

SAN MIGUEL CORP.,	}	IPC NO. 4044
Opposer,	}	Opposition to:
	}	
	}	Serial No. : 76852
-versus-	}	Date Filed: 7-15-91
	}	
	}	Trademark: "GOLDEN
GUANGXI CEREALS OILS	}	EAGLE BRAND & DEVICE"
AND FOODSTUFFS IMPORT	}	
CORPORATION,	}	
Respondent-Applicant.	}	Decision No. 2002 – 21
X-----X		

DECISION

This is an opposition filed by San Miguel Corporation (hereinafter called "Opposer"), a corporation duly organized and existing under Philippine laws with principal office at No. 40 San Miguel Avenue, Mandaluyong City, Metro Manila, against the application for registration of the trademark "GOLDEN EAGLE BRAND AND DEVICE" filed by Guangxi Cereals Oils and Foodstuffs Import Export Corporation (hereinafter called "Respondent-applicant"), a corporation duly organized and existing under Chinese law with postal address at Qixing Road, Nanning, China.

The application for registration of the mark "GOLDEN EAGLE" was published for opposition in Vol. VII, No. 1 pp. 37 and 38, Jan-Feb 1994 issue of the BPTTT Official Gazette and officially released for circulation on 21 March 1994.

The grounds for opposition are as follows:

- "1. Applicant's Golden Eagle Brand mark is likely to cause confusion, mistake and would deceive the public into believing that the goods bearing the mark come from SMC.
- "2. Appropriation by applicant of the word "Golden Eagle" in the duly registered trademark of SMC amounts to infringement of SMC's trademark."

The facts of this case as narrated by Opposer are as follows:

- "2.1 On 15 July 1991, applicant filed an application for the registration of its alleged trademark "GOLDEN EAGLE BRAND & DEVICE" (hereinafter "GOLDEN EAGLE BRAND") with this Honorable Office under Class 30, for dried beans curd sticks, dried bean curd sheet; soy bean milk; soybean cheese and preserved black bean; rice products including rice vermicelli. The application was assigned Serial No. 76852. Purportedly, the application was registered in China under Chinese Reg. Nos. 520809 & 288599 issued on 10 June 1990 and 30 May 1987.
- "2.2 The mark applied for was published for opposition in Volume VII, No. 1, pages 37 and 38 of the Bureau of Patents, Trademarks and Technology Transfer Official

Gazette, January-February 1994 issue, officially released for circulation on 21 March 1994;

- “2.3 Prior to the lapse of the thirty (30) day period to file a Notice of Opposition to the application, SMC requested and was granted extensions of time to file said Notice of Opposition;
- “2.4 SMC is the registered owner of the trademarks “GOLDEN EAGLE & DEVICE” (hereinafter “GOLDEN EAGLE”) in the Philippines, the same having been duly registered in the Principal Register, with Registration No. 34039 issued by the then Philippine Patent Office on 13 February 1985. A copy of the Certificate of Registration is attached hereto as Annex “A”. SMC further submits, together with their Notice of Opposition label of SMC’s products on which its duly registered GOLDEN EAGLE trademark is attached;
- “2.5 SMC’s Gold Eagle trademark remains valid and subsisting to date, its rights therein being guaranteed for a period of twenty (20) years from and after the date of its registration or up to 13 February 2005. The required affidavit of Use was filed on the fifth anniversary of its registration by SMC, or on 20 September 1990. A copy of such affidavit is attached hereto as Annex “B”;
- “2.6 The same Gold Eagle trademark is registered and well-known in different countries like Australia, Papua New Guinea, etc. Attached hereto and made an integral part hereof and Annex “C” is a list registration of the Gold Eagle trademark in other countries.”

Consequently, Respondent-Applicant Guangxi Cereals Oils and Foodstuffs Import Export Corp, through Counsel, filed its Answer on 30 August 1994 specifically denying the material allegations in the Notice of Opposition and claiming the following as its affirmative defenses.

- “3. Respondent-Applicant is the owner of the trademark “GOLDEN EAGLE BRAND & DEVICE” I, having registered the trademark in China. It was issued Certificate of Registration Nos. 288599 dated May 30, 1987 and 520809 dated 10 June 1990;
- “4. It is noteworthy to stress that Opposer has never used the “GOLDEN EAGLE BRAND & DEVICE” FOR GOODS UNDER international Class 30, specifically, for dried beans and curd sticks, dried bean curd sheet, soybean milk, soybean cheese and preserved black bean; rice products including rice vermicelli. Accordingly, Opposer cannot acquire exclusive right to such mark to cover other goods and products. In any event, visual comparison readily admits contrasting distinctions of the trademarks of Opposer and the herein Respondent-Applicant;
- “5. The application being opposed had undergone detailed merit examination by the Bureau of Patents, Trademarks and Technology Transfer (BPTTT) Examining Division and not once had the examiner cited any of the Opposer’s

registrations as a bar to Respondent-Applicant's trademark application.

