

UNILEVER N. V.,
Opposer,

-versus-

S.T. DUPONT S.A.,
Respondent-Applicant.

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IPC No. 14-2012-00278

Opposition to:

Appln. Serial No. 4-2011-012296

Date Filed: 12 October 2011

TM: D DEVICE

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 424 dated 25 November 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 28 November 2016.

MARILYN F. RETUAL
IPRS IV

Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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Opposer,	} Opposition to:
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-versus-	} Appln. Ser. No. 4-2011-012296
	} Date Filed: 12 October 2011
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S.T. DUPONT S.A.,	} Trademark: "D DEVICE"
Respondent-Applicant.	}
	}
x-----x	} Decision No. 2016- 424

DECISION

UNILEVER N.V., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2011-012296. The application, filed by S.T. DUPONT S.A. (Respondent-Applicant)², covers the mark "D DEVICE", for use on "bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentrifices" under Class 3 of the International Classification of Goods³.

The Opposer relies, among others, on the following grounds:

"(a) Opposer is the prior user and first registrant of the DOVE Marks in the Philippines, well before the filing date of Respondent's DOVE trademark application on 12 October 2011. The earliest registration in the Philippines for a DOVE word mark was granted on 2 July 1996 in the name of Opposer's predecessor-in-interest, Lever Brothers Company, under Trademark Registration No. 063161. xxx

As stated, Opposer has also registered about 2,608 DOVE Marks, in around 177 jurisdictions all over the world, including the WIPO, the earliest of which was secured on 9 April 1953 in Canada under Registration No. UCA 44657. Opposer continues open and notorious use

¹ A company organized under the laws of Netherlands with address at Weena 455, Rotterdam, 3013 AL, The Netherlands

² A corporation organized and existing under the laws of France with address at 92 Bd du Montparnasse, 75014 Paris

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

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of the DOVE Marks in the Philippines and in numerous countries worldwide.

(b) Opposer enjoys the exclusive right to prevent all third parties not having its consent from using in the course of trade identical or similar signs for goods which are identical or similar to those in respect of which its trademarks are registered where such use would result in a likelihood of confusion. xxx

In fact, there shall be a presumption that a likelihood of confusion will result if what is used is an identical sign for identical goods. On this score, a cursory examination of the competing marks would show that Respondent's 'D DEVICE' mark is nearly identical and confusingly similar to Opposer's DOVE marks.

(i) First, Respondent's 'D DEVICE' mark completely appropriates the distinctive font and style of the letter 'D' in Opposer's DOVE Marks. A side-by-side examination of the one of Opposer's registered marks and Respondent's 'D DEVICE' mark would readily show such appropriation xxx

Clearly, the dominant element in Respondent's mark, in fact the only element in Respondent's mark, is confusingly similar if not identical to the dominant distinctive element in Opposer's DOVE Marks.

The Opposer alleges the following:

"5. Sometime in 1957, Opposer and/or its predecessor companies coined and adopted the word 'DOVE' for the purpose of using the same as a trademark for a beauty soap bar that was clinically proven to be milder for dry or sensitive skin than other soaps in the market. Armed with the mark's ideal of providing a genuine difference in skin and hair conditions, Opposer launched a wide range of cleansing and personal care products by the 1980's which include moisturizing body wash, deodorants, body lotions, facial cleansers and shampoos and conditioners. The stylized 'DOVE' word mark, in particular, has been used by Unilever in the distinctive font and style depicted below. xxx

"6. To date, various DOVE products, which has recently been offered to both men and women, are sold in numerous jurisdictions in Africa, the Americas, the Asia Pacific, Europe and the Middle East xxx

"7. In fact, its prevalence in the global market has led to the brand's classification by Opposer as one of its 13 'billion-dollar brands', each of which achieve annual sales in excess of 1 billion and, together with the top 25 brands, account for more than 70% of sales. In 2011, the DOVE brand became Opposer's first 3 billion Personal Care brand.

