



UNILEVER N.V.,
Opposer,

-versus-

CHAMPION INTERLINK GROUP CORP.,
Respondent- Applicant.

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}
} IPC No. 14-2011-00151
} Opposition to:
} Appln. Serial No. 4-2010-009452
} Date Filed: 27 August 2010
} TM: "DOVE"
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}
}
}

NOTICE OF DECISION

QUISUMBING TORRES LAW OFFICES
Counsel for Opposer
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Taguig, Metro Manila

MICHAEL LUI
Respondent- Applicant's Agent
Champion Interlink Group Corporation
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GREETINGS:

Please be informed that Decision No. 2016 - 90 dated March 31, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 31, 2016.

For the Director:

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

would show that Respondent's DOVE mark is identical and confusingly similar to Opposer's DOVE Marks.

(i) First, it must be noted that most of the Opposer's DOVE Marks are word marks, i.e., marks that do not bear or claim to have any distinctive stylized depiction of the mark, nor a claim of color. Hence, a word mark may be protected against infringers who colorably imitate substantial or dominant components thereof, no matter how the infringing mark is styled or depicted, thus affording Opposer the broadest amount of protection under the IP Code.

(ii) Second, the goods for which Respondent intends to use its DOVE mark are exactly the same, i.e., surgical gauze and cotton, as the goods currently covered by Opposer's trademark registrations for DOVE, i.e., 'cotton wool, cotton sticks and cosmetics pads,' among others.

The classification of the goods covered by rival marks need not be in the same class in order to be considered related or closely similar. The goods covered by opposing trademark claimants may be deemed to be competing or falling under the same class as long as there is likelihood of confusion as to the source of the goods. After all, the law does not require that the junior applicant's goods be entirely similar to the goods of a prior registrant in order that the junior applicant's goods be barred from the registration. Rather, the law is clear that a mark cannot be registered if it is identical with a registered mark in respect of the same or closely related goods or services.

In other words, as the competing marks involve exactly the same mark for the same goods, the marks are confusingly similar, both visually and aurally, in that it would support, a finding of confusing similarity between the competing marks, if not identity, with the DOVE Marks.

This will confuse consumers by suggesting a connection, association or affiliation with Unilever, thereby causing substantial damage to the goodwill and reputation associated with the DOVE Marks, as well as Unilever's own business reputation.

(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 DOVE mark of Respondent will amount to unfair competition with the 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.

Opposer's goodwill is a property right separately protected under Philippine law, and a violation thereof amounts to downright unfair competition proscribed under Article 6bis of the Paris Convention, Article 28 of the Civil Code and Section 168 of the IP Code:

x x x"

The Opposer's evidence consists of the following:

1. Exhibit "A" - legalized Verified Notice of Opposition
2. Exhibit "B" - legalized Certificate and Special Power of Attorney;

3. Exhibit "C"- Table showing the details of applications and registrations for DOVE Marks;
4. Exhibits "D" - representative samples of certified trademark registrations;
5. Exhibit "E"- screenshots and computer print out of the webpage http://www.adbrands.net/us/dove_advertising_1.htm;
6. Exhibit "F" - screenshots taken from www.dove.us and www.dove.co.uk;
7. Exhibit "G" - compact disc containing downloaded copies of advertisements for the Dove soap ;
8. Exhibit "H" - Affidavit of Andre Betita;
9. Exhibits "H-1 Series" - representative samples of trademark registration from EU, Australia, Canada, China, Great Britain, Northern Ireland, Hong Kong, Japan, Korea, Singapore and U.S.A.;
10. Exhibit "I" - actual product showing the DOVE Marks on Dove products;
11. Exhibit "K" - samples and copies of promotional materials for DOVE Marks in the Philippines; and
12. Exhibit "L" - certified copies of certificate of trademark registration for DOVE and derivative marks in the Philippines.

This Bureau issued on 19 May 2011 a Notice to Answer and served to the Respondent-Applicant's representative Michael Liu on 27 June 2011. The Respondent-Applicant, however, did not file its Answer. On 24 April 2015, Order No. 2015- 635 was issued declaring Respondent-Applicant in default. Accordingly, pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark "DOVE"?

The essence of trademark registration is to give protection to the owners of trademarks. 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. Thus, Sec. 123.1 (d) of the IP Code 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.

The records show that at the time the Respondent-Applicant filed its application for the mark DOVE on 27 August 2010, the Opposer has already existing registrations for its mark DOVE Marks, the earliest of which dates back to 1996. So, between Opposer and Respondent-Applicant, it is the former who enjoys priority date in the use of the mark DOVE.

Going now to the competing marks, a comparison of the same would show that they are confusingly similar. For a better appreciation, the marks are hereunder reproduced:

DOVE



DOVE MOISTURE-LOCK

Dove


Opposer's Marks

DOVE

Respondent-Applicant's Mark

Opposer's Dove Marks have many variations. Its earliest mark registered by its predecessor Lever Brothers Company consists of the word mark DOVE. Through the years, its mark evolved and that aside from the word mark, it also registered the DOVE device, word mark DOVE in combination with other words and a combination of the DOVE device with the word DOVE, among others. On the other hand, Respondent-Applicant's mark consists of the word DOVE. While there is a difference in the font used when compared with Opposer's word mark Dove, such difference is inconsequential and does not veer it away from being confusingly similar to Opposer's mark because they both use the word DOVE.

But what about the goods upon which Opposer's and Respondent-Applicant's marks are used? Opposer's DOVE Marks is used in goods such as "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 cleansing pads, tissues or wipes, beauty masks, facial packs" under Class 03. On the other hand, Respondent-Applicant's goods pertains to "surgical gauze, cotton" under Class 05. It may seem that the goods of the parties are different as they belong to different classes. However, a closer look at the goods of the Opposer would show that it also deals with **cotton wool, cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes**. Thus, albeit the difference in classification, it can be said that Respondent goods which consists of surgical gauze and cotton is similar or related to the goods of Opposer. Considering that Opposer's and Respondent-Applicant's mark are confusingly similar and their goods are also similar or related, to allow the registration of Respondent-Applicant's DOVE mark will likely cause confusion, mistake or deception on the public into believing that Respondent-Applicant's goods come from the Opposer or that information, assessment, perception or impression about the

Respondent-Applicant's goods bearing the mark DOVE may unfairly be cast upon or attributed to the Opposer.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.⁴ The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:⁵

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily 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.

It has been held time and again that in cases of grave doubt between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favour with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.⁶

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

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-009452, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 31 March 2016.


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

⁴ See *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

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

⁶ See *Del Monte Corporation et. al. v. Court of Appeals*, GR No. 78325, 25 Jan. 1990.