



LION CAPITAL LLP,  
Opposer,

-versus-

LION CAPITAL MANAGEMENT LIMITED,  
Respondent- Applicant.

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} IPC No. 14-2008-00355  
} Opposition to:  
} Appln. Serial No. 4-2008-001441  
} Date filed: 05 February 2008  
} TM: "LION GLOBAL INVESTOR"

**NOTICE OF DECISION**

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**GREETINGS:**

Please be informed that Decision No. 2013 - 90 dated May 27, 2013 ( copy enclosed) was promulgated in the above entitled case.

Taguig City, May 27, 2013.

For the Director:

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



**LION CAPITAL LLP,**  
Opposer,

-versus-

**LION CAPITAL MANAGEMENT  
LIMITED,**  
Respondent-Applicant.

**IPC NO. 14-2008-00355**

Opposition to:  
App.Serial No. 4-2008-001441  
Date Filed: 05 February 2008  
**TM: "LION GLOBAL INVESTOR"**

**Decision No. 2013- 90**

X-----X

**DECISION**

Lion Capital LLP<sup>1</sup> ("Opposer"), filed an opposition to Trademark Application Serial No. 4-2008-001441.<sup>2</sup> The application, filed by Lion Capital Management Limited<sup>3</sup> ("Respondent-Applicant"), covers the mark "LION GLOBAL INVESTORS" for use on financial services; fund management; investment management; asset management; unit trust management; financial and investment portfolio management; financial advisory services; financial investment advisory services; investment advisory services; advisory services relating to unit trusts; investment analysis; fund investments; capital investments; unit trust investments; marketing of mutual funds; mutual fund distribution; mutual fund administration; unit trust services; including such services provided on-line or via the internet. under Class 36 of the International Classification of Goods. <sup>4</sup>

The Opposer alleges the following:

"1. The Opposer is the originator, true owner and prior registrant of the **LION CAPITAL** mark, which is covered by Registration Number 42006013681 issued by the Intellectual Property Office ('IPO') on October 6, 2008 covering 'insurance; financial affairs; monetary affairs; financial services; real estate affairs; corporate finance; private equity; investment services; capital, fund and trust investment services; investment management services; mutual fund, collective investment scheme and hedge fund services; unit trust services; financial and investment planning and research; advisory, consultancy and information services relating to all the aforesaid services' in International Class 36.

"2. There is no doubt that the dominant feature of Opposer's registered mark is the word 'LION'. As a matter of fact, during the examination of the Opposer's Application No. 4-2006-013681 (which eventually ripened into its Registration No. 4-2006-013681), the Trademark

<sup>1</sup> A limited liability partnership organized and existing under the laws of England and Wales, with address at 21 Grosvenor Place, London, SW1X 7HF.

<sup>2</sup> The application was published in the Intellectual Property E-Gazette on 15 August 2008.

<sup>3</sup> A corporation organized and existing under the laws of Singapore, with address at One George Street, #08-01, Singapore.

<sup>4</sup>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 Registration of Marks concluded in 1957.

Examiner required the disclaimer of 'CAPITAL'. In the same manner, it cannot be denied that the most prominent and distinctive element of Respondent's mark is also the word 'LION', since the additional word elements 'GLOBAL INVESTORS' are generic, or at the very least, merely descriptive when used in connection with the services covered by its Application No. 4-2008-001441.

"3. In this connection, it must be stressed that the likelihood of confusion is not avoided between otherwise confusing similar marks merely by adding or deleting a house mark or matter that is generic, descriptive or suggestive of the named goods or services.

"4. Moreover, the rule is expressed in terms of dominance of the common term. Thus, if the dominant feature of both marks is the same, as in this case, then confusion may be likely notwithstanding peripheral differences.

"5. Applying the foregoing, Applicant's **LION GLOBAL INVESTORS** mark is confusingly similar to Opposer's registered **LION CAPITAL** mark as used on closely related, if not identical, services in International Class 36. This will certainly cause confusion, mistake and deception on the part of the public.

"6. Opposer's Application No. 4-2006-013681 (which was filed on December 20, 2006) eventually ripened into Registration No. 4-2006-013681) predates the filing of Respondent's application for its confusingly similar mark in respect of identical services on February 5, 2008.

