

BEST BEAN INTERNATIONAL  
PTE. LTD.,

*Appellant,*

-versus-

THE DIRECTOR OF THE BUREAU  
OF TRADEMARKS,

*Appellee.*

x-----x

Appeal No. 04-2011-0003

Application No. 4-2008-013951  
Filing Date: 13 November 2008

Trademark: MR. BEAN'S  
LIFE'S SIMPLE PLEASURES  
& DEVICE

## DECISION

Best Bean International Pte. Ltd. ("Appellant") appeals the Decision dated 30 December 2010 issued by the Director of the Bureau of Trademarks ("Director") sustaining the final rejection of the Appellant's application to register the mark "MR. BEAN'S LIFE'S SIMPLE PLEASURES & DEVICE".

Records show that the Appellant filed on 13 November 2008 Trademark Application No. 4-2008-013951 covering goods<sup>1</sup> under Classes 29 and 43 of the Nice Classification.<sup>2</sup> The Examiner-in-Charge -Charge ("Examiner") issued an official action<sup>3</sup> stating that the Appellant's mark may not be registered because it nearly resembles a registered mark belonging to a different proprietor and the resemblance is likely to deceive or cause confusion. On 27 March 2009, the Appellant filed a "RESPONSIVE ACTION" claiming that its mark is neither identical to nor one that may be considered to be nearly resembling the registered mark cited by the Examiner.

The Examiner issued a "FINAL REJECTION,"<sup>4</sup> of the Appellant's mark because it nearly resembles a registered mark used on similar and closely related goods and it is likely to deceive or cause confusion. The Appellant appealed to the Director contending that its mark is easily distinguishable from the registered mark cited by the Examiner using either the "Holistic Test" or "Dominancy Test". The Director sustained the final rejection of the Appellant's trademark application.

On 09 February 2011, the Appellant filed a "MEMORANDUM ON APPEAL" alleging that the registered mark that was cited by the Examiner and which was the basis for rejecting its trademark application has been cancelled and, thus, should no longer bar the registration of its mark. The Appellant reiterates its arguments that its mark is easily distinguishable using either the Holistic Test or Dominancy Test. The Appellant, thus, seeks the setting aside of the Decision of the Director and the issuance of an order for allowance of the Appellant's trademark application.

On 31 March 2011, the Director filed her "COMMENT" confirming the Appellant's allegation that the registered mark cited by the Examiner was cancelled. According to the Director, the cited mark was cancelled for failure of its registrant to file the required 3rd year Declaration of Actual Use. She manifests no legal objection to the granting of the appeal unless there is another cause to bar the registration of the Appellant's mark.

The Examiner's final rejection of the Appellant's application to register MR. BEAN'S LIFE'S SIMPLE PLEASURES & DEVICE was based on the existence of Cert. of Reg. No. 4-2007-010415 issued in the name of Tosen Foods, Inc..<sup>5</sup> As stated by the Examiner:

## FINAL REJECTION

After an examination of the application, the undersigned IPRS- has determined that the mark subject of the application cannot be registered because it nearly resembles cited mark Tm- Mr. Bean with Registration No. 42007010415 used on similar and closely-related goods and it is likely to deceive or cause confusion. Hence, registration is proscribed under Section 123(d) of R.A. 8293.

The application for registration of the abovementioned mark is therefore FINALLY REJECTED.

In view, however, of the COMMENT filed by the Director confirming the cancellation of Cert. of Reg. No. 4-2007-010415, the final rejection of the Appellant's trademark application has no more legal basis and consequently, this Office can now allow the publication of the Appellant's trademark application. Sec. 133 of Rep. Act No. 8293 known as the Intellectual Property Code of the Philippines ("IP Code") provides in part that:

SEC. 133. Examination and Publication. - 133.1. Once the application meets the filing requirements of Section 127, the Office shall examine whether the application meets the requirements of Section 124 and the mark as defined in Section 121 is registrable under Section 123.

133.2. Where the Office finds the conditions referred to in Subsection 133.1 are fulfilled, it shall, upon payment of the prescribed fee, forthwith cause the application, as filed, to be published in the prescribed manner.

x x x

In this case, the Appellant's trademark application meets the filing requirements, but was not published because of the findings of the Examiner that the Appellant's mark resembles a mark covered by Cert. of Reg. No. 4-20007-010415. With the cancellation of this certificate of registration, the Appellant's Trademark Application No. 4-2008-013951 can now be published in accordance with the provisions of the IP Code and the Trademark Regulations.

Wherefore, premises considered, the appeal is hereby GRANTED. The decision of the Director sustaining the final rejection of the Appellant's Trademark Application No. 4-2008-013951 for the mark MR. BEAN'S LIFE'S SIMPLE PLEASURES & DEVICE is hereby SET ASIDE. Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Trademarks for appropriate action. Let a copy of this Decision be furnished also the library of the Documentation, Information and Technology Transfer Bureau for its information and records purposes.

SO ORDERED.

April 25, 2011, Makati City.

RICARDO R. BLANCAFLOR  
Director General

### FOOTNOTES:

1 Class 29 - soya bean curd-, soya bean drink; soya bean milk-, soya bean milk in liquid and solid form; aerated drinks containing soya based products; food preparations containing soya and milk proteins; foodstuffs containing soya (as the main constituent); preparations based on soya bean protein for making soya milk; preparations made from soya; soya (prepared); soya cream; soya desserts; soya yoghurt; bean curd; soya protein food products for use as substitutes for food; dairy products; desserts made wholly or principally of dairy products; soya bean products; fruit jellies; fruit salads; milk products; milk beverages; jellies for food; pastry fillings of meat or vegetables; yoghurt; chilled desserts-, cream and dairy desserts; dessert in

the form of puddings with a milk or soya base; desserts made from soya or yoghurt with fruit or herb additives; flavoured desserts; powdered mixes for making up into desserts; prepared desserts (fruit based); preparations in the form of powder for making drinks; all included in class 29.

Class 43 - services for providing of food and drinks; provision of foods and drinks in kiosks; restaurant services; cafe services; bistro services; coffee shop services; cafeterias; canteens; snack bar services; food cooking services; self-service restaurants; preparation of food and drink; consultancy services in relation to food and drink; consultancy services relating to food preparation and food cooking services; consultancy services relating to baking techniques; catering services for the preparation and provision of food and drink; advisory services relating to catering; food service apparatus (rental of-); provision of information relating to the preparation of food and drink; all included in class 43.

2 The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral treaty administered by the World Intellectual Property Organization. This 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.

3 Paper No. 02 mailed on 04 February 2009.

4 Paper No. 04 mailed on 28 April 2009.

5 See Annexes "G" and "G-1" of the MEMORANDUM ON APPEAL, dated 08 February 2011.