



OFFICE OF THE DIRECTOR GENERAL

ABS-CBN INTERACTIVE, INC.

Appellant,

-versus-

METRO INTERNATIONAL S.A.,

Appellee.

x-----x

Appeal No. 14-2010-0037

IPC No. 14-2009-00120

Opposition to:

Application No. 4-2007-010483

Date Filed: 21 September 2010

Trademark: METRO

DECISION

This is an Appeal by ABS-CBN Interactive, Inc. (Appellant), against Decision No. 2010-21, dated 13 May 2010, of the Director of the Bureau of Legal Affairs (BLA), sustaining the Opposition of Metro International S.A. (Appellee) to the application for registration of the Appellant's mark, METRO.

CASE SUMMARY

Appellant filed an application for the registration of the mark METRO for goods under Nice Class 38, for mobile phone services, on 21 September 2007.¹ In a Registrability Report², the Bureau of Trademarks (BOT) examiner Valerie V. Marquina found that the said mark may not be registered, citing a number of confusingly similar marks with an earlier filing or priority date, among which is the mark METRO of the Appellee. Appellant responded³, claiming that there is no possibility of confusion between the subject and the cited marks as none of them are used as keywords for mobile phone services. The examiner issued Paper No. 04, reiterating her previous finding.⁴ Subsequently, she issued a Notice of Abandonment⁵, for Appellant's failure to file a response to Paper No. 04. Appellant petitioned for revival⁶, maintaining that it submitted its response to said Paper No. 04, attaching a copy of the response duly received by the Office on 23 July 2008. Finding the said petition to be meritorious, the BOT granted the request for revival.⁷

On 20 April 2009, Appellee filed an opposition⁸ with the Bureau of Legal Affairs (BLA) against Appellant's application for registration, based on the grounds that: (1) it was the first to adopt, use and register METRO worldwide including the Philippines; (2) its mark is internationally well-known; (3) the contending marks are

¹ Appellant's Trademark Application Form

² Official Action Paper No. 2, with mailing date 19 December 2007

³ Letter addressed to the Director of Trademarks, dated 20 February 2008

⁴ Official Action Paper No. 04, with mailing date 20 May 2008

⁵ Official Action Paper No. 05

⁶ Petition to Revive Abandoned Application, dated 22 September 2008

⁷ Official Action Paper No. 08, dated 30 September 2008

⁸ Verified Notice of Opposition, dated 20 April 2009

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identical; and (4) registration will cause likelihood of confusion as to origin or affiliation of the goods.

On 14 October 2009, the BLA issued an order⁹ submitting the case for decision in view of the Appellant's failure to file an Answer within the reglementary period. The BLA Director subsequently rendered the aforementioned decision granting the opposition. Hence, this appeal.

ISSUE/S

- (1) Whether or not the subject marks are identical.
- (2) Whether or not there is likelihood of confusion.
- (3) Whether or not Appellee's mark is well known.

RULING

We find no merit in the appeal.

The subject marks are identical

The two marks are reproduced below:

METRO

Appellant's Mark

METRO

Appellee's Mark

Res ipsa loquitur. A comparison of the subject marks readily demonstrates that the two are identical. Their spelling, pronunciation and meaning are exactly the same. By this fact of identity alone, the registration is proscribed under Section 123.1(d) of Republic Act No. 8293, the Intellectual Property Code of the Philippines (IP Code), which states that:

"Sec. 123. Registrability.- 123.1 A mark cannot be registered if it:

X X X

(d) Is identical with a registered trademark 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."

There is likelihood of confusion

The exact identity between the marks will indubitably cause confusion among the public as to the products or services and their origin. In addition, both marks belong to the same Nice Class 38, although they may not exactly cover identical

⁹ Order No. 2009-1514

products. The BLA Director's observations as to the coverage of the said class are spot on:

"In this regard, the respondent-Applicant seeks to register the mark METRO in its favor for use on services which are similar or closely related to those covered by the Opposer's registered mark. While the Opposer's goods and services include telecommunications and electronic newspaper, the Respondent-Applicants METRO on the other hand, will be used on mobile phone services. The parties' respective products or services are technology-based information and communication and marketing systems/services belonging to Classes (sic) 38. Class 38 includes mainly services allowing at least one person to talk to another, transmit messages from one person to another, and place a person in oral or visual communication with another."¹⁰

Moreover, albeit the competing marks cover different products, the Supreme Court itself has acknowledged the right of trademark owners to be protected as to products that can be considered as normal potential expansion of their business, to wit:

"Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trade-mark or a trade-name is likely to lead to a confusion of source, as where prospective purchasers would be misled into thinking that the complaining party has extended his business over the field (see 148 ALR 56 et seq; 53 Am Jur. 576) or is in any way connected with the activities of the infringer; or when it forestalls the normal potential expansion over his business. (v. 148 ALR, 77, 84; 52 Am. Jur. 576,577)."¹¹

Appellee's mark is well-known

We agree with the ruling of the BLA Director that the Appellee has shown sufficient basis to support its claim that its mark is well-known (although limited to its use in newspapers), in accordance with the requirements of Rule 102 of the Trademark Regulations. The certificates of registration of METRO in numerous countries including the Philippines, the Annual Reports from 2005 to 2007, and the articles uploaded in its website is enough to show the extent and geographical area of the use of the mark.

Wherefore, premises considered, the appeal is hereby **DENIED**. The Decision No. 2010-21, dated 13 May 2010, of the Director of the Bureau of Legal Affairs (BLA), sustaining the Opposition of Metro International S.A. (Appellee) to the application for registration of the Appellant's mark, METRO, is **SUSTAINED**. The



¹⁰ Decision No. 2010-21 of the Director of the Bureau of Legal Affairs, dated 13 May 2010, citing Explanatory Note for Class 38, Part II, Nice Classification, 9th Edition (WIPO, 2006)

¹¹ McDonald's Corp., et al., vs. L. C. Big Mak Burger, G.R. No. 143993, 18 August 2004

Appellant's Trademark Application No. 4-2007-010483 for METRO for goods under Class 38 is hereby **DENIED**.

Let a copy of this Decision as well as the records be furnished and returned to the Director of Bureau of Legal Affairs for appropriate action. Further, let also the Director of the Bureau of Trademarks and the library of the Documentation, Information and Technology Transfer Bureau be furnished a copy of this Decision for information, guidance, and records purposes.

SO ORDERED.

SEP 19 2013 , Taguig City.


RICARDO R. BLANCAFLOR
Director General 