"7. The registration of Applicant's **LION GLOBAL INVESTORS** mark is explicitly proscribed under Section 123.1 (d) of the Intellectual Property Code ('IP Code') which provides that:

x x x

"8. The registration of Applicant's **LION GLOBAL INVESTORS** mark is contrary to Section 147 and other provisions of the IP Code and other relevant laws.

"9. The registration and use by the Applicant of the confusingly similar **LION GLOBAL INVESTORS** mark causes damage to Opposer, and prejudices Opposer's business, as it diminishes the distinctiveness and dilutes the goodwill of Opposer's registered **LION CAPITAL** mark, which is an arbitrary mark for services in International Class 36."

x x x

The Opposer's evidence consists of the following:

1. Exhibit "A" - Legalized Affidavit of Janet Dunlop;
2. Exhibit "B" - Certified true copy of Application No. 4-2006-013681 filed on 20 December 2006 and deemed registered as of 06 October 2008;

This Bureau issued on 14 January 2009 a Notice to Answer and served a copy thereof to the Respondent-Applicant's counsel on 02 February 2009. The Respondent-Applicant filed three (3) successive Motions for Extension of Time to File Verified Answer, which were all granted. On 01 June 2009, the Respondent filed its Answer alleging, among

others, the following:

"28. The VNO fails to state and Opposer has no cause of action, for the following reasons:

***First Defense:** Opposer's mark 'LION CAPITAL' is not confusingly similar with Respondent-Applicant's mark 'LION GLOBAL INVESTORS'*

"29. Opposer essentially claims that its mark 'LION CAPITAL' is confusingly similar with Respondent-Applicant's 'LION GLOBAL INVESTORS'. This claim is utterly baseless.

"30. Time and again, our courts have used two tests in determining confusing similarity: the Holistic Test and Dominancy Test.

"31. Under the Holistic Test, the courts have declared that 'the test is simply to take the words from the marks and compare the spelling and pronunciation of said words. Rather it is to consider the marks in their entirety, as they appear in their respective labels in relation to the goods to which they are attached.' And in order to evaluate the entirety of appearance, the rule is that the best evidence of similarity or dissimilarity are the mark themselves as used by the parties and as compared side by side.

"32. And when making a side-by-side comparison using the Holistic Test, the rule is to look for glaring visual similarities between the marks. As a result, similarity in spelling and pronunciation is further rendered without any weight because as held by the High Court, 'the similarity in spelling or in pronunciation will not make them confusingly similar.' Hence, for instance, in the case of 'ALACTA' and 'ALASKA', the Court accordingly ruled that the dissimilarities in the labels of each mark reject the claim that they are confusingly similar even if the marks are similar in spelling and sound.

"33. The Dominancy Test, on the other hand, confusing similarity between trademarks is determined by the assessment of the essential or dominant feature in the competing trademarks.

"34. In sum, Dominancy Test 'focuses on the similarity of the prevalent features of the competing trademarks that might cause confusion, 'giving little weight to prices, quality, sales outlets and market segments. Otherwise stated, it is 'similarity of the appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding differences'. In short, the test consists of determining if the dominant features are aurally and visually the same.

"35. A side-by-side comparison of Opposer's mark 'LION CAPITAL' and Respondent-Applicant's mark 'LION GLOBAL INVESTORS' readily gives the impression that they are not confusingly similar. Opposer's mark is composed of two words, i.e., 'LION' and 'CAPITAL', while Respondent-Applicant's mark is composed of three, i.e., 'LION', 'GLOBAL', and 'INVESTORS'. Clearly the marks will never cause confusion on the part of the consuming public since they are very distinct in sound, appearance, spelling and pronunciation.

"36. The contending marks, as used in actual commerce, appear as follows:



*Opposer's Mark*



*Respondent-Applicant's Mark*

x x x

"37. In comparing the trademarks as they are used in actual commerce, the following are the notable differences:

*a. Color Scheme and and Visual Appearance*

Opposer's mark consists of letters in dark blue and light blue colors as is accompanied by a LION device; the word 'LION' and 'CAPITAL' are of the same unique font and are also of the same font size. Respondent-Applicant's mark on the other hand, consists of white letters against a rectangular burgundy background; the font of the words 'LION' and 'GLOBAL' are bigger in size.

