

EZAKI GLICO KABUSHIKI KAISHA,  
Opposer,  
- versus -

IPC 14-2007-00154

UNIVERSAL ROBINA CORPORATION,  
Respondent-Applicant.

Opposition to:

TM Application No. 4-2004-005411  
(Filing Date: 18 June 2004)

TM: "JACK N' JILL PRETZ STIX"

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Decision No. 2007-132

## DECISION

This is an opposition to the registration of the mark "JACK N' JILL PRETS STIX" bearing Application No. 4-2004-005411 filed on June 18, 2004 for the goods "*flour based biscuits*" under class 30 of the International Classification of goods which application was published in the Intellectual Property Philippines (IPP) Electronic Gazette (E-Gazette), officially released for circulation on January 26, 2007 the Opposer's in the instant opposition is "EZAKI GLICO KABUSHIKI KAISHA a company organized under the laws of Japan, with principal place of business at 6-5 Utajima 4- Chrome, Nishiyodagawa, Osaka, C Japan.

The Respondent-applicant on the other hand, is "UNIVERSAL ROBINA CORPORATION" with address at 110 E. Rodriguez Avenue, Libis Quezon City

The grounds for the opposition are as follows:

- "1. The registration of the subject mark of this opposition is contrary to Section 123.1 (e) and (f) of Republic Act No. 8293 otherwise known as the Intellectual Property Code of the Philippines (IP Code) which prohibits the registration of the mark that:

"Sec. 123. *Registration*-123.1. a mark cannot be registered if it:

(d) Is identical with a registered mark belonging to a different proprietor of 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;

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;"

- "2. Opposer is the owner of the "PRITZ" mark which is registered with this Honorable Office in the name of the Opposer for goods under Class 30 under Certificate of Registration No. 671771 issued on 10 October 1995.
- "3. Respondent-Applicant's "JACK N' JILL PRETZ STIX" mark nearly Resembles and is confusingly similar to Opposer's "PTETZ" mark as to be likely to deceive or cause confusion. Hence the registration of the Respondent-applicant mark will be violative of Section 123.1 (d) of the IP Code.
- "4. Opposer is entitled to the benefits granted to foreign national under Section 03 of the IP Code, which states:

"Section 3. *International* Conventions and Reciprocity. – Any person who is a national or who is domiciled or has a real and effective industrial establishment in a country which is a party to any convention, treaty or Agreement relating to intellectual property rights or the repression of unfair competition, to which the Philippines is also a party, or extends reciprocal rights to nationals of the Philippines by law, shall be entitled to benefits to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of an intellectual property right is otherwise entitled by this Act."

The Opposer is a corporation domiciled in Japan. Both Philippines and Japan are members of the Paris Convention for the Protection of Industrial Property. The Paris Convention provides:

"Article 6bis

(1) The countries of the Union undertake, ex-officio if Their legislation 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 considered by competent authority of the country of registration or use to be well-known in that country as being the mark of a person entitled to the benefits of this Convention and used for identical or similar goods x x x.

"Article 10bis

(1) The countries of the Union are bound to assure nationals of such countries effective protection against unfair competition."

- "5. Opposer's "PRETZ" mark is well-known and world famous mark. Hence, the registration of the Respondent-Applicant's "JACK N' JILL PRETZ STIX" mark will constitute a violation of Articles 6bis and 10bis of the Paris Convention in relation to Section 123.1 (e) of the IP Code.
- "6. The use by Respondent-Applicant of the word "PRETZ" as the *dominant* component of its "JACK N' JILL PRETZ STIX" mark, which resembles and is confusingly similar to Opposer's "PRETZ" mark, will mislead the purchasing public into believing that the Respondent-Applicant's goods are produced by, originate from, or are under the sponsorship of the Opposer.

Opposer relied on the following facts to support its opposition:

- "1. Opposer is the lawful owner and rightful proprietor of the internationally known trademark "PRETZ" which is used to identify Opposer's snack food products under Class 30.

- "2. As the lawful owner of the "PRETZ" mark, Opposer was able to register the said mark with this Honorable Office under the following registration particulars:



A certified copy of Certificate of Registration No. 61771 is attached hereto and made an integral part hereof as Exhibit "A".

