

RENAISSANCE CAPITAL CORPORATION,  
Opposer,

-versus-

MOUNTAIN SPRING AGRIVENTURES  
CORPORATION,  
Respondent- Applicant.

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IPC No. 14-2012-00038  
Opposition to:  
Appln. Serial No. 4-2011-740197  
Date Filed: 07 October 2011  
TM: "DOLLY PREMIUM  
BANANA AND DEVICE"

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**NOTICE OF DECISION**

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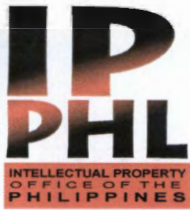
**GREETINGS:**

Please be informed that Decision No. 2016 - 127, dated May 03, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 03, 2016.

For the Director:

*Edwin Danilo A. Dating*  
**Atty. EDWIN DANILO A. DATING**  
Director III,  
Bureau of Legal Affairs



**RENAISSANCE CAPITAL CORPORATION,**  
*Opposer,*

- versus -

**MOUNTAIN SPRING AGRIVENTURES CORPORATION,**  
*Respondent-Applicant.*

X ----- X

IPC No. 14-2012-00038  
Opposition to:

Appln. No. 4-2011-740197  
Date Filed: 07 October 2011  
Trademark: **"DOLLY PREMIUM BANANA AND DEVICE"**  
Decision No. 2016 - 127

**DECISION**

RENAISSANCE CAPITAL CORPORATION ("Opposer")<sup>1</sup> filed a verified opposition to Trademark Application Serial No. 4-2011-740197. The application, filed by MOUNTAIN SPRING AGRIVENTURES ("Respondent-Applicant")<sup>2</sup>, covers the mark "DOLLY PREMIUM BANANA AND DEVICE" for use of goods under class 31<sup>3</sup> namely: *fresh bananas*.

The Opposer alleges the following grounds of the opposition:

"I. The subject application should be denied because it is confusingly similar to Opposer's 'DOLE' mark which in the public's mind has come to be associated with premium quality fruits through Opposer's continuous and exclusive use thereof since 1933.

"II. Opposer is the registered owner of the mark 'DOLE'. Thus, registration of a confusingly similar mark thereto by Respondent-Applicant will infringe Opposer's vested rights.

"III. Opposer's mark 'DOLE' and related marks are well-known marks which are protected against use and/or registration by third parties without Opposer's consent.

"IV. 'DOLE' is the lawful trade name of Opposer's sister company which has been used in the Philippine since 1963. Thus, Respondent-Applicant is barred from registering a confusingly similar mark thereto."

The Opposer's evidence consists of the following:

1. Original and legalized copy of the Certificate of Secretary dated 21 March 2012;
2. Print-out of the pertinent page of the IPO 3-Gazette of the subject application;
3. Brochure of Dole Foods' Worldwide Operations;
4. Print-out of News Release by Dole Foods detailing revenues of corporation;
5. Certified true copy (Ctc) of the Articles of Incorporation of Dole Phils.;

<sup>1</sup> A foreign corporation duly organized and existing under and by virtue of the laws of the United States of America with principal office address at One Dole Drive, Westlake village, California, U.S.A.

<sup>2</sup> A corporation duly organized and existing under the laws of the Philippines, with principal office address at Units 105/106, JLF Parkway Building, Magallanes Street, Davao City.

<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.

6. Sworn Affidavit executed on 26 March 2012 by Brenda Santos-Te, Gen. Manager of Dole Phils.;
7. Photograph of Dole Phils.' pineapple plantation, pineapple operations, manufacturing, canning, and distribution facilities;
8. Photograph of packaged DOLE bananas;
9. Photograph of one of Dole Phils.' banana plantations, the Nature Farm in Calinan Zone;
10. Photograph showing the banana harvest and fruit care;
11. Certificates of Registration for the trademark DOLE and its variants;
12. Bibliographic data of the Respondent-Applicant's DOLE application showing the disclaimer;
13. Sworn Affidavit by Mario Vizconde, Marketing Manager of Dole Phils.;
14. Invoices showing the costs of promotional activities of Dole Phils.;
15. Samples of advertisements and promotional materials of products bearing DOLE mark;
16. Certificates of Performance with Solar Entertainment Corporation of DOLE products;
17. Print-outs of blog articles of DOLE products;
18. Print-outs of the content of Opposer's www.dole.com showing wide variety of DOLE products;
19. Print-out of a section of the New Zealand Dole website www.dolenz.co.nz showing picture of the DOLE BOBBY BANANAS;
20. Photographs of DOLE products sold in major grocery stores in the Philippines;
21. Copies of Opposer's invoices issued to its distributors and major establishment in the Philippines;
22. Sworn Affidavit of Brenda Santos-Te;
23. Certification showing extensive registration of the DOLE mark all over the world; and,
24. List of application and registration of the DOLE trademarks in the name of Dole Foods and its subsidiaries.

On 18 July 2012, Respondent-Applicant filed its Answer alleging the following Affirmative Defenses:

"A. Respondent-Applicant's 'DOLLY PREMIUM BANANA & DEVICE' trademark is not confusingly similar to Opposer's DOLE marks.

"B. Registration of the 'DOLLY PREMIUM BANANA & DEVICE' trademark in the name of Respondent-Applicant will not infringe upon Opposer's exclusive right to use the DOLE trademarks under Section 147 of the IP Code.

"C. The provisions of Section 123.1 (e) of the IP Code and Article 6BIS of the Paris Convention are not applicable in this case as Respondent-Applicant's mark is not confusingly similar to Opposer's DOLE marks.

"D. The protection accorded to a trade name under Section 165 of the IP Code is limited to preventing use by third parties of the same or similar name or mark, and does not extend to a trademark that is different or sufficiently distinctive.

"E. Opposer will not suffer any damage by the registration of Respondent-Applicant's DOLLY PREMIUM BANANA & DEVICE trademark. The application for registration of the DOLLY PREMIUM BANANA & DEVICE trademark should thus be allowed to proceed to registration."

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

1. Duly executed and notarized Secretary's Certificate and Special Power of Attorney;
2. Amended Articles of Incorporation of Respondent-Applicant;
3. Articles of Incorporation of RD Corporation;
4. Print-outs from RD Corporation's website on various industries they are engaged;

5. Print-out from Manila Bulletin's website on Guinogulan Awards;
6. Print-outs from the Ernst & Young's website on the Entrepreneur of the Year Awards winners and finalists in 2004, 2005, 2007 and 2011;
7. Print-out from Philippine Daily Inquirer's website on the Grand Chamber Awards Night;
8. Print-out from the Dolores Hotels & Resorts' website on its hotel and resorts;
9. Print-out from the Filipino Mariners' Survey and Certification Service's website on Filmarine Registry which include the vessels of the RD Group;
10. Certified true copies (Ctc) of Articles of Incorporation of Asia-Pacific Tuna Canning Corporation (APTCC) and RDEX Food International Phils., Inc. (RDEX);
11. Ctc of Certificate of Registration Nos. 4-2003-008443 for DOLLY and 4-2004-011242 for DOLLY TUNA MEAT LOAD;
12. Certificate of Registration issued by the USPTO for DOLLY;
13. Ctc of Certificates of Product Registration issued by the BFAD for various DOLLY products;
14. Various product with distinctive labels with the DOLLY trademark displayed;
15. Packaging for DOLLY TUNA CHICHARON;
16. Print-out from the RD Tuna Cannery website showing DOLLY tuna products;
17. Registration certificates issued for DOLLY in the name of RDTC in the European Union, Australia, Papua New Guinea and Fiji;
18. Print-out from the Asia Fruit Logistica International Trade Exhibition website;
19. Sticker used by Respondent-Applicant on its bananas;
20. Picture of the carton box used by Respondent-Applicant as packaging for bananas; and,
21. Notice of Allowance in the application of Respondent-Applicant's DOLLY PREMIUM BANANA & DEVICE.

The preliminary conference was held and terminated on 19 November 2012. The Opposer submitted its position paper on 18 January 2013; whereas, the Respondent-Applicant submitted its position paper on 17 January 2013. Thus, this instant case is submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark DOLLY PREMIUM BANANA AND DEVICE?

