SUB-ZERO INC., Opposer, -versus- JOHN FILMORE INTERNATIONAL CORPORATION, Respondent-Applicant.	}	IPC No. 14-2011-00280 Opposition to: Appln. Serial No. 4-2011-001040 Date filed: 31 Jan. 2011 TM: "SUB ZERO BEER"

x---x

NOTICE OF DECISION

CESAR C. CRUZ AND PARTNERS LAW OFFICES
Counsel for Opposer
3001 Ayala Life-FGU Center
6811 Ayala Avenue, Makati City

JOHN G. SIOJO
c/o JOHN FILMORE INTERNATIONAL CORP.
for Respondent-Applicant
253 Calderon Compound
Old Balara, Quezon City

GREETINGS:

Please be informed that Decision No. 2012 - 102 dated June 27, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 27, 2012.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer, BLA

CERTIFIED TRUE COPY
SHARON S. ALCANTARA
Records Officer II
Bureau of Legal Affairs, IPO

SUB-ZERO INC., *Opposer,* **-versus -** **JOHN FILMORE INTERNATIONAL CORPORATION,** *Respondent-Applicant.* **x--x**	**IPC No. 14-2011-00280** **Opposition to:** **Appln. Serial No. 4-2011-001040** **(Filing Date: 31 January 2011)** **TM: SUB ZERO BEER** **Decision No. 2012-** 102

DECISION

SUB-ZERO, INC.[1] ("Opposer") filed on 15 July 2011 an opposition to Trademark Application Serial No. 4-2011-001040. The application, filed by JOHN FILMORE INTERNATIONAL CORP.[2] ("Respondent-Applicant"), covers the mark "SUB ZERO BEER" for use on "*Rental of Freezers*" under Class 39 of the International Classification of goods or services.[3]

The Opposer alleges, among other things, that the registration of the subject mark in favour of the Respondent-Applicant is in violation of Sec. 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). According to the Opposer, the mark applied for registration by the Respondent-Applicant is confusingly similar to the Opposer's mark SUB-ZERO which is registered under Serial No. 4-2001-006266 issued on 05 December 2004 for use on "Refrigerators and Freezers". The Opposer's evidence consists of the legalized/authenticated Special Power of Attorney the said party issued on 29 June 2011 in favor of the law firm Cesar C. Cruz & Partners, copies of certificates of registration for the mark SUB-ZERO (4-2001-006266) and for SUB-ZERO & DEVICE (4-2006-012377), copies of documents relating to the numerous worldwide registrations and trademark applications of the Opposer's marks SUB-ZERO and SUB-ZERO & DEVICE, and the affidavits of Steven F. Dunlap and Stephen Sy and the attachments thereto.[4]

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 09 August 2011. However, the Respondent-Applicant did not file an Answer.

Should Trademark Application Serial No. 4-2011-001040 be allowed?

It is emphasized that the essence of trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; 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 to 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 Rep. Act No. 8293, also known as the Intellectual

---

[1]A corporation duly organized and existing under and the laws of the United States of America, with principal address at 4717 Hammersely Road, Madison Wisconsin 53711, U.S. A.
[2] With address at 253 Calderon Compound, Old Balara, Quezon City.
[3] The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 purposes of the Registration of Marks concluded in 1957.
[4] Marked as Exhibits "A" to "F", inclusive.
5 *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 115508, 19 Nov. 1999.

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 earlier filing or priority date, in respect of the same goods or services or closely related goods or services or it nearly resembles such, mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its trademark application on 31 January 2011, the Opposer already has existing trademark registrations for the mark SUB-ZERO and SUB-ZERO & DEVICE. The goods covered by the said registrations – "*refrigerators and freezers*"- are similar and/or closely related to the goods or services indicated by the Respondent-Applicant in its trademark application.

Also, there is no doubt that the Respondent-Applicant's mark is practically identical to the Opposer's. The addition of the word "BEER" in the Respondent-Applicant's mark is of no moment as it is "SUB-ZERO" that defines the trademark. It is the distinctive feature of the Respondent-Applicant's mark which draws the eyes and the ears. 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:[6]

> 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.

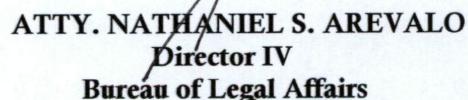
It is inconceivable for the Respondent-Applicant to have come up with the mark "SUB-ZERO" without having been inspired by or motivated by an intention to imitate the Opposer's mark. It is highly improbable for another person to come up with an identical or nearly identical mark for use on the same or related goods purely by coincidence. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the answered riddle is why, of the millions of terms and combination of letters and available, the Respondent-Applicant had come up with a mark identical or so clearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark[7].

Thus, this Bureau finds the instant opposition meritorious. Accordingly, 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. 4-2011-001040 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropaite action.

SO ORDERED.

Taguig City, 27 June 2012.



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

[6] See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.
[7] See *American Wire and Cable Co. v. Director of Patents et.* al (SCRA 544), G.R. No. L-26557, 18 Feb. 1970.