

SLUMBERLAND ASIA PACIFIC LIMITED,
Opposer,

-versus-

POLYFOAM-RGC INTERNATIONAL CORP.,
Respondent-Applicant.

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IPC No. 14-2014-00483
Opposition to:
Appln. Serial No. 4-2013-015213
Date Filed: 20 December 2013

**TM: SLUMBER COOL MATTRESS
BY URATEX**

NOTICE OF DECISION

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POLYFOAM-RGC INTERNATIONAL CORPORATION

Respondent- Applicant
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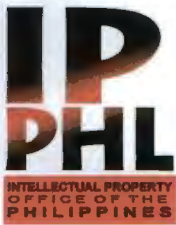
GREETINGS:

Please be informed that Decision No. 2017 - PI dated 02 June 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHEL 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, 02 June 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



SLUMBERLAND ASIA PACIFIC LIMITED,	} IPC NO. 14-2014-00483
Opposer,	} Opposition to:
	}
-versus-	} Appln. Ser. No. 4-2013-015213
	} Date Filed: 20 December 2013
	}
POLYFOAM-RGC INTERNATIONAL	} Trademark: "SLUMBER COOL
CORPORATION,	} MATTRESS BY URATEX"
Respondent-Applicant.	}
X-----X	} Decision No. 2017- 191

DECISION

SLUMBERLAND ASIA PACIFIC LIMITED ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2013-015213. The application, filed by POLYFOAM-RGC INTERNATIONAL CORPORATION. (Respondent-Applicant)², covers the mark "SLUMBER COOL MATTRESS BY URATEX", for use on "mattress" under class 20 of the International Classification of Goods³.

The Opposer relies on the following grounds in support of its Opposition:

- "4.1. Opposer is the true, lawful owner of the well-known Slumberland marks;
- "4.2. Respondent-Applicant's "Slumber Cool Mattress by Uratex" mark is confusingly similar to Opposer's well-known Slumberland Marks, the registration of which will be in violation of Section 123.1 (e) of the IP Code and international treaties; [and]
- "4.3. Respondent-Applicant's use and appropriation of the "Slumber Cool Mattress by Uratex" mark falsely suggests a connection between it and Opposer, thereby causing damage to Opposer and the public."

The Opposer relies on the following facts:

- "5.1. Opposer is the true and rightful proprietor of the internationally known Slumberland trademarks used in connection with Opposer's mattress and bedding-related products under class 20.

¹ A corporation duly organized and existing under the laws of British Virgin Islands, with office address at 2 P.O. Box 957, Offshore Incorporations Centre, Road Town, Tortola, British Virgin Islands.
² A Philippine corporation with address at 1608 Sapang Bakaw, Service Road, east Canumay, Valenzuela City
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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“5.2. Opposer was founded in England in 1919 by Mr. John Seccombe with the famous name ‘Slumberland’ appearing for the first time in the 1930’s. Opposer owns Slumberland brand and its associated brands (Vono, Sleepmate, StarryNite, SlumberKIDS and others) in more than 20 countries across Asia.

“5.3. In 2002, the Opposer became part of the Hilding Anders group, the world’s third largest bed and mattress manufacturer and supplier. As a result of the acquisition, Opposer is now also known as Hilding Anders Asia Pacific Limited, and the Opposer trademark registrations have been transferred in the name of Hilding Anders Asia Pacific Limited in some countries. Xxx

“5.4. In the exercise of lawful ownership over the Slumberland marks, Opposer caused their registration in various countries outside the Philippines. Xxx

“5.5. In the Philippines, as early as 1988, Opposer already sought protection for its Slumberland Marks by filing applications for the registration thereof with this Honorable Office. At present, Opposer owns the following the Philippine trademark registrations covering furniture, mattresses and bedding related products under class 20:

Mark	Reg. No.	Reg. Date	Class
SLUMBERLAND	5416	1 February 1993	20
SLUMBERLAND LOGO	03863	15 April 1988	20
SLUMBERLAND POSTURE SPRINGING	039977	14 July 1988	20

“5.6. Opposer conducts extensive advertising/promotional campaigns for products bearing Slumberland marks worldwide activities.xxx”

Opposer submitted as evidence, the following:

1. Brochure, hotel leaflet, advertisements bearing Opposer’s products published in the 10 October 2014 edition of the Philippine Star and the 22-23 August 2014 edition of Business World;
2. Photograph of a delivery truck of Opposer’s Philippine distributor, Atlas Home Products, Inc., bearing an advertisement for Opposer’s Slumberland products;
3. Copy of the Superbrand Status awarded to Opposer’s Slumberland Marks and products by the Thailand Superbrands Council in 2003/2004;
4. Reports of Opposer’s Marketing Activities;
5. Photographs of Opposer’s showrooms in Shanghai;
6. Photographs of Opposer’s advertisements in Chinese newspapers and magazines;
7. Leaflets and advertisements for Opposer’s products bearing the Slumberland Marks in Singapore; and

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8. Advertisements and articles for Slumberland marks in Malaysia printed and online newspapers and magazines.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 3 February 2015. The Respondent-Applicant, however did not file an Answer. Thus, this Bureau issued Order No. 2015-1289 dated 25 August 2015 declaring the Respondent-Applicant in default.