"8. Hence, to ensure its exclusive use over its brand and protect the goodwill which it had so long tried to build through years of extensive marketing, Opposer and/or its subsidiaries, joint ventures, sister concerns, predecessor-in-title or assignees, sought the trademark registration of about 2,608 DOVE and derivative marks, in around 177 jurisdictions all over the world, including the WIPO, the earliest of which was secured on 9 April 1953 in Canada under Registration No. UCA 44657.xxx

"9. In the Philippines, the following relevant trademarks are held in the name of the Opposer:

- (a) the 'DOVE MOSITURE-LOCK' trademark xxx;
- (b) the 'DOVE' trademark xxx;
- (c) the 'DOVE (WORD AND DEVICE) trademark xxx;
- (d) the 'DOVE (STYLISED) trademark xxx;
- (e) the 'DOVE (STYLISED) & DEVICE trademark xxx;
- (f) the 'DOVE DEVICE' trademark xxx;
- (g) the 'DOVE DEVICE' trademark xxx; and
- (h) the 'DOVE MEN+CARE(STYLISED) & DEVICE trademark xxx

These registrations are valid and subsisting."

To support its opposition, the Opposer submitted as evidence the following:

1. Verified Notice of Opposition dated 31 July 2012;
2. Special Power of Attorney dated 31 July 2012;
3. Table showing details of applications and registrations for the mark "DOVE";
4. Sample trademark registration certificates for the mark "DOVE";
5. Print-out of webpage, http://www.abrands.net/us/dove_advertising_1.html;
6. Screenshots of www.dove.us and www.dove.co.uk;
7. Affidavit of Bienvenido Marquez III dated 13 August 2012;
8. Affidavit of Leah-Jose-Sebastian dated 13 August 2012;
9. Labels of "DOVE" marks;
10. Sample promotional and advertising materials; and
11. Copies of Philippine trademark registrations of the mark "DOVE" and derivative marks.⁴

⁴ Exhibits "A" to "K"

The Respondent-Applicant filed its Answer on 8 March 2013, alleging among other things, the following affirmative allegations and defenses:

“Respondent-Applicant is the lawful owner of the original and well-known ‘D-DEVICE’ mark.

“6. For more than a century, Respondent-applicant has been building and protecting its goodwill with respect to its luxury products. In Europe, the ‘S.T. Dupont’ mark was first adopted and used by Respondent-Applicant’s founder and namesake, Simon Tissot-Dupont, who was born in Savoy in the French Alps in 1847. Simon Tissot-Dupont purchased in 1872 a workshop that crafted prestigious and high quality luggage, leather briefcases, travel cases and other travel requisites for diplomats and businessmen. In particular, he manufactured wallets and ‘maroquins’, the attaché-cases of the time, bearing the initial success of his business, Simon Tissot-Dupont decided to use his initials ‘S.T. Dupont’ as his trademark.

“7. In 1884, while maintaining his private clientele, Simon Tissot-Dupont became the supplier of one of the world’s largest shops, Les Grands Magasins du Louvre which shop remained a prestigious and exclusive shop in France until the 1970’s and had since become a well-known shop for antiques. Henceforth, the history table below shows how Respondent-Applicant’s business and product lines have grown and expanded through the years;

YEAR	Development
1919	Simon Tissot-Dupont handed over control of the company to his two sons, Lucien and Andre. The two sons continued the business under the name of Les Fils de S.T. Dupont meaning ‘the Sons of S.T. Dupont’. Respondent-Applicant’s business continued with activity more focused on high quality travel cases and accessories. Highly qualified craftsmen were engaged and patents were taken out to protect industrial innovations.
1920	Respondent-Applicant’s business grew to employ 250 workers skilled in at least 17 different trades such as goldsmithing, woodworking, engraving, leather crafting, enamel work, locksmithing.
1923	Respondent-Applicant opened a second workshop in Faverges, France, the family’s home town, located in the picturesque Haute Savoie Region, at the foot of the Mont Blanc Mountain in the French Alps, recruiting only the best and the brightest craftsmen from 17 different trades.
1926	Lucien Tissot-Dupont was invited to New York by Lois

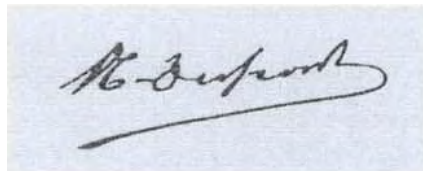
	<p>cartier to present his travel cases at the Cartier Boutique in their 5th Avenue shop. In their salons on Rue Dieu in Paris, the Dupont brothers received the cream of international society. Their loyal customers included: the Maharajah of Patiala, who used to make sumptuous gifts to his one hundred or so favorites, Baron Maurice de Rothschild, the Duke of Kent, to name a few. The Duke of Windsor used to advise Lucien Dupont and Al Capone discreetly dispatched his second-in-command to place an order.</p>
1930	<p>Respondent-Applicant's products became so exclusive and detailed that only up to 10 exceptional travel cases were turned out of Respondent-Applicant's workshops per month, with its master craftsmen using the most precious materials such as crocodile skin, gold and silver, ivory and tortoise shell.</p>
1935	<p>To reduce the weight of its travel cases, Respondent-Applicant decided to try lacquer instead of enamel in its travel cases. Respondent-Applicant built the first workshop was set up in Faverges and especially hired a Russian officer whose travels to China had made him familiar with lacquer works. Novosilzeff, the Russian officer, subsequently trained all lacquer workers of Savoy and thus developed this specialized skill which today remains the hallmark of Respondent-Applicant's quality products.</p>
1941	<p>When World War II broke out in 1939, raw materials became hard to come by, and customers were more and more scarce. The brothers Lucien and Andre were determined to retain their highly skilled staff. Thus, they decided to venture into the business of making lighters which required few raw materials but were made with the best workmanship. Respondent-Applicant's leather-goods maker applied his gold-smith expertise and invented the first pocket petrol lighter. The S.T. Dupont lighters began as a small gold accessory especially for the Great King, packed inside the Maharajah of Patiala's suitcase.</p>
1947	<p>French President Vincent Auriol offered Princess Elisabeth a luxury travel case with a blue leather exterior, a champagne leather interior, and blue Chinese lacquer accessories as wedding gift for her marriage with Prince Philip. The elder Andre Tissot Dupont oversaw the months-long production and crafting of the travel case.</p>
1951	<p>After two years of research, Respondent-Applicant launched its first gas lighter, much more reliable than its competitors.</p>
1953	<p>Andre Dupont created his first ladies' handbag, the 'Riviera'</p>

	<p>as a limited edition, using, amongst others, exotic leathers to complete his range of special orders. Audrey Hepburn became one of his first clients.</p> <p>The inside of the handbag was made of the softest cotton adorned with the famous Double D mark, symbolizing Lucien and Andre Tissot Dupont.</p>
1966	The original S.T. Dupont lighter was improved with a flame adjustment mechanism. The adjustable lighter was born.
1973	Respondent-Applicant launched its first ball-point pen with the slogan 'the new Dupont is not a lighter'. The first model, called 'Classique, has since become one of S.T. DUPONT's most prestigious products.
1970	Chinese lacquer was used for the first time on S.T. DUPONT pen.
1977	Respondent-Applicant revived its leather goods manufacturing business. The first collection was for men, followed two years later by a collection for women. The Line 2 was added to the lighter range the same year. Respondent-Applicant began consolidation and expansion at the same time.
1980	The first S.T. DUPONT boutique was opened in Paris, Faubourg Saint Honore, opposite the Elysee President Palace, an obvious prime site at the heart of Paris.
1981	Respondent-Applicant launched its line of men's watches: the Classique watch in gold or Chinese lacquer. A propelling lead pencil was added to the range of writing instruments and in 1982, the first line of belts was launched, the first item in S.T. DUPONT's 'clothing for men' product line.
1985	The <i>Line D</i> collection was born with the launch of the first <i>Line D</i> lighter, followed the year after by the launch of a line of leather goods. x x x
1993	Respondent-Applicant further expanded its business with the granting of license for a production of a line of optical frames which adds to another level of development of the brand S.T. DUPONT. x x x
1997	Respondent-Applicant launched its ' <i>Geometrie</i> ' watch. A new line of leather goods ' <i>Atoll</i> ' and a pen called ' <i>Lady Mascara</i> ' were added to Respondent-Applicant's product line. Respondent-Applicant also expanded worldwide and more boutiques were opened in Hong Kong, Milan, Moscow, Munich, and Paris.
1998	Respondent-Applicant expanded the line ' <i>Geometrie</i> ' as leather goods, developed a unique first S.T. DUPONT

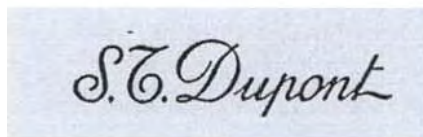
	fragrance for men and women, and launched a Premium Cigar also under the name 'S.T. DUPONT'.
1999	New lines and ranges like 'X.tend', 'D-Light', 'Olympio', 'Essence Pure', lighters, pens and fragrances were launched by Respondent-Applicant. x x x
2013	Respondent-Applicant received the prestigious 'Living Heritage Enterprise' state seal of approval from Mr. Alexis Govciyan, Director Institut Superieur des Metiers, an award given to honour French manufacturers holding rare, renowned or ancestral skills.

"8. From the foregoing detailed narration, it is clear that Respondent-Applicant spent more than 140 years building its reputation and goodwill by creating high-quality, prestigious luxury items for exclusive and prominent clients all over the world.

"9. The S.T. Dupont logo was first designed from the signature of the founder of the company, Simon Tissot-Dupont.



"10. Simon Tissot – Dupont's signature was adopted to be used on his high quality luggage, leather briefcases, travel cases and other travel requisites:



"11. When Respondent-Applicant started to make products using precious metals, French legislation required the manufacturer hallmark, usually a design with some letters, to be printed on such products. The entire 'S. T. Dupont' name being too long to be written as a hallmark, it was decided, beginning in the 1920's, to adopt just the letter 'D' from the 'S.T. Dupont hallmark:



“12. In 1970, when Respondent-Applicant decided to use the ‘D-DEVICE’ mark as the company logo, the mark was redesigned to form an oval shape:



“13. The ‘D DEVICE’ mark was subsequently redesigned for a sharper, more streamlined and modern look into the present ‘D DEVICE’ mark:



“14. Respondent-Applicant’s marks are well-known in many countries throughout the world. Respondent-Applicant has registered its “D-DEVICE’ mark and its variants in several countries, including xxx

“15. Luxury products bearing Respondent-Applicant’s ‘D DEVICE’ mark have been extensively and substantially sold and marketed by the Respondent-Applicant and its licensees in many countries worldwide, including xxx

“16. Because of the Respondent-Applicant’s extensive and continuous use of the ‘D DEVICE’ mark connection with its wide range of goods including lighters, pens, luggage, cosmetic, fragrances, perfume, leather goods, clothing, and fashionable accessories in Classes 3,8,9, 14, 16, 18, 21, 24, 25 and 34, the relevant sector of the public has come to identify the ‘D-DEVICE’ mark exclusively with Respondent-Applicant as the source of these products. x x x

“17. In the Philippines, Respondent-Applicant’s products are sold n different branches of major malls and department stores nationwide

including The Landmark Makati, The Landmark Trinoma, SM Mall of Asia, SM Makati, SM Megamall, SM Norht Edsa, Robinson's Galleria, Robinson's Place Ermita, Robinson's Festival, Metro Gaisano, Crossings, Rustan's Makati, Rustan's Trinoma, Rustan's Gateway Mall, Rustan's Alabang, Rustan's Tower, and Rustan's Cebu. x x x

"18. Respondent-Applicant's products and advertisements have also been featured in local websites such as www.femalenetwork.com and Philippine magazines such as Preview, Cosmopolitan, Meg, FHM, Metro, Mega and Town and Country. x x x

"21. Contrary to Opposer's claim, there is no confusing similarity between Respondent-Applicant's 'D-DEVICE' mark and Opposer's 'DOVE' mark. The visual differences between Respondent-Applicant's 'D-DEVICE' mark and Opposer's 'DOVE' mark are glaring and obvious. xxx"

In support of its defense, the Respondent-Applicant submitted the following evidence:

1. Print-out of relevant pages of Respondent-Applicant's website, <http://www.st-dupont.com/en/univers-st-dupont/1872-birth-french-luxury-house-0;>
2. List of trademark registrations and pending applications of "D-DEVICE";
3. Certified copies of foreign registration certificates of the "D-DEVICE" mark from Andorra, Denmark, Bahrain, Brunei, Colombia, Canada, Brazil, Mexico, United States of America, OHIM and WIPO;
4. Print-out of pages of Respondent-Applicant's website showing list of countries where goods are sold, <http://www.st.dupont.com/en>;
5. Sample product packaging and photographs of products bearing "D-DEVICE";
6. Copies of Product catalog;
7. Photographs of store stall and advertisements of "D-DEVICE";
8. Print-out of pages from www.femalenetwork.com showing Respondent-Applicant's products;
9. Products of Opposer;
10. Print-out of pages of website of www.sulit.com.ph;
11. Copy of Registrability Report with mailing date of 24 November 2011; and
12. Response dated 24 January 2012.⁵

The Preliminary Conference was terminated on 19 June 2013 where the both parties were directed to file their respective position papers. The Opposer and Respondent-Applicant filed their position papers on 9 July 2013 and 1 July 2013, respectively.

⁵ Exhibits "1" to "13" inclusive of submarkings

Should the Respondent-Applicant be allowed to register the trademark D DEVICE?

Records show that at the time Respondent-Applicant applied for registration of the mark "D and DEVICE" the Opposer already registered the mark "DOVE" under Trademark Registration No. 063161 on 11 October 2011 for goods under class "3". The goods indicated in the Respondent-Applicant are similar and/or closely related to the goods covered by the Opposer's trademark registration.

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

DOVE

Opposer's mark

A stylized, cursive letter 'D' logo with a thick, black outline and a white fill. The letter is slanted to the right and has a decorative, flowing tail that loops back under the main stem.

Respondent-Applicant's mark

Opposer's mark consist of the word "DOVE". In its trademark variants, the mark "D-O-V-E", is depicted in stylized letters. Opposer argues that Respondent-Applicant's "D-DEVICE" is identical and confusingly similar to its mark "DOVE", particularly the letter "D". It contends that the style and font of its "DOVE" mark has been copied and asserts its exclusive right to the mark by virtue of its earlier registrations. Considering that the Opposer has advertised and sold its products bearing the "DOVE" trademark both in the Philippines and abroad, it believes that Respondent-Applicant's adoption of the "D and DEVICE", shows its intent to ride on the goodwill attached to Opposer's mark that would lead to a likelihood of confusion among the buying public.

The evidence show that the Respondent-Applicant derived its mark from the first letter of the surname of its founder, Simon Tissot-Dupont. The history of mark⁶ narrates that the name S.T. Dupont was applied to different goods such as travel cases, accessories and luggage. The founders later diversified to other goods, such lighters, ladies' handbags, ball-point pen, men's watches, menswear collection, optical frames, watches, fragrances for men and women and leather goods. The use of the letter "D" evolved from the depiction of the founder's name, Dupont. A variety of its products are advertised and prominently displayed and sold in stalls in the Philippines.⁷ The only resemblance between the two marks is the letter D. The Opposer in its DOVE marks/and variants use the word DOVE and the mere adoption by the Respondent-Applicant of the

⁶ Exhibit "1"

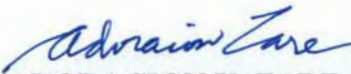
⁷ Exhibit "7"

mark "D and DEVICE" will not necessarily result to consumers thinking that it stands for the word/mark DOVE. The similarity in one letter of Opposer's mark is insufficient as basis for making a conclusion that a likelihood of confusion may occur. Besides, consumers purchasing soaps, cosmetics and similar products would be more conscious and discerning, as these products are applied to the body. *The ordinary purchaser must be thought of as having, and credited with, at least a modicum of intelligence (Carnation Co. vs. California Growers Wineries, 97 F. 2d 80; Hiram Walke and Sons vs. Penn-Maryland Corp., 79 F. 2d 836) to be able to see the obvious differences between the two trademarks in question.*⁸

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-012296 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 25 NOV 2016


Atty. ADORACION U. ZARE, LL.M.
Adjudication Officer
Bureau of Legal Affairs

⁸ *Fruit of the Loom, Inc. v. CA*, G. R. No. 32747, November 29, 1984