

ROCKEFELLER & CO., INC.,	}	Inter Partes Case No. 14-2008-00246
<i>Opposer,</i>	}	Case Filed : 13 October 2008
	}	Opposition to:
	}	
-versus-	}	Appl'n Serial No. : 4-2008-000678
	}	Date Filed : 21 January 2008
	}	Trademark : "ONE ROCKEFELLER"
	}	
STEP ONE PROPERTY	}	
BUILDERS, INC.,	}	
<i>Respondent-Applicant.</i>	}	
x-----x	}	Decision No. 2009-74

DECISION

This is an opposition to the registration of the mark "ONE ROCKEFELLER" bearing Application No. 4-2008-000678 filed on January 21, 2008 for "*real estate management specifically pre-selling and selling of commercial/residential condominium and townhouses*" falling under Class 36 and "*real estate management specifically development of commercial/residential condominium and townhouses*" falling under Class 37 of the International Classification of goods which application was published in the Intellectual Property Philippines (IPP) E-Gazette, officially released on June 13, 2008.

The Opposer in this opposition proceeding is "ROCKEFELLER AND COMPANY, INC." with principal office address at No. 30 Rockefeller Plaza, New York, NY 10112, United States of America.

On the other hand, the Respondent-Applicant is "STEP ONE PROPERTY BUILDERS, INC." with address at 9th Floor, Vicente Madrigal Building, No. 6793 Ayala Avenue, Makati City.

The grounds of the opposition are as follows:

- "1. The registration of the mark "ONE ROCKEFELLER" in the name of the Respondent-Applicant will violate the rights and interests of Opposer over its internationally famous service marks, "ROCKEFELLER" and "ROCKEFELLER & CO." and will therefore cause great and irreparable damage and injury to herein Opposer who is entitled to relief, pursuant to Section 134 of the Intellectual Property Code, Republic Act No. 8293.
- "2. The proposed mark "ONE ROCKEFELLER" of Respondent-Applicant so resembles the Opposer's service marks as to be likely, especially when applied to or used in connection with the services of the Respondent-Applicant, to deceive or cause confusion.
- "3. The Opposer's internationally famous and well-known marks "ROCKEFELLER" and "ROCKEFELLER & CO." are entitled to protection under Article 6*bis* of the Paris Convention for the Protection of Industrial Property and Section 123.1 (e) of the Intellectual Property Code.
- "4. The Opposer's internationally famous trade name is "ROCKEFELLER & CO." is entitled to protection under Article 8 of the Paris Convention also protects the Rockefeller & Co., Inc. trade name.
- "5. Respondent-Applicant's proposed mark "ONE ROCKEFELLER" is confusingly similar, if not identical, to the above-mentioned marks

“ROCKEFELLER” and “ROCKEFELLER & CO.” of Opposer and is intended to ride on the popularity and goodwill of the latter’s mark and to deceive and/or confuse the purchasing public to believe that Respondent-Applicant’s business and services are the same or connected with the business or services offered by Opposer, its affiliates and subsidiaries.

“6. The approval of the application in question will cause great and irreparable damage and injury to herein Opposer.

Opposer relied on the following facts to supports its opposition:

“a. while the Opposer was organized in 1979 as an investment, wealth and portfolio management firm, it evolved from a family office established by John D. Rockefeller about 125 years ago, to manage the Rockefeller family’s assets. Starting in 1979, it expanded to provide financial services to individual, families and institutions in the United States and internationally.

“b. The Rockefeller family name has a widespread reputation in the industrial, financial and political arena. The Rockefeller family was regarded as holding one of the world’s largest private fortunes in the oil business during the late 19th and early 20th century, namely through their investments in the Standard Oil Company. The family is also known for their association with and financial interest in the Chase Manhattan Bank, Now JP Morgan Chase; and also been heavily involved in numerous real estate construction projects in the United States over the span of the twentieth century, such as:

- The Museum of Modern Art – (New York, 1929);
- The Rockefeller Center – (New York, 1930)
- The Cloisters – (New York, 1934);
- Lincoln Center – (New York, 1962);
- The World Trade Center Twin Towers – (New York, 1973);
- The Embarcadero Complex – (San Francisco, 1974);
- The Council of the Americas/Americas Society – (New York, 1985)

“c. The Opposer, its predecessors-in-interest and subsidiaries are and have always been the owner of the service marks “ROCKEFELLER” and “ROCKEFELLER & CO.” since it was first used on Opposer’s business operations and on various wealth and investment management services long before the date of first use of the mark “ONE ROCKEFELLER” by Respondent-Applicant.

“d. The Opposer has used its “ROCKEFELLER & CO.” mark and trade name in its business operations and services not only in the United States, its home country, but in a number of countries of the world, and the registration of the service mark “ONE ROCKEFELLER” will greatly damage and prejudice Opposer in the use of the “ROCKEFELLER” and “ROCKEFELLER & CO.” marks and trade name.