"6. Opposer's claim that the trademark "GOLDEN EAGLE BRAND & DEVICE" is confusingly similar to its alleged registered and existing marks is erroneous;

"6.1 Annex "A" shows that the mark "GOLDEN EAGLE * DEVICE" over the words "Expertly Brewed and Bottled by San Miguel Brewery, Philippines Beer, Reg. Phil. Pat. Office Pend.", while Respondent's Mark illustrates the "GOLDEN EAGLE & DEVICE" with Chinese characters. Surely Opposer's claim of confusion of origin is not tenable;

"6.2 Moreover, Annex "A" is under class 32, covering beer, alger, ale, pilsen, pilsener pils, stout, block and other malt beverages. Respondent's goods as previously stated fall under class 30."

The issues having been joined, the case was set for pre-trial conference on 13 October 1994. However, Counsel for Respondent-Applicant moved that the pre-trial conference be reset to 10 November 1994 because he allegedly has yet to receive the authenticated special power of attorney from his client. Hence, the Bureau through its Order No. 94-756 dated 24 October 1994 granted the Motion.

On 10 November 1994, the scheduled date of pre-trial conference, Respondent-Applicant filed a Motion for Postponement urging the Office to reset anew the pre-trial conference to 9 December 1994. After which, another Motion for Postponement was filed by Respondent-Applicant, resetting the pre-trial conference to 18 January 1995 which the Bureau granted in Order No. 94-880, dated 19 December 1994.

A series of postponements ensued due to lack of notice or the absence of Counsel for Respondent-Applicant. Until on 26 August 1997, Counsel for Opposer moved in open court to declare Respondent-Applicant as in default for failure to attend the scheduled pre-trial conference for several times despite notice.

Correspondingly, the Bureau issued Order No. 98-288, dated 21 August 1998 declaring Respondent-Applicant as in default for failure to attend the pre-trial conference for several times. The case was set for the ex-parte presentation of evidence on 16 September 1998.

On 03 December 1999, Opposer, through Counsel, filed its formal Offer of Evidence ranging from Exhs. "A" to "N", including sub-markings which the Bureau admitted in Order No. 98-513 dated 15 December 1998.

The sole issue to be resolved in the herein case is whether or not Opposer's mark "GOLD EAGLE & DEVICE" is confusingly similar to Respondent-Applicant's "GOLDEN EAGLE BRAND & DEVICE" as applied to their respective products.

Opposer contended that the law allegedly to have been violated are Sections 2-A, 4(d) and 22 of Republic Act No. 166, as amended, the law in force and in effect at the time this Opposition proceeding was filed. Quoted hereunder are the provisions of said law, to viz:

Sec. 2-A. Ownership of trademarks, trade names and service marks, how acquired. – Anyone who lawfully produces or deals in merchandise of any kind or

who engages in any lawful business or who render any lawful service in commerce, by actual use thereof in manufacture or trade, in business and in service rendered, may appropriate to his exclusive use a trade-mark, a trade-name, or a service-mark not so appropriated by another, to distinguish his merchandise, business or service from the merchandise, business or services of others. The ownership or possession of a trademark, trade-name or service-mark, heretofore or hereafter appropriated, as this section provided shall be recognized and protected in the same manner and to the same extent as are other property rights known to the law." (now Sec. 122, R.A. No. 8293)

"Sec.4. Registration of trade-marks, trade-name and service-marks on the principal register. – There is hereby established a register of trade-marks, trade-name and service-marks which shall be known as the principal register. The owner of a trade-mark, trade-name and service-mark used to distinguish his goods, business or services of others shall have the right to register the same on the principal register, unless it:

"(d) Consists of or comprises a mark or trade-name which so resembles 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 services of the applicant, to cause confusion or mistake or to deceive purchasers, or (now Sec. 123, R.A. No. 8293)

"Sec.22. Infringement, what constitutes. – Any person who shall use without the consent of the registrant any registration, counterfeit, copy or colorable imitation of any registered mark or trade-name in connection with the sale, offering for sale, or advertising of any goods, business or services on or in connection with which such use is likely to cause confusion or mistake or to deceive purchasers or others as to the source of such goods or services, identity of such business, or reproduce, counterfeit, copy or colorably imitate any such mark or trade-name and apply such reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used upon or in connection with such goods, business or services shall be liable to a civil action by the registrant for any or all of the remedies herein provided (now Sec. 155, R.A. No. 8293)."

