

WELLA AKTIENGESELLSCHAFT,	}	IPC No. 14-2008-00088
Opposer,	}	Case Filed on: April 14, 2008
	}	
-versus-	}	Opposition to:
	}	Appln. Serial No. 4-2007-006279
CHAMPION INTERLINK GROUP	}	Date Filed: 23 July 2007
CORP.,	}	TM: "WELLA"
Respondent-Applicant.	}	DECISION NO. 2008-184
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## DECISION

Before us is the Verified Notice of Opposition filed against the application for registration of the mark "WELLA" used for pregnancy test kit, gauze, surgical tape, dressing material under Class 05 and for syringe, intravenous catheter, suture, infusion set, catheter, sphygmomanometer under Class 10 of the international classification of goods bearing Application Serial No. 4-2007-007794 filed by Respondent Champion Interlink Group Corp. which was published in the Intellectual Property Office Electronic Gazette, released for circulation on 14 December 2007.

Opposer, Wella Aktiengesellschaft, is a company organized under the laws of the Germany, with address at Berliner Allee 65 D-64274 Darmstadt, Germany, while Respondent-Applicant Champion Interlink Group Corp., is a domestic corporation, with address at 165 Don Manuel Agregado Street corner Sto. Domingo Avenue, Quezon City.

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

"1. The registration of the mark subject of this opposition is contrary to the provisions of Sections 123.1 (d), (e) and (f) of the Republic Act No. 8293, as amended;

2. Opposer is the owner of and has the exclusive rights over the world-famous WELLA trademark;

3. The mark WELLA is registered in Opposer's name with the Philippines Intellectual Property Office in Class 3. The details of the registration appear below:

Mark	Registration No.	Date Issued	Class
WELLA	012150	03 March 1966	3

9. The Opposer has extensively promoted the trademark WELLA worldwide. Over the years, the Opposer has obtained significant exposure for the goods upon which the trademark WELLA is used in various media, including television commercials, advertisements, internationally well-known print publications, and other promotional events.

10. The Opposer has not consented to the Respondent-Applicant's use and registration of the WELLA trademark, or any other mark identical or similar to a well-known trademark WELLA.

11. The Respondent-Applicant's use of the WELLA mark on its goods in classes 5 and 10 and other goods that are similar, identical or closely related to the goods that are produced by, originate from, or under the sponsorship of the Opposer. Potential damage to the Opposer will also be caused as a result of its inability to control the quality of the products offered or put on the market by Respondent-Applicant under the WELLA mark.

12. The use by the Respondent-Applicant of the mark subject of this opposition in relation to its goods, whether or not identical, similar or closely related to the Opposer's goods will take unfair advantage of, dilute and diminish the distinctive character and reputation of the well-known trademark WELLA.

13. The denial of the application subject of this opposition is authorized under other provisions of the Republic Act No. 8293.

Together with the Verified Opposition (Exhibit "A"), Opposer submitted the following pieces of evidence:

Exhibits	Description of Documents
"B"	Authenticated Affidavit of Mr. Klaus Peter Schmitz-Weckauf
"B-1"	List of international registration and applications for the WELLA word mark
"B-2"	List of international registrations and applications for WELLA and Woman's Head Device and WELLA PROFESSIONALS and Woman's Head Device
"C"	Affidavit of Mr. Reylonn Marcelo
"C-1"	Screenshots featuring Wella products taken from the Wella Philippines website, <a href="http://www.wella.com.ph">www.wella.com.ph</a>
"C-2"	Photographs of product bearing the WELLA trademark
"C-3"	Schedule of Seminar at the Wella Studio for 2008
"C-4"	Sample print advertisements
"C-5" and "C-6"	Mega Magazine sales invoice no. 20022 dated February 15, 2008 and Mega Magazine sales invoice no. 20106 dated February 22, 2008 each for ad placements for Wella products
"D"	Affidavit of Althea Olivar-Duque
"D-1"	OR No. 8433 issued by Paladin Beauty Shop for the purchase Wella Pure Lotion
"D-2"	Manual Cash Invoice No. 0272568B issued by the Landmark for the purchase of Wella Decore Color Cream
"D-3"	OR No. 5392 issued by G & J Salon, Inc. for the purchase of Wella High hair Pure Glamour
"D-4"	Cash Invoice No. 215403 issued by Pacita, Inc. for the purchase of Wella High Hair Styling Mousse.
"D-5"	Picture of Wella High Hair Pure Crystal Lotion
"D-6"	Picture of Wella Decore Color Cream
"D-7"	Picture of Wella High Hair Pure Glamour
"D-8"	Picture of Wella High Hair Styling Mousse

"E"	Wella High Hair Pure Crystal Lotion sample
"F"	Wella Decore Color Cream sample
"G"	Wella High Hair Glamour Shine Fluid
"H"	Wella High Hair Styling Mousse sample
"I"	Certified copy of Philippine Certificate of Renewal of Registration No. 12150 for WELLA
"J"	Certified copy of Philippine Certificate of Registration No. 64343 for WELLA & DEVICE
"K"	Certified copy of Philippine Certificate of Renewal of Registration No. 33607 for WELLAZID
"L"	Certified copy of Philippine Certificate of Registration No. 55364 for WELAPOR
"M"	Certified copy of Application No. 4-2007-008148 for WELLA PROFESSIONALS (& WOMAN'S HEAD DEVICE) deemed registered on 10 December 2007
"N"	Original legalized Certificate showing authority of Mr. Klauz Peter Schmitz-Weckauf

On April 29, 2008, a Notice to Answer was issued by this Bureau to the herein Respondent-Applicant which notice was served personally to Respondent-Applicant's representative Michael G. Lui M.D. on May 28, 2008. Despite having received the notice, Respondent-Applicant failed to file its Answer within the reglementary period. Thus, on 20 August 2008, Order No. 2008-1182 was issued waiving Respondent-Applicant's right to file answer and supporting documents and submitting this case for decision. On September 9, 2008, Opposer filed its Position Paper.

The main issue to be resolved in this case is: Whether or not Respondent-applicant's mark "WELLA" should be registered.

To determine the registrability of a mark, the applicable provision of Republic Act No. 8293, as amended particularly Section 123.1 (d) the said section provides:

"Section 123.1 (d) and (f) of Republic act No. 8293, as amended, provides:



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

x 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;"

The marks of the parties are hereunder reproduced for comparison:

Opposer's marks	Respondent-Applicant's Mark
	

Indeed, as correctly pointed out by Opposer, the above marks need no further comparison to show that Respondent-Applicant's mark WELLA is similar in spelling and appearance with the Opposer's registered mark WELLA. Both marks have the same five (5) letters, which are arranged precisely in the same way. Except for the font used, there is no other difference between the marks as to distinguish one from the other. Respondent-Applicant's mark is clearly a literal copy of the Opposer's mark. It is also phonetically identical with Opposer's mark. In view of their similarity, what remains to be determined is whether Respondent-Applicant's use of the similar mark would cause confusion or mistake on the public as to the source or origin of the goods with which Respondent-Applicant deals. The rule that ownership of a trademark or trade name is a right that the owner is entitled to protect has been upheld in our jurisdiction. This is supported by Section 138 of Republic Act No. 8293 which states that: "a certificate of registration is a *prima facie* evidence of the registrant's ownership of the mark, and of the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto". However, when a trademark is used by a party on a product in which the other party does not deal, the use of a same trademark on the latter's product cannot be validly objected to. In the instant case, Opposer's mark is used on preparations for use in treatment of hair namely, hair dyes, hair lotions, hair creams, hair lacquers, liquid hair conditioners, preparations for waving and curling the hair under Class 3 while Respondent-Applicant's mark is for use on pregnancy test kit, gauze, surgical tape, dressing material under Class 05 and for syringe, intravenous catheter, suture, infusion set, catheter, sphygmomanometer under Class 10 of the international classification of goods. Considering that the goods upon which the contending marks are being used belong to different classes, what remains to be reckoned now is whether such goods are related and competing.

In the often-cited case of *ESSO STANDARD EASTERN, INC. vs. COURT OF APPEALS*, the Supreme Court held that:

"Goods are related when they belong to the same class or have the same class or descriptive properties; when they possess the same physical attributes or essential characters with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or sold in grocery store. Thus, biscuits were held related to milk because they are both food products. Soap and perfume, lipstick and nail polish are similarly related because they are common household items nowadays. The trademark "Ang Tibay" for shoes and slippers and pants were disallowed to be used for shirts and pants because they belong to the same general class of goods. Soap and pomade, although non-competitive, were held to be similar or to belong to the same class, since both are toilet articles."

