

GENERAL MILLS, INC.,	}	Inter Partes Case No. 4029
Opposer,	}	Opposition to:
	}	
-versus-	}	Appl'n Serial No. : 82857
	}	Date Filed : October 06, 1992
	}	Trademark : "ROLL-UP"
	}	
TWIN OAKS FOOD CORP.,	}	Decision No. 2002-36
Respondent-Applicant.	}	
x-----x		

DECISION

This is an opposition to the registration of the trademark "ROLL-UP" bearing Serial No. 82857 covering the goods "CHOCOLATES" in Class 30 of the International Classification of goods which application was published for opposition in page 36 of the then Bureau of Patents Trademarks and Technology Transfer (BPTTT) official Gazette No. 1 Vol. VII, which was officially released for circulation on March 21, 1994.

The Opposer in the above-entitled case is "GENERAL MILLS, INC." a corporation organized and existing under the laws of DELAWARE with principal office at Number One General Mills Boulevard, Minneapolis, MN 35426, United States of America.

On the other hand, the Respondent-Applicant is "TWIN OAKS FOOD CORPORATION", a corporation of the Philippines with address at 130 20th Avenue, Cubao, Quezon City, Metro Manila.

The grounds for the opposition are as follows:

- "1. The registration of the mark "ROLL-UP" in the name of the Respondent-Applicant will violate and contravene the provision of Section 4(d) of Republic Act No. 166, as amended, because the said mark is confusingly similar to the trademark "FRUIT ROLL-UPS" owned and unabandoned by the Opposer, as to be likely, when applied to or used in connection with the goods of Respondent-Applicant, to cause confusion or mistake or deceive purchasers thereof;
- "2. The trademark "FRUIT ROLL-UPS" is known in numerous countries to be owned by the Opposer. Hence, the registration of the confusingly similar trademark "ROLL-UP" in the name of the Respondent-Applicant will be a breach of the clear provisions of Article 6bis of the Paris Convention for the Protection of Industrial Property now enforced in the Philippines by virtue of the Memoranda of the then Minister of Trade dated November 20, 1980 and October 25, 1983 directing the Director of Patents to cancel and/or reject/refuse all unauthorized registrations that are identical or confusingly similar to world-famous marks; and
- "3. That the registration of Respondent-Applicant trademark "ROLL-UP" will cause grave and irreparable injury and damages to the business reputation and goodwill of the

Opposer within the meaning of Section 8 of Republic Act No. 166, as amended.

Opposer relied on the following facts to support its opposition:

- “1. The Opposer has registered the trademark “FRUIT ROLL-UPS” in the United States of America under Registration No. 1,127,591; Argentina under Registration No. 1,501,787; Canada under Registration No. 303,220; Japan under Registration Nos. 1,744,752 and 1,759,039; Taiwan under Registration No. 497,807 and Uruguay under Registration No. 262,052. Certified copies of the registration certificate will be presented during the hearing on the merits.
- “2. Opposer has used the trademark “FRUIT ROLL-UPS” extensively and continuously long before Respondent-Applicant filed the instant application for the registration of the trademark ROLL-UP. Hence, the Opposer is a clear senior-user;
- “3. Opposer has established valuable goodwill, fame and favorable reputation for “FRUIT ROLL-UPS” as a result of the sales generated by products bearing the said trademark, and the large sums of money that Opposer has spent worldwide in advertising and promoting the “FRUIT ROLL-UPS” trademark;
- “4. The use and registration of the trademark “ROLL-UP” by the Respondent-Applicant will likely cause confusion, mistake and deception to the buying public on the origin and/or sponsorship of the goods and will definitely dilute the value of the Opposer’s trademark “FRUIT ROLL-UPS” because the mark of the Respondent-Applicant is confusingly similar to that of the Opposer and is intended to cover chocolates which will conflict with the Opposer’s use of the trademark “FRUIT ROLL-UPS” for package fruit snacks.
- “5. Further, the use and registration of the mark ROLL-UP by Respondent-Applicant will cause grave and irreparable damage or injury to the Opposer within the meaning of the trademark law;
- “6. The goods to be covered by the Respondent-Applicant under Serial No. 82857 are chocolates.”

