



THE PROCTER & GAMBLE COMPANY,  
Opposer,

-versus-

CHAMPION INTERLINK GROUP CORP.,  
Respondent –Applicant.

X-----X

IPC No. 14-2011-00157

Opposition to:

Appln. Serial No. 4-2010-009289

Filing Date: 24 August 2010

TM: "REJOICE"

### NOTICE OF DECISION

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#### GREETINGS:

Please be informed that Decision No. 2014 - 81 dated March 25, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 25, 2014.

For the Director:

*Edwin G. Dating*  
Atty. EDWIN DANILO A. DATING

Director III

Bureau of Legal Affairs



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**CHAMPION INTERLINK GROUP CORP.,**  
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**IPC No. 14-2011-00157**

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Filing Date: 24 August 2010

Trademark: **"REJOICE"**

Decision No. 2014 - 81

### DECISION

THE PROCTER & GAMBLE COMPANY ("Opposer")<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2010-009289. The application, filed by CHAMPION INTERLINK GROUP CORP. ("Respondent-Applicant")<sup>2</sup>, covers the mark "REJOICE" for use on "medical patch" and "pregnancy test, sutures, BP apparatus" under classes 05 and 01, respectively of the International Classification of Goods and Services<sup>3</sup>.

The Opposer alleges among other things the following:

"1. The registration of the REJOICE trademark in the Respondent-Applicant's name is contrary to the provisions of Sections 123.1 (d), (e) and (f) of Republic Act No. 8293, as amended, which prohibit the registration of a mark, x x x

"2. Opposer is the owner of and has exclusive rights over the world famous and well known REJOICE trademark. The REJOICE trademark is used, among others, in connection with shampoos and other reparations for the care, treatment and beautification of the hair and scalp.

"3. The REJOICE mark and other marks incorporating the same REJOICE mark are registered in the Opposer's name with the Philippine Intellectual Property Office in class 3. x x x

"4. Respondent-Applicant's REJOICE trademark is confusingly similar to the Opposer's world famous and well-known REJOICE trademark. Respondent-Applicant's REJOICE mark is identical and confusingly similar in terms of spelling, pronunciation and appearance to the Opposer's REJOICE mark. Ostensibly, one may mistake the other as one and the same, effectively diluting and diminishing the unique REJOICE word mark. Hence, the registration of the Respondent-Applicant's mark will be contrary to Section 123.1 (d) of Republic Act No. 8293.

"5. The Opposer is entitled to the benefits granted to foreign nationals under Section 3 of Republic Act No. 8293, x x x

"6. The REJOICE trademark is well-known and world-famous. Hence, the registration of the Respondent-Applicant's REJOICE mark will constitute a violation of Articles 6bis and 10bis of

<sup>1</sup> A corporation duly organized and existing under the laws of the United States of America with principal office located at One Procter & Gamble Plaza, Cincinnati, Ohio 45202, USA.

<sup>2</sup> A corporation with principal office address at 165 Don Manuel St., Sto. Domingo Avenue, Quezon City, Philippines.

<sup>3</sup> The Nice Classification of goods and services is for registering trademark and service marks, based on a Multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

the Paris Convention in conjunction with Sections 3, 123.1(e), and 123.1(f) of Republic Act No. 8293.

"7. The Opposer is the first user and registrant of the REJOICE trademark. In the Philippines, products bearing the trademark have been commercially available for retail since as early as 1989 and prior to the filing date of the application subject of this opposition.

"8. The Opposer has extensively promoted the REJOICE trademark worldwide. Over the years, the Opposer has obtained significant exposure for its REJOICE in various media, including television commercials, advertisements, internationally well-known print publications, the internet, and other promotional events.

"9. The Opposer has not consented to the Respondent-Applicant's use and registration of any trademark that is identical to or similar to the well-known REJOICE trademark.

"10. The Respondent-Applicant's use of the REJOICE trademark on goods in class 3 will mislead the purchasing public into believing that the Respondent-Applicant's goods are produced by, originate from, or are 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 REJOICE trademark.

"11. The use by the Respondent-Applicant of the REJOICE trademark 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 or reputation of the world famous and well known REJOICE trademark."

The Opposer's evidence consists of the following

1. Exhibit "A" - Verified Notice of Opposition;
2. Exhibit "B" - Affidavit of Susan Felder;
3. Exhibit "C" - List of registered and pending marks for REJOICE worldwide;
4. Exhibits "D" - "D-6"- Certified true copies of the Philippine certificates of trademark registration for REJOICE and its variants; and,
5. Exhibit "E" - Secretary's Certificate.

