

BACARDI & COMPANY LIMITED,
Opposer,

versus

PROXIMO SPIRITS,
INC.,
Respondent-Applicant.

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IPC No. 14-2008-00132
Case Filed: 16 June 2008

Opposition to:

Appln. Ser. No. 4-2007-009882
Date Filed: 06 September 2007

TM: "WHAT'S IN YOUR
MARTINI?"

Decision No. 2008-225

DECISION

This is a verified NOTICE OF OPPOSITION filed by Bacardi & Company Limited to the application for registration of the mark "WHAT'S IN YOUR MARTINI?" bearing Application Serial No. 4-2007-009882 filed on September 06, 2007 by respondent-applicant Proximo Spirits Inc. for goods under Class 33, namely, "vodka, alcoholic beverages", which application was published in the Trademark Electronic Gazette of the IP Philippines (IP Phil.) that was officially released for circulation on February 15, 2008.

Opposer is a corporation organized under the laws of Liechtenstein and domiciled at Aeulestrasse 5, Vaduz, Liechtenstein. Respondent-Applicant is a corporation organized under the laws of Delaware with business address at 666 Third Avenue, City of New York, United States of America.

Opposer fled its verified NOTICE OF OPPOSITION based on the following grounds:

"1. Opposer is the registered owner of the following trademarks:

| Trademark | Application No./ Registration No. | Date Filed/ Date Issued | Class |
|--|--------------------------------------|---|-------|
| MARTINI | 001528 | April 26, 1973 April 26, 1993 (renewal) | 33 |
| MARTINI & ROSSI | 019518 | July 18, 1973 July 18, 1993 (renewal) | 33 |
| MARTINI | 024155 | October 4, 1976 October 4, 1996 (renewal) | 33 |
| MARTINI | 056289 | October 21, 1993 | 25 |
| MARTINI | 4-1981-046940 | May 12, 1993 | 25 |
| MARTINI 3-D BOTTLE TGET-UP (2003) | 4-2003-003009 | February 26, 2007 | 33 |
| MARTINI BACK-LABEL (2003) | 4-2003-003006 | April 16, 2007 | 33 |
| MARTINI FRONT LABEL (2003 REDESIGN) | | | |

The above trademarks (collectively, the “*MARTINI Marks*”) are covered by certificates of registration issued by the Intellectual Property Office. Legalized copies of some of these certificates and Declarations/Affidavits of Use are attached to the evidentiary affidavit.

2. Opposer is the first user and prior registrant of the *MARTINI Marks* covering wines (including aromatic wines), vermouth, spirits, liqueurs/liquors, and aperitifs (including bitter aperitifs) in Class 33.

These marks also cover anoraks (parkas), athletic uniforms, headbands, sweatbands, wristbands, bathing suits and trunks, beachwear, belts (clothing), Bermuda shorts, blouses, blousons, blazers, cardigans, chemises, overcoats, raincoats, gloves, gym suits, jackets, jeans, jerseys, knit shirts, neckties, overalls, pajamas, panties, pants, polo shirts, t-shirts, pullovers, scarves, shirts, ski wear, slacks, socks, sport shirts, suits, sweat shirts, sweaters, tennis wear, tracksuits, trousers; knitted and woven clothes and garments; sport clothes, boots, shoes and slippers in Class 25.

3. The *MARTINI Marks* have been used in the United States of America and in the Philippines since at least 1923, and in other countries since the late 1800’s, long before Respondent-Applicant appropriated the confusingly similar mark *WHAT’S IN YOUR MARTINI?* For its vodka and alcoholic beverages which are also in Class 33. Opposer is the producer of wines (including aromatic wines), vermouth, spirits, liqueurs/liquors, and aperitifs (including bitter aperitifs) which fall under Class 33 and distributed in numerous countries across the globe, including the Philippines.

