

MARS INCORPORATED,	}	IPC No. 14-2008-00110
<i>Opposer,</i>	}	Case Filed: May 16, 2008
	}	
	}	Opposition to:
	}	
-versus-	}	Appln. Ser. No. 4-2007-007734
	}	Date Filed: 20 July 2007
KEBIN S. UY	}	Title: "Q & Q's LABEL MARK"
<i>Respondent-Applicant</i>	}	
x-----x	}	Decision No. 2009- <u>30</u>

DECISION

This pertains to the verified NOTICE OF OPPOSITION filed on May 16, 2008 by Mars Incorporated to the application for registration of the trademark "Q & Q's LABEL MARK" for goods under Class 28 and 30 under Application Serial No. 4-2007-007734 lodged by respondent-applicant Kebin S. Uy on July 20, 2007 and published for opposition in the Intellectual Property Philippines (IP Phil.) electronic gazette on January 18, 2008.

Opposer Mars, Incorporated is a corporation organized and existing under the laws of the State of Delaware, U.S.A. and having its principal address at 688 Elm Street, Mclean, Virginia, U.S.A. Respondent-applicant is a natural person with business address at 546 Elcano St., Binondo, Manila.

The grounds for opposition are as follows:

1. The registration of the mark subject of this opposition is contrary to the provisions of Section 123.1 (d), (e) and (f) of Republic Act No. 8293, as amended, which prohibits the registration of a mark which:









"(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;

(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;

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interest of the owner of the registered mark are likely to be damaged by such use."

2. Opposer is the owner of the M & M'S mark and labels bearing the said mark and certain elements appearing in those labels these include the following marks that are registered in the Opposer's name with the Philippine Intellectual Property Office in various classes:

Mark	Registration Number	Date of Registration	Class of Goods
M & M'S LABEL (WITH CHARACTER) IN YELLOW & BROWN 	4-2004-008348	18 December 2006	30
M & M'S PEANUT LABEL (IN COLOUR) 	4-2001-002420	25 December 2006	30
M & M'S LABEL IN YELLOW & BROWN 	4-2004-008356	23 July 2001	30
M & M'S LOGO (IN COLOUR) 	4-2004-009299	5 February 2007	25
M & M'S 	4-1999-005211	16 April 2004	30
YELLOW CHARACTER WITH ARM RAISED 	4-2004-008353	18 December 2006	30
M & M'S YELLOW CHARACTER DEVICE 	4-1998-005661	18 January 2004	30
M & M'S YELLOW CHARACTER (WITH "M")(IN COLOUR) 	4-2001-007472	16 July 2006	6, 9, 14, 16, 18, 21, 24, 25, 26, 28

(the foregoing shall be referred to collectively as the "M & M'S" Marks)

The Opposer has also registered the M & M'S Marks with industrial property offices in other countries.

3. The Q & Q's Label Mark mark closely resembles the opposer's M & M'S Marks as to be likely to deceive or cause confusion, as illustrated in the following side-by-side comparison of the labels and the elements appearing in those labels:

Hence, the registration of the respondent-applicant's mark will be contrary to the provision of Sections 123.1 (d) of Republic act 8293.

4. Opposer is likewise entitled to the benefits granted to foreign nationals under Section 3 of Republic Act 8293, which provides:

"Section 3 International Conventions and Reciprocity. – Any person who is 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 by law, shall be entitled to benefits to the extent necessary to give effect to any provisions of such convention, treaty or reciprocal law, in addition to the rights which any owner of an intellectual property right is otherwise entitled by this Act."

The opposer is domiciled in the United States of America. Both the Philippines and the United States of America are members of the Paris Convention for the Protection of Industrial Property (the Paris Convention"). The Paris Convention provides that:

"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 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. The Opposer's M&M'S mark are well-known and world famous marks, hence, the registration of the Respondent-Applicant's mark will constitute a violation of Articles 6bis and 10bis of the Paris Convention in conjunction with Section3, 123.1 (e) and 123.1 (f) of Republic Act 8293.

6. The Opposer has used the M&M'S Marks in the Philippines and elsewhere prior to the filing date of the application subject of this opposition. The Opposer continues to use the M&M'S mark in the Philippines and in numerous countries.

7. The Opposer has also extensively promoted the M&M'S Marks worldwide. Over the years, the Opposer has obtained significant exposure for the goods and services upon which the M&M'S Marks are used in various media, including television commercials, outdoor advertisements, internationally well-known print publications, and other promotional events. The Opposer also promotes its goods over the internet at the website www.mms.com.

8. The Opposer has not consented to the Respondent-Applicant's use and registration of the Q&Q'S LABEL MARK or any other mark or label identical or similar to the Opposer's M&M'S Marks.

9. The use by the Respondent-Applicant of the Q&Q'S LABEL MARK in connection with goods and services in classes 28 and 30 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. Potential damage to the Opposer will also be caused as a result of its inability to control the quality of the products and services offered or put on the market by the Respondent-Applicant under the Q&Q'S MARK.

10. The use by the Respondent-Applicant of the Q&Q'S LABEL MARK mark in relation to its unfair advantage of, dilute and diminish the distinctive character or reputation of the Opposer's M & M'S marks.

11. The denial of the application subject of this opposition is authorized under other provisions of Republic Act No. 8293.

To support its Verified Notice of Opposition opposer submitted in evidence Annex "A" to "II" inclusive of sub-markings.

On the 03 June 2008, this Bureau issued a Notice to Answer to respondent-applicant and was duly served and received on June 25, 2008, however, no Answer has been filed, and as such, respondent-applicant was declared to have waived his right to present the Answer though Order No. 1495, hence the case was submitted for decision.

The issues to be resolved are as follows:

1. Whether respondent-applicant's "Q & Q's LABEL MARK" is confusingly similar to opposer's "M & M'S" Marks; and
2. Whether respondent-applicant is entitled to the registration of the "Q & Q LABEL MARK".

The subject "Q & Q's LABEL MARK" is depicted below:



Meanwhile, opposer's "M&M'S LABEL (With Character) In Yellow and Brown" is depicted below:



Other "M & M'S" Marks and/or marks registered in opposer's name are depicted below:



"M & M's Peanut Label (In Color)"



"M & M's Label In Yellow & Brown"



"Yellow Character With Arm Raised"

A careful perusal of Opposer's and respondent-applicant's respective marks shows that they are not confusingly similar: The dominant feature of respondent-applicant's mark is the letter "Q" in uppercase while that of Opposer is the letter "M" in lowercase. Certainly, the letter "Q" is far different from the letter "M" visually and aurally. In buying either product, purchasers would mention the name of the product, which is either "Q&Q" or "M&M", not the other features especially that they have not acquired secondary meanings.

Though jurisprudence provides that similarity in size, form and color, while relevant, is not conclusive (*Lim Hoa v. Director of Patents*, G. R. No. L-8072, October 31, 1956; *Co Tiong Sa v. Director of Patents, et al.*, G. R. No. L-5378, May 24, 1954); or that neither duplication/imitation, or the fact that the infringing label suggests an effort to emulate, is necessary (*Co Tiong Sa v. Director of Patents, et al.*, *supra.*), the marked difference in the respective dominant features of the competing marks- "M&M" for opposer and "Q&Q" for respondent-applicant-negates the likelihood of confusion either as to the goods or to the respective businesses of the parties. There is no likelihood that purchasers of the goods of either parties shall confuse the business of one party with that of the other such that a purchaser may be likely deceived to think that one party's business originates from, or is licensed or sponsored by the other, and/or that there is some connection between opposer and respondent-applicant which, fact, does not exist (*Sterling Products International, Inc. v. Farbenfabriken Bayer Aktiengesellschaft*, G.R. No. L-19906, April 30, 1969).

Gauging by the Dominancy Test which considers the dominant features of the competing marks, or which gives greater weight to the similarity of the appearance of the product arising from the dominant features of the mark attached to said product in determining whether such mark is confusingly similar with another mark (*McDonalds Corporation v. L.C. Big Mak, Inc.*, G. R. No.143993, August 18, 2004), the conclusion of this Bureau is that respondent-applicant's and opposer's respective marks are confusingly similar.

As to the first issue thus, this Bureau rules in the negative.

Considering that there is no confusing similarity between the two competing marks, the application of Section 123.1 (d) (iii) and (e) has become moot and academic.

Section 123.1 (d) of the IP Code provides:

“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 propriety date, in respect of:

- (i) The same goods. . . or*
- (ii) Closely related goods . . . or*
- (iii) If it nearly resembles such a mark as to be likely to deceive or to cause confusion . . . “ (Underscoring supplied.)*

In the case at bench, as already discussed, the subject mark “Q&Q” is not confusingly similar with that of opposer’s “M&M’S” Marks. Thus, it is immaterial that opposer was able to cause the registration of its “M&M” Marks earlier than the filing of respondent-applicant’s mark “Q&Q”. Said provision is inapplicable to the case at bench.

Section 123.1 (e) of the IP Code which provides:

“A mark cannot be registered if it:

(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;

is equally not applicable as it also presupposes that the subject mark is identical with or confusingly similar to a mark that is already the mark of a person other than the applicant for registration and, among others, is declared by the competent authority to be well-known internationally and in the Philippines. Again, this Bureau ruling as already discussed has rendered said provision moot and academic.

WHEREFORE, the verified NOTICE OF OPPOSITION is, as it is, hereby DENIED. Consequently, Application Serial No. 4-2007-007734 for the mark “Q & Q’s LABEL MARK” for goods under Class 30 lodged by respondent-applicant Kebin S. Uy on July 20, 2007 is, as it is hereby, GRANTED.

Let the file wrapper of this case be forwarded to the Bureau of Trademarks (BTO) for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, March 04, 2009

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