The Respondent-Registrant filed its Verified Answer on 12 September 2011 alleging among other things the following:

"1. The registration of the REJOICE trademark in respondent-applicant's does not contravene the provisions of Sections 123.1 (d), (e), and (f) of the Republic Act No. 8293, as amended. In the first place, the opposer does not, or cannot even specify which of the three (3) paragraphs - par. (d), (e) or (f), respondent-applicant is allegedly to have violated. Certainly, a simple reading of the paragraph would reveal that a party cannot violate all three (3) paragraphs simultaneously.

x x x

"3. It is readily acknowledged that respondent-applicant's mark is identical to opposer's REJOICE trademark. However, it is not identical to the opposer's mark with respect to (i) the goods or services, or (ii) as closely related goods or services, or (iii) its resemblance with the mark as to likely deceive or cause confusion.

"4. The records will plainly show that opposer's goods are under Class 3, while respondent-applicant's goods are governed by Class 5 and 10. Clearly the parties do not share the same goods or services. Neither can it be said that goods involved are closely related goods. Opposer's shampoo products under Class 3 will never be confused with respondent-applicant's medical products, under Classes 5 and 10, specifically, medical patches and pregnancy test kits. Moreover, opposer is a manufacturer of hair care products while respondent-applicant is an importer of medical equipment produced in People's Republic of China.

x x x

"7. Even in the unlikely event that confusion would exist as to the origin of respondent-applicant's products and/or connection with that of opposer, the nature of respondent-applicant's products would militate against such from happening. As per Philippine Food and Drugs Administration (FDA) rules, respondent-applicant is required to print the name of the manufacturer and importer on the product packaging. In addition, respondent-applicant's products are only sold over the drug store counter and dispensed by trained pharmacists.

"8. Meanwhile, a simple comparison of opposer's REJOICE marks and that of respondent-applicant will immediately show that despite sharing identical marks, they do not share the same font or stylized design. It should be noted that respondent makes constant use of a smiley emotion for its letter 'O' in 'REJOICE', which opposer does not use. Respondent-applicant's stylized mark is therefore, unique and distinct.

"9. In comparing the marks, various factors need to be considered, such as the dominant color, style, size, form, meaning of letters, words, designs and emblems used, the likelihood of deception of the mark or name's tendency to confuse and the commercial impression likely to be conveyed by the trademarks if used in conjunction with the respective goods of the parties. Give these factors, the only conclusion possible is that there is no truth to opposer's assertion that the subject marks are confusingly similar.

"10. Indeed, in its Opposition, opposer could not elaborate on the connection respondent-applicant's medical equipment may have with REJOICE shampoos or just how registration of respondent-applicant's mark will lead to deception and confusion.

x x x

"12. Opposer further contends that the 'REJOICE trademark is well-known and world-famous. Hence the registration of the respondent-applicant's REJOICE mark will 'constitute a violation of Articles 6bis and 10bis of the Paris Convention in conjunction with Section 3, 123.1(e) and (f) of Republic Act No. 8293'.

"13. Despite opposer's bold declaration that it's REJOICE mark is well-known and world-famous, the reality paints a different picture. Rule 102 of the Rules and Regulations on Trademarks enumerates the criteria which should be taken into account, x x x. The opposer has failed to prove that its REJOICE mark comes within the criteria that would allow it to be considered a well-known mark.

x x x

"23. With regard to opposer's claim regarding Article 6bis of the Paris Convention, the same should simply be disregarded for being inapplicable. The subject provision refers only to identical and similar goods, not disparate products as is the case with respondent-applicant and opposer. x x x. From the plain language of the Article, it is clear that under the provision, countries shall refuse or shall cancel the registration of trademarks which constitutes an imitation of a mark considered well known in that country as being already the mark of a person entitled to the benefits of the Convention and used for identical and similar goods.

x x x

“24. Respondent-applicant is surprised to find opposer contend that the alleged confusion with its mark will result in ‘effectively diluting and diminishing the opposer’s unique REJOICE word mark. As to such dilution and diminution, the oppose relies on bare allegations without any effort at substantiating them. First of all, there is nothing distinctive about the trademark REJOICE. To reiterate, there are hundreds, if not thousands, of owners of the REJOICE trademark all over the world. These trademark owners have used the mark on hundred of products in at least fourteen (14) classes of goods under the Nice Classification.

