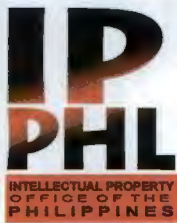


5-1778



**WELLA GmbH,**  
*Opposer,*

**-versus-**

**XU LIANGJI,**  
*Respondent-Applicant.*

X-----X

}	<b>IPC No. 14-2013-00289</b>
}	Opposition to:
}	Appln. Serial No. 4-2012-502003
}	Date Filed: 03 August 2013
}	
}	
}	<b>TM: ARCHIE</b>

**NOTICE OF DECISION**

1 **CESAR C. CRUZ & PARTNERS LAW OFFICES**  
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6811 Ayala Avenue, Makati City

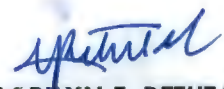
2 **SAPALO VELEZ BUNDANG & BULILAN LAW OFFICES**  
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6776 Ayala Avenue, Makati City

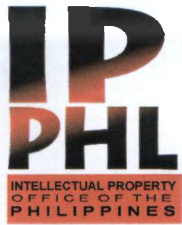
**GREETINGS:**

Please be informed that Decision No. 2016 - 519 dated 23 December 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, 06 January 2017.

  
**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs



WELLA GmbH,

Opposer,

- versus -

XU LIANGJI.,

Respondent-Applicant.

IPC NO. 14 – 2013-00289

Opposition to:

Appln Serial No. 42012502003

Date filed: 3 August 2013

TM: "ARCHIE"

DECISION NO. 2016 - 519

x-----x

### DECISION

WELLA GmbH (Opposer),<sup>1</sup> filed a Verified Notice of Opposition to Trademark Application No. 4-2012-502003 on 9 September 2013. The subject Trademark Application filed by XU LIANGJI (Respondent-Applicant),<sup>2</sup> covers the mark "ARCHIE" for "shampoo" under Class 3 of the International Classification of Goods.<sup>3</sup>

The pertinent allegations in the Verified Notice of Opposition are quoted as follows:

4. The Opposer is the owner of the internationally famous and undoubtedly more senior WELLA trademarks by prior actual use in commerce and prior registration in the Philippines. x x x

5. The Opposer first used its internationally famous WELLA and woman's head device trademark in the 1930s in the United States and has been using the trademark openly and continuously around the world since then. To date, the WELLA and woman's head device trademark is protected in more than 70 jurisdictions worldwide.

6. The significant overall exposure of the WELLA and woman's head device trademark thorough its long, open and continuous use on various products of the Opposer along with its popularization through television commercials, outdoor advertisements, print publications, live promotional events, sponsorships and other promotional events even over the internet and other mobile and digital platform undeniably

<sup>1</sup> A corporation duly organized and existing under and by virtue of laws of Germany, with business address at Sulzbacher Str. 40, 65824 Schwalbach am Tannus, Germany.

<sup>2</sup> An individual with business address at 1163 Narrat Street, Tondo, Metro Manila.

<sup>3</sup> 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 International Classification of Goods and Services for Registration of Marks concluded in 1957.

demonstrates that products bearing the WELLA and woman's head device trademark are famous all over the world in light of the fact that the quality of the Opposer's products bearing the WELLA and woman's head trademark is without compare and have always been subject to ever increasing improvements by the Company since the time that products bearing the WELLA and woman's head device trademark were first launched in the market.

7. As a result of its extensive use of the WELLA and woman's head device trademark, and as a result of the excellence and innovativeness of the Opposer's products, the Opposer has built and now enjoys valuable goodwill in its business as represented by its internationally renowned WELLA and woman's head device trademark, and that the said trademark has become distinctive of the Opposer's hair care products.

8. The Opposer has extensively sold and promoted its products bearing its internationally renowned WELLA and woman's head device trademark across the Asia-Pacific region and has been doing so prior to the Respondent-Applicant's filing of its trademark application for the trademark ARCHIE with this Honorable Office.

9. Notwithstanding the prior use and prior registration of the Opposer's internationally renowned WELLA and woman's head device trademark, the Respondent-Applicant filed with this Honorable Office Trademark Application No. 4-2012-52003 for ARCHIE on August 03, 2012.

10. The Opposer has not consented to the Respondent-Applicant's use and registration of ARCHIE, or any other mark identical or similar to its WELLA and woman's head device trademark. x x x

11. The Respondent-Applicant's application for registration of the trademark ARCHIE should not be given due course by this Honorable Office because its registration is contrary to section 123.1 (d) and Section 123.1 (f) of the Intellectual Property Code x x x

12. The Opposer's WELLA and woman's head device trademark is internationally renowned and has been registered worldwide, as evidenced by a sampling of the numerous Certificate of Registration of the trademark WELLA and woman's head device that the Company has obtained worldwide through out the years x x x

13. The Opposer filed its registration for the WELLA and woman's head device trademark in the Philippines in 1964, and was first granted registration in 1966. Today, there are five (5) WELLA and woman's head device trademarks registered in the name of the Opposer with Philippine Intellectual Property Office.