- "3. Apart from its Philippine registration, Opposer was able to register the "PRETZ" mark in various countries throughout the world, such as:

Korea	273265	01 September 1993	PRETZ
Thailand	TM114446	09 April 1970	PRETZ, Characters & Katakana in Three lines
Malaysia	M/51808	28 February 1969	PRETZ, PRETZ in Malaysia Characters & Kanji in three lines
Singapore	T95/11863G	07 December 1995	PRETZ
China	613156	10 October 1992	PRETZ
Saudi Arabia	403/49	06 December 1995	PRETZ
Australia	679,850	05 December 1995	PRETZ
Canada	301548	04 April 1985	PRETZ
Mexico	541255	06 December 1995	PRETZ
Brazil	818.830.972	08 August 2000	PRETZ
Argentina	1730648	13 April 1999	PRETZ
Finland	121001	05 August 1992	PRETZ
Germany	2013468	28 February 1991	PRETZ
France	1674170	30 October 1991	PRETZ
Spain	1627205	30 April 1991	PRETZ
Portugal	275327	07 June 1993	PRETZ
England	1461258	15 April 1991	PRETZ
Ireland	145153	24 June 1991	PRETZ
Russia	150300	14 March 1997	PRETZ
South Africa	95/15809	28 November 1995	PRETZ
India	690225	11 December 1995	PRETZ
Vietnam	73306	18 October 2004	PRETZ
USA	3144020	19 September 2006	PRETZ
Community Trademark	773549	09 March 1998	PRETZ
Japan	2431348	30 June 1992	PRETZ

- "4. Opposer was established in Japan in 1921 by its Founder, Mr. Riichi Ezaki, who in 1919 confirmed the suitability of glycogen contained in Oysters for use as ingredient in confectionary products. Since then, Opposer has grown to become one of Japan's most established food companies engaged in the production of a diverse line of food products such as confectionary, ice cream, processed foods, health foods and Supplements, dairy products, beverages and desserts. To date, Opposer maintains four companies in Japan, namely Ezaki Glico Company Limited, Glico Dairy Products Co., Ltd., and Glico Foods Co., Ltd., each overseeing the productions and manufacture of Opposer's different product lines. As part of its expansion program, Opposer has established manufacturing facilities in Thailand, France and China. Always keeping in mind the health and well-being of its customers, Opposer focuses on invest heavily in biotechnology to ensure the Health-promoting functions of its food ingredients. Some of Opposer's popular products include "GLICO", "Pocky" and "Pretz" confectionary, "Giant Cone" and "Papico" ice cream snacks, "Kogen" and "Yoji" milk, "Asa No Series" and "Nasu Kogen" meat products, and "Menhao Tei" noodle products. An original copy of Opposer's company profile is attached hereto and made an integral part hereof as Exhibit "AA", Opposer also maintains, a websites at [www.glico.co.jp](http://www.glico.co.jp) where information on its different products and activities may be obtained.
- "5. Opposer first launched its "PRETZ" confectionary products in Japan in 1963 since then has become one of its most popular and successful Products. In fact, from 1995 to 2005, Opposer's world-wide sales of "PRETZ" products amounted to approximately JPY 106, 42,000,000. Confectionary products bearing the "PRETZ" mark were first sold in the Philippines in September 1999 and are continuously made available to Filipino consumers to this day. Copies of shipping invoices evidencing the importation of "PRETZ" confectionary products from Japan to Clarkfield, Pampanga, Philippines in 1999 and 2001 are attached hereto and made an integral parts hereto as Exhibits "BB" and "CC" respectively. Opposer's use of the "PRETZ" mark in the Philippines is further evidenced by Certificate of Registration No. 61771 which contains an annotation of Opposer's compliance with the corresponding use requirements for the fifth (5<sup>th</sup>) Anniversary of the said registration. At present, confectionary products bearing the "PRETZ" mark various supermarkets and groceries evidencing the commercial sale of Opposer's "PRETZ" confectionary products in the Philippines together with the actual packing of the "PRETZ" products as purchased from these establishments are attached hereto and made integral parts hereof as Exhibits "DD", "DD", "DD2", "EE", "EE-2", "FF", "FF-1", "FF-2", "GG", "GG-1", and "GG-2" respectively.
- "6. On 18 June 2004 or almost nine (9) years Opposer was able to register the "PRETZ" mark in the Philippines, Respondent-Applicant applied for the registration of the mark "JACK N' JILL PRETZ STIX" mark with this Honorable Office for products under Class 30, namely flour based biscuits. The registration of the 'JACK N' JILL PRETZ STIX' mark, particularly the use of the word "PETZ" as the *dominant* component thereof will result in confusion among the relevant sector of the republic as Respondent-Applicant's mark and Opposer's "PRETZ" mark nearly resembles each other and cover identical goods under Class 30 (i.e. biscuits). Significantly, the products of both Opposer and Respondent-Applicant flow through the same channels of trade, target the same sectors of the consuming public and directly compete with each other being as they are snack food products.

