils, powders and ointments for the care and the cleansing of the skin, body, hands and feet; deodorants and anti-perspirants for use on the person; talcum powder; after and pre shaving preparations, shaving cream, shaving mousse, shaving gel, shaving oil and shaving foam; cosmetic sun tanning preparations, cosmetic sun-protecting preparations, cosmetic preparations against sun-burn" filed by Tupperware Products S.A. (Respondent-applicant) with address at Route de Jure 37, CH 1700 Fribourg, Switzerland.

In support of the opposition, opposer relies on the following grounds:

"1. Opposer is the registered owner in the Philippines of the COCO and COCO CHANEL marks (the "COCO Marks") for goods in Class 3 under Registration Nos. 033532, 058525, 016020, 016026, 054979 and 047068 issued by the IPO.

Opposer is likewise the registered owner in the Philippines of the trademark COCO under Registration No. 058525 for goods in Class 25.

Opposer is the first user of the COCO Marks for its goods in Class 3 in various countries since at least 1984 and in the Philippines and other countries, long before Respondent-Applicant appropriated the similar mark COCO VIBE for its own products in Class 3. The COCO Marks are also registered in over 150 countries worldwide and cover nearly every class.

2. Respondent-Applicant's trademark COCO VIBE so resembles Opposer's COCO Marks as to be likely, when applied to or used in connection with the goods of Respondent-Applicant, to cause confusion, mistake and deception on the part of the purchasing public by misleading them into thinking that Respondent-Applicant's goods either come from Opposer or are sponsored or licensed by it.

3. The registration and use by Respondent-Applicant of the trademark COCO VIBE will diminish the distinctiveness and dilute the goodwill of Opposer's COCO Marks, which are arbitrary trademarks when applied to Opposer's products.

4. Respondent-Applicant adopted the trademark COCO VIBE on its own goods with the obvious intention of misleading the public into believing that its goods bearing the trademark originate from, or are licensed or sponsored by Opposer, which has been identified in the trade and by consumers as a source of goods bearing the confusingly similar COCO Marks.

5. The approval of Respondent-Applicant's trademark COCO VIBE is based on the representation that it is the originator, true owner and first user of the trademark, which was merely derived from Opposer's COCO Marks.

6. Opposer is the first user of the COCO Marks in Philippine commerce and elsewhere, having utilized the same since 2004 in the Philippines. Opposer's COCO Marks have come to be associated with several products including soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, etc. in Class 3 of the finest quality. Respondent-Applicant's use of a confusingly similar mark as the brand name for its own products is likely to cause consumer confusion as to the origin of said goods.

7. Respondent-Applicant's use of the trademark COCO VIBE infringes upon Opposer's exclusive right to use the COCO Marks, which are well-known trademarks protected under Sections 147 and 123.1 (d), (e) and (f) of the Intellectual Property Code ("IP Code"), Article 6bis of the Paris Convention and Article 16 of the Agreement on Trade Related Aspects of Intellectual Property Rights to which the Philippines and Switzerland adhere.

8. The registration of the trademark COCO VIBE in the name of the Respondent-Applicant is contrary to other provisions of the IP Code."

Opposer submitted the following evidence to prove its allegations:

ANNEX	DESCRIPTION
"A"	Notice of Opposition
"B"	Authenticated Affidavit of Ms. Vanessa Riviere (with Exhibits)
"C"	Certificates of Registration
"D"	Special Power of Attorney

In the Answer filed by respondent-applicant on 3 January 2008, it raised the following affirmative defenses:

"7. The marks of the parties are different from one another. The mark of the Opposer is only one word while that of the Respondent-Applicant contains two words with an exclamation mark after the end of the second word. The word "VIBE" and the exclamation mark do not appear in the mark of the Opposer.

8. There is no indication, symbol, design emblem, sign or figure in the mark of the Respondent-Applicant showing that said mark is related to, sponsored by or originates from the Opposer. Attached is a product/picture showing the mark of the Respondent-Applicant.

