



ZINO DAVIDOFF S.A.,  
Opposer,

-versus-

PEERLESS PRODUCTS MANUFACTURING  
CORPORATION,  
Respondent- Applicant.

X-----X

}  
} IPC No. 14-2011-00582  
} Opposition to:  
} Appln. Serial No. 4-2011-501348  
} Date filed: 09 September 2011  
} TM: "CHAMPION"  
}  
}  
}  
}

### NOTICE OF DECISION

#### SIGUION REYNA MONTECILLO & ONGSIAKO

Counsel for Opposer  
4<sup>th</sup> and 6<sup>th</sup> Floors, Citibank Center  
8741Paseo de Roxas, Makati City

#### SAPALO VELEZ BUNDANG & BULILAN

Counsel for the Respondent-Applicant  
11<sup>th</sup> Floor, Security Bank Centre  
6776 Ayala Avenue, Makati City

#### GREETINGS:

Please be informed that Decision No. 2013 - 151 dated July 24, 2013 ( copy enclosed)  
was promulgated in the above entitled case.

Taguig City, July 24, 2013.

For the Director:

**Atty. PAUSI U. SAPAK**  
Hearing Officer  
Bureau of Legal Affairs



ZINO DAVIDOFF S.A.,  
Opposer,

IPC No. 14-2011-00582  
Case Filed: 19 March 2012

-versus-

Opposition to:  
Appln. Serial No. 4-2011-501348  
Date Filed: 09 September 2011

PEERLESS PRODUCTS MANUFACTURING  
CORPORATION,  
Respondent-Applicant.

Trademark: "CHAMPION"

x-----x

Decision No. 2013 - 151

### DECISION

ZINO DAVIDOFF S.A. ("Opposer")<sup>1</sup> filed on 19 March 2012 an opposition to Trademark Application Serial No. 4-2011-501348. The application, filed by PEERLESS PRODUCTS MANUFACTURING CORPORATION ("Respondent-Applicant")<sup>2</sup>, covers the mark "CHAMPION" for use on "dishwashing liquid; detergent powder; fabric conditioner; shampoo; conditioner; liquid detergent, bleach; dishwashing paste; laundry soap; toilet soap" under Class 3 of the International Classification of Goods and Services<sup>3</sup>.

The Opposer anchors its opposition on the ground that it is the holder of Trademark Registration No. 4-2009-013139 for DAVIDOFF CHAMPION in Class 3 in the Philippines, a mark which was registered prior to the filing of Respondent-Applicant's application for registration. In support of its opposition, the Opposer submitted in evidence the following:

1. Exhibit "A" - Declaration of Actual Use;
2. Exhibit "B" - Registration of the mark Champion in the European Union;
3. Exhibit "C" - Registration of the mark Champion in European Union;
4. Exhibit "D" - Registration of the mark Champion in Germany;
5. Exhibit "E" - Registration of the mark Davidoff Champion in Peru;
6. Exhibit "F" - Registration of the mark Davidoff Champion in Brazil;
7. Exhibit "G" - Registration of the mark Davidoff Champion in Bolivia;
8. Exhibit "H" - Registration of the mark Davidoff Champion in Taiwan;
9. Exhibit "I" - Registration of the mark Davidoff Champion in Kingdom of Cambodia;
10. Exhibit "J" - Registration of the mark Davidoff Champion in China;

<sup>1</sup> A corporation duly organized and existing under the laws of Switzerland with business address at Rue Faucigny 5, 1700 Fribourg, Switzerland.

<sup>2</sup> With address at No. 35 San Francisco Street, Valenzuela City.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the 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 Purpose of the Registration of Marks concluded in 1957.

11. Exhibit "K" - Registration of the mark Davidoff Champion in Japan;
12. Exhibit "L" - Registration of the mark Davidoff Champion in United States; and
13. Exhibit "M" - Registration of the mark Davidoff Champion in Australia.

On 06 August 2012, the Respondent-Applicant filed its Verified Answer denying all the material allegations in the opposition, arguing that it is the first to apply for and to obtain registration of the mark "CHAMPION" under Reg. No. 424537 issued on 22 March 1977. The registration was renewed on 22 May 1997. The Respondent-Applicant also points out that it has obtained registrations from the Intellectual Property Office of the Philippines for the mark "CHAMPION" as follows<sup>4</sup>.

1. CHAMPION Reg. No. 424537 issued on 22 March 1977;
2. CHAMPION (Stylized) Reg. No. 4-2004-009471 issued on 18 February 2006;
3. CHAMPION WITH LOGO Reg. No. 4-2003-003307 issued on 26 February 2007; and
4. POWDER CHAMPION DETERGENT POWDER KALAMANSI FRESH LABEL Reg. No. 4-2004-001697 issued on 27 November 2006.

