

GLOBE TELECOM, INC.,
Opposer,

IPC No. 14-2008-00238
Case Filed:
Opposition to:

- versus -

Appl'n Serial No.: 4-2008-000361
Date Filed: 11 January 2008
Trademark: "CALL KABAYAN and Device"

LINKPHILIPPINES INTERNATIONAL, INC.,
Respondent-Applicant,
X-----X

Decision No. 2009-99

DECISION

For decision is the Verified Notice of Opposition filed on 3 October 2008 by Globe Telecom, Inc. (hereinafter referred to as opposer), a corporation duly organized and existing under Philippine law with office at Globe Telecom plaza, Pioneer corner Madison Streets, Mandaluyong City, against Application Serial No. 4-2008-000361 for the mark CALL KABAYAN! & DEVICE under Class 38 for telecommunication filed on 11 January 2008 filed by Link Philippines International, Inc. with address at Cruz Compound, Bonifacio St., De la Paz, Pasig City.

"A. Opposer's "GLOBE KABABAY AN" trademark is well-known in the Philippines and Internationally, and is entitled to protection under Article 6bis of the convention of Paris for the protection of industrial property, the pertinent provisions of the TRIPS Agreement and the Intellectual Property Code of the Philippines against the registration of identical or confusingly similar marks.

B. Respondent-applicant's "CALL KABAYAN! AND DEVICE" should be denied registration pursuant to Section 123.1 (d) of Republic Act 8293 and Rule 101 (d) of the Rules and Regulations on trademarks, service marks, trade names and marked or stamped containers.

C. Respondent-applicant's application for registration of the "CALL KABAYAN! & DEVICE" trademark was intended to take advantage of the goodwill attached to opposer's "GLOBE KABABAYAN" trademarks."

Opposer submitted the following evidence to wit:

ANNEX	DESCRIPTION
"A"	Power of Attorney
"B"	Amended Articles of Incorporation

“C”	Photocopy of advertising material
“D”	Affidavit of Alan C. Supnet (with attachments)

In its Answer, received on 18 November 2009, respondent-applicant raised the following defenses, to wit:

“To avoid confusion, while Opposer may have merely described its trademark in the entirety of its opposition as “GLOBE KABABAYAN” only and not “GLOBE KABABAYAN and Device”, Respondent-Applicant will describe Opposer’s trademark as “GLOBE KABABAYAN and Device” as a whole as shown in its attachments (see: Annexes “B”, “C”, and unmarked exhibits, Opposition).

One of the Opposer’s trademarks (filed on 28 January 2008, under Application No. 4-2008-000991 [unmarked Exhibit]) is described as follows:

“GLOBE KABABAYAN AND GLOBE *DEVICE* (REVERSED IN BLUE BACKGROUND) THE MARK IS COMPOSED OF THE WORD “GLOBE”, “KABABAYAN” AND THE GLOBE LIFE DEVICE. THE WORD “GLOBE” IS PRINTED IN A SPECIAL HAND DRAWN FONT BESIDE THE GLOBE *LIFE DEVICE*. THE WORD “GLOBE” *LIFE DEVICE* IS A 3 DIMENSIONAL SPHERE WHEREIN A HAND IS DRAWN ON ITS CENTER SURROUNDED CLOCKWISE BY THE FOLLOWING IMAGES: AN ENVELOPE, MAGNIFYING LENS SPEECH BUBBLE, A CAMERA, A COMPASS, A TELEVISION-COMPUTER, AN 8TH MUSICAL NOTE, AND A THOUGH BUBBLE. THE WORD “KABABAYAN” IS PRINTED IN PLUS SANS FONT BELOW A CURVED WHITE LINE CALLED THE HORIZON LINE. THE WORDS “GLOBE” AND “KABABAYAN AND DEVICE” ARE PRINTED IN WHITE KEYLINE WITH A BLUE BACKGROUND.” (Bold supplied)

On the other hand, Respondent-Applicant’s trademark is described as follows:

“An ellipse figure in yellow color, at its middle are written words read as: Call Kabayan! In blue color. On top of said word is a half-encircled receding orange color. Beneath said words, is a hand-paint-like blue color. After the exclamation point is a black telephone hand-set icon with its cord connecting to the letter “a” appearing between letter “y” and “n”. On the left and right side of the ear are three (3) black sharp and short streaks pointing at the headset.

The glaring and clear dissimilarities and distinctions, and evident differences in combinations and variations of symbols, marks, sizes, colors, geometric figures, sound of words and syllables of the subject trademarks as described above are self-explanatory.

Other striking dissimilarities are as follows:

1. Respondent-Applicant’s marks and other feature is enclosed by an ellipse figure.

2. While Opposer's marks and other feature is enclosed by a box or square figure.

3. Thus, trademark of the contending parties are enclosed by a striking different geometric figure which is an ellipse and a square/box.

Nonetheless, Opposer conveniently insists that the "CALL KABAYAN & DEVICE" nearly resembles and is confusingly similar to Opposer's "GLOBE KABABAYAN & DEVICE" registration inasmuch that CALL KABAYAN & DEVICE contains the main or the essential or dominant feature of "GLOBE KABABAYAN & DEVICE" (see par. 26, Opposition).

Opposer claims that the essential/ dominant feature of its trademark is "KABABAYAN"

Respondent-Applicant vigorously disagree.

By mere glance it is undeniable that the dominant / essential "word mark" feature of the Opposer is only the word "GLOBE" - not "GLOBE KABABAYAN" as a whole nor "KABABAYAN" alone. This is so evident and without need of further argument because as can be readily seen:

1. The word "GLOBE" is evidently bigger in size than the word "kababayan";
2. The word "GLOBE" is bolder than the word "Kababayan";
3. The word "GLOBE" is conspicuous than the word "Kababayan"
4. The word "GLOBE" is written on top of the word "Kababayan", thus rendering the word "GLOBE" superior, and make the word "Kababayan" inferior;
5. Considering that the word "Kababayan" is merely situated under the word "Globe", its visibility is diminished.
6. The word "Globe" is separated and is not connected with the word "Kababayan".
7. In fact, the Certificate of Registration issued by the government of Hong Kong (unmarked Exhibit) consists of several words, to wit:

Globe

Kabayan

Mobile Services para sa Pamilyang OFW

(Note: here the size of the word "Globe" is double the size of "Kababayan")

Thus, presence of several word marks in the above trademark have overshadowed the word "Kababayan".

8. In the Certificate of Registration under Application No. 4-2005-002482 issued by this Honorable Office (unmarked Exhibit), Opposer's trademark

Globe

Kabayan

Mobile Services para sa Pamilyang OFW

(Note: here the size of the word "Globe" is double the size of "Kababayan")

Thus, presence of several word marks in the above trademark have overshadowed the word "Kababayan".

9. The word mark "Kababayan" is merely a nominal mark in Opposer's trademark considering that aside from the bolder and bigger mark "Globe", there is a device circular in form, (even bigger in size than the word "Globe") located at its left side, which dwarfed the word "Kababayan".
10. Under no circumstances will it be the intention of the Opposer to use the word "KABABAYAN" rather than "GLOBE" as its dominant essential feature in its trademark considering that "Globe Telecom" (itself) as they claimed had been in the business since 1935, and is today one of the Philippine's leading and largest telecommunication companies. By any standard, no enterprise will disregard its own trademark that have acquired goodwill and to which they have invested substantial capital in lieu of something that has not yet been known, or to re-invent and invest anew for a trademark which has not yet been proven. To hold it otherwise is equivalent to saying that "McDonald" will change its trademarks for something that is new and unknown.

On the other hand, the essential/dominant "word-marks" features of the Respondent-Applicant is "CALL KABAYAN" as a whole. The sizes and location of the two (2) word marks are equal.

Strictly speaking however the essential/dominant word mark of the Respondent-Applicant is "KABAYAN" alone for the following reasons:

1. The word "KABAY AN" consists of several letters and syllables compare to "CALL", thus making it more visible and dominant.
2. In the Registrability Report dated February 29, 2009, the Honorable Office requires the Respondent-Applicant for the registrability of its application to disclaim the word "CALL", to which the latter duly complied with. Thus, the exclusive word mark of the Respondent-Applicant is "KABAYAN" alone.

To sum, Respondent-Applicant's dominant word mark is "KABAYAN", while the Opposer's dominant word mark is "GLOBE". xxx"

Respondent-applicant submitted its Articles of Incorporation as Exhibit "1".

The parties were called to a preliminary conference which was terminated on 2 April 2009. The parties did not reach an amicable settlement of the case and were directed to submit their respective position papers.

The issues for consideration are whether the mark CALL KABAYAN! AND DEVICE is confusingly similar to opposer's GLOBE KABABAYAN MOBILE SERVICES PARA SA OFW", and whether the mark CALL KABAYAN should be denied registration under Sec. 123 (d) and (j) of the Intellectual Property Code. Opposer also poses the issue that GLOBE KABABAYAN is well-known in the Philippines and abroad which entitles it to protection under the provisions of the Paris Convention, the TRIPS Agreement and the Intellectual Property Code.

The marks of the contending parties are reproduced below for comparison:



The Intellectual Property Code states:

“Section 123. *Registrability.* – 123.1 A mark cannot be registered if it:

(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”

The Supreme Court developed tests in determining confusing similarity. In *Mighty Corporation and La Campana Fabrica de Tabaco, Inc. vs. E. & J. Gallo Winery and the Andersons Group, Inc.*, G.R. No. 154342. July 14, 2004, the Supreme Court explained:

“Jurisprudence has developed two tests in determining similarity and likelihood of confusion in trademark resemblance:

- (a) the Dominancy Test applied in *Asia Brewery, Inc. vs. Court of Appeals* and other cases and

(b) the Holistic or Totality Test used in *Del Monte Corporation vs. Court of Appeals* and its preceding cases.

The Dominancy Test focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception, and thus infringement. If the competing trademark contains the main, essential or dominant features of another, and confusion or deception is likely to result, infringement takes place. Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate. The question is whether the use of the marks involved is likely to cause confusion or mistake in the mind of the public or deceive purchasers.”

The Supreme Court in *McDonald’s Corporation v. L.C. Big Mak Burger, Inc.*, G.R. No. 143993, dated 18 August 2004 held:

“The test of dominancy is now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code which defines infringement as the “colorable imitation of a registered mark xxx or a dominant feature thereof.”

Applying the dominancy test, there are two dominant words in opposer’s mark, GLOBE and KABABAYAN. The dominant features in respondent -applicant’s mark are the words CALL KABAYAN. Filewrapper shows that respondent-applicant disclaimed the word CALL such that “no claim is made to the exclusive right to use the word “CALL” apart from the mark as shown.” The word CALL is defined as to “communicate by telephone” (Online Dictionary by Farlex) standing alone would be descriptive of the service for which it is being registered. This can be surmised from the fact that the word CALL is disclaimed.

CALL KABAYAN! when applied for as a mark is not descriptive of the service telecommunication covered by class 38 and does not run afoul with Section 123 (j). The word call has been disclaimed and the representation of a handset is merely suggestive of telecommunication services.

Thus, the word KABAYAN remains to be the main feature of respondent-applicant’s mark. The word KABAYAN is confusingly similar to the word KABABAYAN. The two words when pronounced are phonetically similar. They have the same literal elements except for an additional “BA” in the word KABABAYAN. Both words have the same etymology, meaning or connotation. The visual impression of the words KABAYAN and KABABA YAN are similar.

Respondent-applicant in its Answer relies on the dominancy test but enumerated and scrutinized the details of the marks. Respondent-applicant compared the shapes, background, color and additional words which is done in applying the holistic test but unnecessary when the dominancy standard is used. All that is required is to take the main, essential, dominant, prominent and central feature of a mark and determine whether the same was appropriated. It does not matter that the word GLOBE also forms part of the dominant part, GLOBE KABABAYAN. The fact remains that KABAYAN and KABABA YAN are similar and the same marks are used on identical service under class 38, namely: “communication”.

The test of confusing similarity which would preclude the registration of a trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark would likely cause confusion or mistake on the part of the buying public. The law does not require that the competing marks must be so identical as to produce actual error or mistake. It would be sufficient, for the purpose of the law that the similarity between the two labels be such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it. (Acoje Mining Co., Inc. v. Director of Patents, 38 SCRA 480)

In *Marvex Commercial Co., Inc. vs. Petra Hawpia & Co.* (18 SCRA 1178), the Supreme Court held:

“ The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, *Unfair Competition and Trade Marks*, 1947, vol. 1, will reinforce our view that “SALON PAS” and “L10NPAS” are confusingly similar in sound: “Gold Dust” and “Gold Drop”; “Jantzen” and “Jazz-Sea”; “Silver-splash” and “Supper-Flash”; “Cascarete” and “Celborite”; “Celluloid” and “Cellonite”; “Charteuse” and “Charseurs”; “Cutes” and “Cuticlean”; “Hebe” and “Meje”; “Kotex” and “Femetex”; “Zuso” and “Hoo-hoo” Leon Amdur, in his book “*Trademark law and Practice*”, pp. 419-421, cites, as coming within the purview of the idem sonans rule. “Yusea” and “U-C-A”, “Steinway Pianos” and “Steinberg Pianos” and “Seven-Up” and “Lemon-Up”. In *Co Tiong vs. Director of Patents*, this Court unequivocally said that “Celdura” and “Condura” are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name “Lusolin” is an infringement of the trademark “Sapolin”, as the sound of the two names is almost the same.

In the case at bar, “SALONPAS” and “LIONPAS” when spoken sound very much alike. Similarity of sound is sufficient ground for this court to rule that the two are confusingly similar when applied to merchandise of the same descriptive properties. (See *Celanese Corporation of America vs. E.1. Du Pont*, 154 F. 2d. 146, 148).

“A trade-name in order to be an ‘infringement’ upon another need not be exactly like it in form and sound, but it is enough if the one so resembles another as deceive or mislead persons of ordinary caution into the belief that they are dealing with the one concern when in fact they are dealing with the other.” (*Foss v. Culbertson*, 136 P. 2d 711, 718, 17 Wash. 2d 610). xxx

“‘Infringement’ of trade-mark does not depend on the use of identical words, nor on the question whether they are so similar that a person looking at one would be deceived into the belief that it was the other, it being sufficient if one mark is so like another in form, spelling, or sound that one with not a very definite or clear recollection as to the real mark is likely to be confused or misled.” (*Northam Warren Corporation v. Universal Cosmetic C., C. C. Alil.*, 18 F. 2d 714, 775). (*Philippine Nut Industry, Inc. vs. Standard Brands Incorporated*, 65 SCRA 575)

As regards opposer's contention that GLOBE KABABAYAN is a well known mark, it submitted evidence consisting of registration in the Philippines and several countries abroad like Hong Kong, Great Britain, Japan, Singapore, Australia (Annex "B" of Mr. Alex Supnet's affidavit (Annex "D")). It also presented copies of pending applications in foreign countries (Annex "C" of Mr. Alex Supnet's affidavit (Annex "D")). Opposer also submitted a CD showing pictures and videos of its advertisements and promotions. (Annex "F" of Annex "D").

Section 123 of the Intellectual Property Code of the Philippines (Republic Act No. 8293, hereafter "IP Code") provides:

"Sec. 123. *Registrability.* – 123.1 A mark cannot be registered if it:

x x x

(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 to be well-known internationally and in 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, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark; x x x"

Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers provides:

"Rule 102. Criteria for determining whether a mark is well-known. In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark.
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;

- (h) the exclusivity of use affidavit by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- (i) The presence or absence of identical or similar goods or services owned by persons other than the person claiming that his mark is a well known mark.

Gauging from the evidence submitted, the GLOBE KABABAYAN mark used for as telecommunication under Class 38 which is registered in the Philippines and other countries (Annex "B") and which is also advertised and promoted in the Philippines and other countries abroad (Annex "F") for a specific sector of the public, particularly Filipino migrants or Filipinos overseas for them to be able to connect or communicate to the Philippines cannot be considered a mark that has acquired well-known status. Based on the foregoing discussions respondent-applicant's CALL KABAYAN! Is confusingly similar to GLOBE KABABAYAN, hence it cannot be registered considering the provisions of Sec. 123(d).

WHEREFORE, premises considered the OPPOSITION filed by GLOBE TELECOM, INC. is, as it is, hereby SUSTAINED. Accordingly, Application Serial No. 4-2008-000361 filed by Respondent- Applicant, LINK PHILIPPINES, INTERNATIONAL, INC. on 11 January 2008 for the mark "CALL KABAYANI & DEVICE" used on telecommunication under Class 38, is as it is hereby REJECTED.

Let the filewrapper of "CALL KABAYAN! & DEVICE", subject matter of this case be forwarded to the Bureau of Trademarks (BOT) for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, 10 July 2009.

ATTY. ESTRELLITA BELTRAN-ABELARDO
Director
Bureau of Legal Affairs