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| VOLVO TRADEMARK HOLDING AB, | } | IPC No. 14-2007-00288 |
| <i>Opposer,</i> | } | |
| | } | Opposition to: |
| -versus- | } | |
| | } | Trademark: LOVOL & DEVICE |
| HEBEI AULION HEAVY | } | App. Serial No.: 4-2006-004366 |
| INDUSTRIES CO., LTD., | } | Filed: 26 April 2006 |
| <i>Respondent-Applicant.</i> | } | Class: 7 and 12 |
| x-----x | } | Decision No. 2008-223 |

DECISION

For resolution is the Notice of Opposition filed by Volvo Trademark Holding AB against the application for registration of the trademark "LOVOL & DEVICE" with Application Serial No. 4-2006-004366 dated 26 April 2006 for goods falling under International Class 7 and 12 by Hebei Aulion Heavy Industries Co., Ltd.

Opposer is a corporation duly organized and existing under the laws of Sweden having its principal place of business at c/o AB Volvo, SE-405 08 Goteborg, Sweden. On the other hand, Respondent-Applicant is a corporation existing under the laws of People's Republic of China having its principal place of business at Xuanhua High-Development Zone, Hebei Province, China.

Believing that it will be damaged by the registration of the said trademark, Opposer filed its Verified Notice of Opposition dated 4 October 2007 based on the following grounds:

1. The Opposer is the owner of the Volvo mark, which is registered in industrial property offices worldwide, including the Philippine Intellectual Property Office (IPO). In the IPO, the VOLVO mark is registered in the name of the Opposer for goods falling under Class 7, 8, 9, 11, 12, 17 and 37.
2. The Opposer likewise filed on 17 February 2006 Application No. 4-2006-001904 for VOLVO AND DEVICE in classes 1, 2, 3, 4, 6, 7, 9, 11, 12, 14, 16, 18, 25, 36, 37, 39 and 41.
3. The registration of the mark subject of this opposition is contrary to Sections 123.1 (d), (e), (f) of Republic Act No. 8293.
4. The Respondent-Applicant's mark nearly resembles the Opposer's VOLVO mark in terms of spelling, pronunciation and appearance as to be likely to deceive or cause confusion. 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.
6. The Opposer's VOLVO mark is a well-known and world famous mark. Hence, the registration of the Respondent-Applicant's mark will constitute a violation of Articles 6bis and 10bis of the Paris Convention in conjunction with Sections 3, 123.1 (e) and 123.1 (f) of Republic Act No. 8293.
7. The Opposer's predecessors in interest and licensees have used the VOLVO mark in the Philippines and elsewhere prior to the filing date of the application subject of this opposition. This VOLVO mark continues to be used in the Philippines and in other countries and territories by the Opposer's duly authorized licensees.

8. The Opposer's predecessors in interest and licensees have also extensively promoted the VOLVO mark in the Philippines and in other countries. Over the years, the Opposer's predecessors in interest and licensees have obtained significant exposure for the goods upon which the VOLVO mark is used in various media.
9. The Opposer has not consented to the Respondent-Applicant's use and registration of the LOVOL & DEVICE mark or any other mark identical or similar to the Opposer's VOLVO mark.
10. The use by the Respondent-Applicant of the LOVOL & DEVICE mark on the goods covered by the opposed application and other goods that are similar, identical or closely related to goods and services that are produced or rendered by, originate from, or are under the sponsorship of the Opposer's licensees, such as automobiles, trucks, other land vehicles, machines and engines will mislead the purchasing public into believing that the Respondent-Applicant's goods are produced by, originate from, or under the sponsorship of the Opposer's licensees. Respondent-Applicant's use of the LOVOL & DEVICE mark will constitute unfair competition and potential damage to the Opposer and will be caused as a result of the Opposer's inability to control the quality of the products put on the market by the Respondent-Applicant under the LOVOL & DEVICE mark.
11. The use by the Respondent-Applicant of the LOVOL & DEVICE mark in relation to any goods or services identical, similar or closely related to the goods or services identical, similar or closely related to the goods and services of the Opposer's licensees will take unfair advantage of dilute and diminish the distinctive character or reputation of the Opposer's VOLVO mark.
12. The denial of the application subject of this opposition is authorized under other provisions of Republic Act No. 8293.