As culled from the records and evidence, the Opposer is a wholly-owned subsidiary of Dole Foods. It is the registered trademark owner of the DOLE mark and its variations in the Philippines which it licenses to Dole Philippines, Inc.<sup>4</sup> The Opposer has prior, valid and existing registrations for its trademark DOLE and its variations issued in the Philippines and in various countries abroad.<sup>5</sup> On the other hand, Respondent-Applicant filed its application for trademark registration of DOLLY PREMIUM BANANA & DEVICE only on 07 October 2011.<sup>6</sup> Records however show that Respondent-Applicant is a member of the RD Group of Companies which is managed by RD Corporation. The latter's seafood processing operations in the Philippines is handled by Asia-Pacific Tuna Canning Corporation and RDEX Food International Phils., Inc. which has various applications and registrations for trademark containing the word DOLLY.<sup>7</sup> Likewise, various products with the word DOLLY are issued Certificates of Product Registration by the Bureau of Food and Drug way back 2007.<sup>8</sup>

<sup>4</sup> Exhibit "A" of Opposer.

<sup>5</sup> Exhibit "BB", Annex "E" of Exhibit "BB" of Opposer; IPPHL Philippine Trademark Database, available on <http://www.wipo.int/branddb/ph/en/> (last accessed 28 March 2016).

<sup>6</sup> Filewrapper records.

<sup>7</sup> Exhibits "13", "14" and "15" of Respondent-Applicant.

<sup>8</sup> Exhibits "16" to "16-L" of Respondent-Applicant.

But are the competing marks, as shown below, confusingly similar?



Opposer's Trademark



Respondent-Applicant's Trademark

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear" may be considered.<sup>9</sup> Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

The eyes can see that the marks are different. The similarity between the marks consisting of the word DOLE against DOLLY PREMIUM BANANA, manifest only in the three letters "D", "O" and "L". Such resemblance, however, is not sufficient to conclude that confusion is likely to occur. The Opposer's DOLE has the sound of a long "o" in the middle of the word DOLE, in a single syllable; whereas, Respondent-Applicant's "o" in DOLLY has the sound of a short "a" in the first syllable, as part of a two-syllable word. As to its visual appearance, Opposer's DOLE appears in black and upper case letters. In its other variations, it is accompanied with a sun design which makes it more distinctively presented. On the other hand, Respondent-Applicant's DOLLY PREMIUM BANANA is presented in a stylized white font with a representation of a banana hand in yellow, all inside a blue oval-shaped device with white outline (with disclaimer on the words "PREMIUM BANANA" and the representation of the same).<sup>10</sup>

While the goods covered by the parties traverse each other because both covers fruits or bananas, the distinctive appearance of the marks clearly manifest a distinguishable and independent character of trademarks. Moreover, this Bureau finds merit in the argument of the Respondent-Applicant that the word mark DOLLY has been issued registration covering canned fish,<sup>11</sup> canned tuna and processed seafoods<sup>12</sup> as early as 2005 and to date. The fact that Respondent-Applicant expanded its business from seafood to fruits is not unlikely considering that, its place of business in General Santos, and the plantation of bananas in the provinces of Davao del Norte, Bukidnon and South Cotabato<sup>13</sup> are especially known for tuna products and fruit products, respectively. Thus, the likelihood of public deception is quite remote because a consumer could easily discern that there is no connection between the two marks.

<sup>9</sup> Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

<sup>10</sup> Filewrapper records.

<sup>11</sup> Exhibit "13" of Respondent-Applicant.

<sup>12</sup> Exhibit "14" and "15" of Respondent-Applicant.

<sup>13</sup> Exhibit "25" of Respondent-Applicant.

Corollarily, the enunciation of the Supreme Court in the case of *Mighty Corporation vs. E. & J. Gallo Winery*<sup>14</sup> aptly states that:

"A very important circumstance though is whether there exists likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the source of the goods in question. The 'purchaser' is not the 'completely unwary consumer' but is the 'ordinarily intelligent buyer' considering the type of product involved. He is 'accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The situation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of 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 of 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 sale of an inferior and different article as his product.<sup>15</sup> This Bureau finds that the Respondent-Applicant's mark meets this function.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-740197 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 03 MAY 2016

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

<sup>14</sup> G.R. No. 154342, 14 July 2004.

<sup>15</sup> *Pribhdas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 November 1999.