

JEWEL ULTRA LIMITED, Opposer	}	IPC No. 14-2005-00125
	}	Opposition to:
	}	
-versus-	}	Serial No. : 4-2004-009773
	}	Date Filed : 19 October 2004
	}	
THEO, ARTHUR AND SON'S CORP., Respondent-Applicant,	}	Trademark : "DIAMOND AND LOGO"
	}	Decision No. 2006 – 39
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DECISION

This pertains to the Notice of Opposition to the registration of the mark "DIAMOND AND LOGO" bearing Application Serial No. 4-2004-009773 filed on 19 October 2004 for goods falling under Class 3 of the International Classification of goods including floor wax for selective types of floor materials such as cement, wood floors and wood products, which application was published for opposition in the Intellectual Property Office Gazette released for circulation on July 11, 2005.

The Opposer in the above-entitled case is JEWEL ULTRA LIMITED, a company organized and existing under the laws of England, with principal address at 3 Downs Court, Yalding Hill, Maidstone Kent, ME16 6AL England, United Kingdom.

On the other hand, Respondent-Applicant THEO, ARTHUR AND SON'S CORPORATION, a corporation organized under the laws of the Philippines with office address at 6092 General T. De Leon Street, Valenzuela City, Philippines.

The grounds for opposition are as follows:

"1. Plaintiff is not doing business in the Philippines, but has the capacity to sue under Section 160 of Republic Act No. 8293, known as the Intellectual Property Code of the Philippines (hereinafter the "IP Code").

Further, the Regulations on Inter Partes Proceedings, particularly, under Rule 2, Section 4 thereof, provides that:

"Sec. 4. Right of foreign corporation to sue in trademark or service mark enforcement action. – Any foreign national or judicial person whether or not engaged in business in the Philippines may bring a petition for opposition, cancellation or compulsory licensing; Provided, That the country of which he or it is a national, or domiciled or has a real and effective industrial establishment, is a party to any convention, treaty or agreement relating to intellectual property rights or the repression of unfair competition, to which the Philippines is also a party, or extends reciprocal rights to nationals of the Philippines by law."

Plaintiff has its real and effective commercial establishment in England which country is a member of the Paris Convention of which the Philippines is a signatory by virtue of Senate Resolution No. 89 dated May 10, 1965. Clearly, Plaintiff has a right to oppose Respondent's application for registration of the trademark "DIAMOND AND LOGO", notwithstanding that it is not doing business in the Philippines;

"2. The registration of the mark "DIAMOND AND LOGO" in the name of the Respondent-Applicant will violate and contravene the provisions of Section 123 (e), (g), and (m) of the Intellectual Property Code because said mark is

similar to the marks “DIAMONDBRITE” and “DIAMONDBRITE WORD & CAR & DIAMOND DEVICE” owned and unabandoned by the Plaintiff, as to be likely, when applied to or used in connection with the goods of the Respondent-Applicant to cause confusion or mistake in the trade, or deceive purchasers thereof, to such an extent that the goods covered by the said mark “DIAMOND AND LOGO” may be mistaken by the unwary public to be that of Plaintiff’s, or its licensees or franchisees, or that Respondent-Applicant may be mistaken as an affiliate of or in any way connected with the Plaintiff’s business;

“3. The trademarks “DIAMONDBRITE” and “DIAMONDBRITE WORD & CAR & DIAMOND DEVICE” are known all over the world to be exclusively owned by the Plaintiff. Hence, the registration of similar trademark in the name of Respondent-Applicant will be a breach of the clear provisions of Article 6bis of the Paris Convention for the Protection of Industrial Property;

“4. The registration of the trademark “DIAMOND AND LOGO” will cause grave and irreparable injury and damage to the Plaintiff with the meaning of Section 134 of the IP Code.”

