

CITRUS WORLD, INC.,	}	IPC NO. 14-1999-00039
Opposer,	}	Opposition to:
	}	Serial No. 104832
	}	Date Filed: 12-27-95
-versus-	}	
	}	
ANAPOLIS INTEGRATED FOODS	}	Trademark: "FLORIDA"
CORPORATION,	}	
Respondent-Applicant.	}	Decision No. 2002-47
x-----x		

D E C I S I O N

For resolution by this Office is the Opposition filed by CITRUS WORLD, INC. a corporation organized and existing under the laws of the United States of America, with principal office at 650 Highway 27 North, Lake Wales, Florida 32853, U.S.A., against the registration of the trademark "FLORIDA" for juice under Class 32, bearing Application Serial No. 104832 and filed on 27 December 1995 in the name of ANNAPOLIS INTEGRATED FOODS CORPORATION, a corporation organized and existing under the laws of the Republic of the Philippines, with address at Annapolis Tower, 43 Annapolis St., Greenhills, San Juan, Metro Manila.

The subject application was published on page 93, Volume II, No. 2, March-April 1999 issue of the Official Gazette, which was officially released for circulation by the Intellectual Property Office (IPO) on 16 August 1999. Opposer filed its Unverified Opposition on 15 September 1999 and the Verified Notice of Opposition on 14 December 1999.

The grounds for the opposition to the registration of the trademark FLORIDA are as follows:

"1. Opposer is the owner of and/or registrant in and/or applicant in many trademark registrations of the trademarks FLORIDA'S NATURAL and FLORIDA'S NATURAL GROWERS PRIDE around the world under International Class 32, more particularly for "fruit juices and drinks.;

"2. In the Philippines, Opposer is the applicant for registration of its foregoing trademarks FLORIDA'S NATURAL and FLORIDA'S NATURAL GROWERS PRIDE, as follows:

- 1) Trademark: FLORIDA'S NATURAL  
Applicant: Citrus World, Inc.  
Appln. No.: 4-1999-04162  
Date Filed: June 14, 1999  
Goods: Fruit juices and drinks  
Class: 32
  
- 2) Trademark: FLORIDA'S NATURAL GROWERS PRIDE  
Applicant: Citrus World, Inc.  
Appln. No.: 4-1999-04161  
Date Filed: June 14, 1999  
Goods: Fruit juices and drinks  
Class: 32

"3. By virtue of Opposer's pending applications for registration of the trademarks FLORIDA'S NATURAL and FLORIDA'S NATURAL

GROWERS PRIDE in the Philippines and its prior registration and ownership of these trademarks around the world, said trademarks have therefore become distinctive of Opposer's goods and business;

"4. The registration and use of the trademark FLORIDA, by the Respondent-Applicant for use on similar goods, i.e., "juices" under International Class 32, will deceive and or confuse purchasers into believing that Respondent-Applicant's goods and/or products bearing the trademark FLORIDA emanate from or are under the sponsorship of the Opposer. Respondent-Applicant obviously intends to trade and is trading on Opposer's goodwill;

"5. The registration and use of the trademark FLORIDA by Respondent-Applicant will diminish the distinctiveness and dilute the goodwill of Opposer's trademarks FLORIDA'S NATURAL and FLORIDA'S NATURAL GROWERS PRIDE;

"6. It is evident that the adoption of the trademark FLORIDA by Respondent-Applicant was not made in good faith rather, there is apparently an intent by Respondent-Applicant to "ride on" the goodwill established and "pass off" Respondent-Applicant's goods as those of Opposer;

"7. The allowance of Application Serial No. 104832 in the name of Respondent-Applicant will be violative of the treaty obligations of the Philippines under the Paris Convention for the Protection of Industrial Property, of which the Philippines and the United States of America are member-states."

The Notice to Answer, dated 17, December 1999, was sent to and received by counsel for Respondent-Applicant on 01 January 2000. For failure of the Applicant to file the required Answer within fifteen (15) days from receipt of aforesaid notice, the Applicant was declared in default by the Intellectual Property Office (IPO) as per Order No. 2000-602 dated 21 November 2000 and the Opposer was allowed to present its evidence ex-parte.

Admitted in evidence for the Opposer are Exhibits "A" to "Y" inclusive of submarkings consisting of: (a) the Affidavit-testimony of Walter M. Lincer, President of Opposer Corporation; (b) copy of Trademark Application Serial No. 4-1999-04162 dated 14 June 1999 for the trademark FLORIDA'S NATURAL; (c) copy of Trademark Application Serial No. 4-1999-04161 dated 14 June 1999 for the trademark FLORIDA'S NATURAL GROWERS PRIDE; (d) copy of U.S. Certificate of Trademark Registration No. 1,745,985 dated 12 January 1993, issued in the name of Opposer for the trademark FLORIDA'S NATURAL, for fruit juices in Class 32; (e) copy of Argentina Certificates of Trademark Registration Nos. 1,643,806 and 1,644,440 dated 05 September 1997 and 12 September 1997 respectively, for the trademark FLORIDA'S NATURAL for goods under Class 32; (f) copy of Benelux Certificate of Trademark Registration No. 217220 for the trademark FLORIDA'S NATURAL for goods under Class 32; (g) copy of Chile Certificate of Registration No. 499,478 dated 03 January 1997 for the trademark FLORIDA'S NATURAL for non-alcoholic fruit juices, juice and orange juice under Class 32; (h) copy of Finland Certificates of Trademark Registration Nos. 217220 dated 31 March 2000 for the trademark FLORIDA'S NATURAL GROWERS PRIDE for goods under Class 32; (i) copy of Finland Certificates of Trademark Registration Nos. 217219 dated 31 March 2000 for the trademark FLORIDA'S NATURAL for goods under Class 32; (j) copy of Jordan Certificate of Trademark Registration No. 54462 dated 04 October 2000 for the trademark FLORIDA'S NATURAL for goods under Class 32; (k) copy of Mexico Certificate of Trademark Registration No. 425219 dated 20 May 1991 for the trademark FLORIDA'S NATURAL for fruit juices under Class 32; (l) copy of Costa Rica Certificate of Trademark Registration No. 291240 dated 12 October 2000 for the trademark FLORIDA'S NATURAL for goods under Class 32; (m) copy of Korea Certificate of Trademark

Registration No. 37862 dated 17 October 1997 for the trademark FLORIDA'S NATURAL GROWERS PRIDE for various kinds of juices; (n) copy of Jordan Application for Trademark Registration No. 54440 dated 08 August 1999 for goods under Class 32; (o) copy of Jordan Application for Trademark Registration No. 54446 dated 08 August 1999 for the trademark FLORIDA'S NATURAL for goods under Class 32; (p) magazine advertisements and brochures; (q) brochure/pamphlet of company history; (r) summary of shipments of products in the Philippines; (s) commercial invoices representing sales of FLORIDA'S NATURAL products to the Philippines for the year 2000; and (t) documents showing sampling and promotional costs; (u) summary of product samples and invoices.

The issues to be resolved in this particular case are:

- (a) Whether or not there exists a confusing similarity between the Opposer's trademark FLORIDA'S NATURAL and FLORIDA'S NATURAL GROWERS PRIDE and Respondent-Applicant's trademark FLORIDA; and
- (b) Who between the Opposer and the Respondent-Applicant is the prior user entitled to protection under the Trademark Law.

Considering that the application subject of the instant opposition was filed under the old Trademark Law (R.A. 166, as amended), this Office shall resolve the case under said law so as not to adversely affect rights already acquired prior to the effectivity of the new Intellectual Property Code (R.A. 8293).

The applicable provision of the Trademark Law, Section 4(d) provides:

“Sec. 4. *Registration of trademarks, trade-names and service-marks on the principal register* – xxx The owner of a trademark, trade-name or service-mark used to distinguish his goods, business or services from the goods, business or service of others shall have a right to register the same on the Principal Register, unless it:

xxx

“(d) Consists of or comprise 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 service of the applicant, to cause confusion or mistake or to deceive purchasers.”

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 the mark would *likely* cause confusion or mistake on the part of the buying public. The law does not require that the competing trademarks must be so identical as to produce actual error or mistake. For infringement to exist, it would be sufficient that the similarity between the two trademarks is such that there is a possibility or likelihood of the older brand mistaking the newer brand for it.

In determining whether or not there is confusing similarity between trademarks, the Supreme Court has relied on the dominancy test or the assessment of the essential or dominant features in the competing trademarks. Even the spelling and the similarity in sounds and pronunciation are taken into consideration. Thus, in the case of *Co Tiong Sa vs. Director of Patents* (95 Phil 1) the application for the registration of the trademark “FREEDOM” was rejected due to the existing registration of the mark “FREEMAN” over the same class of goods.

In the case of *Etepha vs. Director of Patents* (16 SCRA 502), the Supreme Court stated that:

“The essential element of infringement is colorable imitation. This term has been defined as “such a close or ingenious imitation as to be calculated to deceive ordinary purchasers, or such resemblance of the infringing mark to the original as to deceive an ordinary purchaser giving such attention as a purchaser usually gives, and to cause him to purchase the one, supposing it to be the other.”

In the case of *Marvex Commercial Co. vs. Hawpia & Co.* (18 SCRA 1178), the Supreme Court found that:

“The tradename ‘LIONPAS’ for medicated plaster cannot be registered because it is confusingly similar to ‘SALONPAS’, a registered trademark also for medicated plaster. xxx Although the two letters of ‘SALONPAS’ are missing in ‘LIONPAS’ the first letter *a* and the letter *s*. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. xxx”

In the case of *American Wire and Cable Co. vs. Director of Patents* (31 SCRA 544), the Supreme Court observed that:

“xxx The similarity between the two competing trademarks, DURAFLEX and DYNAFLEX is apparent. Not only are the initial letters and the last half of the appellations identical but the difference exists in only two out of the eight literal elements of the designations. Coupled with the fact that both marks cover insulated flexible wires under Class 20; xxx no difficulty is experienced in reaching the conclusion that there is a deceptive similarity that would lead the purchaser to confuse one product with the other.”

In the instant case, the trademarks of the Opposer’s FLORIDA’S NATURAL and FLORIDA’S NATURAL GROWERS PRIDE marks and Respondent-Applicant’s FLORIDA, both contain the predominant word FLORIDA, which is the distinctive feature of said trademarks. The trademarks as used by both parties also cover the same goods under Class 32, which flow through the same channels of trades. Thus, use of the trademark FLORIDA by the Respondent-Applicant on its products is likely to lead to confusion as to source.

As per the evidence presented, Opposer first used the mark FLORIDA’S NATURAL and FLORIDA’S NATURAL GROWERS PRIDE in the U.S.A. in 1991, in connection with the processing, marketing, sale and distribution of its products, more particularly, juices and drinks. On 12 January 1993, the United States Patent and Trademarks Office issued to the Opposer Certificate of Registration No. 1745985 for the trademark FLORIDA’S NATURAL for fruit juices, under Class 32. Thereafter, Opposer expanded its sales to various countries worldwide, such as Argentina, Benelux, Chile, Finland, France, Mexico, Costa Rica, Korea, Jordan, including the Philippines, wherein Opposer, likewise, secured/applied for registrations of the trademarks FLORIDA’S NATURAL and NATURAL GROWERS PRIDE. On the other hand, Respondent-Applicant presented no evidence as to its use of the trademark FLORIDA for its products. Between the Opposer and the Respondent-Applicant, Opposer has sufficiency proven prior use of the word mark FLORIDA, and is therefore entitled to protection from infringement thereof. Consequently the mark FLORIDA of Respondent-Applicant cannot be allowed registration for being confusingly similar to Opposer’s trademarks, FLORIDA’S NATURAL and FLORIDA’S NATURAL GROWERS PRIDE.

Also, the word FLORIDA is actually the name of a state in the U.S.A., which is world-famous for oranges, such that the use of Respondent-Applicant of the mark FLORIDA for its orange juice automatically leads to the impression that said products originated from Florida, U.S.A.

Unlike Opposer which is actually based in Florida, U.S.A. and which can therefore rightfully claim that its products originated from and/or are produced in said state, Respondent-Applicant is a Philippine company which is based in the Philippines and which operates in the Philippines. The use by Respondent-Applicant of the trademark FLORIDA for orange juice is geographically misdescriptive. It cannot truthfully claim that its products originated from and/or are produced in Florida, U.S.A. Therefore, Respondent-Applicant's use of the trademark FLORIDA for its orange juice is likely to mislead or deceive the public into thinking that its products are from said state. The use of geographically misdescriptive marks is proscribed under Section 4 (e) of R.A. 166, to wit:

*"Sec. 4. Registration of trademarks, trade-names and service-marks on the principal register – xxx The owner of a trademark, trade-name or service-mark used to distinguish his goods, business or services from the goods, business or service of others shall have a right to register the same on the Principal Register, unless it:*

x x x

*"(d) Consists of or comprise a mark or trade-name which when applied to or used in connection with the goods, business or services of the applicant is merely descriptive or deceptively misdescriptive of them, or when applied to or used in connection with the goods, business or services of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, or is primarily merely a surname."*

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Consequently, Application bearing Serial No. 104832 for the mark "FLORIDA" under Class 32 filed by ANNAPOLIS INTEGRATED FOODS CORPORATION on 27 December 1995 is hereby REJECTED.

Let the filewrapper of FLORIDA subject matter of this case be forwarded to the Administrative, Financial and Human Resource Development Service Bureau (AFHRDSB) for appropriate action in accordance with this Decision and a copy thereof furnished the Bureau of Trademarks for information and update of its records.

SO ORDERED.

Makati City, December 27, 2002.

ESTRELLITA BELTRAN-ABELARDO  
Director  
Bureau of Legal Affairs  
IPO