14. The Opposer's WELLA and woman's head device trademark, being the more senior registrant, undoubtedly enjoys protection under Philippine law. Jurisprudence has granted protection to trademark that have prior, or a more senior registration. x x x

15. Over the passage of time, products bearing the trademark WELLA have always used the woman's head device in connection with

the promotion and sale of its products. In fact, throughout the years, the woman's head device has remained unchanged despite the continued expansion of the range of the Opposer's products resulting in a variety of products which are all promoted and sold by the Opposer using the WELLA and woman's head device trademark.

16. By virtue of the prior and continuous use by the Company and its subsidiaries and affiliates of the woman's head device in relation to the WELLA trademark in the Philippines and all over the world, the woman's head device is almost, a "mark unto itself", which Filipino purchasers closely associate with the products of the Opposer. x x x

17. The resemblance of the Opposer's and the Respondent-Applicant's respective trademark is most evident upon juxtaposition of the said marks, x x x

A mere perusal of the Respondent-Applicant's trademark will clearly show the Respondent-Applicant's trademark is a poor attempt at reproducing the Opposer's internationally renowned WELLA and woman's head device trademark, clearly showing an intent to imitate the woman's head device that is absolutely associated with the Opposer's products.

18. The act of the Respondent-Applicant in adopting the woman's head device in relation to its trademark ARCHIE for its products in Class 3 is clearly an attempt to trade unfairly on the goodwill, reputation and awareness of the Opposer's internationally famous and undoubtedly more senior WELLA trademarks and its woman's head device that were previously applied for registration before this Honorable Office and in many other countries, resulting in the diminution of the value of the trademark WELLA and woman's head device.

19. The Respondent-Applicant's trademark is identical to, or closely resembles, the Opposer's WELLA and woman's device trademarks that were previously registered in the Philippines and elsewhere in the world, such that confusion is likely to result. Hence, the registration of said trademark violates Section 123.1(d) of the Intellectual Property Code.

19.1 Both marks contain the woman's head device concept which undoubtedly heightens the visual and conceptual similarity between the marks.

19.2 It cannot be gainsaid that the concept used by the Opposer for its trademark, that is the WELLA + WOMAN'S HEAD DEVICE combination / concept has attained sufficient notoriety as an internationally famous and undoubtedly more senior trademark and that the same has become distinctive for the Opposer's goods. The use of the woman's head device is undoubtedly the Opposer's property inasmuch as the Opposer is the source of this novelty and is the first to use the woman's head device to identify its goods in the marketplace.

19.3 Use of the woman's head device concept to identify the Opposer's goods in the marketplace has been at the core of its business. It is undeniable that the Opposer has extensively used the same concept for some time and that the Opposer has expended enormous sums of money to make the WELLA and woman's head device trademark concept

distinctive for its goods. It is without question that the Opposer's internationally famous and undoubtedly more senior WELLA and woman's head device is a dominant element of the Opposer's internationally famous and undoubtedly more senior mark. Allowing the same woman's head device to be used by the Respondent-Applicant would inevitably lead to diluting and diminishing the distinctiveness of the WELLA and woman's head device trademark.

20. If the same woman's head device concept is used by the Respondent-Applicant on hair care products, it will undoubtedly create a false business relationship and/or association to the detriment of the Opposer. Thus, if allowed, the Respondent-Applicant will definitely "ride on" the popularity and exposure of the Opposer's trademark in the field of hair care products.

21. The Respondent-Applicant's unauthorized use of the woman's head device, a famous and renowned trademark already clearly and very closely associated with the WELLA trademark owned by the Opposer, as well as the Respondent-Applicant's passing off of its own products as those made by the Opposer, is likely to cause confusion in the minds of the consumers.

22. The Respondent-Applicant's attempt to register and use a woman's head device in connection with its hair care products will take advantage of the long and continuous presence of the trademark in the market place as a trademark registered in the name of the Opposer. Allowing the use of the woman's head device by the Respondent-Applicant will indubitably lead to confusion and will mislead the trade and members of the public that the Respondent-Applicant's product originate from or are sponsored by the Opposer, or at least, originate from economically linked undertakings creating an inappropriate trade connection or association.

