

SWIRE AGRICULTURAL PRODUCTS, INC.,
Opposer,
- versus -

IPC 14-2006-00134

Opposition to:
TM Application No. 4-2000-005305
(Filing Date: 27 June 2000)

H-LAS MARKETING CORPORATION,
Respondent-Applicant.

TM: "SUNRISE"

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Decision No. 2007 – 123

DECISION

For decision is the Notice of Opposition filed by Swire Agricultural Products, Inc., a corporation duly organized and existing under the laws of the Philippines, with address at Rm. 225, 2/F EPCI Bank Bldg., Phase II, Ortigas Ave., Greenhills, San Juan, M.M. 1502 against the Application Serial No. 4-2000-005305 for the mark SUNRISE filed on June 27, 2000 for goods under class 31, namely: "fresh mango and fresh okra" by Hi-las Marketing Corporation, with address at KKK Processing Plant Building, CRB Road, FTI Complex, 1604, Taguig, Metro Manila.

The grounds for the opposition are the following:

- I. The mark SUNRISE cannot be registered because it is confusingly similar to the registered mark SUNRISE PLANTERS AND DESIGN owned by Opposer which is being used for similar or closely related goods.
- II. The registration of the mark SUNRISE will likely mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services.
- III. The mark SUNRISE was not actually used in the Philippines commerce by the Respondent-Applicant.

Opposer submitted the following evidence in support of its opposition:

Exhibit "A"	Special Power of Attorney
Exhibit "B"	Verification and Certification Against Non-Forum Shopping
Exhibit "C"	Print out of SUNRISE application status
Exhibit "D"	Photocopy of Certificate of Registration No. 60809 issued on June 20, 1995 of mark SUNRISE PLANTERS for use on "fertilizers"
Exhibit "E"	Affidavit of Jonathan Gochioco
Exhibit "F"	Photocopy of Declaration of Actual use
Exhibit "G"	Photocopy of letter oh Hi-las Marketing Corporation
Exhibit "H"	Print out from SEC website
Exhibit "I"	Print out from SEC website
Exhibit "J"	Printout from SEC website
Exhibit "K"	Photocopy of Declaration of Actual use

Exhibit "L"	Photocopy of response letter dated 13 December 1993
Exhibit "M"	Photo of Sunrise Planters on package/label of Urea 46 Fertilizer
Exhibit "N"	Certified true copy of articles of incorporation of Swire Agricultural Products, Inc.

In its Answer, Respondent-Applicant refuted the grounds relied upon by the opposer. It argued:

1. Respondent-Applicant seeks to register the mark SUNRISE as shown by Exhibit "C" of the Opposition. The mark is simply the word "Sunrise", it bears no design, no graphics, no other words appended to it. On the other hand, Oppositor's mark, SUNRISE PLANTERS with half sun, Exhibit "D", is markedly different which cannot, by any stretch of imagination and vision, be confusingly similar.
2. In a case, the Supreme Court had ruled that: "In determining that 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 the consider the two marks in their entirety as they appear in their respective labels, IN RELATION TO THE GOODS TO WHICH THEY ARE ATTACHED. (Bristol-Meyers Company vs. The Director of Patents and the United American Pharmaceuticals, Inc. G.R. No. L- 21587, May 19, 1966) xxx
3. The test of dominancy depends on the consumer's recollection of the appearance of the product which he intends to purchase (Co Tiong versus Director of Patents, 95 Phil. 1) xxx
4. Contrary to the Oppositor's claim that the mark SUNRISE was abandoned, Respondent-applicant was directed to pay the publication fee as the trademark it applied for was approved for publication as shown by a copy of the letter of the Director – Administrative, Financial and Human Resource Development Services Bureau, hereto attached as Exhibit "1" and the corresponding receipt number 085293 dated April 19, 2006, issued by the IPO for the payment of the said fee, hereto attached as Exhibit "2".xxx
5. Contrary to oppositor's claim that the Declaration of Actual Use does not comply with Section 124.2 of the IP Code, the said provision requires that the applicant or the registrant should have filed a declaration of actual use. By oppositor's own Exhibit "G", Respondent-Applicant filed its declaration of actual use on August 6, 2002, well within the three-year period from its application for the mark on June 27, 2000.xxx
6. Assuming only for the sake of argument, that the Oppositor has prior use of the mark, apart from mere allegation that Oppositor had sold fertilizers all over Luzon using the mark Sunrise Planters it has not attached any receipt as proof thereof. xxx

In support of its allegations, respondent-applicant submitted the following evidence:

Exhibit "1"	Notice of allowance and payment of publication fee
Exhibit "2"	Copy of Official Receipt no. 085293
Exhibit "3"	Photocopy of Phytosanitary Certificate issued by the Bureau of Plant Industry
Exhibit "4"	Photocopy of Phytosanitary Certificate issued by the Bureau of Plant Industry

Exhibit "5" Photocopy of Phytosanitary Certificate

Exhibit "6" Photocopy of Phytosanitary Certificate

The preliminary conference was terminated on April 19, 2007 wherein no amicable settlement was reached by the parties. The main issue is whether the mark SUNRISE is confusingly similar with the SUNRISE. Corollary is the issue of whether the applicant has complied with the requirement of filing a declaration of actual use to entitle it to registration.

