



**THE MANUFACTURERS LIFE
INSURANCE COMPANY,**

Opposer,

-versus-

**SUN LIFE ASSURANCE COMPANY
OF CANADA,**

Respondent-Applicant.

X-----X

IPC No. 14-2008-00244

Opposition to:

Appln. Serial No. 4-2008-500036

Date filed: 24 January 2008

TM: "BRINGING LIGHT TO LIFE"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 – 211 dated October 23, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 23, 2012.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



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TM: "BRINGING LIGHT TO LIFE"

Decision No. 2012- 2//

DECISION

THE MANUFACTURERS LIFE INSURANCE CO. ("Opposer")¹ filed on 08 October 2008 an opposition to Trademark Application Serial No. 4-2008-500036. The application, filed by SUN LIFE ASSURANCE COMPANY OF CANADA ("Respondent-Applicant")², covers the mark "BRINGING LIGHT TO LIFE" for use on goods under Class 36³. The Opposer alleges among other things, the following:

"1. Opposer is the first to adopt and use worldwide, including in the Philippines, the 'BRINGING DREAMS TO LIFE' mark for insurance and financial investment service falling under International Class 36.

"2. The Opposer's 'BRINGING DREAMS TO LIFE' mark for service falling under International Class 36 is well-known internationally and in the Philippines, taking into account the knowledge of the relevant sector of the public, as being a mark owned by the Opposer.

"3. There is a likelihood of confusion between Opposer's 'BRINGING LIGHT TO LIFE' because said mark comprises of the same words as Opposer's mark, differing only by one word 'LIGHT', as against Opposer's 'DREAMS', and as such, when applied to or used in connection with the services of Respondent-Applicant, causes confusion, mistake and deception on the part of the purchasing public as being a mark owned by the Opposer. No doubt, the use of Respondent-Applicant's 'BRINGING LIGHT TO LIFE' mark for its services will indicate a connection between its services and those of the Opposer's. Hence, the Respondent-Applicant's 'BRINGING LIGHT TO LIFE' mark cannot be registered in the Philippines pursuant to the express provision of Section 123 (e) of R.A. No. 8293.

"4. Respondent-Applicant, in adopting 'BRINGING LIGHT TO LIFE' for its goods, is likely to cause confusion or mistake, or to deceive as to the affiliation, connection, or association with the Opposer, or as to origin, sponsorship, or approval of its goods and services by the Opposer, for which it is liable for false designation of origin, false description or representation under Section 169 of R.A. 8293.

xxx

"1. Opposer is the first to adopt and use the 'BRINGING DREAMS TO LIFE' mark

Opposer is the first to adopt and use the 'BRINGING DREAMS TO LIFE' mark in the Philippines and worldwide. Said mark was used by Opposer in Asian countries such as China, Hong Kong, Indonesia, Japan, Malaysia, Philippines, Singapore, Taiwan, Thailand and Vietnam since the year 2006, as shown by the 11th Anniversary (2007) brochure of the Asia Insurance Industry Awards. Said mark was also shown in the print-outs of scanned promotional material showing use of the mark as early as September 2007 and in the Philippines, the

¹A corporation duly organized and existing under the laws of Canada, with principal office address at No. 200 Bloor Street East, Toronto, Ontario, Canada.

²With address at 150 King Street West, Suite 1400 Toronto, Ontario M5H 1J9, Canada.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

mark was used by Opposer's subsidiary, since 2007 as shown by the promotional materials and the copyright registration of its song entitled "BRINGING DREAMS TO LIFE".

"2.The Opposer's 'BRINGING DREAMS TO LIFE' mark is internationally well-known.

The 'BRINGING DREAMS TO LIFE' mark, which has originated from Opposer and which it has adopted the same for insurance and financial investment services, is internationally well-known. It has also been stated by Opposer, that it's 'BRINGING DREAMS TO LIFE' mark has been and is being used, promoted and advertised for a considerable duration of time and over wide geographical areas in several countries and all over the Philippines. In Asia and globally, Opposer has been using the 'BRINGING DREAMS TO LIFE' mark extensively since it announced its Olympic sponsorship in 2004.

As early as June 2006, Manulife Philippines was made aware of the Manulife Olympic Activation Guide, with the theme 'BRINGING DREAMS TO LIFE' but started using the theme from January 2007 with the agency force, employees and customers as its primary evidence.

In conjunction with Manulife's Centennial anniversary in the Philippines and beyond, the taglines '100 years of BRINGING DREAMS TO LIFE' and 'Over 100 years of BRINGING DREAMS TO LIFE' have been used in agency circulars. A song writing contest among employees was held in mid-2007 with the song 'BRING YOUR DREAMS TO LIFE' chosen as winner.

"3.The 'BRINGING LIGHT TO LIFE' service mark nearly resembles the 'BRINGING DREAMS TO LIFE' service mark of Opposer as to be likely to deceive or cause confusion.

It is therefore Opposer's contention that Respondent-Applicant's service mark is confusingly similar to the 'BRINGING DREAMS TO LIFE' mark of Opposer, both in sound and spelling. The 'BRINGING LIGHT TO LIFE' mark comprises of the same words as Opposer's mark, differing only by one word - 'LIGHT', as against Opposer's 'DREAMS'. When pronounced, the contending marks begin with the same word and sound - the hard sound of the word 'BRINGING', and ends with the same word 'LIFE' having the same lingering soft sound of the letter 'F'.