23. If the products of the Respondent-Applicant are inferior in quality, there will be further irreparable injury to the Opposer's valuable goodwill and its internationally famous and undoubtedly more senior WELLA and woman's head device trademark will suffer from an unfavorable connotation created by the association of the Respondent-Applicant's trademark to the WELLA and woman's head device trademark. Furthermore, the Opposer believes the use and registration of the woman's head device in connection with the Respondent-Applicant's ARCHIE trademark will dilute the distinctive character of the Opposer's internationally famous and undoubtedly more senior WELLA and woman's head device trademarks.

24. The Respondent-Applicant seeks to register the trademark ARCHIE and woman's head device which is confusingly similar to Opposer's WELLA and woman's head device trademark, so as to be likely when applied to the goods of the Respondent-Applicant to cause confusion, mistake or deception to the public as to the source of the goods, and will inevitably falsely suggest a trade connection between the Opposer and the Respondent-Applicant.

x x x

26. Moreover, in the case of McDonald's Corporation vs. L.C. Big Mak Burger, Inc. et, al., the Supreme Court had occasion to rule that

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“while proof of actual confusion is the best evidence of infringement, its absence is inconsequential.”

27. Thus, the denial of Trademark Application No. 4-2012-502003 for the trademark ARCHIE by this Honorable Office is authorized under the provisions of the Intellectual Property Code.

In support of the Opposition, the Opposer submitted the following evidence:

Exhibit “A” – Authenticated copy of the Certificate and Special Power of Attorney; and

Exhibit “B” – Copies of the Certificates of Registration of the Opposer from different jurisdictions including the list of its worldwide registrations.

This Bureau issued a Notice to Answer on 9 October 2013 and received by Respondent-Applicant on 21 October 2013. However, the Respondent-Applicant did not file an Answer to the Opposition. In view of the failure to file an Answer, an Order declaring the Respondent-Applicant in default was issued on 6 July 2015. Consequently, this case was deemed submitted for decision.

The issue in the present case is whether the trademark ARCHIE may be allowed to be registered under the International Class 3.

The Opposition is anchored on Section 123.1 pars. (d), and (f) of Republic Act No. 8293, also known as, the Intellectual Property Code of the Philippines (“IP Code”), to wit ,

123.1. A mark cannot be registered if it:

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;

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;

The Opposer primarily argues that the trademark ARCHIE with a woman's head device being applied by Respondent-Applicant is identical to, or closely resembles, the Opposer's registered WELLA and a woman's head device trademarks that confusion is likely to result. It further claims that if the subject trademark is allowed to be registered, it would mislead the public that Respondent-Applicant's products originate from or are sponsored by the Opposer, or at least, originate from economically linked undertakings creating an inappropriate trade connection or association to the detriment of the Opposer and the buying public.

However, this bureau does not agree.

The competing marks are reproduced below for comparison:



Opposer Trademark



Respondent-Applicant  
Trademark

Upon examination of the two competing trademarks as shown above, this Bureau finds that the marks are not similar and the registration by the Respondent-Applicant of the mark ARCHIE with the woman's head device is unlikely to cause confusion or indicate any connection between the respondent-applicant's goods and that of the Opposer's.

Very apparent from the two contending trademarks are the differences in their visual and textual composition. At the outset, the two marks have different labeling word marks: "WELLA" for the Opposer and "ARCHIE" for the Respondent-Applicant. While the two marks both have a device of a woman's head with hair, the two illustrations are distinctive and can easily be differentiated from each other.

Moreover, even assuming that the woman's head device has already become a "mark unto itself" by virtue of the prior and continuous use by the Opposer and its subsidiaries and affiliates, the same does not warrant the Opposer an exclusive right to use the woman's head with hair devices, especially with respect to hair care and related products. The

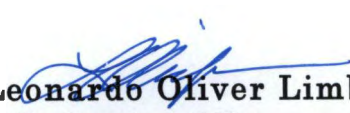
representation of any hair element in a mark is considered generic with respect to hair related products and cannot be exclusively appropriated.

In our jurisdiction, 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>4</sup> This Bureau finds that the trademark being applied for by the respondent-applicant satisfies this function and does not infringe on the registered trademark of the Opposer.

**WHEREFORE**, premises considered, the instant opposition to Trademark Application Serial No. 42012502003 is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 42012502003 be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

**SO ORDERED.**

Taguig City, 23 DEC 2016

  
**Atty. Leonardo Oliver Limbo**  
Adjudication Officer  
Bureau of Legal Affairs

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<sup>4</sup> Gabriel v. Perez, 55 SCRA 406, 417 [1974] citing 52 Am Jur, p. 508; Etepha v. Director of Patents, 16 SCRA 495, 497 [1966]; see also Phil. Refining Co., Inc. v. Ng Sam, 115 SCRA 472, 476-477 [1982]; also cited in Agpalo, Trademark Law and Practice in the Philippines, p. 5 [1990]