

WARNER BROS	}	IPC No. 14-2004-00136
ENTERTAINMENT, INC.,	}	Opposition to:
<i>Opposer</i>	}	
	}	Appln. Serial No.: 4-2001-07435
-versus-	}	Date Filed : 03 October 2001
	}	
ABS-CBN BROADCASTING CORP.	}	Trademark: "MARY D' POTTER"
<i>Respondent-Applicant.</i>	}	
x-----x	}	Decision No. 2006-16

DECISION

This pertains to the Opposition for the registration of the trademark "MARY D' POTTER" filed on October 3, 2001 for "television broadcasting" under Class 41 of the International Classification of Goods bearing Serial No. 4-2001-07435 which application was published for opposition in the Intellectual Property Office (IPO) Official Gazette, Vol. VI No. 18 and released on May 31, 2004.

The herein Opposer is Warner Bros. Entertainment, Inc., a corporation duly organized and existing under the laws of the United States of America, with address at 4000 Warner Boulevard, Burbank, California 91522-1565, U.S.A.

On the other hand, the Respondent-Applicant in the instant opposition case is ABS-CBN Broadcasting Center, Sgt. Esguerra corner Mother Ignacia Avenue, Diliman, Quezon City.

The grounds for the opposition are as follows:

- "1. The trademark "MARY D' POTTER" is identical and/or confusingly similar with Opposer's trademark "HARRY POTTER", a well-known mark owned by Warner Bros., Entertainment, Inc. The "HARRY POTTER" mark was previously used in commerce in the Philippines, as to be likely, when applied to or used connection with the goods/services of the Respondent, to deceive or cause confusion upon consumers or the buying public.
- "2. In addition, the Respondent's mark is identical or nearly resembles the Opposer's "HARRY POTTER" mark, as to be likely deceive or cause confusion, which mark has an earlier filing date as indicated in Application No. 4-2000-000199 for the "HARRY POTTER" mark, filed last January 12, 2000 in Class 41 for, among other services, "Entertainment services in nature of live-action, comedy, drama and/or animated television programs". Verily, the application as proscribed by Section 123, subparagraph (d) of the Intellectual Property Code ("IP Code").
- "3. The registration of the trademark "MARY D' POTTER" in the name of Respondent-Applicant will violate Section 123, subparagraph (e) and Section 131.3 of the Intellectual Property Code ("IP Code"), Republic Act No. 8293, considering that the Respondent's mark is identical with or confusingly similar to the Opposer's mark which is well-known internationally and in the Philippines as being already the mark of the Opposer and which mark has been used for identical services as those for which the Respondent applied its mark.
- "4. The registration by Respondent of the trademark "MARY D' POTTER" will damage the goodwill of Opposer's mark "HARRY POTTER", an

internationally well-known mark which the Opposer has been using in commerce in the Philippines before the Respondent's use of its "MARY D' POTTER" mark.

- "5. The registration of the trademark "MARY D' POTTER" in the name of they Respondent is contrary to other provisions of the Intellectual Property Code, treaty obligations of the Philippines and well settled jurisprudence on the matter.

To support this opposition, Opposer will rely on the following facts:

- "[i] Opposer is the commercial user, applicant and/or registrant in the Philippines as well as in several trademark regulating agencies around the world, for trademark "HARRY PPOTTER" in classes of goods and services, similar or related to the class under which the Respondent applied the "MARY D' POTTER" mark. Opposer is the registered owner of the well-known mark "HARRY POTTER" and has used the said trademark for a wide variety of products.
- "[ii] Opposer is the first, substantial, exclusive and continuous user in the Philippines of the trademark "HARRY POTTER" and the said mark was used by Opposer in commerce long before the Respondent did.
- "[iii] On account of Opposer's worldwide use in commerce of the trademark "HARRY POTTER", consumers who see a mark like "MARY D' POTTER" on Respondent's goods are likely to be mislead into believing that Respondent's products originate from, are licensed by or are under the sponsorship of the Opposer. Said use, by which a connection between Respondent's goods and those of the Opposer is suggested, causes damage to the interest of the Opposer as the prior user and owner of the mark "HARRY POTTER".
- "[iv] Opposer's use of the trademark "HARRY POTTER" has established valuable international goodwill for the Opposer among consumers who have identified the Opposer as the source of quality products.
- "[v] The contending marks are nearly identical and the applicant obviously intends to ride on the international goodwill and reputation of the Opposer in adopting its "MARY D' POTTER" mark. Applying the principle of *idem sonans*, there is an uncanny similitude between the two marks. Respondent employed a character with a first name that is similar in sound to the first name of the Opposer's character mark [Opposer's Harry vis-à-vis Respondent's Mary] and both character marks end with the identical word "Potter".

On October 13, 2004, a Notice to Answer was sent to Respondent-Applicant by registered mail with return card bearing No. W-04-369 requiring it to file its Answer to the Notice of Opposition within fifteen (15) days from receipt thereof, but despite receipt of the notice, Respondent-Applicant did not file its Answer or any responsive pleading thereto.

For failure of the Respondent-Applicant to file an Answer within the reglementary period and pursuant to Section 11(d), Rule 2 of the Rules and regulations on Inter Partes Proceedings, this Office declared Respondent-Applicant in DEFAULT.

Pursuant to the Order of Default (Order No. 2005-311) dated 25 May 2005, Opposer presented its evidence of Exhibits "A" to "H" and their sub-markings.

The only issue to be resolved in the instant case is:

WHETHER OR NOT RESPONDNET-APPLICANT IS ENTITLED TO THE REGISTRATION OF THE MARK “MARY D’ POTTER”.

The applicable provision of law is Section 123.1 paragraph (d) of the Intellectual Property Code of the Philippines which provides:

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

(d) Is identical with a registered mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services;
- (ii) Closely related goods or services or;
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

Opposer’s mark “HARRY POTTER” covers several services in Class 42 in the international Classification of Goods namely “*Entertainment Services*” in the nature of live-action comedy, drama and/or *animated television programs*”.

On the other hand, Respondent-Applicant’s mark “MARY D’ POTTER” is being used on “*television broadcasting*” also falling under Class 41 of the International Classification of goods and services.

The visual and comparative analysis of the competing trademarks as illustrated below:

Opposer	Respondent-Applicant
HARRY POTTER	MARY D’ POTTER
1. Harry Potter is the son of James and Lily Potter, hence, Harry’s last name is POTTER	1. Mary is Mary Panyurutan, not POTTER. She supports her family by making and selling clay pots, thus, the term D’ POTTER
2. Eleven years old Harry Potter discovers he is a wizard with magical powers.	2. In her community, no one knows that Mary has a secret identity – she is a “white witch” a sorcerer with magical powers
3. He inherited his wizarding skills and magical powers from his parents	3. She inherited her wizarding skills and magical powers from her parents
4. Harry is an orphan	4. Mary is a widow.
5. Harry is a helpful dedicated schoolmate.	5. Mary is a helpful dedicated neighbor.

Based from the above-analysis, it is established that the competing marks appears to be confusingly similar.

One vital point to be considered in the case at bar is the word “POTTER” which is present in both trademarks and such as, it is the *dominant* feature of both.

The test of dominancy focuses on the similarity of the prevalent, essential or dominant features of the competing trademarks which might cause confusion or deception. Thus, the Supreme Court in the case of *Philippine Nut Industry, Inc., vs. Standard Brands Incorporated, et.al., G.R. No. L-23035, July 31, 1975*, has ruled that:

“In cases involving infringement of trademarks, it has been held that there is infringement when the use of the mark involved would be likely or cause confusion or mistake in the mind or to deceive purchasers as to the origin or source of the commodity; that whether or not trademark causes confusion and 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 trademark contains the main essential or dominant features of another by reason of which confusion and deception are likely to result, then infringement takes place; and the duplication or imitation is not necessary a similarity of the dominant features of the trademark would be sufficient.”

With respect to the other features of the competing trademarks, “HARRY” for the Opposer and “MARY” for the Respondent-Applicant, as to “gender” they are entirely different, male and female, however as to their inherited powers from their parents as what the story tells about, they are practically the same, “*wizarding skills*” and “*magical powers*”. When pronounce, their sound is strikingly disturbing to the ears as if they are similar.

With all the foregoing circumstances, the consuming public, particularly, the unwary consumers will be deceived, confused and mistaken into believing that the goods or services of the Respondent-Applicant came from or are authorized by the Opposer to its damage and prejudice.

Another point to be taken into consideration is the fact that Opposer’s trademark has been filed for its registration with the Intellectual Property Office (IPO) on *January 12, 2000* earlier than the Respondent-Applicant’s application which was filed on 03 October 2001, hence deserves priority and protection.

The Opposer likewise argues that its mark “HARRY POTTER” is a well-known mark, which deserves protection as consequences of our adherence to the Paris Convention. I support of its position it submitted a list of various pending applications and registrations of the mark “HARRY POTTER” in many countries of the world including the Philippines which application was filed on January 12, 2000, as well as publications, articles, advertisements and clippings.

Section 123.1, paragraph (e) of the Intellectual Property Code provides 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.

Anent thereto, the then Minister of Trade and Industry, Hon. Roberto V. Ongpin, issued the Ongpin Memorandum which establishes the guidelines in the implementation of Article 6*bis* of the Treaty of Paris relating to the protection of intellectual property rights regarding well known marks. These conditions are:

- a.) the ark must be internationally known;
- b.) the subject of the right must be a trademark, not a patent or copyright or anything else;
- c.) the mark must be for use in the same or similar kinds of goods;
- d.) the person claiming must be the owner of the mark.

Moreover, Opposer had shown evidence of international commercial use of the trademark as supported by advertisements, the establishing of factories, sales offices, distributorships, and the like and that it has pending applications and registrations in industrial property offices of another country or countries, taking into consideration the date of such registration as well as long established goodwill and international consumer recognition.

Clearly, from the evidences offered by the Opposer consisting of worldwide registrations and various promotional advertisements (Exhibits "F", "F-2", "F-5", "F-6", "F-7", "F-9", "F-10", "G" TO "G-46", "H" and "H-4") evidencing its claim that the mark "HARRY POTTER" is an internationally well-known mark.

Furthermore, as shown by the records, Respondent-Applicant despite due notice failed to file its Answer to the Notice of Opposition nor filed any motion to lift the Order of Default, such act is indicative of lack of its interest in the application, thus it is deemed to have abandoned the same.

WHEREFORE, premises considered, the Opposition is hereby SUSTAINED. Consequently, Application No. 4-2001-007435 filed on October 3, 2001 for the mark "MARY D' POTTER" is hereby REJECTED and considered ABANDONED.

Let the filewrapper of this case be forwarded to the Administrative, Financial and Human Resource Development Services Bureau (AFHRDSB) for appropriate action in accordance with this DECISION with a copy furnished the Bureau of Trademarks for information and to update its record.

SO ORDERED.

Makati City, 24 March 2006.

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