“25. To be sure the word REJOICE cannot be described as a ‘unique’ mark or an invention of Procter & Gamble. It is a English word used in conversation by all in daily life. A simple research will also show that the word was already in use in 1275 to 1300, or more than five hundred (500) years before oppose company was established. It goes without saying that oppose merely used an existing word as its trademark.”

The Respondent-Applicant’s evidence consists of unmarked downloaded documents showing various REJOICE trademarks in Taiwan, Beijing and United States of America, which appears registered to different applicants/holders. Moreover, the Respondent-Applicant attached Search Results from the DTI-Business Name Registration Systems (BNRS) showing several business names consisting of the word REJOICE, covering diverse types of business.

Should the Respondent-Applicant be allowed to register the trademark REJOICE?

Sec. 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines (‘IP Code’) provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such mark as to be likely to deceive or cause confusion.

The records show that the Opposer has registered its trademark REJOICE and its variants with the Intellectual Property Philippines covering the goods under Class 03 of the International Classification of Goods and Services with date of registration as early as year 2004.<sup>4</sup>

But, are the contending marks, depicted below, resemble each other such that confusion, even deception, is likely to occur?



REJOICE RICH

REJOICE COMPLETE

REJOICE

Opposer’s Trademarks

<sup>4</sup> Exhibits “D” to “D-6” of Opposer.

# **Rej<sup>o</sup>ice**

## Respondent-Applicant's Trademark

The competing marks obviously, are identical or similar in their word mark REJOICE. However, the presence of the smiley face replacing the letter "O" in Respondent-Applicant's trademark confers a difference from that of Opposer's marks. Significantly, the goods or products covered by each mark are different and not even related to each other. The Opposer's marks fall under Class 03 which are generally hair, beauty and personal hygiene products; whereas, Respondent-Applicant's mark covers Classes 05 and 10 namely medical patches and pregnancy test kits. Thus, the buyers cannot be mistaken in the purchase of goods because of the unrelated nature of the mentioned goods.

In one case, the Supreme Court ruled:

"The trademark CANON as used by Petitioner for its paints, chemical products toner and dyestuff, can be used by private respondent for its sandals because the products of these two parties are dissimilar."<sup>5</sup>

In another case, the Supreme Court held:

"The Petroleum Products on which the petitioner therein uses the Trademark ESSO, and the product of Respondent, Cigarettes are so foreign to each other as to make it unlikely that purchasers would think that petitioner is the manufacturer of Respondent's goods."<sup>6</sup>

Finally, in Faberge, Incorporated v. Intermediate Appellate Court,<sup>7</sup> the Supreme Court sustained the Director of Patents which allowed the junior user to use the Trademark of the senior user on the ground that the briefs manufactured by the junior user, the product for which the Trademark "BRUTE" was sought to be registered, was unrelated and non-competing with the products of the senior user consisting of after shave lotion, shaving cream, deodorant, talcum powder, and toilet soap.

This Bureau sustains the fact that trademark protection extends only to goods or services related to those specified in the certificate of registration.<sup>8</sup> One cannot claim exclusive right to use the mark on goods that are not similar or related to those stated in the certificate. While it is true that a mark which is considered well-known by competent authority of the Philippines, satisfying the conditions set forth in Sec. 123 (e) and (f) of the IP Code extends its protection even to unrelated goods, the Opposer in this case failed to establish sufficient proof that its mark REJOICE is well-known in accordance to Rule 102 of the Rules and Regulations on Trademark.

It is emphasized that the essence of trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article or merchandise; the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and

<sup>5</sup> Canon Kabushiki Kaisha v. Court of Appeals and NSR Rubber Corporation, G.R. No. 120900, 20 July 2000.

<sup>6</sup> ESSO Standard Eastern, Inc. vs. Court of Appeals, 116 SCRA 336.

<sup>7</sup> 215 SCRA 326, 1992.

<sup>8</sup> Sec. 138, IP Code.

sale of an inferior and different article as his product.<sup>9</sup> This Bureau finds the Respondent-Applicants' mark consistent with this function.

**WHEREFORE**, premises considered, the Opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-009289 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 25 March 2014.



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

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<sup>9</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No., 115508, 19 Nov. 1999.