Upon issuance of Office Order No. 79 (Amendments to the Regulation on Inter Partes Proceedings), which took effect on Sept. 1, 2005, this case was mandatorily covered by the summary rules in compliance therewith, Opposer submitted the following documentary evidence to support the opposition:

1. Original legalized Verified Notice of Opposition – Exhibit "A"
2. Original legalized Affidavit of Monica Dempe – Exhibit "B" and its attachments, namely:
 - a. Annexes "A-1" to "A-6" – Volvo Car Corporation's Corporate Citizenship Reports for the years 2000 to 2005 – Exhibit "B-1" to "B-6"
 - b. Annexes "A-7" to "A-12" – Volvo Group's Annual Reports for the years 2001 to 2006 – Exhibit "B-7" to "B-12"
 - c. Annex "B" – Advertisements and other promotional materials related to the VOLVO mark – Exhibit "B-13"
 - d. Annex "C" – Printouts of www.volvo.com and www.volvocars.com – Exhibit "B-14"
 - e. Annex "D" – List of VOLVO trademark applications and registrations worldwide – Exhibit "B-15"

- f. Annex "E" – Decisions from all over the world recognizing the well-known status of the VOLVO mark – Exhibit "B-16"
3. Original legalized Certificate showing Monica Dempe's authority to verify the notice of opposition and execute the certificate of non-forum shopping and the undersigned's authority to represent Opposer in these proceedings – Exhibit "C"
4. Hong Kong Trademark Registration No. 300162288 for VOLVO – Exhibit "D"
5. United States of America Trademark Registration No. 3,207,372 for VOLVO – Exhibit "E"
6. United States of America Trademark Registration No. 1,220,779 for VOLVO – Exhibit "F"
7. Singapore Trademark Registration No. T75/65774E for VOLVO – Exhibit "G"
8. Singapore Trademark Registration No. T62/29924A for VOLVO – Exhibit "H"
9. Chile Trademark Registration No. 530,355 for VOLVO and its English translation – Exhibits "I" and "I-1"
10. Republic of Ireland Trademark Registration No. 58193 for VOLVO – Exhibit "J"
11. Australia Trademark Registration No. A164,628 for VOLVO – Exhibit "K"
12. Australia Trademark Registration No. A288,859 for VOLVO – Exhibit "L"
13. Republic of Peru Trademark Registration No. 14519 for VOLVO and its English translation – Exhibits "M" and "M-1"
14. Republic of Peru Trademark Registration No. 20292 for VOLVO and its English translation – Exhibits "N" and "N-1"
15. United Kingdom Trademark Registration No. 1051579 for VOLVO – Exhibit "O"
16. United Kingdom Trademark Registration No. 7473962 for VOLVO – Exhibit "P"
17. Canada Trademark Registration No. 109,888 for VOLVO – Exhibit "Q"
18. Israel Trademark Registration No. 14521 for VOLVO – Exhibit "R"
19. South Africa Trademark Registration No. 1445/55 for VOLVO – Exhibit "S"
20. Morocco Trademark Registration NO. 56612 for VOLVO and its English translation – Exhibits "T" and "T-1"
21. Japan Trademark Registration No. 941788 for VOLVO and its English translation – Exhibits "U" and "U-1"
22. Community Trademark Registration No. 2361087 for VOLVO – Exhibit "V"
23. Colombia Trademark Registration No. 34288 for VOLVO – Exhibit "W"
24. Venezuela Trademark Registration Nos. 26290 and 26660 for VOLVO – Exhibit "X"

25. Sweden Trademark Registration No. 78133 for VOLVO and its English translation – Exhibits “Y” and “Y-1”
26. Sweden Trademark Registration No. 135541 for VOLVO and its English translation – Exhibits “Z” and “Z-1”
27. China Trademark Registration No. 1060406 for VOLVO and its English translation – Exhibits “AA” and “AA-1”
28. China Trademark Registration No. 1089832 for VOLVO and its English translation – Exhibits “BB” and “BB-1”