4. Respondent-Applicant’s trademark *WHAT’S IN YOUR MARTINI?* So resembles Opposer’s *MARTINI Marks* because their dominant and distinctive word element, i.e. *MARTINI*, is identical, as to be likely, when applied to or used in connection with the goods of Respondent-Applicant, to cause confusion, mistake and deception on the part of the purchasing public by misleading them into thinking that Respondent-Applicant’s goods either come from Opposer or are sponsored or licensed by it.

5. The registration and use by Respondent-Applicant of the trademark *WHAT’S IN YOUR MARTINI?* will diminish the distinctiveness and dilute the goodwill of Opposer’s *MARTINI Marks*, which are arbitrary trademarks when applied to Opposer’s goods.

6. Respondent-Applicant adopted the trademark *WHAT’S IN YOUR MARTINI?* on its own goods (i.e., vodka and alcoholic beverages) with the obvious intention of misleading the public into believing that its goods bearing said trademark originate from, or are licensed or sponsored by Opposer, which has been identified in the trade and by consumers as a source of wines (including aromatic wines, vermouth, spirits, liqueurs/liquors, and aperitifs (including bitter aperitifs bearing the confusingly similar *MARTINI Marks*.

7. The approval of Respondent-Applicant’s trademark *WHAT’S IN YOUR MARTINI?* is based on the representation that it is the originator, true owner and first user of the trademark, which was merely derived from Opposer’s *MARTINI Marks*.

8. Opposer is the first user of the *MARTINI Marks* in the Philippine commerce and elsewhere, having utilized the same extensively for nearly one hundred years in the Philippines. Opposer’s *MARTINI Marks* are so popular and have come to be associated with numerous products of the highest standard.

Respondent-Applicant's use of a confusingly similar mark for its own goods is likely to cause consumer confusion as to the origin of said goods.

9. Respondent-Applicant's use of the trademark WHAT'S IN YOUR MARTINI? infringes upon Opposer's exclusive right to use the MARTINI Marks, which are well-known trademarks protected under Sections 147 and 123.1 (d) and (f) of the Intellectual Property Code ("IP Code"), Article 6bis of the Paris Convention and Article 16 of the Agreement on Trade related Aspects of Intellectual Property Rights to which the Philippines adheres.

10. The registration of the trademark WHAT'S IN YOUR MARTINI? in the name of the Respondent-Applicant is contrary to other provisions of the IP Code. In approaching WHAT'S IN YOUR MARTINI? as a mark, Respondent-Applicant betrayed its awareness of Opposer's existence and the prior use and renown of Opposer's MARTINI Marks. This Office must implement the provisions of the Paris Convention and the IP Code by confirming Opposer's rightful ownership of its MARTINI Marks."

To support the opposition, Opposer will prove and rely upon the following:

"1. Opposer adopted and has been using the MARTINI Marks for its goods since at least 1923, long before Respondent-Applicant's unauthorized usage of the confusingly similar trademark WHAT'S IN YOUR MARTINI?. Opposer has been commercially using the MARTINI Marks in the Philippines for nearly one-hundred years before Respondent-Applicant filed its application for the registration of the trademark WHAT'S IN YOUR MARTINI? on September 6, 2007.

2. Opposer is the first user and rightful owner of the MARTINI Marks. Opposer has also used and registered or applied for the registration of the MARTINI Marks in many other countries worldwide, including the Philippines.

3. Opposer's MARTINI Marks are arbitrary trademarks and are entitled to broad legal protection against unauthorized users like Respondent-Applicant which has appropriated the deceptively similar trademark WHAT'S IN YOUR MARTINI? for its own goods which are identical of the goods of Opposer.

4. Opposer is the first user of the MARTINI Marks in the Philippines and elsewhere. Respondent-Applicant has appropriated the trademark WHAT'S IN YOUR MARTINI? for obvious purpose of capitalizing upon the renown of Opposer's self-promoting trademark by misleading the public into believing that its goods originate from, or are licensed or sponsored by Opposer.

5. The registration and use of a confusingly similar trademark by the Respondent-Applicant will tend to deceive and/or confuse purchasers into believing that Respondent-Applicant's products emanate from or are under the sponsorship of Opposer and damage Opposer's interests for the following reasons:

i) The trademarks are confusingly or deceptively similar. Their dominant and distinctive elements are identical.

ii) Respondent-Applicant's unauthorized appropriation and use of the trademark WHAT'S IN YOUR MARTINI? will dilute Opposer's reputation and goodwill among consumers.

iii) Respondent-Applicant used the trademark WHAT'S IN YOUR MARTINI? on its own goods as a self-promoting trademark to gain acceptability for its goods through its association with Opposer's famous MARTINI Marks, which have attained well known status and international renown.

iv) Respondent-Applicant intends to trade, and is trading on, Opposer's goodwill.

6. The registration and use of an identical trademark by Respondent-Applicant will diminish the distinctiveness and dilute the goodwill of Opposer's MARTINI Marks."

A NOTICE TO ANSWER was furnished to respondent-applicant through its representative who received it on July 04, 2008. However, respondent-applicant failed to file its verified Answer, albeit within the reglementary period, despite due notice for which reason it is deemed to have waived its right to file/submit said verified Answer. The case is now submitted for decision.

The issues to be resolved are:

1. Whether respondent-applicant's mark "WHAT'S IN YOUR MARTINI?", is confusingly similar to opposer's "Martini Marks", and

2. Whether respondent-applicant is entitled to the registration of the mark "WHAT'S IN YOUR MARTINI?"

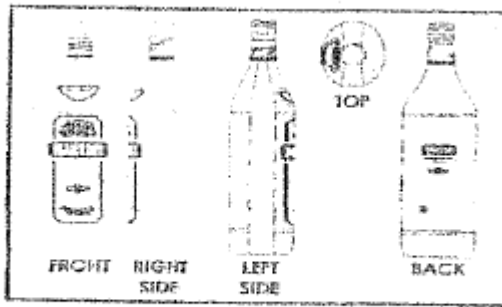
Respondent-applicant's mark "WHAT'S IN YOUR MARTINI?" is depicted below:

WHAT'S IN YOUR MARTINI?

Meanwhile, Opposer's "Martini Marks" are depicted below:

MARTINI

"MARTINI" as depicted in Certificate of Renewal no. 1528



MARTINI 3-D BOTTLE GET-UP (2003)

“MARTINI 3-D BOTTLE GET-UP (2003)” in
Certificate of Registration no. 4-2003-003009



“MARTINI” FRONT LABEL (2003 DESIGN)” in
Certificate of Registration No. 4-2003-003010



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1st and 2nd pictures of Exhibit "E"

A careful examination of opposer's and respondent-applicant's respective marks shows that the word "MARTINI" is the dominant feature. In opposer's marks, the word "MARTINI" is either the mark by itself or the predominant word considering the bold and conspicuous presentation of the letters that spell "MARTINI", as well as the placement of the word "MARTINI" on the upper part of the labels where the eyes normally focus upon looking at the goods. Respondent-applicant's mark presented by way of a question centers on the word "MARTINI": The "question" mark stirs one's curiosity about the product and image of "MARTINI". The question of respondent-applicant's mark culminates in the word "MARTINI". It creates visual, aural, and connotative impressions that link up to opposer's "Martini Marks".

The visual and aural impressions created by the dominant word "MARTINI" is that the goods of one party are those of the other party, and that the respective goods of the parties originated from the other, or that one party has permitted or given license to the other to use the word "MARTINI" for the other party's product, or that there is a relation/connection between the two parties when, in fact, there is none. This is especially true considering that the products of both parties belong to the same class and are identical in nature: Alcoholic beverages/spirits. Hence, confusion of goods and of business may likely result.

Under the Dominancy Test, the dominant features of the competing marks are considered in determining whether these competing marks are confusingly similar. Greater weight is given to the similarity of the appearance of the products arising from the adoption of the dominant features of the registered mark, disregarding minor differences. The visual, aural, connotative, and overall comparisons and impressions engendered by the marks in controversy as they are encountered in the realities of the marketplace are the main considerations (McDonald's Corporation, et al. v. L. C. Big Mak Burger, Inc. et al, G.R. No. 143993, August 18,

2004; Societe Des Produits Nestle, S.A., et al. v. Court of Appeals, et al., G.R. No. 112012, April 4, 2001). If the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place (Lim Hoa v. Director of Patents, 100 Phil. 214 [1956]); Co Tiong Sa v. Director of Patents, et al., G.R. No. L-5378, May 24, 1954). Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate (Lim Hoa v. Director of Patents, *supra*, and Co Tiong Sa v. Director of Patents, *supra*). Actual confusion is not required: Only likelihood of confusion on the part of the buying public is necessary so as to render two marks confusingly similar so as to deny the registration of the junior mark (Sterling Products International, Inc. v. Farbenfabriken Bayer Aktiengesellschaft, et al., G.R. No. L-19906, April 30, 1969).

As to the first issue of whether Respondent-Applicant's mark "What's in your Martini?" is confusingly similar to Opposer's "MARTINI" marks, this Bureau rules in the affirmative.

The records bear the following:

1. Opposer's Registration No. 001528 was issued on April 26, 1973 and renewed on April 26, 1993 for the mark "MARTINI" for Class 33 goods;
2. Opposer's Registration No. 019518 was issued on July 18, 1973 and renewed on July 18, 1993 for the mark "MARTINI & ROSSI" for Class 33 goods;
3. Opposer's Registration No. 024155 was issued on October 4, 1976 and renewed on October 4, 1996 for the mark "MARTINI" for Class 33 goods;
4. Opposer's Registration No. 4-2003-003009 was issued on February 26, 2007 for the mark "MARTINI 3-D BOTTLE GET-UP (2003)" for Class 33 goods; and
5. Opposer's Registration No. 4-2003-003006 was issued on April 16, 2007 for the mark "MARTINI BLACK-LABEL (2003)" for Class 33 goods

Section 123.1 (d) of the IP Code provides:

(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*
- (ii) Closely related goods. . . or*
- (iii) If it nearly resembles such a mark as to be likely to deceive or to cause confusion. . ." (Underscoring Supplied.)*

Pursuant to said provision, the application for registration of the subject mark cannot be allowed: Respondent-applicant's mark "WHAT'S IN YOUR MARTINI?" is confusingly similar to opposer's "Martini Marks" and is applied to goods that are similar and/or related to opposer's goods, which are generally alcoholic beverages; moreover, opposer has already been issued registrations of its "Martini Marks" and which registrations were issued way before Respondent-Applicant applied for the subject mark hence, Respondent-Applicant's later mark cannot be allowed registration.

To repeat, opposer has already registered the MARTINI marks used on goods under Class 33 which are closely identical and/or closely related to Respondent-Applicant's "What's in Your Martini?" which is confusingly similar. Therefore, Opposer's Martini mark is entitled to protection under the law.

Section 138 of the IP Code provides that a certificate of registration of a mark is *prima facie* evidence of the validity of the registration, the registrant's ownership of the mark, and of the

registrant's exclusive right to use the same in connection with the goods and those that are related thereto specified in the certificate (Underscoring supplied.)

WHEREFORE, the verified NOTICE OF OPPOSITION is, as it is, hereby SUSTAINED. Consequently, Application Serial No. 4-2007-009882 for the registration of the mark "WHAT'S IN YOUR MARTINI?" under Class 33 filed on September 06, 2007 by Respondent-Applicant Proximo Spirits Inc. is, as it is hereby, REJECTED.

Let the file wrapper of this case together with this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 19 December 2008.

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