*b. Spelling*

Opposer's and Respondent-Applicant's mark are spelled differently. Opposer's mark is spelled L-I-O-N C-A-P-I-T-A-L while Respondent-Applicant's mark is spelled L-I-O-N G-L-O-B-A-L I-N-V-E-S-T-O-R-S. Note should also be made that Opposer's mark is composed of two words with five (5) syllables while Respondent-Applicant's mark is composed of three words with seven (7) syllables.

*c. Sound*

When pronounced, Opposer's and Respondent-Applicant's mark sound differently and are distinct from each other.

*Under the Holistic Test, the marks are not confusingly similar*

"39. Using the Holistic Test, the glaring dissimilarities in the marks reject the claim that they are confusingly similar. Even though the word 'LION' may be found in both marks, this will hardly cause confusion as there are numerous dissimilarities in the appearance of both marks.

x x x

"41. With the foregoing decisions in mind, it could not be denied that likelihood of confusion is nil and that Respondent-Applicant's 'LION GLOBAL INVESTORS' can co-exist



with Opposer's mark 'LION CAPITAL' notwithstanding the common presence of the word 'LION'. After comparing the trademarks involved in their entirety as they appear on the products, the striking dissimilarities are significant enough to warn any purchaser that one is different from the other. The only similarity in Opposer's mark and Respondent-Applicant's mark is the word 'LION'. The dissimilarities between the marks are however striking and significant enough to warn any customer that one is different from the other.

*Even under the Dominancy Test, the marks are not confusingly similar*

"42. Even when the Dominancy Test is used, the conclusion is the same, i.e., there is no confusing similarity between the Opposer's and Respondent-Applicant's marks. Under the Dominancy Test, the dominant features of Opposer's mark are the words 'LION' and 'CAPITAL' and not merely 'LION' as Opposer's insist. In fact, Opposer never uses the word 'LION' alone but always uses it with the word 'CAPITAL'. This is very evident in Opposer's website found at <lioncapital.com.> Hence, Opposer itself deems both words essential or dominant, contrary to its self-serving claims in its Verified Opposition. This is also very evident in the appearance of Opposer's mark where both words 'LION' and "CAPITAL' are of the same font size, thus:



"43. On the other hand, the dominant features in Respondent-Applicant's mark are the words 'LION' and 'GLOBAL'. This can easily be inferred from the way said words are presented in Respondent-Applicant's logo, which shows the words 'LION GLOBAL' in bigger fonts than the 'INVESTORS'. Thus:



"44. Furthermore, Respondent-Applicant significantly uses the words 'LION GLOBAL' together in the business transactions and in identifying its products or services, such as:

x x x

"45. Noticeably, Respondent-Applicant even joined the words 'LION' and 'GLOBAL' in the foregoing products which only highlights the fact that the public has come to know Respondent-Applicant by the name 'LION GLOBAL' and not merely 'LION'.

*Under the Dominancy Test in determining confusing similarity, what is taken into account is the impression of the mark on the part of the consuming public.*

"46. Opposer argues that since the word 'CAPITAL' has been disclaimed in its trademark registration, only the word 'LION' is the dominant feature of its mark. This is a very short-sighted and obviously self-serving interpretation of the Dominancy Test.

"47. Under the Dominancy Test what is taken into account is the impression of the mark on the part of the consuming public. It is therefore of no importance that the word 'CAPITAL' has been disclaimed by the Opposer in trademark registration. The consuming public will never know that capital has been disclaimed and would never think that only 'LION' is dominant. Based on the actual use by Opposer of its mark, both the words 'LION' and 'CAPITAL' are dominant as they always go together. Opposer's business is therefore identified by the words 'LION CAPITAL' and not merely the word 'LION'.

x x x

"53. To reiterate, the following representations of the marks of Opposer and Respondent-Applicant should be the basis of comparison since they represent the form in which the trademarks are perceived by the consumers in a commercial setting and on the basis of which the opinion and perception of the consumer are shaped:



*Opposer's Mark*



*Respondent-Applicant's Mark*

"54. From the foregoing, what will be implanted in the mind of the public are the words 'LION CAPITAL' when they look at the Opposer's trademark, and 'LION GLOBAL' when they look at Respondent-Applicant's trademark.

x x x

"60. Significantly, the business focus of Opposer and Respondent-Applicant is very much different, which further negates any claim of confusing similarity. Opposer's business revolves around raising funds and investing them by way of equity investments in consumer brand companies. This business focus can be clearly seen in Opposer's website <http://www.lioncapital.com> where Opposer declares: 'We strive to be the leading investment firm focused on the consumer sector'. Opposer further claims in its website as follows:

x x x

A handwritten signature in blue ink is located in the bottom right corner of the page.

"61. Clearly, Opposer's business is very focused and narrowly targeted form of financial investment services. Not surprisingly, Opposer proudly claims that it has invested equity capital in some of the largest and most successful consumer-based companies in the markets. These consumer-based companies, as listed in the Opposer's website, are as follows:

x x x

"62. In contrast, Respondent -Applicant is an 'asset management company'. As an asset management company, it deals with investments in regional and global equities and fixed income markets. Respondent-Applicant offers a comprehensive suite of investment products covering all asset classes to institutional as well as retail investors. It also offers discretionary investment management and advisory services and manages over 42 funds, most of which are retail mutual funds. Respondent-Applicant, therefore, has a broader business focus and has a broader client base. In particular, the Opposer's registration details as listed on the United Kingdom's Financial Services Authority's ('FSA') records appear to show that they do not target retail investors. This information may be gleaned publicly from the FSA's website at <http://www.fsa.gov.uk/register/firmPermissions.do?sid=107311>, where any classifications of the Opposer's 'Customer Type' do not include any references to retails investors.

*Respondent-Applicant is not riding on the goodwill or reputation of Opposser.*

"66. Parenthetically, the likelihood of confusion is in the context of a scheme of one party seeking to confuse the public in order to mistake its goods as belonging to another with established goodwill or reputation. But Respondent-Applicant is itself a highly reputable company, which therefore indicates that it does not need Opposer's alleged goodwill in order to be successful. It is already successful.

"67. Not only is Respondent-Applicant successful, its mark 'LION GLOBAL INVESTORS' even qualifies as a well-known mark. In determining whether a mark is well-known within the ambit of Section 123.1 (e) and (f), the factors to be taken into consideration are enumerated in Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers.

"68. Considering the criteria in Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers and the evidence presented, Opposer's trademark 'LION GLOBAL INVESTORS' should be considered to have attained a well-known status internationally. Such a well-known status is clearly shown by the following facts:

"a. Respondent-Applicant was created from the merger of the asset management businesses of two major players in Asian financial industry, the OCBC banking group and the Great Eastern insurance group via their asset management arms, namely OCBC Asset Management Limited and Straits Lion Asset Management Limited, respectively. The merger in 2005 created one of the largest asset management companies in Singapore and Southeast Asia.



"b. The adoption of a LION-formative name for Respondent-Applicant therefore has its roots in its founding entities: Straits Lion Asset Management Limited contains the word 'LION' in its name and Great Eastern (which owns 70% share in Respondent-Applicant), has been using a LION logo for over 100 years.

"c. On 2 June 2008, Respondent-Applicant embarked on a global re-branding exercise and changed its corporate name to its current one, Lion Global Investors Limited. This change embodies Respondent-Applicant's global aspirations and expanding client base, and underpins its ambition to build awareness of its services in the global marketplace.

"d. Respondent-Applicant has extensively advertised and promoted its asset management and related services under the 'LION GLOBAL INVESTORS' and 'LION GLOBAL INVESTORS (stylized words with device)' marks since 2008, and boasts in excess of S\$26 billion of assets under management (as of 31 December 2008). Respondent-Applicant's audited revenue (fee income) for 2006, 2007 and 2008 were S\$79, 551,057, S\$98, 799, 878 and S\$72, 222, 439, respectively.