- "7. Similarly between the two marks caused primarily by Respondent-applicant's adopted of the dominant element "PRETZ" is revealed by a side-by-side comparison of the same:

Opposer's mark	Respondent-Applicant's mark
	

- "8. The registration and use of Respondent-Applicant's 'JACK N' JILL PRETZ STIX" mark will diminish the distinctiveness and dilute the goodwill associated with Opposer's "PRETZ" mark which has become distinctive of the confectionary products manufactured and sold by Opposer in the Philippines and all over the world. Moreover, it will mislead the purchasing public into believing that the Respondent-Applicant's products are produced by, originate from, or are under the Sponsorship of the Opposer.
- "9. The registration and use of Respondent-Applicant's 'JACK N' JILL PRETZ STIX" mark, which nearly resembles Opposer's "PRETZ" mark as to be likely to deceive or cause confusion, will cause incalculable damage and prejudice to Opposer's reputation, goodwill and general business standing.
- "10. Respondent-Applicant's adoption of the dominant word "PRETZ" as a means to identify similar if not identical products under Class 30 was done with deliberateness for the purpose of taking advantage of the popularity, goodwill and reputation generated by Opposer's "PRETZ" mark. By adopting the word "PRETZ" as the dominant element of its mark, Respondent-Applicant clearly intends to attract potential customers by exploiting the reputation built by Opposer for its registered "PRETZ" Mark.
- "11. Respondent-Applicant's trademark application for the registration of the "JACK N' JILL PRETZ STIX" was filed on 18 June 20054 or almost nine (09) years after Opposer has secured the registration of its "PRETZ" mark in the Philippines on 10 December 1995. Accordingly, the registration of Respondent-Applicant's 'JACK N' JILL PRETZ STIX" mark is proscribed under Section 123.1 (d) of the IP Code.
- "12. The use and adoption by Respondent-Applicant of the "JACK N' JILL PRETZ STIX" marks likewise constitutes an unlawful appropriation of the well-known "PRETZ" mark. For this reason, the registration of Respondent-Applicant's "JACK N' JILL PRETZ STIX" mark is proscribed under Sec. 123.1 (e) of the IP Code.

Exhibit	Description
Exhibit "A"	Certified Copy of Philippine Registration Certificate No. 61771 for the mark "PRETZ"
Exhibit "B"	Copy of Hong Kong Trademark Registration No. B03932/2004
Exhibit "C"	Copy of Taiwan Trademark Registration No. 67493
Exhibit "D"	Copy of Korean Trademark Registration No. 273265
Exhibit "E"	Copy of Thailand Trademark Registration No. TM114446
Exhibit "F"	Copy of Malaysia Trademark Registration No. M/51808
Exhibit "G"	Copy of Singapore Trademark Registration No. T95/11863G
Exhibit "H"	Copy of China Trademark Registration No. 613156
Exhibit "I"	Copy of Saudi Arabia Trademark Registration No. 403/39
Exhibit "J"	Copy of Australia Trademark Registration No. 679,850
Exhibit "K"	Copy of Canada Trademark Registration No. 301548
Exhibit "L"	Copy of Brazil Trademark Registration No. 818.830.972
Exhibit "M"	Copy of Argentina Trademark Registration No. 1730648
Exhibit "N"	Copy of Finland Trademark Registration No. 121001
Exhibit "O"	Copy of Germany Trademark Registration No. 2013468
Exhibit "P"	Copy of France Trademark Registration No. 1674170
Exhibit "Q"	Copy of Spain Trademark Registration No. 1627205
Exhibit "R"	Copy of Portugal Trademark Registration No. 275327
Exhibit "S"	Copy of Great Britain Trademark Registration No. 1461258
Exhibit "T"	Copy of Ireland Trademark Registration No. 145153

On the other hand, Respondent-Applicant did not submit any evidence in support of its application subject of the instant opposition, in fact it filed its Verified Answer despite Having received the Notice to Answer issued by the Bureau of Legal Affairs on June 22, 2007.

Section 11 of the Summary Rules (Office Order no. 79, Series of 2005) provides:

"Section 11. *Effect of failure to file an Answer.* In case the Respondent-Applicant fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the Petition or Opposition, the affidavit of the witnesses and Documentary evidence submitted by the Petitioner or Opposer."

The issue to be resolved in the instant opposition is:

**WHETHER OR NOT THE RESPONDENT-APPLICANT IS ENTITLED TO THE REGISTRATION OF THE MARK 'JACK N' JILL PRETZ STIX'.**



The applicable provision of the law is, Section 123 (d) of Republic Act No. 8293, which provides:

"Sec. 123. *Registrability*-123.1 *A mark cannot be registered if it:*  
(d) Is identical with a registered mark belonging to a Different proprietor or 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,”

The trademark of the Opposer consists of the word “PRETZ” while that of the Respondent-Applicant consists of the words ‘JACK N’ JILL PRETZ STIX”.

The competing trademarks are reproduced below for scrutiny and comparison:

Opposer’s mark	Respondent-Applicant’s mark
	

To be noted is the fact that the Respondent-Applicant mark is a composite one. It is composed of many components. In the manner of display/presentation, it appears that its dominant feature is the word “PRETZ”

The word “PRETZ” which is present in the Respondent-Applicant’s mark is exactly the same with the mark of the Opposer “PRETZ” both in spelling, pronunciation and composition of letter. In short, there is confusing similarity between the two competing trademark.

One critical consideration to be factored in cases of trademarks that are identical or Confusingly similar is the goods or products to which they are actually used/covered.

In the present opposition, the goods covered by the competing trademarks fall under the same Class 30 of the International Classification of goods.

Records will show that the Opposer’s mark “PRETZ” has been registered with the Bureau of Patents, Trademarks and Technology Transfer (BPTTT) now the Intellectual Property Philippines (IPP) on October 10, 1995 bearing Registration No. 61771 for the goods, chocolate, chocolate confectionary, biscuits, biscuits confectionary, candy under Class 30 (Exhibit “A”) while Respondent-Applicant’s ‘JACK N’ JILL PRETZ STIX” is being used on the flour based biscuits hence, the goods Opposer as well as Respondent-Applicant are similar or related.

Considering that the Opposer’s trademark, it is no longer subject for Appropriation by any third party otherwise it would be contrary to Section 123.1 (d) of republic Act No. 8293 otherwise known as the Intellectual Property Code of the Philippines.

In the case of Chuanchow Soy & Canning Co., vs. The Director of Patents and Rosario Villapanta [G.R. No. L-13947, June 30, 1960] the Supreme Court ruled:

“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 owner and user of A previously registered label or 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 an established goodwill.”

In this particular case, it is very difficult to understand why the Respondent-Applicant has included in its trademark the word “PRETZ” which has been already appropriated by another as

there millions of words available to choose from, is not only to take advantage of the goodwill of the Opposer's trademark.

The laws on trademarks and trade-names are 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 the traders, is justified in damaging or jeopardizing another's business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good, name and reputation built by another (Baltimore vs. Moses, 182, Md 229, 34 A92d 338).

Section 147.1 of the Intellectual Property Code of the Philippines provides:

*"Section 147. Rights conferred.*

x        x        x

Section 147.1 The owner of a registered mark shall have the exclusive right to prevent all third party not having the owner's consent from using in the course of trade identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services a likelihood of confusion shall be presumes."

WHEREFORE, in light of all the foregoing, the instant Opposition is, as it is hereby, SUSTAINED. Consequently, trademark application bearing Serial No. 4-2004-005411 filed on June 18, 2004 by "UNIVERSAL ROBINA CORPORATION" for the mark "JACK N' JILL PRETZ STIX" is hereby REJECTED.

Let the filewrapper of the trademark "JACK N' JILL PRETZ STIX" subject matter Of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 25 September 2007.

Atty. ESTRELLITA BELTRAN-ABELARDO  
Director Bureau of Legal Affairs