

YEAST ASIA LIMITED,

Opposer,
-versus-

UNIVERSAL ROBINA CORPORATION,
Respondent-Applicant.

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IPC NO. 14-2009-000151

Opposition to:
Appln. Ser. No. 4-2008-005646
Date Filed: 14 May 2008
TM: "WHITE ROSE SOFT
FLOUR AND DEVICE"

Decision No. 2011- 26

DECISION

Yeast Asia Limited ("Opposer"), a corporation organized and existing under the laws of Hong Kong, S, A, R, with address at Room 2801, 28 Floor, Wing On Center 111, Coannaughty Road, Central Hong Kong, Filed on 15 June 2009 an opposition to Trademark Application Serial No. 4-2008-005646. The trademark application, filed by Universal Robina Corporation ("Respondent- Applicant"), with address at 110 E. Rodriguez, Jr. Avenue. Libis, Quezon City, covers the mark "WHITE ROSE SOFT FLOUR & DEVICE" for use on "all purpose flour/ wheat flour" falling under Class 30 of the International Classification of goods.

The Opposer alleges the following:

"1. Opposer is the prior registrant, in the Philippines and around the world, of the mark WHITE ROSE (with rose device) which is being used in respect of instant yeast in Class 30. Opponent's predecessor-in-interest, the Taiwanese company Yung Cheng Industries Ltd. first registered the mark in 1968. The yeast business of Yung Cheng Industrial Ltd, including the mark WHITE ROSE, was sold to the Opponent in 1992. At present, the Opponent has registrations for the mark in Pakistan, China, Malaysia, Singapore, Hong Kong, Bangladesh, the Philippines and Taiwan Opponent, by itself and through its predecessor, has owned, used, and promoted, the mark WHITE ROSE in respect of instant yeast since 1978, or for more than three decades now, first in Taiwan, and around the world. As a result of this commercial use and registration of the mark WHITE ROSE, it has acquired good will as a trademark of the Opponent and consume worldwide have always identified it with the Opponent yeast in Class 30.

"2. Because it incorporates, as its dominant element, the dominant word elements of Opponent's mark and also includes a similar rose device, Applicant's WHITE ROSE SOFT FLOUR AND DEVICE appears so closely similar or identical to Opponent's trademark WHITE ROSE as to be likely, when applied to or used in connection with the Applicant's closely similar flour products to cause confusion, mistake and deception on the part of the relevant purchasing public by misleading them into thinking and believing that Applicant's products either come from the Opponent or are endorsed, sponsored, franchised or licensed by it.

"3. The registration and used by Applicant of the trademark WHITE ROSE SOFT FLOUR AND DEVICE will thus, diminish the distinctiveness and dilute the goodwill of Opponent's WHITE ROSE (with rose device) trademark, which is an arbitrary trademark when applied on Opponent's products.

"4. Applicant adopted the trademark WHITE ROSE SOFT FLOUR AND DEVICE for use on goods that are so closely related or identical to those of Opponent's product with the obvious intention of capitalizing on the goodwill of the Opponent's identical trademark and misleading the public into believing that their related products are franchised, licensed or sponsored by Opponent, which has been identified in the trade and by

consumers in Philippines and around the world as the source of quality reliable yeast products bearing the WHITE ROSE trademark.

“5. The approval for publication of Applicant’s trademark is based on the representation that it is the originator, true owner and first user of the mark. However, in truth, said device was merely copied/ derived from Opponent’s identical trademark WHITE ROSE.

“6. Opponent is the first user of the words WHITE ROSE and a rose device as a trademark in respect of Class 30 goods in local commerce. It has used and promoted said mark around the world, including the Philippines, in respect of their products exclusively and extensively for decades. Opponent is also the first to register the mark WHITE ROSE around the world. In the Philippines, Opponent filed its application for registration on July 21, 1992 and obtained its registration under Reg. No. 4-1992-083397 in Class 30 in November 23, 1999.

“7. Opponent’s WHITE ROSE trademark is a well-known mark. Applicant’s appropriation and use of WHITE ROSE and the rose device as the dominant elements of its trademark infringes upon Opponent’s exclusive right to use the distinct WHITE ROSE (with rose device) trademark, which is a well-known trademark protected under Section 37 of the old Trademark Law, Section 123.1 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 and Hong Kong adhere.

The Respondent-Applicant filed on 04 November 2009 its Answer denying the material allegations of the opposition and alleging that its mark is not confusingly similar with the Opposer’s. According to the Respondent-Applicant:

1. The pictorial presentation of the competing marks are entirely different;
2. The presentation of the words “White Rose” and the colors used therein are entirely different;
3. The printed matters on the competing marks are also at variance with each other;
4. The identity of the manufacturers in the respective marks are clearly indicated in the labels; and
5. The goods are not similar or closely related.

Should the Respondent-Applicant be allowed to register the mark WHITE ROSE SOFT FLOUR AND DEVICE?

It is emphasized that 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 procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against and sale of an inferior and different articles of his product. In this regard, Sec. 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines (“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.

It is also stressed that an opposition proceeding is basically a review of the trademark application in question, to determine whether the requirements under the law are complied with. Accordingly, this bureau may and should take cognizance of the contents of the Trademark Registry and other records of the Intellectual Property Office of the Philippines by judicial notice.

Thus, records show that at the time the Respondent-Application filed its application in 2008, the Opposer has existing trademark application for WHITE FLOUR, filed on 21 July 1992.

The application, which was allowed and the mark was registered on 23 November 1999 under Reg. No. 4-1992-83397, for use on “instant yeast” under Class 30, and therefore closely related to the goods covered by the Respondent-Applicant’s mark. In *Societe Des Produits Nestle, S.A. v. Court of Appeals, et al*, the Supreme Court, held:

“Goods are related when they belong to the same class or have same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores. x x x”

Yeast and flour are common bakery ingredients that usually flow through the same trade channels. They are closely related as they are the essential ingredients for bread and other bakery products, and fall under class 30. These are common consumer items that appear side by side in the shelves of supermarkets or groceries.

The question is: Are the competing marks, as shown below, resemble each other that confusion or deception is likely to occur?

WHITE
ROSE
SOFT FLOUR
Respondent-Applicant’s mark

White Rose
Opposer’s mark

This Bureau finds that the competing marks are practically identical. Both marks contain the words “WHITE ROSE” and the visual representation of the rose flower. The minor differences in the details are inconsequential. The Respondent-Applicant’s mark is obviously a colorable imitation of the Opposer’s. Colorable imitation does not mean such similitude as amount to identify, or does it require that all details be literally copied. It refers to such similarity in form, content, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential, substantive and distinctive part as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.

Aptly, the determinative-factor in a contest involving registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark would likely cause confusion or mistake on the part of the buying public. In short, 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 to 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. Moreover, the likelihood of confusion would subsist not only on the public’s perception of services but on the origins thereof as held by the Supreme Court:

“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.”

The likelihood of confusion, mistake or deception is heightened by the fact that, as discussed above, the goods on which the competing marks are used are closely related.

It is emphasized that the law on trademark and tradenames is based on the principle of business integrity and common justice. This law, both in letter and spirit is laid upon the premise that, while it encourages fair trade in every way and aims to foster, and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing others business by fraud, deceit, tricky or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another. A "boundless" choice of words, phrases and symbols is available to one who wishes a trademark sufficient unto itself to distinguish his products from those of others. When, however, there is no reasonable explanation for the defendant's choice of such a mark through the field for his selection was so broad, the inference is inevitable that it was chosen deliberately to deceive.

WHEREFORE, premises considered, the opposition is hereby SUSTAINED. Let the filewrapper of the Trademark Application Serial No. 4-2008-005646 be returned, together with a copy of this Decision, on the Bureau of Trademark (BOT) for appropriate action.

SO ORDERED.

March 18, 20011