Furthermore, the Respondent-Applicant has subsequently registered and filed applications for registrations of its various "CHAMPION" trademarks before the Intellectual Property Office<sup>5</sup>.

The Respondent-Applicant's evidence consists of the following:

1. Exhibit "1" - Affidavit executed by Mr. Samuel Tui;
2. Exhibit "2 series" - Print-out of the details of the registrations downloaded from the IPO;
3. Annex "A" - Photocopy of peerless products manufacturing corporation identification card;
4. Annexes "B" and "C" - Company profile of peerless as well as its Articles of Inc.;
5. Annex "D series" - Pictures of "CHAMPION" billboards in the provinces and advertisements for the various detergent products;
6. Annex "E series" - Pictures of CHAMPION and GLOW detergent products of peerless;
7. Annex "F series" - Actual labels of CHAMPION variants;
8. Annex "G" - Certified true copy of registration bearing the CHAMPION mark;
9. Annexes "H" to "J" - Copies of various certificates for the mark CHAMPION variants;
10. Annex "K series" - Print-out of peerless various CHAMPION trademarks and CHAMPION derivative marks found in IPO database;

---

<sup>4</sup> Annexes "G" to "G".

<sup>5</sup> Exhibit "2" series.



11. Annex "L series" - Copies of the company's sample sales invoices from 1978 to 2011;
12. Annex "M series" - Copies of news papers ads, internet articles and promotional materials of CHAMPION trademarks;
13. Annex "N series" - Certified copies of sample billing invoices for its promotional and marketing advertisements on newspapers, radio and television;
14. Annex "O series" - Cd's of television advertisements;
15. Annex "P series" - Copy of the summary of peerless various television advertisements from 2005 to 2012; and
16. Annexes "Q" and "R series" - Copy of survey and certification.

Pursuant to Office Order No. 154, s. 2010 (Rules on Mediation Proceedings), this Bureau issued on 22 August 2012 Order No. 2012-168 referring the case to mediation. The parties, however, failed to settle their dispute. Hence, the preliminary conference was conducted and terminated, followed by the parties' submission of their respective position papers.

Should the Respondent-Applicant's trademark application be allowed?

The Opposer anchors its opposition on Section 123.1 (d) of R. A. No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"), which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date in respect of the same goods or services or closely related goods or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

In the instant case, there is no dispute that the contending marks are identical using the same word CHAMPION. Also, the marks are used on the same or closely related goods falling under Class 3 of the International Classification of goods.

The records show that the Opposer obtained its registration for the mark DAVIDOFF CHAMPION in the Philippines on 12 August 2010 bearing Registration No. 4-2009-013139. In other countries, the earliest certificate of registration issued to the Opposer was in the year 2009. The Respondent-Applicant, on the other hand, was issued a certificate of registration for its CHAMPION mark as early as 22 March 1977 under Registration No. 424537. The said registration was renewed on 22 May 1997. Also, the Respondent-Applicant was able to present copies of sample sales invoices dating from 1978 to 2011<sup>6</sup>.

Thus, while it is true that the Opposer's registration was earlier than the Respondent-Applicant's Trademark Application No. 4-2011-501348, there are other trademark registrations for the identical or similar marks used on the same or closely related goods that predate the said Opposer's registration. These registrations belong not to the Opposer nor to a proprietor other than the Respondent-Applicant. The registrations are owned or belonging to the Respondent-Applicant itself.

---

<sup>6</sup> Annex "L" series.

Succinctly, the Opposer cannot invoke Sec. 123.1 (d) of the IP Code. A party who opposes a trademark application pursuant to Section 123.1 (d) of the IP Code must show that it is the owner/holder of the earliest prior and subsisting trademark registration or application.

Likewise, this Bureau cannot sustain the opposition on the basis of Sec. 123.1 (e) of the IP Code. The trademark subject of this opposition case is just a variation of the mark used and registered by the Respondent-Applicant since 1977. At that time, the Opposer's marks did not yet exist, much less, for obvious reason, well-known mark. Corollarily, the Respondent-Applicant could not have copied, or derived "inspiration" from the Opposer's marks. A scrutiny of the registrations of the Opposer's marks in other countries, show that these were obtained only starting 2009. If ever the Opposer's mark may be considered a well-known mark, this could not be earlier than 2009. The Opposer would then have the right to invoke Sec. 123.1 (e) of the IP Code only by the year 2009.

**WHEREFORE**, premises considered the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-501348 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate actions.

SO ORDERED.

Taguig City, 24 July 2013.

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