The records show that on 11 October 2007, a Notice to Answer was issued requiring Respondent-Applicant to file its verified Answer within thirty (30) days from receipt thereof. The said Notice was received by Respondent-Applicant on 18 October 2007, thus it had until 18 November 2007 within which to file its verified Answer. On 15 November 2007, Respondent-Applicant filed an Urgent Motion for Extension of Time to File Answer which was granted by this Bureau. Accordingly, Respondent-Applicant was given a period of until 18 December 2007 within which to file its Answer. Subsequently, on 14 December 2007 and 17 January 2008, Respondent-Applicant filed a second and third motion for extension of time to file answer which were both granted, thus, Respondent-Applicant was given an addition period of until 16 February 2008 within which to file its verified Answer.

Taking into account that this Bureau has already granted three (3) Motions for Extension of Time to File Verified Answer filed by Respondent-Applicant and that the 120 days maximum period allowed by the Rules for the filing of Respondent’s Verified Answer has already lapsed, this Bureau denied Respondent-Applicant’s fourth Motion for Extension of Time in Order 2008-396.

On 7 March 2008, Respondent-Applicant filed its Motion to Admit Compliance with Verified Answer. However, this Bureau can no longer accept the said Motion and the attached Verified Answer because it was filed out of time. This Bureau has already given Respondent-Applicant sufficient time to comply with the requirements, but still it failed to do so. For the same reason, Respondent-Applicant’s Verified Answer may not be taken into consideration.

Section 8.2 of Office Order No. 79 clearly provides:

8.2 The respondent shall file the answer within (30) days from receipt of the Notice to answer together with the duly marked affidavits of witnesses and other documents serving copies thereof upon petitioner or opposer. Upon proper motion and payment of the applicable fee, the Bureau may grant an additional period of thirty (30) days within which to file the answer. No further extension shall be granted except for the most compelling reason and in no case shall the period exceed 120 days from receipt of the Notice to Answer. (Emphasis supplied)

Since Respondent-Applicant failed to file its Verified Answer within the reglementary period, this case is now deemed submitted for decision.

The main issue to be resolved in the instant case is:

WHETHER OR NOT THE RESPONDENT’S MARK “LOVOL & DEVICE” IS CONFUSINGLY SIMILAR TO OPPOSER’S MARK “VOLVO”.

Even without the Verified Answer of Respondent-Applicant, this Bureau can conclude that “LOVOL & DEVICE” is not at all confusingly similar to “VOLVO”.

The Supreme Court, in determining whether or not there is confusing similarity between trademarks, has relied on the dominancy test or the assessment of the essential or dominant features in the competing trademarks. Even the spelling and the similarity in sounds and pronunciation are taken into consideration.

By simple examination of the two marks, there can be no mistaking the fact that the two are very different not only in appearance, but also in their spelling and pronunciation as well. In the matter of their appearance, although both are composed of five (5) letters each and use only the letters "V", "O" and "L" that is the only extent of their similarity. Each mark has a distinct pronunciation. Moreover, the Opposer's mark "VOLVO" is written in white, enclosed by a black rectangle and encapsulated in a double ringed circle with an arrow protruding from north east pointing outward, while Respondent-Applicant's mark "LOVOL" is written in black and enclosed in a stylized rectangle. Under these facts, there can be no confusion as to the two marks.

Considering that no confusing similarity exist between the marks "LOVOL & DEVICE" and "VOLVO", discussion of the goods covered becomes immaterial.

WHEREFORE, premises considered, the Notice of Opposition is, as it is, hereby DENIED. Consequently, Application Serial No. 4-2006-004366 for the registration of the mark "LOVOL & DEVICE" on goods under Classes 7 and 12, filed on 26 April 2006 by Hebei Aulion Heavy Industries Co., Ltd. is, as it is, hereby GIVEN DUE COURSE.

Let the filewrapper of "LOVOL & DEVICE" subject mater in this case together with this decision be forwarded to the Bureau of Trademarks (BOT) with for appropriate action.

SO ORDERED.

Makati City, 19 December 2008.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office