



CHANEL SARL,
Opposer,

-versus-

BEE YOUNG GO,
Respondent-Applicant.

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}
} IPC No. 14-2010-00082
} Opposition to:
} Appl. Serial No. 4-2009-003319
} Date Filed: 31 March 2009
} TM: "BEST COCO AND
} DEVICE"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 06 dated January 16, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 16, 2013.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



CHANEL SARL,	}	IPC No. 14-2010-00082
Opposer,	}	Opposition to:
	}	Appln. Serial No. 4-2009-003319
- versus -	}	Date Filed: 31 March 2009
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BEE YOUNG GO,	}	
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DECISION

Opposer, CHANEL SARL ("Opposer"), filed an Opposition to Trademark Application Serial No. 4-2009-003319. The application filed by BEE YOUNG GO² ("Respondent-Applicant") covers the mark BEST COCO for use on "hair color cream, developer lotion, bleaching powder, hair care cream, hair conditioner, hair restore liquid, style mud, hair style gel, hair foam gel liquid, hair gel liquid, hairstyle spray gel, hair spray fixture, perm liquid, straight hair liquid" under Class 03 of the International Classification of Goods.³ The Opposer alleges the following:

"1. Opposer is the registered owner in the Philippines of COCO for goods in Class 3 under Registration No. 16026 issued by the IPO. Opposer is likewise the registered owner in the Philippines of registration No. 54979 for COCO CHANEL and Registration No. 047068 for COCO CHANEL OPEN CARTON, both covering "soaps, perfumery, essential oils, cosmetics, lotions for the hair and dentifrices" in Class 3 (hereinafter collectively referred to as the 'COCO Marks').

"2. Opposer has been using the COCO Marks in most countries since 1984 and, through long and uninterrupted advertising, the COCO Marks have become inextricably linked with Chanel throughout the world and in the Philippines, particularly in relation to fragrances and related cosmetic products. COCO was first registered in the Philippines by Opposer in 1970 and has been in use in the Philippines since 1999, long before Respondent-Applicant appropriated the mark BEST COCO for identical or similar goods.

"3. Respondent-Applicant's trademark BEST COCO wholly incorporates COCO and so resembles Opposer's COCO as to be likely, when applied to or used in connection with beauty products, 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.

"4. When looked at side by side in their entirety, as applied for, BEST COCO and COCO create a similar overall impression. COCO is unquestionably the dominant portion of Respondent-Applicant's mark and the word "best" does not change or

1 A corporation duly organized under the laws of Switzerland with business address at Burgstrasse 26, CH 8750 Glarjus, Switzerland.

2 A Filipino citizen with address at 1321 E. Rodriguez Avenue, Quezon City.

3 The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

alter the dominant emphasis of COCO or the meaning of the mark in any way. On the contrary, the different color claims for each of the two portion of Respondent-Applicant's mark further accentuates COCO as the dominant portion of the BEST COCO mark.

"5. There is nothing inherent in the BEST COCO mark or in the goods listed in Class 3 suggesting that the mark is somehow limited to coconut derived products or is otherwise distinguishable from Opposer's COCO Marks.

"6. The goods listed in Respondent-Applicant's BEST COCO application in class 3 are identical or closely related to the goods for which Opposer's COCO Marks are used and registered. Opposer's COCO and COCO MADEMOISELLE Trademarks are used on *inter alia*, fragrances, soaps and various cosmetic products such as body lotions bath and shower gels and fragranced powder.

"7. The registration and use by Respondent-Applicant of the Trademark BEST COCO in relation to beauty products will diminish the distinctiveness and dilute the goodwill of Opposer's COCO Marks. The COCO Trademark has been recognized as well-known by courts and Intellectual Property Offices in numerous years, there is no question that COCO is exclusively associated with Chanel for fragrances and related products in Class 3.

"8. Given the worldwide recognition and prior use of Opposer's COCO Marks in the Philippines, there is no clear reason for Respondent-Applicant to have adopted the BEST COCO Mark, other than to trade on the goodwill and worldwide recognition of the COCO Marks, thereby misleading the public into believing that its identical or similar goods bearing the trademark originate from, or are licensed or sponsored by Opposer, which has been identified in the trade and consumers as the exclusive source of fragrances and related products bearing the COCO Marks.

"9. The approval of Respondent-Applicant's trademark BEST COCO is based on the representation that it's the originator, true owner and first user of the trademark 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.

"10. Opposer is the first user of the COCO Marks in the Philippine commerce and elsewhere, having utilized the same since at least 1999 in the Philippines. Respondent-Applicant's use of a confusingly similar mark as the brand name for its own related products is likely to cause confusion as to the origin of said goods.

"11. Respondent-Applicant's use of the trademark BEST COCO infringes upon Opposer's exclusive right to use the COCO Marks, which are well-known trademark 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.

"To support this opposition, Opposer will prove and rely upon, among other facts, the following:

"1. Opposer adopted and has been using the COCO Marks for fragrances and related cosmetic products for over 20 years throughout the world, long before Respondent-Applicant's adoption of the confusingly similar trademark BEST COCO. Opposer has been commercially using the COCO Mark in the Philippines since at least 1999 LONG before the filing of the application for the registration of

the trademark BEST COCO by Respondent-Applicant in the year 2009. Opposer has been using the COCO MADEMOISELLE trade mark since 2001.

"2. Opposer is the first user and rightful owner of the COCO Marks. Opposer and its related companies have also used and registered or applied for the registration of the COCO Marks in over 150 countries worldwide. There is no reason for Respondent-Applicant to adopt the BEST COCO mark, which wholly incorporates Opposer's COCO Marks, other than trade on Opposer's reputation.

"3. Opposer is the first user of the COCO Marks for the above mentioned goods. Respondent-Applicant has appropriated the trademark BEST COCO for the purpose of capitalizing upon the renown of Opposer's self promoting trademark by misleading the public into believing that its goods originate from, or are licensed or sponsored by Opposer.

"4. The registration and use of a nearly identical trademark by the Respondent-Applicant in relation to identical or similar goods in Class 3 will tend to deceive and/or confuse purchasers into believing that Respondent-Applicant's products emanate from or under the sponsorship of Opposer and damage Opposer's interests for the following reasons:

- i. When comparing COCO and BEST COCO side by side, the similarities of the prevalent features of the marks are significant. The addition of the word "best" does nothing to distinguish the overall commercial impression of the marks.
- ii. COCO is derived from the name of Chanel's founder, Coco Chanel, and is recognized as such around the world, particularly in relation to fragrances and related products.
- iii. The goods on which BEST COCO will be used are closely related or identical to those for which Opposer uses, and has registered the COCO Marks.
- iv. Respondent-Applicant's unauthorized appropriation and use of the trademark BEST COCO will dilute Opposer's reputation and goodwill among consumers because COCO has become exclusively associated with Chanel for fragrances and related cosmetics.
- v. Respondent-Applicant has applied to register the trademark BEST COCO as a self-promoting trademark to gain public acceptability for its products through its association with Opposer's popular COCO Marks, which have attained international renown for products of the finest quality.
- vi. Respondent-Applicant intends to trade, and is trading on, Opposer's goodwill.

"5. The registration and use of a nearly identical trademark by Respondent-Applicant for similar or identical goods in Class 3 will diminish the distinctiveness and dilute the goodwill of Opposer's COCO Marks.

The Opposer's evidence consists of the following:

1. legalized and authenticated copy of Special Power of Attorney;
2. legalized and authenticated Affidavit of Ms. Vanessa Riviere;
3. copy of Times/CBS New: People of the Last One Hundred Years [Simon and Schuster 1999]
4. copies of Registration No. 016026 for the COCO mark; Registration No. 054979 for COCO CHANEL; and Registration No. 047068 for the COCO CHANEL CARTON;
5. copies of the selected commercial invoices and delivery notices showing sales of products bearing Chanel's Coco Marks in the Philippines;
6. list of registrations of the Coco Marks in over 150 countries;
7. select sampling of Certificates of Registrations for the Coco Marks covering Class 3;
8. advertisements for Chanel's products bearing the Coco Marks in selected magazines and periodicals circulated worldwide;
9. selected court decisions in other countries involving the Coco Marks; and
10. selected editorials and press clippings from various publications showing the Coco Marks.⁴

The Respondent-Applicant filed its Answer on 05 June 2009, alleging among other things, the following:

AFFIRMATIVE DEFENSES

"7. Respondent-Applicant reiterates the foregoing by way of reference as part and parcel of the instant affirmative defenses;

"8. Moreover, respondent-applicant alleges by way of affirmative defenses that the Notice of Opposition should be denied on the following:

GROUND S

"I.

With due respect, Opposer does not have the legal capacity to institute the instant opposition.

"II.

With due respect, the alleged authorized signatory has not been authorized through a board resolution duly issued by the Board of Directors of Channel SARL.

"III.

With due respect, the mark of the respondent-applicant will not cause confusion, mistake and deception on the part of the prudent purchasing public.

"IV.

With due respect, the mark of the Opposer is not well known internationally or locally."

The Respondent-Applicant's evidence consists of the following:

1. copy of the Registration No. 42009004284 for the Opposer's mark COCO downloaded from the IPOPHL TM database;

2. copy of the Application Serial No. 42009003319 for the mark BEST COCO of Respondent-Applicant downloaded from IPOPHL's TM database;
3. sample Official Receipts issued by Respondent's corporation evidencing sales its product carrying the mark BEST COCO.⁵

On 27 September 2010, the Preliminary Conference was terminated. Then after, the Opposer filed its Position Paper on 15 November 2010 while the Respondent-Applicant did so on 02 December 2010.

The Respondent-Applicant raised the issue that the instant opposition should be dismissed on the grounds that the Opposer has no legal capacity to institute the instant opposition because it is a foreign corporation doing business in the Philippines without a license and, that the alleged signatory of the Opposer has not been authorized through board resolution duly issued by the Board of Directors of Opposer.

According to the Respondent-Applicant, the Opposer being a foreign corporation is bound to comply with the laws, rules and regulations applicable to domestic corporations of the same class. Its capacity to sue must be affirmatively alleged in its Notice of Opposition in order that it may proceed to effectively institute a case in the Philippine courts or administrative agencies.

In this regard, contrary to the Respondent-Applicant's contention that the Opposer has no legal capacity to sue, the Opposer's right to sue is defined under Section 160 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IPCode"), to wit:

Sec. 160. Right of Foreign Corporation to Sue in Trademark or Service Mark Enforcement Action. - Any Foreign national or juridical person who meets the requirements of Section 3 of this Act and does not engage in business in the Philippines may bring a civil or administrative action hereunder for opposition, cancellation, infringement, unfair competition, or false designation or origin and false description, whether or not it is licensed to do business in the Philippines under existing laws.

Corollarily, the right of a foreign corporation under Section 160 must meet the qualifications stated in Section 3 of the IP Code, which states:

Section 3. International Conventions and Reciprocity. Any person who is a national or who is domiciled or has a real or effective business establishment in a country which 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, shall be entitled to the benefits to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of an intellectual property right is otherwise entitled by this Act.

This Bureau noted that the Opposer is filing the instant opposition under under

⁵ Marked as Exhibits "1" to "3".

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. The Opposer's country of origin or domicile, *i.e.* Switzerland, is a member-nation of or a signatory to the Paris Convention on Protection of Industrial Property Rights and the World Trade Organization and the Agreement on Trade-Related Aspects of Intellectual Property Rights which grants to corporate and juristic persons of the Philippines the privilege of bringing similar actions for protection of industrial property rights in its country or origin or domicile.

The Respondent-Applicant also alleges that if the alleged authorized signatory was not in fact duly authorized by the Opposer's board of directors, then the verification, certification of non-forum shopping and special power of attorney ("SPA") executed in favor of Opposer's counsel are invalid and has no legal effect.

The records show that Vanessa Riviere, purportedly, the "Authorized Signatory" of the Opposer signed the verification and certification of non-forum shopping attached to the notice of opposition and executed and signed an SPA constituting and appointing as its attorney-in-fact, SYCIP SALAZAR HERNANDEZ & GATMAITAN. However, no document, specifically a Board Resolution or Secretary's Certificate, was submitted establishing her legal personality or authority to act on behalf of Opposer Company and to authorize the said law office through an SPA to prosecute the instant case.

It is well settled that it is obligatory for the one signing the verification and certification against forum shopping on behalf of the principal party or the other petitioners that he/she has the authority to do the same.⁶ If the real party-in-interest is a corporate body, an officer of the corporation can sign the certification against forum shopping so long as he has been duly authorized by a resolution of its board of directors.⁷ If the certification against forum shopping signed by a person on behalf of a corporation, is unaccompanied by proof that said signatory is authorized to file a petition on behalf of the corporation, the same shall be sufficient ground to dismiss the case.⁸

WHEREFORE, premises considered, the instant Opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2009-003319 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 16 January 2013.


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

⁶ Fuentabella vs. Rolling Hills Memorial Park, G.R. No. 150865, 30 June 2006.

⁷ *Supra*.

⁸ Mediserv, Inc. vs. Court of Appeals, et al., G.R. No. 161368, 05 April 2010.