"e. To maintain the goodwill and fame the LION GLOBAL INVESTORS trademark, Respondent-Applicant has advertised the same in numerous media such as magazines, newspapers, website and in-train panels. Respondent-Applicant spent approximately S\$1 million in the year 2008 to advertise and promote its LION GLOBAL INVESTORS trademark.

"f. Respondent-Applicant has already gained notoriety in Singapore and in Asia. It is therefore not surprising that the leading search engine 'Google' generated 13,100,000 hits for the search key 'LION GLOBAL' and 138,000 hits for the search key 'LION GLOBAL INVESTORS'.

"g. Respondent-Applicant's mark is featured in Internet articles including the following:

x x x

"h. Respondent-Applicant has also been featured in popular publications such as The Edge Singapore magazine, newspaper in Singapore such as The Straits Times, The Business Times, xxx and Today, and Taiwanese dailies such as xxx.

"i. Respondent has numerous registrations and applications all over the world for the mark 'LION GLOBAL INVESTORS'.

"69. The Respondent-Applicant is successful is proven by the highest awards it received from the industry year after year. In fact, since 2006, Respondent-Applicant has received awards which include honors from the following:

x x x

"70. It is clearly seen from the above-mentioned facts and above discussions that

Respondent-Applicant's trademark 'LION GLOBAL INVESTORS' already attained the status of an internationally well-known mark. As such, Respondent-Applicant has attained a goodwill and reputation separate from that of Opposer.

*Second Defense: Even if there is a likelihood of confusion between Opposer's mark 'LION CAPITAL' and Respondent-Applicant's mark 'LION GLOBAL INVESTORS', Respondent-Applicant can still claim good faith or fortuitous adoption as a defense.*

x x x

"72. Hence, even assuming that the mark 'LION CAPITAL' and 'LION GLOBAL INVESTORS' will likely cause confusion, the fact that the use of 'LION GLOBAL INVESTORS' is in good faith or fortuitous is a valid defense based on the comments of the Supreme Court in the Big Mak case quoted above.

"73. The adoption of a LION-formative name for Respondent-Applicant therefore has its roots in its founding entities: Straits Lion Asset Management Limited contains the word 'LION' in its name and Great Eastern (which owns 70% share in Respondent-Applicant), has been using a LION logo for over 100 years. Below is an image of the LION logo.



"74. It should, furthermore, be noted that Singapore is referred to as 'The Lion City' and that the lion is a national symbol deeply ingrained in the national psyche of Respondent-Applicant's country.

"75. On 2 June 2008, Respondent-Applicant embarked on a global re-branding exercise and changed its corporate name to its current one, Lion Global Investors Limited. This change embodies Respondent-Applicant's global aspirations and expanding client base, and underpins its ambition to build awareness of its services in the global marketplace.

"76. With the global re-branding exercise, Respondent-Applicant commenced use of the 'LION GLOBAL INVESTORS' and 'LION GLOBAL INVESTORS (stylized words with device)' marks. Both marks appear on marketing and promotional material used by Respondent-Applicant, including Respondent-Applicant's website, and all of Respondent-Applicant's corporate stationery.

"77. In this case, therefore, even assuming that the application of the tests lead to the conclusion that there is likelihood of confusion, Respondent-Applicant can still claim a final defense, and that is, it adopted the similar mark due to honest mistake, or its adoption is fortuitous, considering that there is strong evidence that the use of the word 'LION' by

Respondent-Applicant is readily an honest use.

"78. Another factor that leads to a conclusion that the use of LION is an honest and fortuitous use is the use of the same by different entities whose trademarks have been allowed to co-exist in the Philippines and other jurisdictions, such as the United States.

*Third Defense: Opposer cannot claim exclusive right to use the word 'LION' as it is a weak mark*

"79. Opposer claims that the registration of Respondent-Applicant's mark 'LION GLOBAL INVESTORS' is proscribed since it already has a trademark registration in the Philippines for the mark 'LION CAPITAL'. And since Respondent-Applicant's mark includes the word 'LION', it should not be allowed registration for being identical with its mark 'LION CAPITAL', citing Section 123.1 (d) of the Intellectual Property Code.

"80. The co-existence in the Philippines and other jurisdictions of trademarks bearing the word 'LION' owned by different unrelated entities is a strong indication that 'LION' is a weak trademark in that it has no capacity to identify strongly a single original or source of goods or services.

"81. A search of the database of the Intellectual Property Office shows that there are 408 trademark registrations and applications bearing the word 'LION' or which use the image of a lion as trademark. This only underscores the fact that 'LION' is widely used as a trademark and taken alone is not very distinctive as to effectively identify the source of goods or services. To cite a few examples, the following marks lifted from the database of the Intellectual Property Office use the word 'LION' as mark or part of the mark:

x        x        x

"83. If the common element of co-existing trademarks is a word that is 'weak', then this reduces the likelihood of confusion. A portion of the mark may be 'weak' in the sense that such portion is descriptive, highly suggestive, or is in common use by many other sellers in the market xxx.

"85. 'LION' therefore is a 'weak' trademark, and whether a mark is classified as 'strong' or 'weak' is a very important element in deciding the likelihood of confusion. When a component of a trademark is weak, its ability to suggest a single source or origin of goods or services is correspondingly weakened. If so, the claim by any single entity that it has the sole right to use that word or trademark component lacks validity in fact and in law.

"86. The records of the United States Patent and Trademark Office (USPTO) show that there are 1444 trademark applications and/or registrations for 'LION' many of which belong to different unrelated entities.

"87. It is significant to note that in the United States, there are numerous examples of seemingly conflicting marks where the court ruled out confusing similarity. Xxx

x        x        x

"89. Applying the legal justification adopted by the courts in the afore-cited cases, this Honorable Office can justifiably conclude that likelihood of confusion between the trademarks of the parties herein is absent. The dissimilarity of the marks in their entirety as to appearance and commercial impression is not in doubt. The presence of other registrations using the word 'LION' in the Philippines and under other entities also proves that the mark is weak and that the nature and extent of actual confusion is nil.

90. Hence, from all of the foregoing, Opposer's claim that its 'LION CAPITAL' mark and the Respondent-Applicant's 'LION GLOBAL INVESTORS' mark are identical and confusingly similar is simply without any basis in fact and in law.

*Fourth Defense: Respondent-Applicant is a true owner of the trademark 'LION GLOBAL INVESTORS' hence, Opposer cannot rely on the first-to-file rule to prevent registration of the same.*

"91. It is a well entrenched rule in the IP Code that ownership of a mark is acquired by adoption and use thereof, and that the person who has established prior adoption and use of the mark or trade name acquires ownership thereof on goods upon which it is used or affixed or on goods and articles related thereto.

"92. Opposer makes issue of the fact that it filed its mark 'LION CAPITAL' ahead of Respondent-Applicant. This is however irrelevant since in this jurisdiction, it is not the registration that confers ownership of trademark; rather, it is ownership of the trademark that gives to the right to cause its registration and enjoy exclusive use thereof for the goods associated with it.

"93. This was the natural result when the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement) was implemented through RA 8293 or the Intellectual Property Code. Article 15 of the TRIPS Agreement states that:

x x x

"96. From the foregoing, it is very clear that the right of registration belongs to an owner and that it is ownership of the trademark that gives rise to the right to cause its registration and enjoy exclusive use thereof.

"97. The only deduction that can be derived from the foregoing is that Respondent-Applicant, being a true owner of the mark 'LION GLOBAL INVESTORS' by virtue of the long history of use of the LION device by its founding entity, Great Eastern and the use of the word 'LION' by Straits Lion Asset Management Limited. Incorporated in 1908, Great Eastern has the great distinction of being the oldest and most established insurance company in Singapore and Malaysia. Since its inception, it has used the lion logo and has been using it until now. Hence, as it is the true owner of the mark 'LION GLOBAL INVESTORS' it should be allowed registration of the same in the Philippines notwithstanding the fact that Opposer has prior application and registration of the mark 'LION CAPITAL'.



The Respondent-Applicant's evidence consists of the following:

1. Exhibit "A" – Legalized Affidavit of Chan Choong Seng, Daniel;
2. Exhibit "B" – material showing the history of Great Eastern;
3. Exhibits "C" to "C-3" – sample marketing and promotional materials and corporate stationery;
4. Exhibits "D" and "E" – Respondent-Applicant's financial reports for the year 2007 and 2008;
5. Exhibits "F" to "H" – certified copies of trademark registrations for the mark LION GLOBAL INVESTORS and variations thereof issued in Singapore;
6. Exhibit "I" – Proof of awards received by Respondent-Applicant;
7. Exhibit "J" – Affidavit of Amando S. Aumento;
8. Exhibit "K" – printouts from Respondent-Applicant's website <http://www.lookforlion.com/> ;
9. Exhibits "L" to "L-1" – copies of Philippine trademark applications for "LION" and "LION CAPITAL";
10. Exhibits "M" to "M-1" – printed pages of the search engine Google showing search results for "LION GLOBAL" and "LION GLOBAL INVESTORS";
11. Exhibits "N" to "N-14" – printed pages of websites where the mark "LION GLOBAL INVESTORS" appear;
12. Exhibits "O" to "O-1" – printed pages of Opposer's and Respondent-Applicant's website;
13. Exhibits "P" to "P-28" – printed pages of IPO's website showing result for marks containing "LION";
14. Exhibits "Q" to "Q-12" – printed pages of IPO's website showing search result for mark "LION" in Class 36;
15. Exhibits "R" to "M-1" – printed pages USPTO showing search result for "LION";

The preliminary conference was terminated on 06 April 2010 and this Bureau issued Order No. 2010-428 requiring the parties to submit their respective position papers. The Opposer filed its Position Paper on 26 April 2010 while the Respondent-Applicant did so via registered mail on 04 May 2010.

Should the Respondent-Applicant be allowed to register the mark **LION GLOBAL INVESTOR**?

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>5</sup> Thus, Sec. 123.1 (d) of the IP Code provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

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<sup>5</sup>See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.



It is undisputed that at the time the Respondent-Applicant filed its trademark application for the mark LION GLOBAL INVESTORS on 05 February 2008, the Opposer has already a pending application for registration for the trademark LION CAPITAL<sup>6</sup> covering services under Class 36 namely: *insurance; financial affairs; monetary affairs; financial services; real estate affairs; corporate finance; private equity; investment services; capital, fund and trust investment services; investment management services; mutual fund, collective investment scheme and hedge fund services; unit trust services; financial and investment planning and research; advisory, consultancy and information services relating to all the aforesaid services*, which was eventually registered (Registration No. 4-2006-013681) on 06 October 2008.

The contending marks are reproduced below for comparison.

**LION CAPITAL**

**LION GLOBAL INVESTORS**

*Opposer's Mark*

*Respondent-Applicant's Mark*

It is evident that both marks are aurally and visually similar because both marks contain the word "LION". The similarity between the marks is immediately recognizable despite the addition of the word "CAPITAL" in Opposer's and the word "GLOBAL INVESTORS" in Respondent-Applicant's. Their similarity is even more appreciated because they deal with the same services, i.e., financial services. Thus, the only thing to be determined is whether the registration of the Respondent-Applicant's mark would cause a likelihood of confusion among the consumer of the services covered by the application.

Contrary to Respondent's argument, the word "LION" is certainly not descriptive of financial services. While it is true that there are numerous trademark registrations and application using the word "LION" or a representation of a lion, only a few of them uses the word "LION" for financial services. The word "LION" has an average degree of distinctiveness for financial services. It may not be as distinctive as an invented word but the word "lion" suggests or characterizes strength which is a good image for a company that deals with financial services. As to the word "CAPITAL" in Opposer's mark, it is descriptive of "capital investment" which is one of the services for which registration is sought, therefore, the word "LION" is the most distinctive part of Opposer's registered mark. Thus, the adoption and registration of a similar or confusingly similar mark by Respondent in its

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<sup>6</sup> Filed on December 20, 2006.

services which is identical or closely related to that of Opposer's would cause likelihood of confusion since the consumers are likely to believe that LION GLOBAL INVESTORS is a global development undertaken by LION CAPITAL.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.<sup>7</sup> The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:


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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.<sup>8</sup>

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2008-001441, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 27 May 2013.

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

<sup>7</sup> See *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

<sup>8</sup> See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.