



FEDERATION INTERNATIONALE  
DE FOOTBALL ASSOCIATION,  
Opposer,

-versus-

FILIPINO INTERNATIONAL  
FRANCHISE CORPORATION,  
Respondent-Applicant.

X-----X

}  
} IPC No. 14-2011-00418  
} Opposition to:  
} Appln. Serial No. 4-2010-011080  
} Date filed: 08 October 2010  
} TM: "FIFA FILIPINO  
} INTERNATIONAL FRANCHISE  
} ASSOCIATION AND DESIGN"

### NOTICE OF DECISION

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### GREETINGS:

Please be informed that Decision No. 2013 - 130 dated July 15, 2013 ( copy enclosed) was promulgated in the above entitled case.

Taguig City, July 15, 2013.

For the Director:

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



**FÉDÉRATION INTERNATIONALE  
DE FOOTBALL ASSOCIATION,**  
Opposer,

IPC No. 14-2011-00418  
Opposition to Trademark  
Application No. 4-2010-011080  
Date Filed: 08 October 2010

-versus-

**FILIPINO INTERNATIONAL  
FRANCHISE CORPORATION,**  
Respondent-Applicant.

Trademark: "**FIFA FILIPINO  
INTERNATIONAL FRANCHISE  
ASSOCIATION AND DESIGN**"

x ----- x

Decision No. 2013- 130

### DECISION

Fédération Internationale De Football Association<sup>1</sup> ("Opposer") filed on 08 November 2011 an opposition to Trademark Application Serial No. 4-2010-011080. The contested application, filed by Filipino International Franchise Corporation<sup>2</sup> (Respondent-Applicant), covers the mark "FIFA FILIPINO INTERNATIONAL FRANCHISE ASSOCIATION AND DESIGN" for use on "*office functions/business administration principally help in the working or management of a commercial undertaking, or help in the management of the business affairs or commercial functions of an industrial or commercial enterprise, as well as the services rendered by advertising establishment primarily undertaking communications to the public, declarations or announcements by all means of diffusion and concerning all kinds of goods and service; bringing together, for the benefit or others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods; services consisting of the registration, transcription, composition, compilation or systematization of written compilation of mathematical or statistical data; services of advertising agencies and services namely distribution of prospectuses, directly through the post, or distribution of samples*" under Class 35 of the International Classification of Goods<sup>3</sup>.

<sup>1</sup> An association organized and existing under the laws of Switzerland, with principal address at FIFA-Strasse 20, Zurich, Switzerland.

<sup>2</sup> A corporation duly organized and existing under the laws of the Philippines with principal address at 104 Minnesota Mansion, 267 Ermin Garcia Street, Cubao, Quezon City.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

Opposer maintains that it is the owner of the famous and internationally well-known FIFA MARKS which include FIFA (script), FIFA (word), FIFA WORLD CUP (script), FIFA WORLD CUP (word). It alleges that the mark FIFA has first been used in 1904 and registered on 02 February 1994 in France. It claims to have obtained various registrations worldwide. In the Philippines, it has been issued Certificate of Registration Nos. 4-2000-004606 and 4-1994-96496 for FIFA and FIFA WORLD CUP marks, respectively.

According to Opposer, it is an association founded in 21 May 1904 as a body to govern football's major international tournaments and is widely known and referred to as "FIFA". The number of member states and countries of the association, which includes the Philippines, allegedly evidences its worldwide reach of the use and familiarity of its marks. It claims that its marquee event, the FIFA WORLD CUP, held every four years in different locations around the world, is the most anticipated and viewed sporting event. It furthers that in 2010 in South Africa, it has an estimated viewership of 530.9 million people. It states that it has generated an estimated sum of Euro 40-45 million from merchandise sales of goods worldwide and that through extensive promotion, marketing and advertising globally, it has built valuable goodwill in the word FIFA and its FIFA MARKS.

Opposer asseverates that the subject mark "FIFA FILIPINO INTERNATIONAL FRANCHISE ASSOCIATION AND DESIGN" should not be allowed registration for being exactly the same as its own marks. It furthers that Respondent-Applicant's mark is likely to cause confusion in the minds of the Filipino public and to wrongly create an association between the two parties. It accuses Respondent-Applicant in adapting the said mark as an attempt to usurp and trade unfairly the goodwill, reputation and awareness of its FIFA marks.