In support of the above opposition, Opposer relied on the following facts and circumstances:

“1. Plaintiff, JEWELULTRA LIMITED, is the owner of the internationally well-known trademarks “DIAMONDBRITE” and “DIAMONDBRITE WORD & CAR & DIAMOND DEVICE”. Attached herewith as Annex “B” is the Affidavit-Direct Testimony of John Boseley, Managing Director of JEWELULTRA LIMITED attesting to the truth of this fact Attached as Annex “A” of the aforementioned affidavit is a list of the active registrations and pending applications of the trademark worldwide including Australia, Bahrain, Bosnia and Herzegovina, Canada, China, Croatia, CTM (European Community TM), Egypt, Guyana, Hong Kong, India, International Protocol, Japan, Jersey, Kuwait, Lebanon, Malaysia, Mauritius, New Zealand, Nigeria, Norway, OAPI, Oman, Pakistan, Philippines, Qatar, Saudi Arabia, Taiwan, Ukraine, United Arab Emirates, United Kingdom and the United States, among others. Also attached to the affidavit as annex “B” are some of the certificates of registration which are described as follows, covering the marks which were obtained by Plaintiff in its name:

Country	Trademark	Registration No.	Registration Date
Philippines	DIAMONDBRITE	4-2001-007826	July 8, 2004
South Africa	DIAMONDBRITE	2000/12035	June 12, 2000
Hong Kong	DIAMONDBRITE	B08652	October 16, 2001
Malaysia	DIAMONDBRITE	01013892	October 22, 2001
Hong Kong	DIAMONDBRITE WORD & CAR & DIAMOND DEVICE	B03663	October 16, 2001
Office of the Harmonization in the Internal Market (Community Mark)	DIAMONDBRITE	002620045	June 30, 2003
United States of America	DIAMONDBRITE	2,756,334	August 26, 2003
Saudi Arabia	DIAMONDBRITE	718/20	March 10, 2004
Saudi Arabia	DIAMONDBRITE	718/21	March 10, 2004
United Arab Emirates	DIAMONDBRITE	46072	March 28, 2003
United Arab Emirates	DIAMONDBRITE	44724	March 26, 2003

Bahrain	DIAMONDBRITE	32364	June 21, 2004
United Kingdom	DIAMONDBRITE	2350115	November 27, 2003
United Kingdom	DIAMONDBRITE	2350116	November 27, 2003
New Zealand	DIAMONDBRITE	707548	August 5, 2004
Office of the Harmonization in the Internal Market	DIAMONDBRITE	003562345	November 26, 2003
Croatia	DIAMONDBRITE	Z20040513	March 29, 2004

In the Philippines, Plaintiff has obtained registration for the mark "DIAMONDBRITE" under Certificate of Registration No. 4-2001-007826 and has a pending application for registration of the good in Class 30 under Philippine Trademark Application No. 4-2001-007824.

"2. Plaintiff has earned valuable goodwill as a result of sales generated by products bearing the mark "DIAMONDBRITE" and "DIAMONDBRITE WORD & CAR & DIAMOND DEVICE". The total worldwide sales of the company of the products bearing the aforementioned marks for the last five years (but only up to March 31, 2005) are shown in the following figures:

2001 (01/02/01 to 31/03/02)	£ 19, 555,093.00
2002 (01/04/02 to 31/03/03)	£ 2,012,480.00
2003 (01/04/03 to 31/03/04)	£ 2,425,265.00
2004 (01/04/04 to 31/03/05)	£1,150,600.00

In the Philippines, where products bearing the mark "DIAMONDBRITE" and the trademark "DIAMONDBRITE (WORD & CAR & DIAMOND DEVICE)" are sold thru Form Motor Companies, Land Rover/Jaguar PAG and Volvo, the total sale for the last five years are shown in the following figures:

2001	£ 22,000.00
2002	£ 25,000.00
2003	£ 28,000.00
2004	£ 36,000.00
2005	£ 57,000.00

"3. Plaintiff has spent considerable amount of money, time and effort to promote and advertise its products bearing the marks "DIAMONDBRITE" and "DIAMONDBRITE WORD & CAR & DIAMOND DEVICE". Samples of advertising and promotion materials of the Plaintiff are attached to the affidavit of John Boseley as Annex "C". Following are the figures showing the total expenses of the Plaintiff for worldwide promotion and advertising of products bearing the marks "DIAMONDBRITE" and "DIAMONDBRITE WORD & CAR & DIAMOND DEVICE" for the last five years:

2005	£ 425,000.00
2004	£ 360,000.00
2003	£ 295,000.00
2002	£ 210,000.00
2001	£ 190,000.00

In the Philippines, total expenses of the Plaintiff for advertising and promoting products bearing the marks "DIAMONDBRITE WORD & CAR & DIAMOND DEVICE" for the last five years are shown below:

2005	£ 5,200.00
2004	£ 4,700.00
2003	£ 4,100.00
2002	£ 3,200.00
2001	£ 2,500.00

“4. In the International scenario, and in view of the above worldwide registrations, international promotion and publicity, herein Plaintiff is undoubtedly the true and actual owner of the internationally well-known marks “DIAMONDBRITE” and “DIAMONDBRITE WORD & CAR & DIAMOND DEVICE”. Hence, it would be inconsistent and unjust to have a similar trademark registered in the Philippines, in the name of Respondent-Applicant who is unrelated to and unauthorized by Plaintiff.

“5. Respondent-Applicant’s use of the “DIAMOND LOGO” mark constitutes clothing the former’s business, goods and services with the general appearance of the Plaintiff’s trademarks, since the marks are confusingly similar.

“6. Respondent-Applicant’s business, goods and services are likely to confuse or deceive the purchasing public into believing that the business, goods and services of said Respondent-Applicant are under the sponsorship of the Plaintiff. Respondent-Applicant has obviously clear intentions to have a free-ride and to trade upon the popularity of Plaintiff’s products and goodwill associated therewith. Because of the international popularity of Plaintiff’s marks “DIAMONDBRITE” and “DIAMONDBRITE WORD & CAR & DIAMON DEVICE”, it is evident that Respondent-Applicant seeks to gain immense benefits therefrom, by making it appear that it is associated with Plaintiff.

“7. Further, the use and registration of the mark “DIAMOND AND LOGO” in the name of Respondent-Applicant will cause grave and irreparable injury to the Plaintiff within the meaning of the Intellectual Property Code.”

Upon issuance of Office Order No. 79 (Amendments to the Regulations on Inter Partes Proceedings) which took effect on September 1, 2005, this case was mandatorily covered by the summary rules and in compliance therewith, Opposer submitted the following documentary evidence to support the above opposition:

Exhibits	Description
“A”	Special Power of Attorney
“A-1”	Apostille page or legalization certificate
“A-2”	Authentication page
“A-3”	Affidavit of Good Faith by Ms. Emily O. Viray
“B” to “B-2”	Affidavit-Direct Testimony of Mr. John Boseley, Managing Director of Jewelultra Limited
“B-3”	Apostille page or legalization certificate
“B-4”	Authentication page

<p>“C” to “C-21”</p> <p>“C-22”</p> <p>“C-23”</p> <p>“C-24”</p>	<p>List of active registrations and pending applications of the internationally well-known trademark “DIAMONDBRITE” and “DIAMONDBRITE WORD & CAR & DIAMOND DEVICE” in the name of the company, worldwide</p> <p>Authentication page</p> <p>Notarial Seal and signature of Notary Public Robert D. Ryder of Seven Oaks, England</p> <p>Apostille page or legalization certificate</p>
<p>“D”</p> <p>“D-1” to “D-37”</p> <p>“D-38”</p> <p>“D-39”</p> <p>“D-40”</p>	<p>Cover page</p> <p>Copies of Certificate of Registrations from various countries covering the marks “DIAMONDBRITE” and “DIAMONDBRITE WORD & CAR & DIAMOND DEVICE” in the name of the company, worldwide, as listed on pages 3-4 of the Verified Notice of Opposition</p> <p>Authentication page</p> <p>Notarial Seal and signature of Notary Public Robert D. Ryder of Seven Oaks, England</p> <p>Apostille page or legalization certificate</p>
<p>“E” to “E-55”</p> <p>“E-56”</p> <p>“E-57”</p> <p>“E-58”</p> <p>“E-59”</p>	<p>Samples of advertising and promotion materials of products and/or service depicting the word mark “DIAMONDBRITE” and “DIAMONDBRITE WORD & CAR & DIAMOND DEVICE”</p> <p>Authentication page</p> <p>Notarial Seal and signature of Notary Public Robert D. Ryder of Seven Oaks, England</p> <p>Apostille page or legalization certificate</p> <p>Cover page for the advertising and promotion samples</p>

On December 19, 2005, a Notice to Answer was sent to Respondent-Applicant directing the latter to file its Verified answer to the Notice of Opposition in compliance with Office Order No. 79 within thirty (30) days from receipt of the said Notice.