It is additionally contended by Opposer, that visually, the two marks are similar, notwithstanding the difference in the second words. Thus, to the eye of an observer, the dominant words are the first word 'BRINGING', and the last word 'LIFE', appearing in both marks. With a cursory glance of an untrained observer, who is in a hurry, the words that most certainly would be remembered are the words 'BRINGING' and 'LIFE'. The fact that both contending marks begin and end with the same words creates confusion in the mind of the consuming public as to the origin of the products/services carrying these two contending marks. No doubt, the use of Respondent-Applicant's 'BRINGING LIGHT TO LIFE' mark for its services will indicate a connection between its services and those of the Opposer's.

"4.The use of Respondent-Applicant's service mark 'BRINGING LIGHT TO LIFE' would indicate a connection with the services covered in Opposer's 'BRINGING DREAMS TO LIFE' mark, hence, the interests of the Opposer are likely to be damaged.

Since Respondent-Applicant's products/services are clearly identical to Opposer's products/services covered by its 'BRINGING DREAMS TO LIFE' mark, it would undoubtedly mislead the public into believing that its products/services are licensed or sponsored by the Opposer or that Respondent-Applicant is associated with or an affiliate of the Opposer.

Thus, it is the contention, additionally, of Opposer, that Respondent-Applicant has appropriated the mark 'BRINGING LIGHT TO LIFE' for the obvious purpose of capitalizing upon or riding on the valuable goodwill and popularity of the 'BRINGING DREAMS TO LIFE' mark, which Opposer gained through tremendous effort and expense over a long period of time, clearly constituting an invasion of Opposer's Intellectual Property Rights.

On the whole, Opposer contends that Respondent-Applicant's use of the 'BRINGING LIGHT TO LIFE' mark will dilute the distinctiveness of its (Opposer's) 'BRINGING DREAMS TO LIFE' mark. The use, sales and distribution by the Respondent-Applicant of its 'products' using the 'BRINGING LIGHT TO LIFE' mark will inflict considerable damage to the interests of the Opposer."

The Opposers' evidence consists of the "11th Anniversary (2007) brochure of the Asia Insurance Awards", print-outs of scanned promotional materials allegedly showing use of BRING YOUR DREAMS TO LIFE as a mark as early as September 2007, copyright registration of the Opposer's song entitled "Bring Your Dreams To Life", various promotional materials, and the Affidavit of Robert Allen Cook and the annexes thereto.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 12 November 2008. The Respondent-Applicant filed three successive motions for extension of time to file Answer, all of which were granted by this Bureau. However, the Respondent-Applicant still failed to file the Answer.

The Opposer anchors its case on Sec. 123.1(e) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), which provides that a mark cannot be registered if it:

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

The Opposer claims that it has a well-known mark that is confusingly similar to the Respondent-Applicant's mark BRINGING LIGHT TO LIFE. But to successfully invoke Sec. 123.1(e) of the IP Code, the Opposer must first establish that BRINGING DREAMS TO LIFE is a well-known mark. Corollarily, Rule 102 of the Trademark Regulations sets forth the criteria for determining whether a mark is well-known, to wit:

Rule 102. *Criteria for determining whether a mark is well-known.* In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- c) the degree of the inherent or acquired distinction of the mark;
- d) the quality-image or reputation acquired by the mark;
- e) the extent to which the mark has been registered in the world;
- f) the exclusivity of registration attained by the mark in the world;
- g) the extent to which the mark has been used in the world;
- h) the exclusivity of use attained by the mark in the world;
- i) the commercial value attributed to the mark in the world;
- j) the record of successful protection of the rights in the mark;
- k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- l) the presence of absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.

⁴Marked as Exhibits "A" to "F", inclusive.

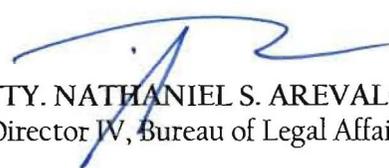
A scrutiny of the records show that there is no proof that BRINGING DREAMS TO LIFE is a well-known mark. There is no single registration of BRINGING DREAMS TO LIFE as a trademark in any country. The "11th Anniversary (2007) brochure of the Asia Insurance Awards" refers to the name or mark MANULIFE. Also, the advertisement and promotional materials submitted by the Opposer show that the phrase "*Bringing Dreams To Life*" is only a complementary feature to the MANULIFE mark and logo.

In this regard, 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.⁵ While "*Bringing Dreams To Life*" could be a "*visible sign capable of distinguishing the goods (trademark) or service (service mark)*"⁶, the Opposer, however, has not even clearly established that it thus serves such function or purpose of a trademark prior to the Respondent-Applicant's filing of a trademark application⁷. There can be no basis to arrive at a conclusion that "*Bringing Dreams To Life*" points out distinctly the origin or ownership of goods and services because what the public sees or notices is not solely that phrase but also the name or mark and logo of MANULIFE. It is more likely that the identity, origin and reputation of the Opposer's services are defined and be remembered by the public through the name or mark and logo of MANULIFE.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2008-500036, together with a copy of this Decision, be returned to the Bureau of Trademark for appropriate action.

SO ORDERED.

Taguig City, 23 October 2012.


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

⁵*Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

⁶ See definition of a mark under Sec. 121.1 of the IP Code.

⁷ Application Serial No. 4-2008-004556 filed on 18 April 2008 (Annex "C" of Exhibit "F").