We find Opposer's contention to be devoid of merit.

The case of Bristol Myers Co. vs. The Director of Patents is noteworthy, to wit: "(I)n determining whether two trademarks are confusingly similar, the test is not simply to take their words and compare the spelling and pronunciation of said words. Rather, it is to consider the two marks in their entirety, as they appear in their respective labels, in relation to the goods to which they are attached.

As in the instant case, while the appearance of the words "GOLD EAGLE" and "GOLDEN EAGLE", with the exception of the last two letters in the word "GOLDEN", are apparently similar in spelling and sounds, these cannot be made as hallmark in determining confusing similarity because the overall impression – e.g. the dominant or essential features of the mark as they appear in their respective labels and the goods to which these marks are applied will ultimately be the yardstick in testing whether or not the purchasing public is misled, or deceived into believing that the two marks are one and the same, or originate from the same source, or an affiliate or under the sponsorship of another.

Going over the records of the case, more particularly the trademark application of herein Respondent-Applicant where the mark "GOLDEN EAGLE" brand is contained, the Bureau sees no concrete evidence whatsoever to conclude that the purchasing public may be deceived into

believing that Respondent-Applicant's mark "GOLDEN EAGLE BRAND & DEVICE" is confusingly similar to the mark GOLD EAGLE & DEVICE of Opposer, much less proceed from the same source or origin, or has some connection thereto.

As appearing in the specimen drawing on file with this Office, Respondent-Applicant's eagle device is depicted in its flying state (active) in contrast to the eagle device in Opposer's mark which is in its stationary state (passive). Likewise, the presence of the Chinese character which is the dominant feature in Respondent-Applicant's mark is a clear indication that it is alien from Opposer San Miguel Corp which is of Spanish origin. Hence, Opposer's inference that the application for registration of the mark "GOLDEN EAGLE" is violative of RA 166, as amended, more particularly Secs. 2A, 4(d), and 22 thereof, is without basis in fact and in law.

Moreover, as to the goods to which both marks are being used, it is observed that these goods are unrelated and non-competing. As shown by Opposer's evidence (Exh. "B-1"), the mark "GOLDEN EAGLE & DEVICE" is used on beer, lager, ale, pilsen, pilsener, pils, stout, bock and other malt beverage which fall under Class 32, whereas the mark "GOLDEN EAGLE BRAND & DEVICE" of Respondent-Applicant as appearing in its trademark application, is being used on dried beans, curd sticks, dried bead, curd sheet, soybean milk, soybean cheese and preserved black beans, rice products including rice vermicelli which fall under Class 30. Therefore, the possibility of confusion arising from the similarity or relationship of the goods to which both marks are used is not likely.

In the case of Esso Standard vs. Court of Appeals, 116 SCRA 336, the Supreme Court has expounded on what "relationship of the goods" is all about, thus:

"Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, textures or quality. They may also be related because they serve the same purpose or are sold in grocery stores. Thus, biscuits were held related to milk because they are both food products. Soap and perfume, lipstick and nail polish are similarly related because they are common household item nowadays."

Some jurisprudence dealing with non-competing and unrelated goods where the High Court consistently ruled by the High Court as not violative of the trademark laws for not having cause deception or confusion on the purchasing public as to the source of origin. Some of them are as follows:

1. In the case of Acoje Mining Co. Inc. v. Director of Patents (G.R. No. 28744, April 23, 1971, 38 SCRA 480) the Supreme Court held that the trademark "LOTUS" for edible oil was held not confusingly similar to LOTUS for soy sauce because there is quite a difference between soy sauce and edible oil. If one is in the market of the former, he is not likely to purchase the latter just because of the trademark "LOTUS".
2. In Philippine Refining Co., Inc. v. Ng Sam, G.R. No. 2206, July 30, 1982, 155 SCRA 472, the high court ruled that the trademark "CAMIA" for lard, cooking oil, abrasive detergents, polishing materials and soap were not confusingly similar to CAMIA used on ham because the products are unrelated and while ham and some of the products of the Junior user fall under the same classification as prescribed by the Philippine Patent Office, the fact alone may not be decisive factor in the resolution as to whether or not the goods are related, the emphasis being on the similarity of the products and not on the arbitrary classification or general description of their properties or characteristics;

3. In the case of Shell Co. of the Philippines Ltd. v. Court of Appeals, G.R. No. June 23, 1979, the Court affirmed the Patent Office's registration of the trademark "SHELL" as used in cigarettes manufactured by Fortune Tobacco Corp., notwithstanding Shell Company's opposition thereto as the prior registrant of the same trademark for its "GASOLINE" and other petroleum trademarks.