On January 18, 2006, Respondent-Applicant duly received the Notice to Answer issued by this Office as evidenced by the Registry Return Receipt and for failure of Respondent-Applicant to file its Answer within the reglementary period, this Office issued Order No. 2006-297

dated February 22, 2006, directing the Opposer to submit documents including its position paper and draft decision, if necessary, in support of its opposition.

Opposer duly filed its compliance attaching therewith its opposition paper on April 27, 2006 and received by the Bureau of Legal Affairs on April 28, 2006.

Hence, this case is now deemed submitted for decision on the basis of the verified opposition and supporting documents filed by Opposer.

The issues to be resolved in this case are:

- Whether or not there exists a confusing similarity between the Opposer's trademarks "DIAMONDBRITE" and "DIAMONDBRITE WORD & CAR & DIAMOND DEVICE" and Respondent-Applicant's trademark "DIAMOND LOGO;"
- Whether or not Respondent-Applicant is entitled to the registration of the trademark "DIAMON LOGO" in its favor.

It should be noted that the trademark application being opposed was failed on October 19, 2004 or during the effectivity of Republic Act No. 8293 otherwise known as the Intellectual Property Code of the Philippines. Thus, the applicable provision of law in resolving the issue involved is Sec. 123.1 (d) of R.A. 8293, which provides:

"Section 123. *Registrability.* – 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,
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion.

x x x"

the determinative factor in a contest involving registration of trade mark is not whether the challenged mark would *actually* cause confusion or deception of the purchasers but whether the use of such mark would *likely* cause confusion or mistake on the part of the buying public. x x x 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. (American Wire and Cable Company v. Director of Patents, 31 SCRA 544)

Anent the first use, it is undeniable that the contending marks of Opposer and Respondent-Applicant both contain the word DIAMOND. Opposer's mark is described as "DIAMONDBRITE" and "DIAMONDBRITE WORD & CAR & DIAMOND DEVICE" while that of Respondent-Applicant "DIAMOND & LOGO".

It is settled that in ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, two kinds of tests have been developed – the *Dominancy Test* applied in *Asia Brewery, Inc. v. Court of Appeals*, 224 SCRA 437; *Co Tiong v. Director of Patents*, 95 Phil. 1; *Lim Hoa v. Director of Patents*, 100 Phil. 214; *American Wire & Cable Co. v. Director of Patents*, 31 SCRA 544; *Philippine Nut Industry, Inc. v. Standards Brands, Inc.* 65 SCRA 575; *Converse Rubber Corp. v. Universal Rubber Products, Inc.* 147 SCRA 154; and the *Holistic Test* developed in *Del Monte Corporation v. Court of Appeals*, 181 CRA 410; *Mead*

Johnson & Co. v. N. V. J. Van Dorp., Ltd., 7 SCRA 771; Bristol Myers Co. v. Director of Patents, 17 SCRA 128; Fruit of the Loom, Inc. v. Court of Appeals, 133 SCRA 405.

As its title implies, the test of dominancy focuses on the similarity of the prevalent, essential or dominant features of the competing trademarks which might cause mandates that the entirety of the marks in question must be considered in determining confusingly similarity.

In the case of Philippine Nut Industry, Inc. v. Standard Brands, Inc, and Tiburcio S. Evalle (G.R. No. L-23035, July 31, 1975), the Supreme Court has stated that:

“In case involving infringement of trademarks, it has been held that there is infringement when the use of the mark involved would be likely to cause confusion or mistake in the mind of the public or to deceive purchasers as to the origin or source of the commodity; that whether or not a trademark causes confusion and likely to deceive the public is a question of fact which is to be resolved by applying the “test of dominancy”, meaning, if the competing trademark contains the main or essential or dominant features of another by reason of which confusion and deception are likely to result, then infringement takes place; and that duplication or imitation is not necessary, a similarity of the dominant features of the trademark would be sufficient.”

