



CAMPBELL SOUP COMPANY,  
Opposer,

-versus-

MORNING STAR MILLING CORPORATION,  
Respondent- Applicant.

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}  
} IPC No. 14-2010-000023  
} Opposition to:  
} Appln. Serial No. 4-2009-003960  
} Date Filed: 21 April 2009  
} TM: "LE PREGO AND DEVICE"  
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}  
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}

### NOTICE OF DECISION

#### SANTOS PILAPIL & ASSOCIATES

Counsel for the Opposer  
Suite 1209, Prestige Tower, F. Ortigas Jr. Road  
Ortigas Center, Pasig City

#### MORNING STAR MILLING CORPORATION


Respondent-Applicant  
Penthouse Morning Star Center  
No.347 Gil Puyat Avenue, Makati City

#### GREETINGS:

Please be informed that Decision No. 2014 - 125 dated May 06, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 06, 2014.

For the Director:

  
Atty. EDWIN DANILO A. DATING  
Director III  
Bureau of Legal Affairs



CAMPBELL SOUP COMPANY,  
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MORNING STAR MILLING CORPORATION,  
Respondent-Applicant.

} IPC NO. 14-2010-000023

} Opposition to:

} Application No. 4-2009-003960

} Date filed :21 April 2009

} Trademark: LE PREGO AND  
} DEVICE

x-----x } Decision No. 2014- 125

### DECISION

CAMPBELL SOUP COMPANY (Opposer)<sup>1</sup> filed on 22 January 2010 an opposition to Trademark Application Serial No. 4-2009-003960. The application, filed by MORNING STAR MILLING CORPORATION (Respondent-Applicant)<sup>2</sup>, covers the mark "LE PREGO AND DEVICE", for use on "Spaghetti" under Class 30 of the International Classification of Goods<sup>3</sup>.

The Opposer relies on the following grounds in support of its Opposition:

"1. Opposer CAMPBELL SOUP COMPANY is the registered owner of the mark 'PREGO' for Sauces, namely: Pasta and Spaghetti Sauces, Dipping Sauces, Frozen prepared Entrees consisting of pasta or rice in Class 30 under Philippine Certificate of Registration No. 4-2005-006845 issued on February 7, 2007.

"2. Opposer has likewise registered the mark 'PREGO' in the United States of America and in many other countries of the world.

"3. Opposer has widely used the mark 'PREGO' in the United States of America and distributed its products using the mark 'PREGO' throughout the world including the Philippines. Hence, registration of the similar mark 'LE PREGO AND DEVICE' in the name of the Respondent-Applicant is contrary to the clear provisions of Section 123 (d) of the Intellectual Property Code (R.A. 8293), which provide that:

xxx

"4. The Respondent-Applicant's mark 'LE PREGO AND DEVICE' is confusingly similar to the mark 'PREGO' owned by Opposer as to be

<sup>1</sup> A corporation of the State of New Jersey, U.S.A with principal office at One Campbell Place, Camden, New Jersey 08103 U.S.A.

<sup>2</sup> A corporation organized under Philippine laws with address at Penthouse, Morning Star Center, 347 Gil Puyat Ave., Makati City

<sup>3</sup> The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

likely, when applied to or used in connection with Respondent-Applicant's goods, to cause confusion or mistake and deceive the public, or the public may be led to believe that the goods of the Respondent-Applicant are owned by Opposer or originated from or sponsored by the Opposer. Thus, the application for registration of the mark 'LE PREGO AND DEVICE' in the name of Respondent-Applicant should not have been given due course since it has already been proscribed by Opposer's prior registration for similar mark under Section 123.1 (d).

"5. The registration of the mark 'PREGO AND DEVICE' in the name of the Respondent-Applicant will cause grave and irreparable injury and damage to the Opposer within the meaning of Section 134 of Republic Act 8293."

The Opposer submitted as evidence the following:

1. Authenticated and notarized Sworn Statement of Ashok Madhavan dated 5 January 2010, and
2. Certified true copy of Certificate of Registration No. 4-2005-006845 issued on 12 February 2007 for the mark "PREGO".<sup>4</sup>

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 1 March 2010. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 29 October 2010 Order No. 2010-1235 declaring the Respondent-Applicant to have waived its right to file its answer.

Should the Respondent-Applicant be allowed to register the trademark LE PREGO AND DEVICE?

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

- (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.

The records show that when the Respondent-Applicant filed its application on 21 April 2009, the Opposer already has an existing registration for the trademark PREGO<sup>5</sup> issued on 12 February 2007 covering goods under Class 30 namely, "Sauces, namely: Pasta and Spaghetti Sauces, Dipping Sauces, Frozen prepared Entrees consisting of pasta or rice". The Respondent-Applicant's trademark application therefore indicates goods

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<sup>4</sup> Exhibit "A"

<sup>5</sup> Exhibit "A"

that are similar and/or closely related to those covered by the Opposer's trademark registration. The Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's, particularly, spaghetti, which flow through the same channels of trade.

But are the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?



Opposer's mark



Respondent-Applicant's mark

The word PREGO used in both marks is identical. Thus, they are visually and aurally similar. Even if the Respondent-Applicant appended the word LE before PREGO, LE is merely a pronoun for the word PREGO, LE PREGO meaning "You are welcome". Even if the Respondent-Applicant's mark is a composite mark, wherein the words LE PREGO is atop a small circle with a sprig of wheat inset with the word SPAGHETTI (which is disclaimed) below, placed inside a bond roll, all inside a rectangular enclosure, when the marks are applied on related goods, confusion and deception is likely to result.

In the instant case, the Opposer proved that it applied and obtained an earlier registration for the mark PREGO in the Philippines and has registered the mark PREGO for pasta, spaghetti sauce in other countries.<sup>6</sup> Succinctly, because the Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's, it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.<sup>7</sup>

<sup>6</sup> Notarized and authenticated Sworn Statement of Ashok Madhavan

<sup>7</sup> *Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

The public interest, therefore, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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.<sup>8</sup>

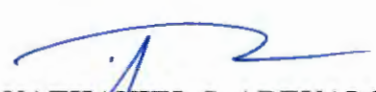
The Respondent-Applicant despite the opportunity given, did not file an Answer to defend its trademark application and to explain how it arrived at using the mark LE PREGO AND DEVICE which is confusingly similar to that of the Opposer's PREGO. The Opposer's mark is unique and highly distinctive. It is incredible for the Respondent-Applicant to have come up with exactly the same mark for use on similar goods by pure coincidence. Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why of the millions of terms and combinations of letters and designs available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.<sup>9</sup>

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2009-003960 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 6 May 2014.

  
Atty. **NATHANIEL S. AREVALO**  
Director IV  
Bureau of Legal Affairs

<sup>8</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents*, *supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

<sup>9</sup> *American Wire & Cable Company v. Director of Patents*, G. R. No. L-26557, 18 February 1970.