For its part, Respondent-Applicant rejects Opposer's declaration that the FIFA MARKS are internationally well-known. It denies that there is confusing similarity stating that its mark represents a franchising association in the Philippines while that of Opposer's of a football federation. It contends that the subject mark stands for the name of a Philippine association that brings together franchisors, franchisees and other stakeholders in the franchising industry, is used in connection with outreach activities Respondent-Applicant organized, is specifically linked to the management function in relation to its business affairs, commercial function, advertising and promotion, organizing exhibits and events on the subject of franchising and caters to a specific public, i.e. Filipinos interested in franchising.

Respondent-Applicant claims to be using its name since 2005 and has over 200 member corporations all over the country engaged in retail operation. It asserts that it has been in partnership with the Department of Trade and Industry (DTI) and the overseas Filipino workers (OFWs). It furthers to have a bi-quarter publication on franchising circulating in 28 "SM" malls nationwide.

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer issued on 17 May 2012 Order No. 2012-109 referring the case to mediation. On 04 June 2012, this Bureau's Alternative Dispute Resolution Services submitted a report that the parties refused to mediate. Accordingly, the Hearing Officer conducted and terminated the preliminary conference.

Essentially, the issue to be resolved is whether Application No. 4-2010-01180 should be allowed.

It is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. 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>4</sup>

The records reveal that at the time Respondent-Applicant filed an application for registration of the mark "FIFA FILIPINO INTERNATIONAL FRANCHISE ASSOCIATION AND DESIGN" on 08 October 2010, the Opposer has already been granted registration of its FIFA MARKS, which include Certificate of Registration Nos. 4-2000-2006 and 4-1994-96496 issued respectively on 10 March 2000 and 22 January 2007. Unquestionably, the Opposer is the prior registrant.

Now, to determine whether they are confusingly similar, the contested marks are depicted below:



Opposer's FIFA MARKS

<sup>4</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.



Respondent-Applicant's mark

When one looks at the Opposer's marks, what is impressed and retained in the eyes and mind are the letters or word "fifa". This letter combination or word is the dominant feature of the mark that identifies the Opposer and what it represents. Upon scrutiny of Respondent-Applicant's mark, the same conclusion may be withdrawn therefrom. There is no doubt that the two marks are identical in spelling and the same sounding when pronounced. It is obvious that notwithstanding the ornaments and font style, the word "FIFA" stands out in all the marks. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchased as to cause him to purchase the one supposing it to be the other.<sup>5</sup>

Noteworthy, Opposer's registration includes services for *"education, providing of training, entertainment including organization of lotteries; sporting and cultural activities, organization of sporting and cultural events and activities; exploitation and sporting activities; rental services for audio and video equipment, radio, television program and video tapes production services, production of animation movies, production of animation tv programs, seat booking services for shows and sporting event; sport event time measurement services, entertainer managing services; promotion of soccer events; videotaping production"* under Class 41. These services are closely related to that with Class 35 which Respondent-Applicant seeks to register its services. While it is true that Opposer is a football federation, it can be gleaned from its registrations that it has engaged in other businesses and industries. To allow Respondent-Applicant's registration may falsely instill on the mind of a third person that the franchising or the publications issued by it is but another of Opposer's ventures

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<sup>5</sup> Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

outside football. As pronounced by the Supreme Court in the case of *Might Corporation vs. E&J Gallo Winery*<sup>6</sup>:

*"Thus, apart from the strict application of Section 20 of the Trademark Law and Article 6bis of the Paris Convention which proscribe trademark infringement not only of goods specified in the certificate of registration but also of identical or similar goods, we have also uniformly recognized and applied the modern concept of 'related goods.' Simply stated, when goods are so related that the public may be, or is actually, deceived and misled that they come from the same maker or manufacturer, trademark infringement occurs."*

Succinctly, Callman notes two types of confusion. The first is the *confusion of goods* "in which event the ordinarily 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."<sup>7</sup>

Moreover, the Supreme Court held in the case of *McDonald's Corporation vs. MacJoy Fastfood Corporation*<sup>8</sup> that:

*"When one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark, this not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill."*

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code, which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor with an earlier filing or priority date, with respect to the same or

<sup>6</sup> G.R. No. 154342, 14 July 2004.

<sup>7</sup> *Societe des Produits Nestle, S.A. vs. Dy*, G.R. No. 1772276, 08 August 2010.

<sup>8</sup> G.R. No. 166115, 02 February 2007.

closely related goods or services, or has a near resemblance to such mark as to likely deceive or cause confusion.<sup>9</sup> With respect to the Opposer's claim that its mark is a well-known mark, it failed to present evidence showing that all or a combination of the criteria under Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Tradenames and Marked or Stamped Containers concur.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-011080 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 15 July 2013.

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

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<sup>9</sup> Great White Shark Enterprises vs. Danilo M. Caralde, Jr., G.R. No. 192294, 21 November 2012.