Applying the foregoing tenets to the present controversy, the question now lies as to what constitute the dominant feature of a label.

The Supreme Court in the same case of Philippine Nut Industry, Inc. v. Standard Brands, Inc. and Tiburcio S. Evalle (ibid.) has resolved the issue as to what constitute the dominant feature of a label, to wit:

“An ordinary word like PLANTERS may be considered as the dominant and striking mark of a label where it is used not merely to describe the nature of the product, but to project the source or origin thereof, and it is so printed across the label in bold letters that it easily attracts and catches the eye of the ordinary consumer and it is that word and none other that sticks in his mind when he thinks of the product.”

Guided by the foregoing ruling, it can be properly concluded that the dominant feature in the Opposer’s “DIAMONDBRITE” and “DIAMONDBRITEWORD & CAR & DIAMOND DEVICE” trademark and that of Respondent-Applicant’s “DIAMOND & LOGO” mark is the word DIAMOND.

The competing trademarks of Opposer and Respondent-Applicant are hereby reproduced for purposes of Comparison:



Opposer’s trademark



Respondent-Applicant's trademark

Upon visual comparison of the contending marks, it can be properly concluded that the word DIAMOND strikingly printed on the labels of Opposer and Respondent-Applicant is the feature that easily attracts and catches the eye of the ordinary consumer. The said conclusion is further strengthened by the fact that both labels contain the word and a drawing or representation of a diamond.

Consistent thereto, if the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place. Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate. (McDonald's Corp., et. al. v. L. C. Big Mak Burger, G. R. No. 143993, August 18, 2004)

Another important factor for consideration is the fact that both marks of Opposer and Respondent-Applicant cover related goods falling under Class 3.

Opposer's mark "DIAMONDBRITE" bearing Registration No. 4-2001-007826 registered on July 8, 2004 includes the following goods, to wit:

"Cleaning, polishing, scouring, waxing, shampooing and abrasive preparations; protective preparations for chrome, rubber, metallic and cellulose painted surfaces, exterior and interior plastic vinyl. Preparations for fabric, carpet and leather protection." (Exhibit "D-1")

On the other hand, Respondent-Applicant's trademark "DIAMOND & LOGO" covers the following goods, to wit:

"Floor wax for selective types of floor materials such as cement, wood floors and wood products,"

Clearly, the marks in dispute cover related goods referring to polishing or waxing preparations. The fact that they apply to different products will not negate the existing confusion as they connote the same purpose and use and flow through the same channels of trade.

Relative thereto, in the case of McDonald's Corp., et.al. vs. L.C. Big Mak Burger (ibid.), our Supreme Court has this to say:

"Whether a hamburger is single, double or triple-decker, and whether wrapped in plastic or Styrofoam it remains the same hamburger food product. Even Respondent's use of the "Big Mak" mark on non-hamburger products cannot excuse their infringement of Petitioner's registered mark, otherwise registered marks will lose their protection under the law."

It appearing under the law and jurisprudence that Opposer has clearly established its right over the registered trademark "DIAMONDBRITE WORD & CAR & DIAMOND DEVICE" which is entitled to protection under the law.

It appearing further that the aforementioned marks of Opposer and Respondent-Applicant's "DIAMOND & LOGO" are confusingly similar, the latter is not entitled to the registration of the mark in its favor.

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Consequently, application bearing Serial No. 4-2004-009773 filed by Respondent-Applicant THEO ARTHUR AND SON'S CORPORATION on October 19, 2004 for the registration of the mark "DIAMOND AND LOGO" used for floor wax for selective types of floor materials such as cement, wood floors and wood products, is hereby REJECTED.

Let the filewrapper of "DIAMOND AND LOGO", subject matter of this case be forwarded to the Administrative, Financial and Human Resource Development Services Bureau (AFHRDSB) for appropriate action in accordance with this Decision with a copy furnished the Bureau of Trademarks (BOT) for information and update of its record.

SO ORDERED.

Makati City, 26 May 2006.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs