



PRIMARY STRUCTURES CORPORATION,
Opposer,

-versus-

ROCKWELL LAND CORPORATION,
Respondent –Applicant.

X-----X

} **IPC No. 14-2013-00174**
} Opposition to:
} Appln. Serial No. 4-2012-014880
} Date Filed: 20 November 2012
} **TM: "PRIMARIES"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 102 dated April 08, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 08, 2014.

For the Director:


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



PRIMARY STRUCTURES CORPORATION,	}	IPC No. 14-2013-00174
<i>Opposer,</i>	}	Opposition to:
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-versus-	}	Appln. Serial No. 4-2012-014880
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ROCKWELL LAND CORPORATION,	}	TM: PRIMARIES
<i>Respondent-Applicant.</i>	}	
x-----x		Decision No. 2014- <u>102</u>

DECISION

PRIMARY STRUCTURES CORPORATION ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2012-014880. The application, filed by ROCKWELL LAND CORPORATION ("Respondent-Applicant")², covers the mark "PRIMARIES" for use on "construction and development of condominium and townhouse projects and sales and marketing of condominium townhouse projects" under Classes 35 and 37 of the International Classification of Goods and Services³.

The Opposer anchors its opposition on the ground that the Respondent-Applicant's trademark application for the mark "PRIMARIES" is confusingly similar with Opposer's mark "PRIMARY" hence registration is proscribed under Section 123.1 paragraph (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") which provides:

- (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;

To support its opposition, Opposer submitted in evidence the following:

1. Exhibit "A" – Trademark Certificate of Reg. No. 4-2008-014150 for the "PRIMARY" mark for Class 35 for "real estate marketing services namely

¹ A corporation organized and existing under the laws of the Philippines with address at the PSC Building, 333 V. Rama Avenue, Cebu City.

² A corporation organized and existing under the laws of the Philippines with principal address at Rockwell Center, Makati City.

³ 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.

- on-line services featuring the promotion of residential sales real estate management, real estate advertising services”;
2. Exhibit “B” – Trademark Certificate of Reg. No. 4-2008-014151 for the “PRIMARY” mark for Class 36 for “leasing of real estate, financing real estate development projects, real estate development consulting, real estate management”;
 3. Exhibit “C” – Trademark Certificate of Reg. No. 4-2008-014152 for the “PRIMARY” mark for Class 37 for “plumbing and other utility services namely carpentry, drywall, painting, electrical, building and framing contractor services, repair and installation particularly heating, cooling and environmental control systems”;
 4. Exhibit “D” – Trademark Certificate of Reg. No. 4-2008-014153 for the “PRIMARY” mark for Class 42 for “architectural and engineering services, engineering services for building and property condition assessment, facility management, repair and restoration, building instrumentation and monitoring, structural engineering design services, graphic illustration and drawing services to commercial, industrial building designs to cad drawings preparation of residential building and factory designs services”; and
 5. Exhibit “E” – Trademark Certificate of Reg. No. 4-2009-006709 for the “PRIMARY” mark for Class 41 for “educational services namely, training, developing and conducting workouts, workshops, presentation and on-line training in the field of architectural and engineering services.

The Respondent-Applicant filed its Verified Answer on 26 June 2013, wherein it admitted some of the allegations of the opposition but denied all the material allegations thereof. According to the Respondent-Applicant, its trademark “PRIMARIES” is not a colorable imitation or confusingly similar to the Opposer’s “PRIMARY”.

In support of its trademark application, Respondent-Applicant submitted in evidence the following:

1. Annex “A” – the main page of “PRIMARIES” website at <http://www.primaries.com.ph>; and
2. Annex “B-1” – Primaries advertisement.

Should the Respondent-Applicant trademark application be allowed?

It is emphasized that the essence of trademark registration is to give protection to the owner of the 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 products.⁴

Thus, Sec. 123.1 (d) R.A. No. 8293, also known as the Intellectual Property Code of the Philippines (“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

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999.

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.

Records show that at the time the Respondent-Applicant filed its trademark application on 20 November 2012, the Opposer has the following existing trademark registrations for the mark "PRIMARY".

1. Reg. No. 4-2008-014150, date of registration 04 May 2009 under Class 35;
2. Reg. No. 4-2008-014151, date of registration 04 May 2009 under Class 36;
3. Reg. No. 4-2008-014152, date of registration 09 October 2009 under Class 37;
4. Reg. No. 4-2008-014153, date of registration 04 May 2009 under Class 42; and
5. Reg. No. 4-2009-006709, date of registration 26 November 2009 under Class 41.

The goods and services covered by the Opposer's trademark registration are similar and/or closely related to those indicated in the Respondent-Applicant's trademark application.

The competing marks are reproduced below for comparison and scrutiny:

PRIMARY

PRIMARIES

Opposer's Mark

Respondent-Applicant's Mark

The marks are practically identical. The Respondent-Applicant's mark "PRIMARIES" is merely the plural form of the word "PRIMARY". The consumers therefore may likely assume that the Respondent-Applicant's mark is just a variation of or related to the Opposer's and/or the goods or services originate from the same source. In this regard, 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 purchaser as to cause him to purchase the one supposing it to be the other?

The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of letters are available, the Respondent-Applicant had 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 mark⁶.

⁵ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 4 April 2001, 356 SCRA 207, 217.

⁶ American Wire and Cable Co. v. Director of Patents et.al. SCRA 544 G.R. No. L-26557, 18 Feb. 1970.

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.

Accordingly, the Respondent-Applicant's trademark application is proscribed by Section 123.1(d) of the IP Code.

WHEREFORE, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-014880 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 08 April 2014.


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

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