

UNILEVER N.V.,

Opposers,

- versus -

INTERCOSMETIC HOLDINGS SDN. BHD.,
Respondent-Applicant.

X-----X

IPC NO. 14-2012-00023

Appln. No. 4-2011-011072

Date Filed: 15 Sept. 2011

TM - "DOVERA & DEVICE"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 366 dated October 11, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 11, 2016.


MARILYN F. RETUTAL
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Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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UNILEVER N.V.,

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INTERCOSMETIC HOLDINGS SDN. BHD.,

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IPC No. 14-2012-00023

Opposition to:

Application No. 4-2011-011072

Date Filed: 15 September 2011

Trademark: DOVERA & DEVICE

Decision No. 2016- 366

DECISION

NOVARTIS AG¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-011072. The application, filed by Intercosmetic Holdings SDN. BHD.² ("Respondent-Applicant"), covers the mark "DOVERA & DEVICE" for use on "colour cosmetic for skin and eyes; hair dyes; skin care products [non-medicated]; skin moisturizers [non-medicated toilet preparations]; body lotions [other than for medical purposes]; skin balms (non-medicated-); creams (non-medicated) for the skin; body soaps; cleansing facial masks; skin cleansers; body deodorants; shaving foams; aftershave lotion; cologne and body sprays [non-medicated]; shampoo for personal use; essential oils for the care of the body and the skin; essential oil for cosmetic purposes and personal use; all included in class 03" under Class 03 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"Statement of Facts and of the Case

"5. Sometime in 1957, Opposer and/or its predecessor companies coined and adopted the word 'DOVE' for the purpose of using the same as a trademark for a beauty soap bar that was clinically proven to be milder for dry or sensitive skin than other soaps in the market. Armed with the mark's ideal of providing a genuine difference in skin and hair conditions, Opposer launched a wide range of cleaning and personal care products by the 1980's, which include moisturizing body-wash, deodorants, body lotions, facial cleaners and shampoos and conditioners.

"6. To date, various DOVE Products, which had recently been offered to both men and women, are sold in numerous jurisdictions in Africa, the Americas, the Asia Pacific, Europe and the Middle East, such as:

x x x

¹A foreign corporation organized under the laws of The Netherlands, with business address at Weena 455, Rotterdam, 3013 AL, The Netherlands.

²With address at No. 27, Jalan TSB 1 Taman Industri Sungai Buloh 47000 Selangor Malaysia.

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.

"7. In fact, its prevalence in the global market has led to the brand's classification by Opposer as one of its 13 'billion-dollar brands,' each of which achieve annual sales in excess of €1 billion and, together with the top 25 brands, account for more than 70% of sales.

"8. Hence, to ensure its exclusive use over its brand and protect the goodwill which it had so long tried to build through years of extensive marketing, Opposer and/or its subsidiaries, joint ventures, sister concerns, predecessors-in-title or assignees, sought the trademark registration of about 2,608 DOVE and derivative marks, in around 177 jurisdictions all over the world, including the WIPO, the earliest of which was secured on 9 April 1953 in Canada under Registration No. UCA 44657. Attached as Annex 'A' hereof is a table showing the details of applications and registrations for the DOVE mark worldwide. Representative samples consisting of certified true copies of trademark registration certificates from major markets are attached as Annex 'B Series'

x x x

"9. In the Philippines, the following relevant trademarks are held in the name of Opposer:

x x x

"10. From the time products bearing the DOVE Marks first became available in 1957, Opposer and its worldwide affiliates have continuously and exclusively marketed the product. In fact, in 2004, Opposer started the 'DOVE Self-Esteem Fund,' which purports to be an agent of change to educate and inspire girls on a wider definition of beauty to make them feel more confident about themselves through a series of tools and workshops which ultimately protects and nurtures their body-related self-esteem and enables them to become fully realized adults. As of the end of 2008, this campaign has been featured in over 25 major television channels and in more than 800 articles in opinion leading newspapers from El Paris to Le Parisien, from The Sun to The Times, as well as in popular women's magazines.

"11. Apart from the campaign, Opposer likewise created a number of short films, including Daughters (which also aired in a 75-second spot during the Super Bowl XL), Evolution (which won two awards at the Cannes Lions International Advertising Festival), Onslaught, and Amy. A third party website known as www.adbrands.net even dedicated a webpage featuring 12 'classical advertising for the DOVE soap brand,' the earliest of which was aired in the mid-1960's. x x x

"12. In the course of Opposer's extensive and notorious use and appropriation of DOVE to identify its various personal care products throughout the world, DOVE was firmly established as a well-known mark and has obtained goodwill and general international consumer recognition as belonging to only one source, i.e., Unilever. Soon, DOVE became a trusted name among consumers, synonymous with Opposer's worldwide reputation for quality. x x x

"13. This worldwide reputation likewise reached Philippine borders. Opposer had undertaken activities to familiarize consumers with the various DOVE Products in the Philippines, launching a special website for Filipinos known as www.dove.ph, which links to other DOVE websites worldwide, and which are all accessible throughout the world including the Philippines.

"14. Sometime in December 2011, Opposer learned that Respondent intended to register a 'DOVERA & DEVICE' mark under Trademark Application No. 4-2011-011072 filed on 15 September 2011, for 'colour cosmetic for skin and eyes; hair dyes; skin care products [non-medicated]; skin moisturizers [non-medicated toilet preparations]; body lotions [other than for medical purposes]; skin balms (non-medicated-); creams (non-medicated) for the skin; body soaps; cleansing facial masks; skin cleansers; body deodorants; shaving foams; aftershave lotion; cologne and body sprays [non-medicated]; shampoo for personal use; essential oils for the care of the body and the skin; essential oil for cosmetic purposes and personal use; all included in class 03.'

"15. A cursory examination of the competing marks shows that Respondent's DOVERA & DEVICE, on the one hand, and Opposer's DOVE Marks, on the other, are confusingly similar, if not identical, inasmuch as Respondent likewise appears to use a device that mimics Opposer's dove device, which alone constitutes sufficient ground for the Honorable Office to rule that the two marks are visually and aurally confusingly similar. The mark appears as follows:

x x x

"16. Hence, this verified Notice of Opposition, which rests on the following grounds:

"(a) Opposer is the prior user and first registrant of the DOVE Marks in the Philippines, well before the filing date of Respondent's DOVE trademark application on 15 September 2011. The earliest registration in the Philippines for a DOVE word mark was granted on 2 July 1996 in the name of Opposer's predecessor-in-interest, Lever Brothers Company, under Trademark Registration No. 063161. Currently, the details of the various DOVE Marks held by Opposer are as follows:

x x x

"(b) Opposer enjoys the exclusive right to prevent all third parties not having its consent from using in the course of trade identical or similar signs for goods which are identical or similar to those in respect of which its trademarks are registered where such use would result in a likelihood of confusion. Section 123 (d), (e), (f), and (g) of the IP Code provide:

x x x

"(c) Opposer's DOVE Marks are not only well-known marks, both internationally and in the Philippines, but are likewise registered as a mark belonging to Opposer in the Philippines. As such, Opposer is entitled to a wider scope of protection under Philippine law and to protect its DOVE Marks against marks that are liable to create confusion in the minds of the public or used in bad faith under Article 6bis of the Paris Convention, thus:

x x x

"(d) If allowed to proceed to registration, the consequent use of the DOVERA & DEVICE mark by Respondent will amount to unfair competition with and dilution of Opposer's DOVE Marks, which have attained valuable goodwill and reputation through years of extensive and exclusive use. This is prohibited under Section 168 of the IP Code.

x x x

- "(e) The registration of Respondent's mark will work to impede the natural expansion of Opposer's use of its DOVE Marks in the Philippines;
- "(f) The registration and consequent use of the DOVERA & DEVICE mark by Respondent will result in a confusion of source or reputation, which is proscribed under the IP Code and applicable precedents; and
- (g) Other provisions of the IP Code and related international agreements or conventions on the subject of intellectual property rights warrant the denial by this Honorable Office of Respondent's trademark application.

"17. It is apparent that Respondent's mark is calculated to ride on or cash in on the popularity of the DOVE Marks, which undoubtedly have earned goodwill and reputation worldwide through Opposer's extensive use and promotion since 1957.

"18. Opposer has not consented to Respondent's use and application for registration of the DOVERA & DEVICE mark, or any other mark identical or similar to Opposer's DOVE Marks.

"19. Opposer and/or its respective subsidiaries, joint ventures, sister concerns, predecessors-in-title, licensees and assignees in several other countries have extensively promoted the DOVE Marks worldwide, and have obtained significant exposure for the goods upon which the DOVE Marks are used in various media, including television commercials, advertisements, internationally well-known print publications, and other promotional events.

"20. If Respondent were to be allowed to register and use its mark in connection with the advertisement, sale and distribution of its goods that are similar, identical, or closely related to Opposer's own goods, the consuming public would no doubt be misled into assuming or believing that Respondent's goods are delivered by, originate from, or are under the sponsorship of Opposer. Respondent's use of its mark would indicate a connection between Respondent's goods and Opposer's, when in truth and in fact there is none.

"21. This no doubt results in the clear irreparable damage of Opposer's goodwill and reputation. Potential damage to Opposer may result in light of its inability to control the quality of the products offered or put on the market by Respondent under the DOVERA & DEVICE mark.

"22. Moreover, considering the substantial investment incurred by Opposer in promoting its goods and identifying themselves throughout the world through the DOVE Marks, it is clear that Respondent's deceitful conduct in attempting to secure the registration of a mark similar to Opposer's and in exploiting the same is aimed towards unduly enriching itself at the expense of Opposer.

"23. At the very least, the use by the Respondent of the DOVERA & DEVICE mark in relation to its goods, whether or not identical, similar or closely related to Opposer's goods, will take unfair advantage of, dilute and diminish the distinctive character or reputation of the DOVE Marks, which have proved to be viable and significant assets of Opposer.

"24. Under the circumstances, Respondent's trademark registration for DOVERA & DEVICE under Application No. 4-2011-011072, filed on 15 September 2011, must be denied.

The Opposer's evidence consists of the Notice of Opposition; the Special Power of Attorney constituting Quisumbing Torres as its attorneys in this particular opposition case; a table showing the details of applications and registrations for around 2,608 DOVE and derivative marks worldwide; representative samples consisting of copies of trademark registration certificates from major markets; screenshot and computer print out of the webpage, http://www.adbrands.net/us/dove_advertising_1.htm; screenshots taken from the www.dove.us and www.dove.co.uk websites, evidencing extensive promotion of the DOVE Marks worldwide; Affidavit of Bienvenido A. Marquez III, attaching thereto a representative sample of various trademark registrations secured in the name of Opposer for DOVE and derivative marks; Affidavit of Unilever Philippines, Inc.'s General Counsel, Ma. Leah Jose-Sebastian.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 13 April 2012. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark DOVERA & DEVICE?

The Opposer anchors its opposition on the following provisions of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

Sec. 123.Registrability. - 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;"

(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

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

large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

- (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 service 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;
- (g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;

Records show that at the time the Respondent-Applicant filed its trademark application on 15 September 2011, the Opposer has an existing trademark registration for the mark DOVE (WORD AND DEVICE) under Certificate of Registration No. 4-2005-700 issued on 25 December 2006. The registration covers "soaps; detergents; bleaching preparations, cleaning preparations; perfumery, toilet water, aftershave, cologne; essential oils; aromatherapy products, not for medical use; massage preparations, not for medical use; deodorants and antiperspirants; preparations for the care of the scalp and hair; shampoos and conditioners; hair colourants; hair styling products; toothpaste; mouthwash, not for medical use; preparations for the care of the mouth and teeth; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparation; pre-shave and aftershave preparations; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool, cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleaning pads, tissues or wipes, beauty masks, facial packs" under Class 03. This Bureau noticed that the goods covered by the Respondent-Applicant's trademark application is identical or closely-related to the Opposer's.

But, are the competing marks, as shown below, resemble each other such that confusion, or even deception is likely to occur?



Opposer's trademark



Respondent-Applicant's mark

A handwritten signature in blue ink, consisting of a stylized letter 'Z' followed by a horizontal line.

The Respondent-Applicant's mark DOVERA & DEVICE is confusingly similar to Opposer's trademark DOVE (WORD AND DEVICE). Respondent-Applicant's mark DOVERA & DEVICE adopted the dominant features of Opposer's DOVE (WORD AND DEVICE) mark consisting of the letters or the word "DOVE". Respondent-Applicant merely added the letters R and A in Opposer's DOVE mark to come up with the mark DOVERA & DEVICE. The fact that the Respondent-Applicant's mark DOVERA & DEVICE is enclosed in a black box with an accompanying device (a leaf-like figure) between the letters V and E or upwardly emanating therefrom and has a different font style is of no moment. Both marks bear the word or the letters DOVE. Respondent-Applicant's mark DOVERA & DEVICE covers cosmetics, soaps, deodorants and toiletries, among others, in Class 03, goods which the Opposer deals in under the mark DOVE (WORD AND DEVICE). It is likely therefore, that a consumer who wishes to buy cosmetics, soaps, deodorants and toiletries and is confronted with the mark DOVERA & DEVICE, will think or assume that the mark or brand is just a variation of DOVE (WORD AND DEVICE) or is affiliated with the Opposer's.

The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

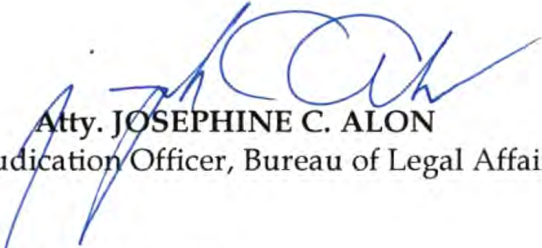
Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.⁵

In conclusion, the Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) (iii) of the IP Code.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-011072 is hereby SUSTAINED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 11 OCT 2016.


Atty. JOSEPHINE C. ALON
Adjudication Officer, Bureau of Legal Affairs

⁵ *Converse Rubber Corp. v. Universal Rubber Products, Inc. et. al.*, G.R. No. L-27906, 08 Jan. 1987.