



OFFICE OF THE DIRECTOR GENERAL

YUAN LONGPING HIGH-TECH
AGRICULTURAL CO., LTD.,
Appellant,

Appeal No. 04-2011-0005

Application No. 4-2007-010928
Date Filed: 01 October 2007

-versus-

Trademark: YUAN LongPing
and Device

DIRECTOR OF THE BUREAU
OF TRADEMARKS,
Appellee.

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DECISION

YUAN LONGPING HIGH-TECH AGRICULTURAL CO., LTD. ("Appellant") appeals the decision of the Director of the Bureau of Trademarks ("Director") sustaining the final rejection of the Appellant's Trademark Application No. 4-2007-010928 for the mark "YUAN LongPing and Device".

Records show that the Appellant filed on 01 October 2007 an application to register YUAN LongPing and Device for use on *plant seeds; grains (cereals); wheat; maize, flowers, natural; plants; fruit, fresh; vegetables; fresh; sample of bacterium; bean (unprocessed)* which fall under Class 31 of the Nice Classification.¹ Subsequently, the Examiner-in-Charge ("Examiner") issued an official action² stating that the mark may not be registered because it consists of a name identifying a particular living individual without his/her written consent and that the mark nearly resembles a registered mark belonging to a different proprietor and the resemblance is likely to deceive or cause confusion.

The Appellant filed a response letter dated 29 February 2008 submitting the written consent of Professor Yuan Longping to use his name in the Appellant's mark. The Appellant averred that there is no possibility of confusion

¹ The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

² Paper No. 02, Registrability Report with mailing date of 04 January 2008.

or likelihood of deception between the registered mark cited by the Examiner and its mark because the Filipinos are very particular about the rice grains and other related agricultural products that they purchase.

The Examiner issued another official action³ reiterating the findings of a likelihood of confusion because the Appellant's mark resembles in spelling, pronunciation and appearance a registered mark. According to the Examiner, the Appellant's mark cannot be registered because the goods of the Appellant are identical to the goods covered by the registered mark.

On the basis of the official action by the Examiner, the Appellant appealed to the Director the rejection of its trademark application. The Director, however, denied the appeal and sustained the rejection of the Appellant's trademark application. The Appellant filed on 03 February 2011 a "MOTION FOR RECONSIDERATION" which the Director denied for lack of merit.

Not satisfied, the Appellant filed on 02 March 2011 a "MEMORANDUM OF APPEAL" contending that the Director erred in finding a likelihood of confusion in the event that the Appellant's mark is registered. The Appellant argues that the dominant feature of its mark is not "Yuan Long Ping" but the entire logo or design that is included in its trademark application. The Appellant maintains that there is no confusion of goods and business because the packaging is entirely different and the logo of its mark is neither used nor indicated in the mark cited by the Examiner. The Appellant claims that SL Agritech, the owner of the registered mark cited by the Examiner, did not "manifest opposition but instead gave its consent to registration". According to the Appellant, the likelihood of confusion being a relative concept, cases affecting trademarks must be decided with a careful consideration of the peculiar facts in each instance.

The Director filed her "COMMENT" dated 31 March 2011 contending that the Appellant's mark contains no other distinctive features that differentiates it with the mark cited by the Examiner. The Director maintains that "YUAN LONG PING" is the most dominant feature in the Appellant's mark and the registered mark cited by the Examiner. According to the Director, the registration of the Appellant's mark will give rise to a situation where a consumer would readily assume that goods being offered by the Appellant originated from the owner of the mark cited by the Examiner or vice versa. The Director maintains that trademark registration involves public interests and that the consent to use a mark issued to a junior proprietor will not suffice to allow the registration of a confusingly similar mark.

³ Paper No. 04 with mailing date of 23 May 2008.

The issue in this case is whether the Director was correct in sustaining the rejection of the Appellant's application to register the mark YUAN LongPing and Device.

Below are the illustrations of the Appellant's mark and the registered mark cited by the Examiner:



Appellant's mark



Registered mark cited by the Examiner

A scrutiny of these marks shows that the terms "Yuan" and "LongPing" in the Appellant's mark are also present in the registered mark cited by the Examiner. Hence, the Appellant's use of Yuan LongPing gives the impression that this mark is just a variation of the other mark. As correctly pointed out by the Director:

In its Appeal Memorandum, applicant-appellant argued that there are major differences in its mark and the cited mark that would enable consumers to distinguish one from the other. It cannot be stressed enough that the most dominant feature of both marks is the words "YUAN LONG PING" and not other. As such, the subject mark cannot be registered under trademark law.⁴

While there are differences in the features of the Appellant's mark and the registered mark cited by the Examiner, these differences are not distinct enough to prevent the association of the Appellant's mark as a variation of the latter mark or vice versa. This is not a remote possibility considering that these marks refer to the same class of goods. The registered mark cited by the Examiner cover the following goods falling also under Class 31 of the Nice Classification: rice, corn, grains of all kinds and other agricultural farm products, seeds, vegetables, and horticultural growths. Clearly, these goods are similar if not related to the goods covered by the Appellant's mark.

In this regard, Sec. 123.1(d) of the Intellectual Property Code of the Philippines ("IP Code") states that a mark cannot be registered if it:

⁴ COMMENT dated 31 March 2011, pp. 4-5.

(d) Is identical with a registered mark 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;

Therefore, to allow the Appellant to register its mark would violate Sec. 123.1(d) of the IP Code and would negate the very essence of trademark registration. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁵

In this instance, because of the similarity of the Appellants mark and the registered mark cited by the Examiner, and the use of these marks on the same class of goods, the purchasing public may be led to believe that the products bearing these marks as originating from the same source or origin. The public may be deceived that the Appellant' mark and the registered mark cited by the Examiner are owned by the same person.

The Appellant's contention that the owner of registered mark cited by the Examiner has given the consent for the Appellant to use "YUAN LONG PING" would not justify the registration of the Appellant's mark. This Office examined the alleged consent given by SL Agritech Corporation, the owner of the registered mark cited by the Examiner, and found that this consent refers to the use of the name 'YUAN LONG PING' which does not necessarily refer to the consent to the registration of the Appellant's mark.

Moreover, the rights in a mark shall be acquired through registration made validly in accordance with the provisions of the law.⁶ In one case, the Supreme Court of the Philippines held that an application for registration under the Patent Law is not an ordinary litigious controversy between private parties. Public interest is involved and all questions as to whether or not the law is satisfied may be considered by the Patent Office or by the Court even though not specifically raised by either of the parties.⁷

⁵ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 November 1999.

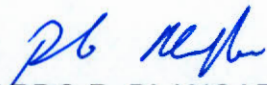
⁶ IP Code, Sec. 122.

⁷ Operators Incorporated vs. Director of Patents, G. R. No. L-17901, 29 October 1965.

WHEREFORE, premises considered, the appeal is hereby DISMISSED. Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Trademarks. Let a copy of this Decision be furnished also the library of the Documentation, Information and Technology Transfer Bureau for its information and records purposes.

SO ORDERED.

SEP 20 2013 Taguig City


RICARDO R. BLANCAFLOR
Director General