Should the Respondent-Applicant be allowed to register the trademark SLUMBER COOL MATTRESS BY URATEX?

The records show that at the time Respondent-Applicant applied for registration of the mark "SLUMBER COOL MATTRESS BY URATEX" on 20 December 2013 for goods under Class 20, the Opposer already has existing registrations for the marks "SLUMBERLAND" under Reg. No. 54106⁵ issued on 1 February 1993; "SLUMBERLAND AND LOGO" under Reg. No. 03864⁶ on 15 April 1988 and "SLUMBERLAND POSTURE SPRING" under Reg. No. 039977⁷, for goods under Class 20, namely: "furniture, mattresses, mattress bases, divans, bedding, other than bed clothing), pillows, (not for surgical or curative purposes) bolsters and cushions (upholstery)".

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

Opposer's mark

SLUMBERLAND

Respondent-Applicant's mark



Both marks, are similar with respect to the word SLUMBER differing in that the Opposer appends the word LAND, while the Respondent-Applicant added the stylized word COOL. Beneath the mark are the words "mattress by Uratex". The addition of these words are negligible because SLUMBER is the dominant or central part of the mark which was appropriated by the Respondent-Applicant. In the case of Dermaline, Inc. v. Myra Pharmaceuticals, Inc.⁸, the Supreme Court explains:

The Dominancy Test focuses on the similarity of the prevalent features of the competing trademarks that might cause confusion or deception. It is applied when the trademark sought to be registered contains the main, essential and dominant features of the earlier registered trademark, and confusion or deception is likely to

⁴ Exhibits "A" to 'R"

⁵ Exhibit "B"

⁶ Exhibit "B"

⁷ Ibid

⁸ G.R. No. 190065, 16 August 2010

result. Duplication or imitation is not even required; neither is it necessary that the label of the applied mark for registration should suggest an effort to imitate. The important issue is whether the use of the marks involved would likely cause confusion or mistake in the mind of or deceive the ordinary purchaser, or one who is accustomed to buy, and therefore to some extent familiar with, the goods in question. Given greater consideration are the aural and visual impressions created by the marks in the public mind, giving little weight to factors like prices, quality, sales outlets, and market segments. The test of dominancy is now explicitly incorporated into law in Section 155.1 of R.A. No. 8293 which provides-xxx

On account of Respondent-Applicant's use of the dominant word SLUMBER, visually and aurally, the marks are confusingly similar. The Supreme Court in the case of Marvex Commercial Co., Inv. V. Petra Hawpia & Co. and the Director of Patents⁹ is instructive on the matter, to wit:

Two letters of "SALONPAS" are missing in "LIONPAS"; the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance (Co Tiong Sa vs. Director of Patents, 95 Phil. 1 citing Nims, The Law of Unfair Competition and Trademarks, 4th ed., vol. 2, pp. 678-679). xxx

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jazz-Sea"; "Silver Flash" and "Supper-Flash"; "Cascarete" and "Celborite"; "Celluloid" and "Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo". Leon Amdur, in his book "TradeMark Law and Practice", pp. 419-421, cites, as coming within the purview of the *idem* sonans rule, "Yusea" and "U-C-A", "Steinway Pianos" and "Steinberg Pianos", and "Seven-Up" and "Lemon-Up". In Co Tiong vs. Director of Patents, this Court unequivocally said that "Celdura" and "Cordura" are confusingly similar in sound; this Court held in Sapolin Co. vs. Balmaceda, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin", as the sound of the two names is almost the same.

In the case at bar, "SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (see Celanese Corporation of America vs. E. I. Du Pont, 154 F. 2d. 146, 148).

⁹ G.R. No. L-19297, 22 December 1966


Furthermore, the Opposer submitted proof of its ownership of the “SLUMBERLAND” mark, such as its Philippine registrations; foreign registrations¹⁰ of the mark “SLUMBERLAND”; and various advertisements, articles and photographs of the mark as used here and abroad.

Succinctly, the public interest, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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.¹¹

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2013-015213 is hereby **SUSTAINED**. 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, 02 JUN 2017


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

¹⁰ Exhibit “C” to “F”

¹¹ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).