On July 21, 1994, Respondent-Applicant filed its answer to the Notice of Opposition denying all the material allegations therein and further alleged that:

- “1. The Opposition was filed out of time and must perforce be dismissed;
- “2. Opposer’s trademark is composite, consisting of two words while that of Respondent-Applicant is a simple mark, consisting of only one word;

- “3. A mere glance at Opposer’s mark automatically creates the impression that it is used in connection with fruits while looking at Respondent-Applicant’s mark alone does not bring about any idea as to the goods in connection with which it is being used;
- “4. Opposer’s products, packages fruit snack, are non-competing with those of Respondent-Applicants which are chocolates. The said products have different and distinct characteristic properties and mode of manufacture;
- “5. Opposer’s alleged registrations with other countries are not registrations in the Philippines. Opposer has apparently no commercial use in the Philippines. Under such circumstances Opposer cannot claim itself as a senior user, much less as having established valuable goodwill, fame and favorable reputation for its mark as in fact these are clearly its mere gratuitous conclusion without factual or legal basis;
- “6. Opposer’s claim that its mark is intended to cover chocolates deserves no consideration whatsoever as a trademark is a creation of use and may not be a subject of speculation or reservation;
- “7. A side-by-side comparison between the two trademarks will readily show their obvious dissimilarities.”

The parties were not able to come out with an amicable settlement for which trial on the merit was conducted.

The main issue to be resolved in this particular case is:

WHETHER OR NOT Respondent-Applicant’s trademark “ROLL-UP” is confusingly similar to Opposer’s trademark “FRUIT ROLL-UPS”.

To be taken into consideration is the fact that the mark “ROLL-UP” bearing opposed was filed on October 6, 1992 and further, that the opposition was filed on June 30, 1994 when the law governing Intellectual Property Rights is Republic Act No. 166, as amended.

The applicable provision is Section 4(d) of Republic Act No. 166 as amended which provides as follows:

“SEC. 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 service of the applicant, to cause confusion or mistake or to deceive purchases.”

Well settled is the rule that the determinative factor in a contest involving registration of trademarks is not whether the challenged mark would actually cause confusion or mistake on the part of the buying public. To constitute infringement, the law does not require that the competing trademarks be so identical as to produce actual error or mistake. It would be sufficient for that 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 (AMERICAN WIRE & CABLE CO. vs DIRECTOR OF PATENTS, 31 SCRA 544).

In the case at bar, and as shown by the evidence presented, Respondent-Applicant’s trademark “ROLL-UP” is confusingly similar to Opposer’s trademark “FRUIT ROLL-UPS” which is registered in many countries of the world, as follows:

Exhibit “A”, United States of America Registration No. 1,127,591; Exhibit “B”, Canada Registration No. 303,220; Exhibit “C”, Japan under Registration No 1,759,039; Exhibit “D”, Taiwan Registration No. 497,807; Exhibit “E”, Uruguay Registration No. 262,052; Exhibit “F”, Argentina Registration No. 1869070; Exhibit “G”, China Registration No.; Exhibit “H”, Denmark Registration No. VR00650 1995.

Likewise, the goods covered by the Opposer’s trademarks has been exported to a number of other countries including the Philippines. (Exhibit “J”).

The only difference between the two contending marks is the presence of the word “FRUIT” in the Opposer’s trademark:

Respondent-Applicant can not appropriate Opposer’s trademark in TOTO and to avoid the likelihood of confusion by deleting the word “FRUIT”. In the case of Continental Connector Corp. vs. Continental Specialist Corp., 207 USPQ 60, it has been ruled that “Courts have repeatedly held that the confusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term.” Examples are “Miss USA WORLD” (Miss UNIVERSE, Inc. vs. Patricelli, 161 USPQ 129); “GUCCI LOGO” (GUCCI Shops vs. R.H. Macy & Co. 446 F: Supp.838); “COMFORT and FOOT COMFORT” (Scholl, Inc. vs. Tops E.H.R. Corp., 185 USPQ 754); “Washington Mint” and “GEO Washington Mint” (George Washington Mint, Inc. vs. Washington Mint, Inc. 176 USPQ 251); “ACE” and “TEN ACE” (Becton, Dickson & Co. vs. Wiguarum Mills, Inc. 199 USPQ 607);

In determining confusing similarity, a side-by-side comparison of the marks emphasizing differences in detail is not the appropriate test. The key inquiry is not similarity PER SE but rather whether a similarity exist which is likely to cause confusion. (SEE EXXON Corp. vs. ZOIL Energy Resources Inc., 552 Fsupp. 1008, 1016, 216 USPQ 634,641-642 [S.D.N.Y.J.]). This test must be applied from the perspective of purchasers. thus, it must determined whether the impression which the infringing mark makes upon the consumer is such that it is likely to believe the product is from the same source as the one he knows under the trademark. (McGREGOR-DONIGER, INC. vs PRIZZLE, INC. 599 F 2d at 1133, 202 USPQ 81, 85-7). In making this determination, it is the overall impression of the marks as a whole that must be considered. Likewise, it has been consistently held that infringement of a trademark is to be determined by the test of DOMINANCY. Similarity in size, forms, and colors, while relevant, IS NOT CONCLUSIVE. If the competing trademarks contain the main essential or dominant features of another, and confusion and deception is likely to result, infringement takes place. Duplication or imitation is not necessary; nor it is necessary that the infringing label should suggest an effort to imitate (CO TIONG S.A. vs. DIRECTOR of PATENTS, G.R. No. L-5378, 95 Philippines).

Moreover, the merchandise or goods being sold by the parties which are covered by their marks are ordinary commodities purchased by average persons who are at times ignorant and

unlettered. These are the persons who will not as a rule examines the printed small letters on the container but will simply be guided by the striking dominant mark "SUPER" on the label. Differences there will always be, but whatever they are, these play into insignificance in the face off an evident similarity of the dominant feature (the word SUPER) and overall appearance of the labels (Phil. NUT INDUSTRY, INC. vs. STANDARD BRAND, INC., 65 SCRA 575).

Those who desire to distinguish their goods from the goods of another have a broad field from which to select a trademark for their wares and there is no such poverty in the English language or paucity of signs, symbols, numerals, etc. as to justify one who really wishes to distinguish his product from those of all others in entering the twilight zone of the field already appropriated by another (WECO PRODUCTS CO. vs. MILTON RAY CO., 143 F 2d 985, 31 C.C.P.A. Patents 1214).

"Why of 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 AND CABLE CO. vs. DIRECTOR of PATENTS, 31 SCRA 544).

It should be emphasized that the trademark "FRUIT ROLL-UPS" of the herein Opposer has been registered in its own country of origin, United States of America on December 11, 1979 (Exhibit "A") which is much earlier than the Respondent's claim of first use which is January 5, 1990 as stated in Respondent-Applicant's trademark application. There is therefore, no doubt as to the Opposer's ownership and prior use of the mark "FRUIT ROLL-UPS".

Another vital point to be emphasized in the instant proceedings is the fact that herein Respondent-Applicant failed to present any evidence as a proof of its claim of ownership over the mark "ROLL-UP" (Order No. 2001-373) dated 5 July 2001.

Therefore, as the rightful owner and prior user of the trademark "FRUIT ROLL-UPS", Opposer should be given protection from the unlawful copying or imitation pursuant to the provisions of the Law on Intellectual Property Rights. THUS, the Supreme Court has declared in several cases, thus:

"That object of a trademark are to point out distinctively the origin or ownership of the article to which it is affixed, to secure to him, who has been instrumental in bringing into the market a superior article or merchandise; the fruit of his industry and skill, and to prevent fraud and imposition. (ETEPHA vs. DIRECTOR of PATENTS, 16 SCRA 495; LA CHEMISE LACOSTE, S.A. vs. Fernandez, 129 SCRA 373)."

WHEREFORE, premises considered, the Opposition is hereby SUSTAINED. Consequently, trademark application bearing Serial No. 82857 for the mark "ROLL-UP" used on chocolates filed on October 6, 1992 by TWIN OAKS FOOD CORPORATION, is hereby REJECTED.

Let the file wrapper of the trademark ROLL-UP subject matter 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 (BOT) for information and to update its records.

SO ORDERED.

Makati City, 17 December 2002.

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