The marks of the contending parties are reproduced hereunder for reference.

A comparison of the marks show that respondent's application is for the word mark SUNRISE. Opposer's registered mark SUNRISE PLANTERS & DESIGN (exhibit "D") consist not only of the word SUNRISE but includes the word PLANTERS which is written in the same size and font as the word SUNRISE. There appears to be a design of half sun rising beyond the word SUNRISE. The contending marks distinct visual appearance eliminates any likelihood of confusion. The Supreme Court has laid down two tests in determining confusing similarity, these are the holistic test and the dominance test.

In *Mighty Corporation and La Campana Fabrica de Tabaco, Inc. vs. E. & J. Gallo Winery and the Andresons Group, Inc.*, G.R. No. 154342. July 14, 2004, the Supreme Court elaborates:

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

- (a) The Dominance Test applied in *Asia Brewery, Inc. vs. Court of Appeals 76* and others cases, and
- (b) The Holistic or Totality Test used in *Del Monte Corporation vs. Court of Appeals* and its preceding cases.

The dominance 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 purchaser.

On the other hand, the Holistic Test requires that the entirety of the marks in question be considered in resolving confusing similarity. Comparison of words is not the only determining factor. The trademarks in their entirety as they appear in their respective labels or hang tags must also be considered in relation to the goods to which they are attached. The discerning eye of the observer must focus not only on the predominant words but also on the other features appearing in both labels in order that he may draw his conclusion whether one is confusingly similar to the other in comparing the resemblance or colorable imitation of marks, various factors have been considered, such as the dominant color, style, size, form, meaning of letters, words, designs and emblems used, the likelihood of deception of the mark or name's tendency to confuse and the commercial impression likely to be conveyed by the trademarks if used in conjunction with the respective goods of the parties."

Applying the tests in comparing both marks, there is no identity or similarity in the visual presentation of the marks. The dominant feature of the opposer's mark is the word. No similarity with respect to coloring scheme or layout of labels can be perceived. Neither is there any evidence of copying of the style in the lettering of the word SUNRISE with the backdrop of a half

rising sun and a big yellow mango fruit in right under the word SUNRISE. The word SUNRISE is written between the depiction of the sun and the mango and written in a slanting way which matches the contour of a side of the mango and a portion of the half sun. The variance in the pictorial impressions of the marks would prevent any likelihood of confusion among the buying public.

More importantly, assuming *arguendo* that there is identity in the physical appearance of the marks, still no confusion will result on account of the fact that the goods described by the marks are non-competing and unrelated. The opposer uses the mark SUNRISE PLANTERS on fertilizers under Class 1 while the respondent-applicant uses the mark SUNRISE for goods under Class 31, specifically "fresh mango and fresh okra". The goods which the marks identify are totally different from each other.

The Supreme Court in the case of *Esso Standard Eastern, Inc., vs. the Honorable Court of Appeals and United Cigarette Corporation*, G.R. No. L- 29971. August 31, 1982 Explained what are related goods, it held:

"It is undisputed that the goods on which petitioner uses the trademark ESSO, petroleum products, and the product of respondent, cigarettes, are non-competing. But as to whether trademark infringement exists depends for the most part upon whether or not the goods are so related that the public may be, or is actually, deceived and misled that they came from the same maker or manufacturer. For non-competing goods may be those which, though they are not in actual competition, are so related to each other that it might reasonably be assumed that they originate from one manufacturer. xxx The vast majority of courts today follow the modern theory or concept of "related goods" which the Courts has likewise adopted and uniformly recognized and applied.

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. Thus, biscuits were held related to milk because they are both food products. Soap and perfume, lipstick and polish are similarly related because they are common household items nowadays. The trademark "Ang Tibay" for shoes and slippers was disallowed to be used for shirts and pants because they belong to the same general class of goods. Soap and pomade, although non-competitive, were held to be similar or to belong to the same class, since both are toilet articles. But no confusion or deception can possibly result or arise when the name "Wellington" which is the trademark for shirts, pants, drawers and other articles of wear for men, women and children is used as a name of a department store"

The Court in *Philippine Refining Co., Inc. vs. Ng Lam* (115 SCRA 472 [1982]) allowed the registration of the mark "CAMIA" for ham notwithstanding the petitioner's earlier registration of an identical mark for goods edible oil which were also under the same Nice classification of Class 47 (Foods and Ingredients of Food). Thus, one who has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others for products which are of a different description. In the instant case, the adoption by the respondent-applicant of the word SUNRISE to be used on "fresh mango and fresh okra" which forms merely of opposer's registered composite mark used by opposer on "fertilizers" cannot be objected to.

This Bureau is not inclined to accept opposer's argument that the registration of the mark SUNRISE will mislead the public as the origin of the goods. For one, we note that the SUNRISE PLANTERS trademark registration certificates in the Philippines covers fertilizers only, without any evidence or indication that registrant expanded or intended to expand its business to food.

Again in *Mighty Corporation and La Campana Fabrica de Tabaco, Inc. vs. E. & J. Gallo Winery and the Andresons Group, Inc.*, G.R. No. 154342, July 14, 2004, the High Court held:

“Likelihood of confusion is admittedly a relative term, to be determined rigidly according to the particular (and sometimes peculiar) circumstances of each case. Thus, in trademark cases, more than in other kinds of litigation, precedents must be studied in the light of each particular case. xxx

In determining the likelihood of confusion, the Court must consider; [a] the resemblance between the trademarks; [b] the similarity of the goods to which the trademarks are attached; [c] the likely effect on the purchaser and [d] the registrant’s express or implied consent and other fair and equitable considerations. xxx

Petitioners and respondents both “GALO” in the labels of their respective cigarette and wine products, But, as held in the following cases, the use of an identical mark does not, by itself, lead to a legal; conclusion that there is a trademark infringement:

(a) in *Acoje Mining Co., Inc. vs. Director of Patent*, we ordered the approval of Acoje Mining’s application for registration of he trademark LOTUS for its soy sauce even though Philippine Refining Company had prior registration and use of such identical mark for its edible oil which, like soy sauce, also belonged to Class 47;

(b) in *Philippine Refining Co., Inc. vs. Ng Sam and Director of Patents*, we upheld the Patent Director’s registration of the same mark CAMIA for Ng Sam’s ham under Class 47, despite Philippine Refining Company’s prior trademark registration and actual use of such mark on its lard, butter, cooking oil (all of which belonged to Class 47), abrasive detergents, polishing materials and soaps;

(c) in *Hickok Manufacturing Co., Inc. vs. Court of Appeals and Santos Lim Bun Liong*, we dismissed Hickok’s petition to cancel private respondent’s HICKOK trademark registration for its Marikina shoes as against petitioner’s earlier registration of the same trademark for handkerchiefs, briefs, belts and wallet;

(d) in *Shell Company of the Philippines vs. Court of Appeals*, in a minute resolution, we dismissed the petition for review for lack of merit and affirmed the Patent Office’s registration of the trademark SHELL used in the cigarettes manufactured by respondent Fortune Tobacco Corporation, notwithstanding Shell Company’s opposition as the prior registrant of the same trademark for its gasoline and other petroleum products;

(e) in *ESSO Standard Eastern, Inc. vs. Court of Appeals*, we dismissed ESSO’s complaint for trademark infringement against United Cigarette Corporation and allowed the latter to use the trademark ESSO for its cigarettes, the same trademark used by ESSO for its petroleum products, and

(f) in *Canon Kabushiki Kaisha vs. Court of Appeals and NSR Rubber Corporation*, we affirmed the rulings of the Patent Office and the CA that NSR Rubber Corporation could use the trademark CANON for its sandals (Class 25) despite Canon Kabushiki Kaisha’s prior registration and use of the same trademark for its paints, chemical products, toner and dyestuff (Class 2)

Finally, opposer points out that respondent-applicant failed to file a Declaration of Actual Use (DAU) within three years from the date of the filing of the application as required under Section 124.2. It further asserts that the DAU was filed only on June 24, 2004. Opposer points out that the use by respondent-applicant is not in the domestic market.

We cannot give credence to the suppositions of the opposer. This Bureau notes that the file wrapper of the instant case contains a DAU which appears to be notarized on April 4 with an IPO stamp received which signified payment and is dated April 8, 2003. A notation on the upper right portion of said DAU indicates #6 and a label of SUNRISE is stapled thereon. Aside from this, another DAU was filed on June 24, 2004. In this later DAU, applicant Roberto C. Amores,

president of respondent-applicant Hi-las Marketing Corporation indicated that the goods are found in the following outlets: IPM Nishimo Co. Ltd., Tokyo, Japan and Sunrdo Co., Ltd. Seoul, Korea. In fact, opposer affirms that respondent-applicant in response to Official paper #2, replied through a letter signifying that:

“Furthermore, the “SUNRISE” trademark we currently use is exclusively used for the export market to Japan, South Korea and United States of America. xxx

Indeed, trademark is a creation of use. What the law contemplates is commercial use. That the applicant engages in business by exporting products bearing the mark from the Philippines to other parts of the world through export sales is a legitimate commercial transaction which to our mind satisfies the connotation of commercial use of a trademark which benefits the trademark owner. There is nothing objectionable in applying for a mark to identify Philippine goods originating from the Philippines to be sold for export sales to other countries or territories outside the Philippines.

WHEREFORE, premises considered the OPPOSITION filed by SWIRE AGRICULTURAL PRODUCTS, INC. is, as it is hereby, DENIED. Accordingly, Application Serial No. 4-2000-005305 filed by Respondent-Applicant, Hi-Las Marketing Corporation, Inc. on 27 June 2000 for the mark “SUNRISE” used on “fresh mango” and “fresh okra” under class 31, is as it is hereby, GIVEN DUE COURSE.

Let the filewrapper of “SUNRISE”, 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, 31 August 2007

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