



PAGODA PHILIPPINES, INC.,
Opposer,

-versus-

FAMILY CHOICE GRAINS PROCESSING
CENTER, INC.,
Respondent-Applicant.

x-----x

} IPC No. 14-2011-00208
} Opposition to:
} Appln. Serial No. 4-2010-008661
} Date Filed: 09 August 2010
} TM: "FAMILY CHOICE LOGO"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 144 dated July 23, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 23, 2013.

For the Director:

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



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DECISION

PAGODA PHILIPPINES, INC. ("Opposer")¹, filed an opposition to Trademark Application Serial No. 4-2010-008661.² The application filed by FAMILY CHOICE GRAINS PROCESSING, INC. ("Respondent-Applicant"),³ covers the mark "FAMILY CHOICE LOGO" for use on "rice" under Class 30 of the International Classification of Goods.⁴ The Opposer alleges, among other things, that:

"1. The approval of Application SN 4-2010-008661 is contrary to Sections 123.1 (d) and (f), and 138 of Republic Act No. 8293;

"2. Respondent-applicant is not entitled to register the mark "FAMILY CHOICE LOGO" in its favor and the approval of Application SN 4-2010-008661 has caused and will continue to cause great and irreparable damage and injury to herein Opposer."

Opposer's evidence consists of the following:

1. Exhibit "A" - certified copy of Registration No. 29065 for the trademark FAMILY issued on April 13, 1981 for use on rubbing alcohol issued to Violeta Y. Alday which was subsequently assigned to Opposer;
2. Exhibit "B"- certified copy of Registration No. 51745 for the trademark FAMILY & REP. OF A RIBBON issued on November 5, 1991 for use on rubbing alcohol issued to Violeta Y. Alday and subsequently assigned to Opposer;
3. Exhibit "C"- certified copy of Registration No. 65188 for the trademark FAMILY issued on September 2, 1997 for use on toothpaste issued to Violeta Y. Alday and subsequently assigned to Opposer;

¹ A corporation organized and existing under the laws of the Philippines with business address at 4626 Valenzuela Street, Old Sta. Mesa, Manila

² The application was published in the Intellectual Property E-Gazette on 02 May 2011.

³ A domestic corporation with address at 56 Diamantina, Cabatuan, Isabela.

⁴ 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.

4. Exhibit "D" - certified copy of Registration No. 4-1992-080068 for the trademark FAMILY issued on October 30, 2004 for use mosquito coils and insecticides;
5. Exhibit "E" - certified copy of Registration No. 4-1993-085710 for the trademark FAMILY issued on July 8, 2004 for use on liquid detergents issued to Violeta Y. Alday;
6. Exhibit "F" - certified copy of Registration No. 4-1994-96831 for the trademark FAMILY & REPRESENTATION OF A FAMILY CONSISTING OF A FATHER, MOTHER AND THREE CHILDREN INSIDE A HEXAGONAL DEVICE issued on July 12, 2000 for use on absorbent cotton ;
7. Exhibit "G" - certified copy of Registration No. 4-2000-002712 for the trademark FAMILY ALOEGEL issued December 23, 2006 for use on hand sanitizer;
8. Exhibit "H" - certified copy of Registration No. 4-2000-002713 for the trademark FAMILY VITAGEL WITH VITAGEL WRITTEN VERTICALLY BELOW FAMILY issued January 20, 2003 for use on hand sanitizer;
9. Exhibit "I" - certified copy of Registration No. 4-2004-004128 for the trademark FAMILY ALCOLOGNE issued April 28, 2006 for use on alcohol with cologne, alcohol with cologne and baby oil, alcohol with cologne and aloe vera, alcohol with cologne and gel, alcohol with cologne, vitamins and gel;
10. Exhibit "J" - certified copy of Registration No. 4-2007-008932 for the trademark FAMILY HERBAL COFFEE 4-in-1 WITH SILYMARIN issued November 3, 2008 for use on herbal coffee;
11. Exhibit "K" - certified copy of Registration No. 4-2009-009417 for the trademark FAMILY issued November 26, 2010 for use on green peas, bottled water, and fruit juices falling under Classes 29 and 32;
12. Exhibit "L" - certified copy of Registration No. 4-2010-0500547 for the trademark FAMILY issued November 26, 2010 for use on toothbrush falling under Class 21;
13. Exhibit "M" - certified copy of Registration No. 4-2010-006992 for the trademark FAMILY and DEVICE issued December 23, 2010 for use on rubbing alcohol, toothpaste, liquid detergents; mosquito coils and insecticides; and toothbrush falling under Classes 01, 03, 05 and 21;
14. Exhibit "N" - certified copy of Application SN 4-1999-009740 for the trademark FAMILY filed on December 17, 1999 for use on chicharon, nuts, pop corn, cheese curls, candies, chocolate bars, jellies, chocolate drinks, fruit juices, fruit drinks, canned goods such as sardines, mackerel, corned beef, Vienna sausage, meatloaf, liver spread, green peas and fruit cocktail falling under Class 29, 30 and 32;
15. Exhibit "N-1" and "N-2" - certified copies of printout of opposer's Application SN 4-1999-009740 published in the e-Gazette last January 24, 2011 and the Notice of Issuance;
16. Exhibit "O" - certified copy of Application SN 4-2006-003977 for the registration of the trademark FAMILY filed on April 11, 2006 by Universal Canning, Inc. for use on tomato sauce and catsup falling under Class 30, and subsequently assigned to Opposer;
17. Exhibit "P" - certified copy of the Declaration of Actual Use filed on November 8, 2002 in connection with Application SN 4-1999-09740 including the documents evidencing actual use of the trademark FAMILY for use on food products falling under Classes 29 and 30;
18. Exhibit "Q" - certified copy of the Declaration of Actual Use filed on May 31, 2010 in connection with Application SN 4-2007-008932 including the documents evidencing

actual use of the trademark FAMILY HERBAL COFFEE 4-in-1 WITH SILYMARIN for use on herbal coffee falling under Class 30;

19. Exhibit "R" - printout of Respondent-Applicant's mark FAMILY CHOICE LOGO as published in the e-Gazette last May 2, 2011; and

20. Exhibit "S" - Affidavit of Elaine Gwendolyn M. Amistad.

This Bureau issued on 17 June 2011 a Notice to Answer and personally served a copy thereof upon the Respondent-Applicant's representative on 27 June 2011. On 15 July 2011, Respondent filed via registered mail its Answer alleging, among others, that:

"1. The law categorically allows the same or similar words to be used on trademarks for goods and services which are not the same.

"2. There is no confusing similarity between the marks registered to the Opposer and to the mark applied by the Respondent when measured against all applicable tests in jurisprudence."

Respondent's evidence consists of the following:

1. Exhibit "1" - copy of the Certificate of Incorporation issued to Family Choice Grains Processing Center, Inc.;
2. Exhibit "2" - copy of the Respondent's Family Choice Logo;
3. Exhibit "3" - original copy of the Declaration of Actual Use filed on 08 July 2011 for the mark FAMILY CHOICE LOGO.

Opposer filed its Reply on 28 July 2011. The issues having been joined, the preliminary conference was conducted and terminated on 06 December 2011. The parties were directed to submit their respective position papers. Opposer filed its Position Paper on 13 December 2011 while Respondent filed it on 16 December 2011 through registered mail.

Should the Respondent-Applicant be allowed to register the mark FAMILY CHOICE LOGO?

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.⁵ 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.

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

The records show that at the time the Respondent-Applicant filed its application for the mark FAMILY CHOICE on 09 August 2010, the Opposer has registered its mark FAMILY as early as 13 April 1981 for "alcohol" falling under Class 05.⁶ Opposer has also registered its FAMILY mark for use on "herbal coffee" under Class 30 on 03 November 2008;⁷ for green peas under Class 29 and bottled water and fruits juices under Class 32 on 26 November 2010;⁸ and has filed its application for registration of the mark FAMILY for use on chicharon, nuts, pop corn, cheese curls, candies, chocolate bars, jellies, chocolate drinks, fruit juices, fruit drinks, canned goods such as sardines, mackerel, corned beef, Vienna sausage, meatloaf, liver spread, green peas and fruit cocktail falling under Class 29, 30 and 32 on 17 December 1999, among others.⁹

As shown below, the marks of the Opposer and Respondent-Applicant are confusingly similar because they both contain the word "family". While Respondent-Applicant's trademark also contains the word "choice", it is hardly noticeable because it is written in small size fonts and in gold color that is barely seen because of the more dominant green background color while the word "family" can easily be perceived even at a distance and constitutes the main feature of the Respondent's mark.

FAMILY

FAMILY

FAMILY



Opposer's Various Marks



Respondent-Applicant's Mark

As to the goods upon which the competing marks are used, it may appear that the competing marks are used on different goods/services as Opposer started using its mark "FAMILY" on "alcohol" based on its first registered "FAMILY" trademark issued in 1981. But Opposer also presented evidence to show it has already ventured into manufacturing and selling food products like herbal coffee, nuts, pop corn, cheese curls, candies, chocolate bars and chocolate drinks; corned beef, Vienna sausage, meatloaf, liver spread, green peas, fruit cocktail

⁶ See Exhibit "A" of Opposer.

⁷ See Exhibit "J" of Opposer.

⁸ See Exhibit "K" of Opposer.

⁹ See Exhibit "N" of Opposer.

and chicharon; and fruit juices and fruit drinks, which does not only belonging to Class 30, the same class as that of Respondent-Applicant's goods, but also under different classes such as Classes 29 and 32.¹⁰ At the same time, it has registered and applied for registration of its FAMILY mark for use on these kinds of goods much earlier than Respondent-Applicant. As such, to allow the registration of Respondent-Applicant's FAMILY CHOICE mark will likely cause confusion, mistake or deception on the public into believing that Respondent-Applicant's goods originated or is sourced from the Opposer or would give the impression that Respondent-Applicant has been authorized by the Opposer to use its FAMILY mark in its rice.

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.¹¹ 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:¹²

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 plaintiffs 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.

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. 4-2010-008661, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 July 2013.


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

¹⁰ See Exhibits "N-1", "P" and "Q".

¹¹ *American Wire and Cable Co. v. Director of Patents, et al*, G.R. No. L-26557, 18 Feb. 1970, (31 SCRA 544).

¹² *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.