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|---------------------------|---|----------------------------|
| MATIMCO, INC.,            | } | IPC No. 14-2007-00233      |
| Opposer,                  | } | Opposition to:             |
|                           | } |                            |
| -versus-                  | } | Serial No. 4-2006-008335   |
|                           | } | Date filed: August 1, 2006 |
| THE DOW CHEMICAL COMPANY, | } | Trademark: "WEATHERMATE"   |
| Respondent-Applicant.     | } | Decision No. 2008-213      |
| x-----x                   |   |                            |

## DECISION

This pertains to a Verified Notice of Opposition filed on 13 August 2007 by herein opposer, Matimco, Inc., with business address at Highway Estancia, Mandaue City, Cebu, against the application filed on 01 August 2006 bearing Serial No. 4-2006-008335 for the registration of the trademark "WEATHERMATE" used for goods in Class 19 of the Classification of Goods, for non-metallic building and construction materials, namely, plastic film used for moisture and vapor barrier to reduce air and vapor infiltration and/or air escape, which application was published in the Intellectual Property Office Official Gazette and officially released for circulation.

The respondent-applicant in this instant opposition is The Dow Chemical Company with business address at Midland Michigan 48674, U.S.A.

The instant case posed the ground for opposing the subject trademark "WEATHERMATE" as follows:

The subject mark "Weathermate" is confusingly similar to the opposer's registered "Weatherwood" marks. Moreover, the subject mark is applied for class 19, the same class where the "Weatherwood" mark is also registered. Thus, the "Weathermate" application should be rejected.

The allegations of facts are provided, to wit:

2. The Opposer, since 1963, has been engaged in the business of selling wood products. Other than WEATHERWOOD, among the Opposer's registered and applied marks are MATWOOD, MATIMCO, INC., HORSE HEAD DEVICE, MAT, TANALIZED, and TANALITH.

3. On July 28, 2005, the Opposer filed an application for registration of the "WEATHERWOOD" as a trademark for Class 19 and was subsequently granted registration on April 23, 2007.

4. Since its adoption in 2005 and its continued use in commerce up to the present day, the "WEATHERWOOD" trademark has been developed and extensively advertised by the Opposer in the Philippines on the following wood products: deck, trellis, walkaway, garden application such as bench, plant boxes, gazebo structure and façade.

5. The Opposer is filing this Opposition against the registration of the mark "WEATHERMATE" on the ground that it creates confusion of origin, source and business – causing injury and damage on the original trademark "WEATHERWOOD". The Opposer is entitled to the preservation of the valuable link between it and the public that has been created by its adoption and use of the "WEATHERWOOD" trademark on its business and products by restraining the use of the mark "WEATHERMATE."

6. The Respondent is applying for the registration of WEATHERMATE for Class 03, (sic) the same Class where the WEATHERWOOD mark is registered.

In support of the opposition, Opposer submitted the following documentary evidence, to wit:

| Exhibits      | Description   |
|---------------|---|
| "A"           | Certification to the effect that "WEATHERWOOD" is "Deemed Registered as of April 23, 2007 and pending issuance of Certificate of Registration |
| "B" to "B-30" | Advertising materials of the Opposer for "WEATHERWOOD"  |

On 20 February 2008, respondent-applicant in compliance to this Bureau's Notice to Answer dated 03 October 2007, submitted its Verified Answer which consists of admissions only in so far as the first sentence of paragraph 6 of the Statement of Facts. As to other allegations in the said Opposition, respondent-applicant specifically denied them, stating in furtherance the following Affirmative and Special Defenses, to wit:

6. Respondent is the registered owner and proprietor of the mark WEATHERMATE for Plastic Film for use in further manufacture, in Class 17 and for Non-metallic Building and Construction Materials, namely, plastic film use for moisture and vapor barrier to reduce air and vapor infiltration and/or air escape falling in Class 19 in Japan, under registrations 5024874 and 5044353; Australia under registration 1125417; Germany under registration 30646734; Canada under registration TMA 601673; Mexico under registrations 721472 and 690209; and Spain under registrations 2724897 and 2724901.

7. In addition to the six countries listed in paragraph 6, Respondent likewise has pending applications for registration of the mark WEATHERMATE in more than five (5) countries around the world, including the United States, China, France, New Zealand and the Philippines. On the other hand, there is no showing that Opposer's mark WEATHERWOOD AND DEVICE is registered in any country other than the Philippines.

8. Respondent first used the mark WEATHERMATE on its products as early as 2001. Opposer claims first use of its trademark WEATHERWOOD AND DEVICE only in 2005.

9. Through the years, Respondent has extensively used the WEATHERMATE mark throughout the world and has marketed its products bearing the WEATHERMATE mark in eleven (11) countries, making WEATHERMATE an internationally famous mark and known around the world to be exclusively owned by Respondent within the meaning of the Paris Convention, the TRIPS Agreement and the Intellectual Property Code of the Philippines. On the other hand, Opposer's trademark WEATHERWOOD AND DEVICE can not be considered as an internationally famous mark within the meaning of the Paris Convention, TRIPS Agreement and the Intellectual Property Code for the Opposer to claim that the registration of Respondent's mark WEATHERMATE would forestall the normal expansion of its business.

10. As a consequence of the Respondent's long, exclusive and uninterrupted use of the mark WEATHERMATE, the multi-country sales of the

WEATHERMATE products and the enormous amount spent for the mark's promotion and advertisement, the WEATHERMATE mark has attained a high degree of fame and popularity, has become a source identifier, and has made the mark attain "secondary meaning" in relation to the goods covered by the mark.

11. On the other hand, Opposer's mark WEATHERWOOD AND DEVICE has a descriptive connotation when used in connection with wood products and, as admitted in the Verified Opposition, the words "WEATHER" and "WOOD" have been used by other parties such that they have become a common descriptive terms to designate all-weather wood products. The late adoption and the limited use and advertisement by Opposer of its WEATHERWOOD AND DEVICE trademark has failed to make the mark attain "secondary meaning" in relation to the goods covered by the said mark.

12. Respondent's mark WEATHERMATE is neither confusingly similar, not identical with the Opposer's mark WEATHERWOOD AND DEVICE nor with other cited marks MATWOOD, MATIMCO, INC., HORSEHEAD DEVICE, MAT, TANALISED and TANALITH.

13. Respondent's mark WEATHERMATE is used on plastic film, as an airborne and house-wrap in Class 17, which is different, unrelated and non-competing with wood products in Class 19, for which Opposer's mark WEATHERWOOD AND DEVICE is registered."

The respondent-applicant did not submit any exhibit, affidavit, or any evidence to support its Answer.

Thereafter, opposer filed its Reply to the respondent-applicant's Answer arguing that the latter pleading is not accompanied by any exhibits, affidavits, or any documentary evidence. Therefore, all the allegations therein are deemed denied for being mere conclusions of fact and law without any basis, including the trademark registrations of "WEATHERMATE" in 6 countries, trademark applications in 5 countries and the proof of use of the subject mark "WEATHERMATE".

Subsequently, during the scheduled Preliminary Conference on 09 April 2008, only counsel for respondent-applicant was present. Opposer's failure to appear despite due notice has caused the waiver of its right to file Position Paper, pursuant to Office Order No. 79, series of 2005.

On 21 April 2008, opposer filed a Manifestation regarding the receipt of the Notice of Preliminary Conference with an attached Position Paper, stating that the said Notice was received by its counsel on 11 April 2008, or two (2) days after the scheduled conference. A copy of this Bureau's Notice of Preliminary Conference and letter envelope exhibiting the dates 11 April and 08 April 2008, respectively, as attached to the Notice, proved opposer's belated receipt of the said Notice.

Considering the justifiable reasons laid by herein opposer, the Position Paper attached to the Manifestation is considered in the adjudication of this instant case.

The issue –

Whether or not there is confusing similarity between opposer's registered trademark "WEATHERWOOD" and respondent-applicant's "WEATHERMATE", both covering class 19 goods.

It is worthy of note that this Bureau has taken note of the allegation of facts of herein respondent-applicant relative to the registrations and the applications for registration of its mark

“WEATHERMATE” (pars. 6 and 7 of the Verified Answer). Further noted was the allegation in paragraph 8 of the Verified Answer of respondent-applicant’s first use of its trademark “WEATHERWOOD AND DEVICE” only in 2005, including the former’s continuous use thereof (pars. 8 and 9 of the Verified Answer).

While these allegations could have spelled the difference as proof of ownership of the mark applied for, respondent-applicant ponderously failed to substantiate its allegations by any exhibits or documentary proof to establish the same. Therefore, all the allegations therein are deemed mere conclusions of fact and law without any basis. It remained to be mere self-styled statements questionable as to its truth or genuineness.

Finding no basis on the claim of respondent-applicant due to the absence of evidence to support the same, this instant case has to be resolved on whether or not confusion is present between the contending marks.

The pertinent provision of law reads as follows:

“Sec. 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, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

x x x

(Emphasis Supplied)

In a contest involving registration of trademark, the determinative factor is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would *likely* cause confusion or mistake on the part of the buying public.

It does not require that the competing trademarks must be so identical as to produce actual error or mistake. It is rather sufficient that the similarity between the two trademarks is such that there is a possibility or likelihood of the older brand mistaking the newer brand for it.

The existence of confusion of trademark or the possibility of deception to the public hinges on “*colorable imitation*”, which has been defined as “such similarity in form, content, words, sound, meaning, special arrangement or general appearance of the trademark or trade name in their overall presentation or in their essential and substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.” (Emerald Garment Mfg. Corp. v Court of Appeals, 251 SCRA 600)

Thus, in resolving the issue of confusing similarity, the law and jurisprudence has developed two kinds of tests – the *Dominancy Test* as applied in a litany of Supreme Court decisions including *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 Standard Brands, Inc.*, 65 SCRA 575; *Converse Rubber Corp. v Universal Rubber Products, Inc.*, 147 SCRA 154; and the *Holistic Test*, as developed in *Del Monte Corporation v Court of Appeals*, 181 SCRA 410; *Mead*

Johnson & Co. v N.V.J. Van Dorp, Ltd., 7 SCRA 771; 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 features, or the main, essential and dominant features of the competing trademarks which might cause confusion or deception.

On the other side of the spectrum, the Holistic Test, in the case of Mighty Corporation v E& J Gallo Winery, 434 SCRA 473, so holds that, “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 conclusion whether one is confusingly similar to the other.

The Honorable Supreme Court has consistently relied on the *Dominancy Test* in determining questions of infringement of trademark, as enunciated in the land mark case of Mc Donald’s Corporation v LC Big Mak, 437 SCRA 10, to wit:

“This Court, however, has relied on the dominancy test rather than the holistic test. The dominancy test considers the dominant features in the competing marks in determining whether they are confusingly similar. Under the dominancy test, courts give greater weight to the similarity of the appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding minor differences. Courts will consider more the aural and visual impressions created by the marks in the public mind, giving little weight to factors like prices, quality outlets and market segments.”

Relying on the foregoing law and jurisprudence, this Bureau finds the word “WEATHER” to be the dominant feature, visually and aurally displayed in the contending marks.

As a matter of fact, the word mark “WEATHER” is the one actually covered by protection of law as the word “WOOD” is disclaimed by herein opposer in its trademark application from (Exhibit “A”). Thus, to duplicate an earlier filed trademark transgresses the right afforded by law to claim exclusive ownership over registered mark to the exclusion of others, unless consent from the registered owner.

The probable confusion of trademarks is moreover determined by the relatedness of goods or the indication of connection leading to possible confusion of source origin of goods. It has been held that “goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores.” (2 Callman, Unfair Competition and Trademarks, p. 1257)

As appearing in opposer’s Certificate of Registration (Exhibit “A”), its trademark “WEATHERWOOD” under class 19 covers wood products for deck, trellis, walkway, garden, application such as bench, plant boxes, gazebos structure and façade. On the other hand, respondent-applicant’s goods, as indicated in the file wrapper records of this subject mark, likewise fall under class 19 for non-metallic building and construction materials, namely, plastic film used for moisture and vapor barrier to reduce air and vapor infiltration and/or air escape.

The goods of opposer vis-à-vis respondent-applicant’s products may be different in attributes and form. Nonetheless they are deemed related goods because they are both construction materials and they flow through the same channels of trade. Thus, it is likely that these goods maybe sold commercially in the same market and has common class of purchasers. Apparels, foot wears, and body accessories and marketed similarly because these items are

generally displayed and offered for sale in boutiques or department stores with greater chances that they will be placed or displayed in the shelves side-by-side.

The goods which the contending marks respectively carry are likely to arise to confusion of source or origin. This exists when, "in view of the similarity or identicalness of the marks involved, one party's product or service, though different from that of another or on which the latter does not use his mark, is such as might reasonably be assumed to originate from the latter and as to likely deceive the public into the belief that there is some business association between the parties which, in fact, is absent." (Sterling Products International, Inc. v Farbenfabriken Bayer Aktiengesellschaft, 27 SCRA 1214)

Therefore, this Bureau finds confusing similarity between opposer's "WEATHERWOOD and DEVICE" and respondent-applicant's "WEATHERMATE". Finally, it bears stressing that pursuant to section 123.1 (d), supra., opposer's aforementioned trademark was applied for registration on 28 July 2005 and is deemed registered on 23 April 2007, marking a priority date vis-à-vis respondent-applicant's application for registration of its subject mark on 10 August 2006.

WHEREFORE, the Notice of Opposition is hereby SUSTAINED. Consequently, application bearing Serial No. 4-2006-008335 filed by respondent-applicant The Dow Chemical Co. on 01 August 2006 for the registration of the mark "WEATHERMATE" used under Class 10 of the Nice Classification of Goods covering the aforementioned goods is, as it is, hereby REJECTED.

Let the file wrapper of "WEATHERMATE", subject matter in this case together with a copy of this decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 19 December 2008.

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