“e. The service mark “ONE ROCKEFELLER”, subject of the application of Respondent-Applicant is used for “*real estate management*” which is similar or closely related to the services on which the Opposer uses its “ROCKEFELLER” and “ROCKEFELLER & CO.” service marks, to the

extent that the public will be confused and may assume that the services of Respondent-Applicant are services of Opposer;

- “f. Opposer continues to use its “ROCKEFELLER” and “ROCKEFELLER & CO.” marks on services under International Classes 35 and 36.
- “g. By virtue of Opposer’s prior and continued use, if not prior registration and application for, of the “ROCKEFELLER” and “ROCKEFELLER & CO.” mark and trade name in its home country the United States and other part of the world, the “ROCKEFELLER” and “ROCKEFELLER & CO.” marks have become popular and internationally well-known and goodwill has been established goodwill with the public, which identifies the Opposer as the source of services bearing the “ROCKEFELLER” and “ROCKEFELLER & CO.” marks. The long used and promotion of the trademarks, the trade name and the reputation of the family name has generated an immense goodwill for said service marks in many other countries of the world, and has acquired general international consumer recognition as belonging to the one owner and source, i.e. the Opposer herein, and Opposer’s services have acquired the reputation of high quality services with the general public so that Opposer’s “ROCKEFELLER” and “ROCKEFELLER & CO.” marks have become strong and distinctive and are not, therefore, ordinary, common and weak service marks.
- “h. This strong and distinctive goodwill of the “ROCKEFELLER” and “ROCKEFELLER & CO.” marks and trade name will now be diluted, whittled away, and diminished, if not tarnished by the service mark “ONE ROCKEFELLER” of Respondent-Applicant.
- “i. Opposer’s “ROCKEFELLER & CO.” mark has been registered and applied for registration and used, as has ROCKEFELLER per se been used, in a number of countries of the world and, these are therefore well-known marks, such that they are entitled to protection under the Intellectual Property Code, Republic Act No. 8293 and Article 6bis of the Paris Convention for the Protection of Industrial Property.
- “j. The service mark “ONE ROCKEFELLER” subject of the application of Respondent-Applicant is so confusingly similar to Opposer’s “ROCKEFELLER” and “ROCKEFELLER & CO.” marks and trade name, and when applied to or used with the services of Respondent-Applicant will likely cause confusion or mistake or deceive the public in general as to the source or origin of Respondent-Applicant’s services to such an extent that the services covered by the service mark “ONE ROCKEFELLER” will be mistaken by the unwary public to be the services offered by Opposer or will cause the general public to believe that herein Respondent-Applicant is affiliated or connected with Opposer’s business.
- “k. The service mark “ONE ROCKEFELLER” subject of Respondent-Applicant’s application is a flagrant and veritable imitation of Opposer’s “ROCKEFELLER” and “ROCKEFELLER & CO.” marks and trade name so that its use on the services of Respondent-Applicant will indicate that Respondent-Applicant’s services are the same or connected with the services of herein Opposer falsely suggesting a connection between the Opposer’s and the Respondent-Applicant’s business, therefore, defrauding the Opposer of its long-established business.

- “l. The services covered by the service mark “ONE ROCKEFELLER” of Respondent-Applicant will be offered, marketed, promoted and rendered in the same financial sectors as those of Opposer’s “ROCKEFELLER” and “ROCKEFELLER & CO.” marks and trade name. This will likely lead to confuse the general public in view of the similarity of Respondent-Applicant’s service mark with Opposer’s “ROCKEFELLER” and “ROCKEFELLER & CO.” marks both in appearance and pronunciation, to the great prejudice of Opposer.
- “m. The service mark “ONE ROCKEFELLER” of Respondent-Applicant is so confusingly similar to Opposer’s “ROCKEFELLER” and “ROCKEFELLER & CO.” marks and trade name such that it may have adopted and used by Respondent-Applicant with the intention of riding on the long established goodwill of the “ROCKEFELLER” and “ROCKEFELLER & CO.” marks and trade name.

Opposer submitted the following in support of its opposition.

Exhibit	Description
“A”	True copies of pages from Rockefeller & Co., Inc., website.
“B”	True copies of articles depicting the role, services and view of Rockefeller & Co., Inc. and its key players in wealth management services doing business under the terms Rockefeller & Co.,
“C”	Certified copy of United States Registration No. 3,414,179
“D”	Representative true copies of advertisements and notes in publications showing the service marks “ROCKEFELLER” and “ROCKEFELLER & CO.”
“E”	Collection of websites and true copies of website print-outs.
“F”	Copy of the Spanish Decision.

On the other hand, the Respondent-Applicant failed to file its verified answer, despite having received on November 14, 2008, the Notice to Answer sent by the Bureau of Legal Affairs dated October 27, 2008.

