CARLTON AND UNITED, BREWERIED, LTD., *Opposer,*	}	IPC No. 14-2001-00012 Opposition to:
-versus-	}	Appl'n. Serial No. : 85157 Date filed : March 23, 1993 Trademark : "FOSTER'S HOLLYWOOD"
BRENTFIELD INVESTMENTS, N.V., *Respondent-Applicant.*	}	Decision No. 2003-25

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Decision

This is an opposition to the registration of the mark "FOSTER'S HOLLYWOOD" filed by Hollywood Café, S.A. and assigned to BRENTFIELD INVESTMENT, N.V. on December 9, 1994 and then to GRUPO ZENA DE RESTAURANTES, S.A. on August 9, 1999 of Orense, 4, 28020 Madrid, Spain, which trademark application covers the services characteristic of restaurants, self-service restaurant and other services characteristic of Hotel industry in Class 42 of the International Classification of goods and services. The said trademark application was published in Official Gazette of the Intellectual Property Office in Vol. III, No. 5, page 77 which was officially released on 26 March 2001.

The Opposer in the instant opposition proceedings is CARLTON AND UNITED BREWERIES, LTD., a foreign corporation organized under the laws of Victoria, Australia.

On July 26, 2001, this Office sent a Notice to Answer to the Respondent-Applicant through registered mail with return card bearing No. J-01-735 requiring the said party to file its Answer to the Verified Notice of Opposition within fifteen (15) days from receipt of said notice, however, no such Answer was filed by Respondent-Applicant.

On March 21, 2002, Opposer through counsel filed a Motion to Declare Respondent-Applicant in Default for failure to file its Answer within the reglementary period which motion was granted under ORDER No. 2002-149 dated 15 April 2002.

Pursuant to the ORDER of Default, Opposer presented its evidence ex-parte and subsequently filed its Formal Offer of Evidence consisting of Exhibits "A" to "R" inclusive of sub-markings.

The grounds upon which Opposer based its opposition were as follows:

"1. The registration of the mark "FOSTER'S HOLLYWOOD" logo in the name of Respondent-Applicant is proscribed by Section 123.1(d), (e), (f) and (g) of Republic Act No. 8293.

"2. Opposer is the prior registered owner of the "FOSTER'S" marks, having been the first to adopt and us the same in actual trade and commerce since 1889. Applications for registration of the "FOSTER'S" mark have been filed and prior registrations of Opposer's said mark in countries all over the world have been obtained, including the Philippines.

"3. The trademark which Opposer herein originated and adopted is similar and will-known internationally and in the Philippines as "FOSTER'S" and is commercially used here and around the globe for its beer, liquor and beverage products. Opposer's products carried under said mark, had, through the years, earned international acclaim and the distinct reputation of high quality products."

Opposer relied on the following facts to support its opposition:

"1. Opposer was used by the then Bureau of Patents, Trademarks and Technology Transfer "BPTTT", now Intellectual Property Office Certificate of Registration No. 42080 for the "FOSTER'S" trademark covering brewed liquors.

"2. The mark "FOSTER'S HOLLYWOOD" of Respondent-Applicant is flagrant and veritable imitation of herein Opposer's mark as likely to cause confusion, mistake and deception to the buying public as to source and origin of Respondent-Applicant's goods/services. Opposer is unaware of any use by Respondent-Applicant of the "FOSTER'S HOLLYWOOD" logo in the Philippines or any other country outside continental Europe.

"3. Opposer has invested tremendous amount of resources in the promotion of the "FOSTER'S" mark i.e., advertisements in well-known newspapers and magazines and other publications around the world. Opposer has attained enormous goodwill and popularity worldwide in its "FOSTER'S" mark, including in the Philippines, and so the Respondent-Applicant's use of the mark "FOSTER'S HOLLYWOOD" will necessarily cause confusion amongst a significant portion of the public. Accordingly, the use and approval for Respondent-Applicant's mark will constitute an infringement of invasion of Opposer's property rights to its registered "FOSTER'S" mark which is protected by law. Such will most assuredly cause the dilution and loss of distinctiveness of Opposer's mark as well as cause irreparable damage and injury to Opposer.

To be noted in this particular case is the fact that the trademark application being opposed bearing Serial No. 85157 for the mark "FOSTER'S HOLLYWOOD" was filed on March 23, 1993 and the governing law at that time is Republic Act No. 166 as amended.

It is also observed that the Opposition was filed on July 17, 2001 whereby the Opposer invoked SECTION 123.1(d), (e), (f) and (g) of Republic Act No. 8293.

The only issue to be resolved in this particular case is WHETHER OR NOT RESPONDENT-APPLICANT'S TRADEMARK "FOSTER'S HOLLYWOOD" IS CONFUSINGLY SIMILAR TO OPPOSER'S MARK "FOSTER'S".

Section 4(d) of Republic Act No. 166, as amended reads:

"SECTION 4. Registration of trademarks, trade names and service marks on the principal register. There is hereby established a register of trademarks, trade names and service marks which shall be known as the principal register. The owner of a trademark, trade name or service mark used to distinguished his goods, business or

services of others shall have the right to register the same on the principal register, unless it:

x x x

> (d) Consist of or comprises a mark or trade name which so resembles a mark or trade name registered in the Philippines or a mark or trade name previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or services of the applicant to cause confusion or mistake or to deceive purchasers."

Section 123.1 (d) of Republic Act No. 8293 provides:

"SECTION 123.1 – A mark cannot be registered if:

> (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."

In resolving the issue at hand, the above-cited provisions of law are to be appreciated and perceived to be the same or equal effect.

A cursory review of the documentary exhibits indicates that both trademarks contain the word "FOSTER'S". They differ only in the presence of the word "HOLLYWOOD".

To be noted is the fact that Opposer's mark "FOSTER'S" is registered with the then Bureau of Patents, Trademarks and Technology Transfer (BPTTT), under Registration No. 41636 issued on October 28, 1988 for the goods, BEER, ALE, ALGER and other brewed beverages products under class 32 (Exhibit "K-23) and Registration No. 42080 issued on November 28, 1988 for the goods Brewed Liquors class 32 (Exhibit "K-22).

Further, Opposer's trademark "FOSTER'S" has been likewise registered in many countries of the world. (Exhibits "K-1" to "K-52")

On the other hand, it must be emphasized that Respondent's trademark FOSTER'S HOLLYWOOD contains the word "FOSTER'S" which is the dominant feature and which is identical to Opposer's mark "FOSTER'S" both in spelling, sound/pronunciation, hence they are confusingly similar.

The issue of whether or not a trademark causes confusion and is likely to deceive the public is a question of fact which is to be resolved by applying the "TEST OF DOMINANCY".

The Supreme Court in the case of PHILIPPINE NUT INC., vs. STANDARD BRANDS INCORPORATED, et al. 65 SCRA 575, 579, has stated thus:

> "In case involving infringement of trademark brought before the Court, it has been consistently held that there is

> infringement of trademark when the use of the mark involved would be likely to cause confusion or mistake in the mind of the public or to deceive purchasers as to the origin or source of the commodity; whether or not a trademark causes confusion and is likely to deceive the public is a question of fact which is to be resolved by applying the "TEST OF DOMINANCY", meaning, if the competing trademarks contain the main or essential or dominant features of another by reason of which confusion and deception are likely to result, then infringement takes place. That duplication or imitation is not necessary. A similarity in the dominant features of the trademark would be sufficient." (CO TIONG SO vs. DIRECTOR OF PATENTS, 1954, 94 Phil. 1, citing VIZ CLARKE vs. MANILA CANDY CO., 36 Phil. 100: ALHAMBRA CIGAR & CIGARETTE CO., vs. JAO OGE, 47 Phil. 75, ETEPHA A.G. vs. DIRECTOR OF PATENTS and WESTMONT PHARMACEUTICALS INC., NO. L-20635, 16 SCRA 495)

Likelihood of confusion cannot be avoided by adding the word "HOLLYWOOD" to FOSTER's which also the Opposer's trademark. Thus, in Continental Connector Corp., vs. Continental Specialties Corp., 207 USPQ 60, the oft repeated rule was applied to wit: That the conclusion created by the use of the same word as the primary element in a trademark is not counteracted by the addition of another term.

Examples:

"Miss U.S.A." and Miss U.S.A. WORLD"
(Miss Universe, Inc., vs. Patricelli, 161 USPQ 129)

"GUCCI" and "GUCCI-GOO"
(Gucci Shops vs. R.H. Macy & Co., 446 USPQ 754)

"COMFORT" and "FOOT COMFORT"
(Scholl, Inc. vs. Topes E.H.R. Corp., 185 USPQ 754)

"ACE" and "TEN-ACE"
(Becton, Dickenson & Co., vs. Wiguan Mills, Inc., 199 USPQ 607)

In connection with the use of a confusingly similar or identical mark, it has been ruled, thus:

> "Those who desire to distinguish their goods from the goods of another have a broad field from which to select their ware and there is no such poverty in the English language or paucity of signs, symbols, numerals etc., as to justify one who really wishes his products from those of all others entering the twilight zone of a field already appropriated by another" (WECO PRODUCTS CO., vs. MILTON RAY CO., 143 F 2d, 985, 32 C.C.P.A. Patents 1214)

> "Why the million of terms and combinations of letters and designs available, the appellee had to choose those so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark." (AMERICAN WIRE & CABLE CO., vs. DIRECTOR OF PATENTS, 31 SCRA 544)

> "x x x Why, with all the birds in the air, and all the fished in the sea, and all the animals on the face of the earth to choose from, the defendant company (MANILA CANDOY CO.,) elected two roosters as its trademark, although its directors and mangers must have been well aware of the long-continued use of a

roster by the plaintiff with the sale and achievement of its goods? x x x a cat, a dog, a carabao, a shark or an eagle stamped upon the container in which candies are sold would serve as well as a rooster for the product of defendants factory. Why did defendant select two roosters as its trademark?" (CLARKE vs. MANILA CANDY CO., 36 Phil. 100)

When one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a preciously registered label of trademark, this is not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and established goodwill. (CHUAN CHOW SOY & CANNING CO., vs. DIRECTOR PATENTS and VILLAPANTA, 108 Phil. 833, 863)

WHEREFORE, the Opposition is SUSTAINED. Consequently, trademark application bearing Serial No. 85157 filed on March 23, 1993 by Brentfield, Investments, N.V. for the registration of the trademark "FOSTER'S HOLLYWOOD" for services characteristics of hotel industry is hereby REJECTED.

Let the filewrapper of FOSTER'S HOLLYWOOD subject matter of this case be forwarded to the Administrative, Financial Human Resource Development Service Bureau (AFHRDSDB) for appropriate action in accordance with this DECISION with a copy furnished the Bureau of Trademarks (BOT) for information and to update its records.

SO ORDERED.

Makati City, 16 May 2003.

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