And in the latest case of Canon Kabushiki v. Court of Appeals G.R. No. 120900, July 20, 2000, the Supreme Court reiterated the doctrine; laid down in Esso Standard Eastern, Inc. v. Court of Appeals, supra it said thus:

"In case of confusion of business or origin, the question that usually arises is whether the respective goods or services of the senior user and the junior user are so related as to likely cause confusion of business or origin and thereby render the trademark or trade name confusingly similar. Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores." (Underscoring supplied)

Opposer evoked the fear that registration of trademark "GOLDEN EAGLE", will lead into the possibility that it may conflict with the food business of Opposer of which it is currently engaged in, aside from its man business enterprises, and also, the likelihood of Opposer's mark "GOLD EAGLE" branching out in Respondent-Applicant's domain will not be a remote possibility.

This is untenable. A perusal of the trademark registration of herein Opposer for the mark "GOLD EAGLE" in Asia, namely Philippines (Exh. "B"); Indonesia (Exh. "C" and "D"); Brunei Darussalam (Exh. "E"); Taiwan (Exh. "F"); Australia (Exh. "H"); Thailand (Exh. I"); Vietnam (Exh. "J"); Japan (Exh. "K"); Cambodia (Exh. "L"); South Korea (Exh. "M" and "N"); inclusive of submarkings, would disclose that not a single trademark registration in these countries indicates that Opposer's mark was used or being used on the same line of goods for which Respondent-Applicant's mark is being applied for registration. Neither were there evidentiary facts submitted to support Opposer's claim that Respondent-Applicant's mark will cause confusing similarity with any other trademarks under its corporate name.

Moreover, well-settled is the rule that certificate of trademark registration confers upon the registrant exclusive right to use the same in connection with the goods, services specified in the certificate, subject to any conditions and limitations stated therein (Sec. 20, R.A. 166, as amended). With this, it cannot be asseverated that Opposer has the right to obviate Respondent-Applicant to pursue registration of the mark "GOLDEN EAGLE" for the superficial reasoning that there is a possibility that it (Opposer) will expand its "GOLD EAGLE" mark to cover Respondent-Applicant's goods, absent any evidence in the Philippines and in any other countries on goods similar or related to Respondent-Applicant.

And as held by the High Court in the case of Faberge, Inc. v. IAC, 215 SCRA 326 (1992), and further reiterated in Canon Kabushiki Kaisha v. Court of Appeals, supra, the trademark registration is limited only to the goods covered in the certificates of registration and the senior user cannot and should not be allowed to feign that (junior user) has invaded (the senior user's) exclusive domain.

In the same vein, this Office believes that Opposer's business reputation will not be adversely affected as a result of Respondent-Applicant's use of the mark "GOLDEN EAGLE" for goods under class 30 because there is a certain degree of demarcation between the subject marks as attested to by their visual features herein-above presented.

Besides, the products bearing the parties' trademarks are catered to different market segments or customers such that the "GOLD EAGLE" mark of Opposer is generally patronized

by adult male drinkers, whereas the "GOLDEN EAGLE" mark of Respondent-Applicant is for general consumption. Evidently, in kind and nature, the products of either party are poles apart. (Esso Standard East Inc. v. Court of Appeals, *supra*)

With all the foregoing, and despite the declaration of Respondent-Applicant as in default, this Office firmly believes that confusion between Opposer's GOLD EAGLE & DEVICE used on beer, lager, pale, pilsen pilsener, pills, stout, bock and other malt beverages which fall under Class 32, and Respondent-Applicant's "GOLDEN BRAND & DEVICE" used on dried beans, curd sticks, dried beans, curd sheet, soybean milk, soybean cheese and preserved black beans, rice products including rice vermicelli which fall under Class 30, is not likely to cause confusion, mistake nor deception on the buying public as they are neither related nor competitive as to origin, reputation and on the goods covered. Accordingly, Respondent-Applicant's Appln. Serial No. 76852 filed on July 15, 1991 for the registration of the mark GOLDEN EAGLE BRAND & DEVICE used on the above enumerated goods is, as it is hereby, GIVEN DUE COURSE.

Let the filewrapper of "GOLDEN EAGLE BRAND & DEVICE" subject matter of the instant case be forwarded to the Administrative, Financial Human Resource Development Service Bureau (AFHRDSB) for appropriate action in accordance with this decision with a copy thereof to be furnished the Bureau of Trademarks (BOT) for information and update of its records.

SO ORDERED.

Makati City, 17 September 2002.

ESTRELLITA BELTRAN-ABELARDO
Director Bureau of Legal Affairs
Intellectually Property Office