

PAGODA PHILIPPINES, INC.,
Opposer,

-versus-

IPC NO. 14-2005-00119
Opposition to:
App. Ser. No. 4-2002-010765
Date Filed: December 17, 2002
TM: "FAMILY'S BRAND"

UNIVERSAL CANNING, INC.
c/o ANITA L. KAW,
Respondent-Applicant,
x-----x

Decision No. 87

DECISION

For consideration is the Verified Notice of Opposition filed on October 5, 2005 against the application for registration of the mark "FAMILY'S BRAND" used for green peas under Class 31 of the international classification of goods bearing Application Serial No. 4-2002-010765 which was published for opposition in the Intellectual Property Office Electronic Gazette officially released for circulation on July 28, 2005.

Opposer, PAGODA PHILIPPINES, INC., is a corporation duly organized and existing under the laws of the Philippines, with business address at 4626 Valenzuela Street, Old Sta. Mesa, Manila.

Respondent-Applicant is UNIVERSAL CANNING, INC., a domestic corporation with address at Calle San Isidro, Ayala, Zamboanga City.

The grounds for Opposition to the registration of the mark are as follows:

"1. Respondent-applicant's trademark FAMILY'S BRAND (Brand having been disclaimed) is identical and/or confusingly similar to Opposer's trademark FAMILY and derivatives thereof. Accordingly:

a. The approval of the application in question is contrary to Sections 123.1 (d) and (f) of Republic Act 8293;

b. The approval of application in question will violate Opposer's right to the exclusive use of the trademark FAMILY and derivatives thereof which is duly registered in its favor and the extension of the use of said marks to other goods;

c. The approval of the application in question has caused and will continue to cause great and irreparable damage and injury to herein Opposer;

d. Respondent-applicant is not entitled to register the trademark FAMILY'S BRAND in its favor.

3. Opposer has not abandoned the use of its trademark FAMILY and derivatives thereof but continues its use thereof up to the present;

4. The trademark FAMILY'S BRAND being applied for registration by respondent-applicant is identical and/or confusingly similar to Opposer's trademark FAMILY and derivatives thereof;

5. The approval of the application in question is contrary to Section 123.1 (d) and (f) of Republic Act No. 8293 since Opposer's Application Serial No. 4-1999-09720 filed on December 17, 1999 included green peas, the same goods covered by the respondent's Application Serial No. 4-2002-010765 filed only on December 17, 2002 and subject to the Notice of Opposition;

6. The approval of the application in question is violative of the right of the Opposer to the exclusive use of the trademark FAMILY and derivatives thereof and of its rights to extend the use of the said marks to other goods;

7. Opposer has spent a substantial amount of money to popularize and promote its products bearing the trademark FAMILY and derivatives;

8. Through extensive advertising and promotional campaigns and because of the high quality of its products bearing the trademark FAMILY and derivatives thereof, said marks have become distinctive of Opposer's products and have established valuable goodwill in favor of the Opposer. Indeed, Opposer's advertising slogan "HINDI LANG PAMPAMILYA PANG SPORTS PA" has become household byword;

9. The approval of the respondent's application to register the trademark FAMILY'S BRAND for use on green peas has caused and will continue to cause great and irreparable damage and injury to Opposer since its Application Serial No. 4-1999-09740 also covers green peas, among other food products;

10. Respondent-Applicant is not entitled to register the trademark FAMILY'S BRAND in its favor pursuant to Section 123.1 (d) and (f) of the IP Code; The Opposer relied on the following facts to support its opposition:

"a. Opposer through its predecessor-in-interest, Violeta Alday, adopted and started using the trademark FAMILY for rubbing alcohol on January 5, 1969;

b. Since then, Opposer has continued and extended the use of the trademark FAMILY and derivatives thereof to other goods, including various food products;

c. The trademark FAMILY & REPRESENTATION OF A RIBBON was first registered in favor of the Opposer's predecessor-in-interest on April 13, 1981 under Registration Certificate No. 29065;

d. That at present the trademark FAMILY and derivatives thereof, is duly registered in favor of the Opposer under the following registrations, namely:

1. Registration Certificate No. 51745 for the trademark FAMILY & REPRESENTATION OF A RIBBON issued on November 5, 1991, which registration continues to be in full force and effect.

2. Registration Certificate No. 65188 for the trademark FAMILY issued on September 2, 1997.

3. Registration Certificate No. 4-2000-02713 for the trademark FAMILY VITAGEL issued on January 20, 2003.

4. Registration Certificate No. 4-1993-085710 for the trademark FAMILY issued on July 8, 2004.

5. Registration Certificate No. 4-1992-080068 for the trademark FAMILY issued on October 30, 2004.

e. That in addition, Opposer also filed the following applications for the registration of the trademark FAMILY and derivatives thereof, namely:

1. Application Serial No. 4-1999-09740 for the trademark FAMILY filed on December 17, 1999.

2. Application Serial No. 4-2000-02712 for the trademark FAMILY ALOEGEL filed on April 5, 2000.

3. Application Serial No. 4-2000-02714 for the trademark FAMILY ALCOGEL filed on April 5, 2000.

4. Application Serial No. 4-2004-004128 for the trademark FAMILY ALCOLOGNE filed on May 7, 2004.

On 27 October 2005, A Notice to Answer the Verified Notice of Opposition was issued by the Bureau to the herein Respondent-Applicant. Respondent-Applicant filed its Answer on January 16, 2006 stating among others, the following defenses:

“1. The approval of Respondent-Applicant’s trademark does not contravene Section 123.1 (d) and (f) of R.A. 8293;

2. Opposer does not have exclusive right to use the trademark FAMILY on food products under Class 31;

3. Opposer is not authorized by its Article of Incorporation to manufacture food products;

4. Opposer does not even pretend to have ventured into the production of goods under Class 331;

5. No damage will be sustained by the Opposer;

6. UCI is entitled to the registration of its FAMILY’S trademark for use under Class 31.

a. Respondent-Applicant is the first to apply for registration for its FAMILY’S trademark for use on food products;

b. Opposer has only filed its trademark application for use of its supposed Family trademark on food products subsequent to that filed by herein respondent-applicant;

c. Respondent-Applicant has actually used the trademark FAMILY’S on green peas and garbanzos.

On January 18, 2005, a Notice of Preliminary Conference was issued by this Bureau setting the preliminary conference on March 16, 2006. In the interim, Opposer filed its Reply on January 27, 2006. During the preliminary conference, the parties moved for resetting of the same to give them ample time to explore the possibility of an amicable settlement. After several postponements and without any compromise agreement being submitted, Opposer and Respondent-Applicant filed their respective Position Papers on July 20, 2006. Hence, this case is now ripe for decision.

The main issue to be resolved in this case is: Whether or not Respondent’s application for registration of mark “FAMILY’S BRAND” should be denied for being confusingly similar to the Opposer’s mark “FAMILY”.

Section 123.1 of Republic Act No. 8293 states:

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

x x x x

(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;

A cursory reading of the records of this case and the documentary evidence submitted indicates that the competing trademarks contain the word "FAMILY". The marks differ only with the addition of the word "BRAND" to Respondent-Applicant's mark.

Records further reveal that Opposer has existing Philippine registrations for the marks, FAMILY & REP. OF A RIBBON issued on April 3, 1981 under Certificate of Registration No. 29065 for use on rubbing alcohol [Class 5] (Exhibit "A"); FAMILY & REP. OF A RIBBON issued on November 5, 1991 under Certificate of Registration No. 51745 for use on rubbing alcohol [Class 5] (Exhibit "B"); FAMILY issued on September 2, 1997 under Certificate of Registration No. 65188 for use on toothpaste [Class 3] (Exhibit "C"); FAMILY & REPRESENTATION OF A FAMILY issued on July 12, 2000 under Certificate of Registration No. 4-1994-96831 for use on absorbent cotton [Class 5] (Exhibit "D"); FAMILY VITAGEL issued on January 20, 2003 under Certificate of Registration No. 4-2000-02713 for use on hand sanitizer [Class 5] (Exhibit "E"); FAMILY issued on July 8, 2004 under Certificate of Registration No. 4-1993-085710 for use on liquid detergents [Class 3] (Exhibit "F"); and FAMILY issued on October 30, 2004 under Certificate of Registration No. 4-1992-080068 for use on mosquito coils and insecticides [Class 5] (Exhibit "G"). Opposer also has a pending application for the mark FAMILY for use on various food products belonging to Classes 29, 30, 31 and 32 under Application Serial No. 4-1999-09740 filed on December 17, 1999 (Exhibit "H"); FAMILY ALOEGEL and FAMILY ALCOGEL for use on hand sanitizer falling under Class 5 which were both filed on April 5, 2000 under Application Serial Nos. 4-2000-02712 and 4-2000-02714 (Exhibits "I" and "J"); and FAMILY ALCOLOGNE for use on alcohol with cologne and baby oil, alcohol with cologne and aloe vera, alcohol with cologne and gel, alcohol with cologne, vitamins and gel under Class 1 filed on May 7, 2004 under Application Serial No. 4-2004-004128 (Exhibit "K").

On the other hand, Respondent-Applicant's mark "FAMILY'S BRAND" subject of this case is being applied for registration to be used in goods belonging to Class 31 such as green peas and garbanzos. Respondent's application for registration was filed on December 17, 2002. It has also a pending application for the mark FAMILY'S BRAND under Application Serial No. 4-1998-09114 filed on 15 December 1998 (Exhibit "1") under Class 29; Application Serial No. 4-1993-87228 filed on 03 August 1993 (Exhibit "2") also under Class 29.

As earlier observed, Respondent-Applicant's mark "FAMILY'S BRAND" contains the word "FAMILY", which is the dominant feature of the Opposer's mark. This dominant feature or characteristic is reproduced or imitated in respondent-applicant's trademark. Respondent-Applicant's mark differs with the Opposer's mark only with the addition of the word "BRAND" which, incidentally has been disclaimed by Respondent-Applicant. The use of a different font is almost unrecognizable so that Respondent-Applicant's mark, while slightly different in terms of font with that of the Opposer's, nonetheless, are all written or printed in capitalized letters, similar to Opposer's. Thus, Respondent-Applicant's mark clearly contains the main or essential or dominant features of Opposer's mark and confusion and deception is likely to result. An unfair competitor need not copy the entire mark to accomplish its fraudulent purposes. It is enough if he takes the one feature which the average buyer is likely to remember.

In line of the cases, the Supreme Court held that in cases involving the infringement of trademark brought before the court, it has been consistently held that there is infringement of trademark when the use of the mark involved would be likely to cause confusion or mistake in the mind of the public or to deceive purchasers as to the origin or source of the commodity; whether or not trademark causes confusion and is likely to deceive the public is a question of fact which is to be resolved by applying the TEST OF DOMINANCY, meaning if the competing trademarks contain the main or essential or dominant features of another by reason of which confusion and

deception are likely to result, then infringement takes place. The duplication or imitation is not necessary. A similarity in the dominant features of the trademark would be sufficient.

In one American case, it was held that the conclusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term. In the same manner, the mere addition of the word "BRAND" after the word "FAMILY" cannot avoid likelihood of confusion.

Another consideration to be made is the fact that Opposer's mark "FAMILY" deals, among others, with goods under Class 31 (green peas), the same goods included in Respondent's application subject of this opposition, confusing similarity arises as both parties are engaged in the same line of business. Because of the similarity in the marks and goods in which the parties deal, it will likely cause confusion or mistake on the part of unwary purchasers to believe that Respondent-Applicant's goods originate or under the sponsorship of the Opposer.

Further emphasis should also be made on the filing dates of the application for registration of the marks of the parties. As already stated, Respondent-Applicant's filed its application for herein subject mark on December 17, 2002 while Opposer filed its application for goods under Classes 29, 30, 31, and 32 on December 17, 1999 under Application Serial No. 4-1999-09740, hence, the latter is the first filer of the application for the same trademark under "the first-to-file" rule. As correctly pointed out by the Opposer, Respondent-applicant cannot rely on Application Serial No. 4-1998-09114 to determine the first filer as the goods covered by said application was only for canned sardines, which is under Class 29 while the mark under question is being used on green peas under Class 31 filed in December 17, 2002 for which Opposer has pending application since December 17, 1999.

On the issue of abandonment, since it is in the nature of a forfeiture of the right, it must be shown by clear and convincing evidence. To work an abandonment, the disuse must be permanent and not ephemeral; it should be intentional and voluntary, and not involuntary or even compulsory. The fact the Opposer is objecting the registration of Respondent-Applicant's mark only establishes Opposer's non-abandonment of the use of its mark.

WHEREFORE, premises considered, the Notice of Verified Opposition filed by Opposer, PAGODA PHILIPPINES, INC. against respondent-applicant UNIVERSAL CANNING, INC. subject application is, as it is hereby SUSTAINED. Consequently, the trademark application for the registration of the mark "FAMILY'S BRAND" bearing Application Serial N. 4-2002-010765 filed by respondent-applicant Universal Canning, Inc. on 17 December 2002 for green peas under Class 31 of the International Classification of Goods is, as it is hereby, REJECTED.

Let the filewrapper of FAMILY'S BRAND be transmitted to the Bureau of Trademarks (BOT) for appropriate action in accordance with this DECISION.

SO ORDERED.

Makati City, 31 August 2006.

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