In the case of *FABERGE, INCORPORATED vs. INTERMEDIATE APPELLATE COURT*, the High Court stated: "judging from the physical attributes of petitioner's and private respondent's products, there can be no doubt that confusion or the likelihood of deception to the average purchaser is unlikely since the goods are non-competing and unrelated." The glaring discrepancies between the two products had been amply portrayed to such an extent that indeed, a purchaser who is out in the market for the purpose of buying respondent's BRUTE brief would definitely be not mistaken or misled into buying BRUT after shave lotion or

deodorant” as categorically opined in the decision of the Director of Patents relative to the inter-partes case.” (Underscoring supplied)

A comparison of the goods of the parties is herein tabulated:

Distinctions	Opposer’s Goods/Products	Respondent-Applicant’s Goods/Products
A. Classification of Goods	Class 03 “preparations for use in treatment of hair namely, hair dyes, hair lotions, hair creams, hair lacquers, liquid hair conditioners, preparations for waving and curling the hair.”	Class 05 “pregnancy test kit, gauze, surgical tape, dressing material”; and  Class 10 “syringe, intravenous catheter, suture, infusion set, catheter, sphygmomanometer”
B. Where the Goods are sold	Salons and Department Stores	Drugstores, Hospitals and Medical Supply Stores

Judging from the above matrix, indubitably, Respondent-Applicant’s goods are unrelated or non-competing against the goods of Opposer. The goods of the parties do not have the same descriptive properties. They do not have similar physical attributes or essential characteristics. In the same manner, the parties’ goods serve different purpose and are sold through different trade channels. Respondent-Applicant’s goods medical related goods and made available through hospitals, drugstores and medical supply stores. On the other hand, Opposer’s hair products are being sold in department stores and salons. The disparity of the goods of the parties buttress the fact that it is unlikely that the use by Respondent-Applicant of the mark on its goods would likely cause confusion or mistake on the buying public or that it will deceive and/or confuse purchasers into believing that Respondent-Applicant’s goods and/or products bearing the trademark WELLA emanate from or are under the sponsorship of Opposer. The mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the trademark by others on unrelated articles of a different kind. Thus, the evident disparity of the products of the parties in the case at bar renders unfounded the apprehension of Opposer that confusion of business or origin might occur if Respondent-Applicant is allowed to use the mark WELLA.

And on Opposer’s argument that Respondent-Applicant’s mark should be barred from registration since it is similar to its well-known WELLA mark, Section 123.1 (f) of Republic Act No. 8293 is applicable, which states:

“SEC. 123. *Registrability.* – 123.1 A mark cannot be registered if it:

x 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.”

Applying the above-cited provision, in order to bar registration, the use of a mark similar to a well-known mark used on different goods should indicate a connection to the owner of the registered mark. In this case, assuming *arguendo* that Opposer’s WELLA mark is well-known, still it cannot bar the registration of Respondent-Applicant’s mark for the reason that the use of such similar mark on the goods of Respondent-Applicant does not indicate any connection with

Opposer as the goods of Opposer and Respondent-Applicant are entirely antithetic or diverge from each other.

WHEREFORE, premises considered, the Notice of Verified Opposition filed by Opposer, WELLA AKTIENGESELLSCHAFT against respondent-applicant CHAMPION INTERLINK GROUP, INC. is, as it is hereby DENIED. Consequently, the trademark application for the registration of the mark "WELLA" used for pregnancy test kit, gauze, surgical tape, dressing material underclass 05 and for syringe, intravenous catheter, suture, infusion set, catheter, sphygmomanometer under Class 10 of the international classification of goods bearing Application Serial No. 4-2007-007794 filed by respondent-applicant Champion Interlink Group, Inc. filed on July 23, 2007 is, as it is hereby, GIVEN DUE COURSE.

Let the filewrapper of WELLA be transmitted to the Bureau of Trademarks (BOT) for appropriate action in accordance with this DECISION.

SO ORDERED.

Makati City, 16 October 2008.

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