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

Section 11. Effect of Failure to File Answer – In case 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 witness and documentary evidence submitted by the petitioner or opposer.

The lone issue to be resolved in the present opposition case is:

“WHETHER OR NOT THE RESPONDENT-APPLICANT IS ENTITLED TO THE REGISTRATION OF THE MARK “ONE ROCKEFELLER”.

The applicable provision of the law is Section 123.1 (e) of Republic Act No. 8293, which 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;

The contending trademarks are reproduced below for comparison and scrutiny.



Opposer's mark



Respondent-Applicant's mark

It is observed that upon visual comparison of the competing trademarks, both contained the word "ROCKEFELLER", which is likewise the dominant feature of both.

The dominance test sets sight on the similarity of the prevalent featured of the competing trademarks that might cause confusion and deception, thus constitutes infringement. Under this norm, the question at issue turns on whether the use of the marks involved would likely to cause confusion or mistake in the mind of the public or deceive purchasers.

Applying the dominance test in this particular case, the Bureau of Legal Affairs is convinced that there exist confusing similarity between the contending trademarks as their dominant feature is the word "ROCKEFELLER" which has exactly the same composition of letters, same *sound/pronunciation* as well as in meaning and practically in all aspects.

What remains to be resolved is:

WHO BETWEEN THE CONTENDING PARTIES HAS A BETTER
RIGHT OVER THE MARK IN QUESTION?

At the outset, the word "ROCKEFELLER" as appearing in the Internet, is the United States Industrialist who made a fortune in oil business and gave half of it away.

As stated in the opposition, while the Opposer was organized in 1979 as an investment, wealth and portfolio management firm, it evolved from a family office established by John D. Rockefeller about 125 years ago, to manage the Rockefeller family's assets. Starting in 1979, it expanded to provide financial services to individuals, families and institutions in the United States and internationally.

Records will show that Opposer's mark "ROCKEFELLER & CO." have been registered in the *United States Patent and Trademark Office* on April 22, 2008 bearing Registration No. 3,414,179 claimed first use on *December 21, 1979* (Exhibit "C"). The registration covers the services under classes 35 and 36 of the International Classification of goods.

Opposer's mark has been likewise registered and applied for its registration in other countries outside the United States, its home country.

Worthy to be noted is the statement of *Paula J. Mueller*, the Vice President, Secretary and General Counsel of Rockefeller & Co., Inc. As contained in her affidavit, although it was only incorporated in 1979, the Opposer has its roots in a New York family office established by *John D. Rockefeller* about 125 years ago to manage his family's assets.

It cannot therefore, be denied that "Rockefeller" has been in existence since one hundred twenty five (125) years ago and well-known throughout the world and that he is one of the wealthiest man in the world.

Further, Rockefeller is the trade name or corporate name of the Opposer which already existed since 1979. Under the Paris Convention, it is protected even without the obligation of registration.

Article 8 of the Paris Convention provides:

"A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark."

In "Philips Exports B.V. vs. Court of Appeals (2006 SCRA 457)" the Supreme Court ruled:

"A corporation's right to use its corporate and trade name is a property right, a right *in rem* which it may assert and protect against the whole world in the same manner as it may protect its tangible property, real or personal against trespass or conversion. A corporation has the exclusive right to the use of its name which may be protected by injunction upon a principle similar to that upon which persons are protected in the use of trademarks and trade names. It is a fraud on the corporation which has acquired a right to that name and perhaps carried on its business thereunder, that another should attempt to use the same, or the same name with a *slight variations*, in such a way to induce persons to deal with it in the belief that they are dealing with the corporation which has given reputation to the name."

It is therefore very clear that the Opposer is the prior user and adopter of the word "ROCKEFELLER" which is confusingly similar to Respondent-Applicant's mark "ONE ROCKEFELLER".

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 the owner and user of a previously registered label or trademark. This not only avoids confusion on the part of the public, but also protects an already *used* and *registered* trademark and an established goodwill. (Chuanshow Soy & Canning Co., vs. The Director of Patents and Rosario Villapanta [G.R. No. L-13947, June 30, 1960])

The Respondent-Applicant's mark is not overshadowed by the presence of the word "ONE" because what catches the eyes and mind of the public is the word "ROCKEFELLER". The likelihood of confusion on the part of the consuming public is bound to occur, as well as confusion of source affiliation or connection if Respondent-Applicant's mark is registered. Compounding confusion and deception is the fact that the contending trademarks or trade names both cover services falling under Classes 35 and 36 of the International Classification of goods and services.

WHEREFORE, in light of all the foregoing, the opposition is, as it is hereby SUSTAINED. Consequently, Application No. 4-2008-000678 filed on January 21, 2008 for the mark "ONE ROCKEFELLER" by "STEP ONE PROPERTY BUILDERS, INC." is, as it is hereby REJECTED.

Let the filewrapper of the trademark "ONE ROCKEFELLER" 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, 02 June 2009.

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