9. The mark COCO VIBE! was coined by the Respondent-Applicant due to the fact that the product on which the mark is being applied is based on

and uses Virgin Coconut Oil as one of its ingredients. A cursory glance at the product shows not only the mark COCO VIBE! but likewise the words VIRGIN COCONUT OIL, a representation on drawing of two broken coconuts and coconut leaves acting as the background. The word COCO is a familiar and highly popular symbol or shortened term for coconut, a plant in huge abundance in the Philippines.

10. The Respondent-Applicant, being one of the biggest corporations in the world has no intention of riding in the goodwill of the mark of another company or person.

11. COCO, collectively with other words or designs, has been registered as a mark before this Honorable Office. Some of the registered marks are the following:

<u>Trademarks</u>	<u>Registration No.</u>
a. Coco 10 Kukutin Label mark	42003007224
b. Coco Banana & Banana Device	41990013866
c. Coco Delight	42002009081
d. Coco Honey	SR-7915
e. Coco Label	SR-9322
f. Coco Loco	41995101409
g. Coco Puro	42004008762
h. Coco Rico	049855
i. Coco Song & Device	42005008259
j. Coco/J	057554
k. Cocoapro	42002008667
l. Cocoavia	42004003005

The preliminary conference was set at 13 February 2008 at which no amicable settlement was obtained between the parties. The issue is whether the opposer's COCO marks are confusingly similar to respondent-applicant's mark COCO VIBE. Corollary issue is whether COCO is a well-known mark.

The Intellectual Property Code states:

"Section 123. *Registrability.* – 123.1 A mark cannot be registered if it:

xxx

(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”

Evidence show that the opposer is the owner of the COCO mark for goods under classes 3 and 25 (Annex “C”) while respondent-applicant’s application is also for goods under class 3. Opposer registered the mark COCO CHANEL OPEN CARTON IN BLACK & GOLD WITH WORDS for goods under Class 3 namely: “soaps, essential oil, cosmetics, lotions for the hair and dentrifices” under Certificate of Registration 47068 (Annex “B” – Exhibit “B”) on 18 December 1989. Opposer’s also submitted COCO mark for goods under Class 25 under Certificate of Registration 58525 (Exhibit “B” – Annex “B”) issued on 23 June 1994. The first word of respondent-applicant’s mark is identical with opposer’s mark but the second word VIBE is not present in any of the opposer’s marks. The presence of an identical component in previously registered mark in a mark being applied may not necessarily lead to confusion. The Supreme Court in Philip Morris, Inc. Benson & Hedges (Canada), Inc., and Fabriques de Tabac Reunies, S.A. v. Fortune Tobacco Corporation, GR No. 15859, 27 June 2006, found that no infringement was committed by the respondent who adopted the word MARK which was identical to the mark of the complaint and used on identical goods. The Supreme Court held:

“For one, as rightly concluded by the CA after comparing the trademarks involved in their entirety as they appear on the products, the striking dissimilarities are significant enough to warn any purchaser that one is different from the other. “Indeed, although the perceived offending word “MARK” is itself prominent in petitioner’s trademarks “MARK VII” and “MARK TEN,” the entire marking system should be considered as a whole and not dissected, because a discerning eye would focus not only on the predominant word but also on the other features appearing in the labels. Only then would such discerning observer draw his conclusion whether one mark would be confusingly similar to the other and whether or not sufficient differences existed between the marks. xxx

But, even if the dominance test were to be used, as urged by the petitioners, but bearing in mind that a trademark serves as a tool to point out distinctly the origin or ownership of the goods to which it is affixed, the likelihood of confusion tantamount to infringement appears to be farfetched. The reason for the origin and/or ownership angle is that unless the words or devices do so point out the origin or ownership, the person who first adopted them cannot be injured by any appropriation or imitation of them by others, nor can the public be deceived.”

As applied in the present case, the word COCO standing by itself do not point out to opposer as the only source of goods bearing that term. In Etepha v. Director of Patents G.R. L. 20635, 31 March 1966, the Supreme Court describes colorable imitation in this wise:

“The phrase “colorable imitation” denotes such a close or ingenious imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive an ordinary purchaser giving such attention as purchaser usually gives, and to cause him to purchase the one supposing it to be the other.” (87 C.J.S. p., 287)

The High Court in Mighty Corporation and La Campana Fabrica de Tabaco, Inc. v. E. & J. Gallo Winery and the Andersons Group, Inc. (G.R. No. 154342. July 14, 2004.) explained:

In determining the likelihood of confusion, the Court must consider: [a] the resemblance between the trademarks; [b] the similarity of the goods to which the trademarks are attached; [c] the likely effect on the purchaser and [d] the registrant's express or implied consent and other fair and equitable considerations.

The Dominancy Test focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception xxx

The Holistic Test requires that the entirety of the marks in question be considered in resolving confusing similarity. Comparison of words is not the only determining factor. The trademarks in their entirety as they appear in their respective labels or hang tags must also be considered in relation to the goods to which they are attached. The discerning eye of the observer must focus not only on the predominant words but also on the other features appearing in both labels in order that he may draw his confusion whether one is confusingly similar to the other.

Applying the dominancy and holistic tests, we find that the dominant feature of the COCO. Yet the appendage of the word VIBE in respondent's mark dispels any possibility of confusion. Applying the holistic test, there are additional elements in the labels such as the picture of a coconut and the style of lettering and color form a unique and distinct visual impression.

Moreover, in determining whether there is a likelihood of confusion in the contemporaneous use of the marks, the type of purchaser and attendant circumstances to the sale must be considered. In *Dy Buncio v. Tan Tiao Bok* 42 Phil 190 (1921), court noted that:

"the "purchaser" is not the "completely unwary consumer" but is the "ordinarily intelligent buyer" considering the type of product involved. 109 He is "accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The simulation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

Thus, giving due regard to the goods' usual purchaser's profile or character and attitude in purchase, the Bureau believes that a customer will not mistake or confuse goods bearing COCO VIBE as the products of the opposer, given the difference in style of presentation of the goods of the respondent-applicant. (Annex "A" of respondent) and the usual style of the opposer's goods. (Annex "B" of opposer) and the nature of the product being purchased. Since these are toiletries, the purchaser would be discriminating in making the purchase.

The opposer also claims to be that its mark is well-known which precludes the registration of respondent-applicant. The law states:

"Sec. 123. *Registrability*. – 123.1 A mark cannot be registered if it:

x x x

(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; x x x”

(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”

The Bureau has earlier held that the marks are not confusingly similar, therefore, there is no need to belabor the issue of well-knownness. The foregoing provision on the protection of well-known mark implies that if a mark is found to meet the criteria of being well-known, registration of a confusingly similar mark is proscribed. Since there is no likelihood of confusion by respondent-applicant’s adoption of the mark COCO VIBE, a finding of whether the opposer’s mark is well-known doe not matter.

WHEREFORE, premises considered the OPPOSITION filed by Channel is, as it is hereby, DENIED. Accordingly, Application Serial No. 4-2006-013327 for the mark COCOVIBE covering goods under Class 3, namely “soaps, liquid soaps, shower and bath gel, shower and bath foams; perfumes, fragrances; cosmetics; essential oils; hair care preparations; hair creams, hair gel, brilliantines, hair shampoo, hair lotions, hair conditioners, hair dyes, hair tonics, hair dressings, hair moisturizers, dandruff creams, dandruff lotions, dandruff tonics; dentifrices; toilet water, eau de cologne; non-medicated showers, and other non-medicated additives for use in bath and in showers; creams, lotions, milks, oils, powders and ointments for the care and the cleansing of the skin, body, hands and feet; deodorants and anti-perspirants for use on the person; talcum powder; after and pre shaving preparations, shaving cream, shaving mousse, shaving gel, shaving oil and shaving foam; cosmetic sun tanning preparations, cosmetic sun-protecting preparations, cosmetic preparations against sun-burn” filed by Tupperware Products S.A. is, as it is, hereby given DUE COURSE.

Let the filewrapper of “COCO VIBE”, subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 23 January 2009.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs