

DC COMICS,
Opposer-Appellant,

APPEAL NO. 14-03-33
IPC NO. 14-2002-00084

-versus-

Opposition to:
Serial No. 115259
Filed: 04 November 1996
Trademark: "SUPERBITE"
Goods: Class 30

WILLIAM LIM,
Respondent-Applicant-Appellee,
X-----X

DECISION

This concerns Decision No. 2003-37 dated 12 November 2003 rendered by the Director of the Bureau of Legal Affairs (Director) denying the Opposition filed by Opposer-Appellant DC Comic (Appellant)¹, and giving due course to Trademark Application Serial No. 115259 for the mark SUPERBITE filed by Respondent-Applicant-Appellee WILLIAM LIM (Appellee)² for corn snacks on 04 November 1996.

The controversy involves the determination as to whether or not the Appellee's mark SUPERBITE for corn snacks under Class 30 is confusingly similar to the Appellant's mark SUPERMAN for magazine under Class 39³.

Records show that on 04 November 1996 the Appellee filed with the defunct Bureau of Patents, Trademarks and Technology Transfer (BPTTT) an Application for Registration of the trademark SUPERBITE with Serial No. 115259 for corn snacks under Class 30 of the International Classification of Goods⁴. The application was published for opposition in Volume V, No. 4 of the Intellectual Property Office (IPO) Official Gazette which was released for circulation on 05 August 2002.⁵

On 03 December 2002, the Appellant filed a Verified Notice of Opposition alleging the following:⁶

- 1) The trademark "SUPERBITE" is identical and/or confusingly similar with Appellant's trademark "SUPERMAN", a well-known mark, registered under the name of DC COMICS in trademark regulating agencies worldwide; registered and previously used in commerce in the Philippines, as to be likely, when applied to or used in connection with the goods of the Appellee, to deceive or cause confusion upon the buying public. In addition, the Appellee's use of the trademark "SUPERBITE" would indicate, in regards to goods of the latter, a connection or relation of sponsorship with the Appellant and likely cause confusion as to source and origin, thereby resulting in compensable damage to the goodwill and property rights of the Appellant. The application, therefore, is a violation of Section 123 and 147 of the Intellectual Property Code.
- 2) The trademark "SUPERMAN", through the Appellant's substantial and exclusive use over a long period of time has created such distinctiveness in relation to the Appellant's goods that it has acquired a secondary meaning and may not, be the subject of another's entity's application for trademark registration.
- 3) The registration of the trademark "SUPERBITE" in the name of the Appellee will violate Section 123, subparagraph (e) and section 131.3 of the Intellectual Property Code (IP Code), Republic Act No. 8293.

- 4) The registration by Appellee of the trademark "SUPERBITE" will damage the goodwill of Appellant's mark "SUPERMAN", an internationally well-known mark which the Appellant has been using in commerce in the Philippines long before 04 November 1996, i.e., the date of first use claimed by the Appellee for "SUPERBITE."
- 5) The registration of the mark "SUPERBITE" in the name of the Appellee is contrary to other provisions of the IP Code, treaty obligations of the Philippines and well-settled jurisprudence on the matter.

A Notice to Answer dated 05 December 2002 was issued by the Bureau of Legal Affairs (BLA) directing the Appellee to file his Answer within fifteen (15) days from receipt of the said notice. However, records show that the Appellee failed or did not file the required Answer within the reglementary period despite receipt of the Notice to Answer on 02 January 2003. Thus, the Motion to Declare the Appellee in Default filed by the Appellant on 21 March 2003 was granted per Order No. 2003-133 dated 26 March 2003.

Thus, on 12 November 2003, the Director rendered the assailed Decision, the pertinent portion of which reads as follows:

"As shown by the records, herein Opposer failed to comply with the third requirement of the said Memorandum, that is, *the mark must be for use in the same or similar kinds of good*. The Opposer is using the mark 'SUPERMAN' for magazines under class 16 while the Respondent-Applicant is using the mark 'SUPERBITE' corn snacks under class 30.

"WHEREFORE, in view of the foregoing, the instant Opposition is hereby DENIED. Consequently, trademark application bearing Serial No. 115259 for the mark 'SUPERBITE' filed on November 4, 1996 by William Lim for 'corn snacks' is hereby given due course.

"Let the filewrapper of this case be forwarded to the Administrative, Financial Human Resource Development Service Bureau (AFHRDSB) for appropriate action in accordance with this DECISION with a copy furnished the Bureau of Trademarks for information and to update its record."

Consequently, the Appellant filed with this Office a Notice of Appeal on 16 December 2003. Nothing that the mode of appeal pursued by the Appellant was not in accordance with the IPO Uniform Rules on Appeal, this Office issued an Order dated 18 December 2003 requiring said party to submit an appeal memorandum not later than 31 December 2003.

On 09 January 2004, this Office received the Appellant's Appeal Memorandum.⁷ Records show that it was sent by registered mail on 05 January 2004. Considering that 31 December 2003 up to 04 January 2004 were holidays/non-working days, the Appeal Memorandum was deemed filed on time. In the appeal, the Appellant contends that:

- 1) The Director, in arriving at her decision, completely ignored the voluminous, clear and convincing evidence presented by the Appellant on the issue of confusing similarity between the opposing marks; and
- 2) The decision is contrary to the provisions of sub-paragraphs (e) and (f) of Section 123 of the Intellectual Property Code of the Philippines.

Since the Appellee did not file its Comment, this Office issued an order on 04 March 2004 stating that the instant appeal is deemed submitted for decision.⁸

After due consideration of the foregoing and review of the records of this case, this Office finds the appeal devoid of merit.

Republic Act No. 166, the law which governs the opposed trademark applications, provides, to wit:

“Section 4. *Registration of trade-marks, trade-names and service-marks on the principal register* – There is hereby established a register if trade-marks, trade-names or service-marks which shall be known as the principal register. The owner of a trade-mark, trade-name or service-mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register unless it:

xxx

(d) Consists 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 mistakes or to deceive purchasers.”

Thus, in determining whether or not the competing marks are confusingly similar, the following factors should be considered: (1) appearance or reputation of the marks; and (2) the goods to which it is being used.

The competing marks are reproduced below for comparison:

APPELLANT'S MARK⁹



APPELLEE'S MARK¹⁰



This Office agrees with the Director that the competing marks are different from each other as to composition, spelling, pronunciation as well as in meaning. While the word "SUPER" is present on both marks, nevertheless, in their last syllable, they are entirely different from each other and by merely pronouncing the two marks, it could hardly be said that it will provoke a confusion, as to mistake one for the other.¹¹ As correctly stated by the Director in her decision, the similarity of the competing trademarks in this case is completely lost in the substantial differences in their meaning, pronunciation and in spelling as well.¹²

As to the goods on which the contending marks are used, the Supreme Court had spoken that goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with the 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.¹³ Goods will be considered as not falling under the same class if they are so dissimilar or so foreign to each other as to make it unlikely that the purchasers would think the first user made the second user's goods.¹⁴

In this instance, Appellant's mark is used for magazines under Class 16 while that of the Appellee is used for corn snacks under class 30. Obviously, magazines and corn snacks are not identical. Neither do they belong to the same class of goods. They have different channels of trade.

Aptly, a rudimentary precept in trademark protection is that the right to a mark is a limited one, in the sense that others may use the same mark on unrelated goods. Thus, the mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description.¹⁵ The owner's exclusive right to the use of a trademark generally refers to goods which or in connection with which the trademark is used and to those related thereto, and not to unrelated and non-competing goods. The reason can be deduced from the provision that a certificate of registration of a mark or trade-name shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark or trade-name, and of the registrant's exclusive right to use the same in connection with the goods, business or services specified in the certificate, subject to any conditions and limitations stated therein¹⁶, which implies that trademark protection extends only to goods, business or services related to those specified in the certificate. Otherwise, if the certificate of registration were to be deemed as including goods not specified therein, then a situation may arise whereby an applicant may be tempted to register a trademark or any and all goods on a whim even if he never intends to use the trademark for the said goods. In fact, this was strengthened by the Intellectual Property Code, Section 124.2 of which requires the submission of the declaration of actual use otherwise the application shall be denied or if already registered, the same shall be canceled by this Office.

In the instant case, the fact that the goods covered by the contending marks are entirely distinct from each other was even admitted by the Appellant itself.¹⁷

Further, the Appellant failed to substantiate its claim by convincing evidence of indication that it expanded or intended to expand its business to goods under class 30 in the Philippines. Even Certificate of Renewal No. 928 and Registration No. 2635¹⁸ of the Appellant does not include goods under Class 30. On the contrary, these documents speak of magazines.

The Appellant's reliance on Exhibit "M", as well as, Exhibits "B-14", "B-15", "B-23", "B-30", "B-37", "B-90", "B-91", "B-104", "B-108", "B-141", and "B-142", is no moment.¹⁹

According to the Appellant, the purpose of Exhibit "M" is to establish that the mark SUPERMAN in telescopic lettering was used as early as 1940 for chewing gum which is a junk food that belongs to a class of goods similar or related to the goods for which the Appellee has applied the mark SUPERBITE.²⁰ This Office, however, finds that Exhibit "M" does not show that the mark SUPERMAN in telescopic lettering was used for chewing gum in the Philippines.

Interestingly, Appellant's Exhibit "I" partly state that the gum that "helped keep teeth strong" has long been gone. Clearly, the Appellant failed to establish that it used the mark SUPERMAN for snack foods in the Philippines.

Consequently, the Appellant failed to substantiate its claim that it is entitled to the protection and benefit under Article 6bis of the Paris Convention. Without a doubt, SUPERMAN is well-known in the Philippines as a fictional character or super-hero and as trademark for magazines. However, insofar as chewing gum or snack foods are concerned, it is not. Whether the trademark under consideration is well-known in the Philippines or is a mark already belonging to a person entitled to the benefits of the Convention, should be established according to the criteria set in Article 6bis²¹ of the Paris Convention for the Protection of Industrial Property. In this regard, the Appellant failed to present substantial evidence to prove that its mark is well-known in the Philippines as far as chewing gum or snack foods are concerned. As can be gleaned from the records, the supposed worldwide registration of the mark is contained only in the listing of countries not supported by copies of the actual certificates of registration that are authenticated and certified by the proper government agencies. Failing to establish that the mark SUPERMAN used for chewing gum or snack foods or similar goods is well-known, the Appellant is not entitled to protection under Article 6bis of the Paris Convention. Appellant cannot take refuge in a bare supposition.

WHEREFORE, premises considered, there is no cogent reason to disturb Decision No. 2003-37 dated 12 November 2003 rendered by the Director of the Bureau of Legal Affairs. Accordingly, the instant appeal is DENIED and the appealed decision is hereby AFFIRMED.

Let a copy of this Decision be furnished the Director of the Bureau of Legal Affairs for appropriate action, and the records be returned to her for proper disposition. Further, let the Directors of the Bureau of Trademarks and the Administrative, Financial and Human Resource Development Service Bureau be furnished copies hereof for information and/or appropriate action.

SO ORDERED.

December 10, 2004. Makati City, Philippines.

EMMA C. FRANCISCO
Director General

FOOTNOTES:

1 A corporation duly organized and existing under the laws of the United States of America, with address at 75 Rockefeller Plaza, New York, New York, 10019, USA. See: Appellant's Appeal Memorandum dated 31 December 2003 page 1.

2 A Filipino citizen with address at #8 Furing St., Bo. Punturin, Valenzuela, Metro Manila. See: Appellee's Trademark Application dated 04 November 1996.

3 Now Class 16 under the NICE Classification, 8th Edition.

4 Also known as the Nice Classification. It is based on a multilateral treaty administered by WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of Registration of Marks, which was concluded in 1957. The Agreement is open to States party to the Paris Convention for the Protection of Industrial Property.

5 Incidentally, on 01 January 1998, Republic Act No. 8293 also known as the Intellectual Property Code of the Philippines (IP Code) took effect. It abolished, among other things, the BPTTT and transferred its functions to the newly created Intellectual Property Office.

6 Appellant's Verified Notice of Opposition dated 03 December 2002, pages 2-3.

7 Appellant's Appeal Memorandum, supra, page 8.

8 In Order dated 13 January 2004, this Office directed the Appellee to file its Comment to the Appeal Memorandum within thirty (30) days from receipt.

9 Exhibit "O-4".

10 Exhibit "H".

11 Decision No. 2003-37 dated 12 November 2003, page 5.

12 Decision, supra.

13 Esso Standard Eastern, Inc. vs. CA, 116 SCRA 336, 31 August 1982, page 342.

14 Ang vs. Teodoro, 74 Phil. 50, 14 December 1942, page 54.

15 Philippines Refining Co., Inc. vs. Ng Sam, 115 SCRA 472, 30 July 1982, page 476, citing the pronouncement of U.S. Supreme Court in the case of American Foundries vs. Robertson, 269 US 372, 381, 70 L ed 317, 46 Sct. 160.

16 Republic Act No. 166, Section 20.

17 The pertinent portion of the Appellant's Memorandum dated 10 June 2003, page 21, provides that: secondly, the Philippine registration falls under a class of goods (for magazines, presently class 16) that is different from that of the opposed application (i.e., "corn snacks" or class 30).

18 Exhibit "O-3".

19 Appellant's Memorandum, supra, page 19.

20 See Appellant's Appeal Memorandum, supra, page 18-19.

21 Article 6bis (1) "The countries of the Union undertake, ex officio if their legislations so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well-known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith."