



THE UNITED STATES PLAYING CARD CO.,  
Opposer,

-versus-

FERNANDO G. MONTEVERDE,  
Respondent –Applicant.

X-----X

IPC No. 14-2012-00115  
Opposition to:  
Appln. Serial No. 4-2011-750088  
Date filed: 04 November 2011  
TM: "BEE KILLERSPIN AND  
LOGO"

### NOTICE OF DECISION

**CRUZ MARCELO & TENEFRANCIA**  
Counsel for the Opposer  
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**FERNANDO G. MONTERVERDE**  
Respondent-Applicant  
2138 A. Luna Street  
Pasay City

#### GREETINGS:

Please be informed that Decision No. 2014 - 49 dated February 19, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 19, 2014.

For the Director:

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



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<i>Opposer,</i>	}	Opposition to:
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<i>Respondent-Applicant.</i>	}	
x-----x		Decision No. 2014- <u>49</u>

### DECISION

THE UNITED STATES PLAYING CARD CO. (“Opposer”)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2011-750088. The application, filed by FERNANDO G. MONTEVERDE (“Respondent-Applicant”)<sup>2</sup>, covers the mark “BEE KILLERSPIN AND LOGO” for use on “sporting good/articles, golf equipment, skateboard, swimming accessories, exercise mats, sports and fitness accessories” under Class 28 of the International Classification of Goods and Services<sup>3</sup>.

The Opposer alleges, among other things that:

1. The Opposer is the true originator and rightful owner of the marks “BEE” and the Bee Design;
2. Respondent-Applicant’s mark “BEE KILLERSPIN AND LOGO” is confusingly similar to Opposer’s registered marks “BEE” and “BEE TUCK CASE”;
  - a. Respondent-Applicant’s mark “BEE KILLERSPIN AND LOGO” is visually and aurally identical to Opposer’s registered marks “BEE” and “BEE TUCK CASE”.
  - b. Respondent-Applicant’s mark “BEE KILLERSPIN AND LOGO” covers goods that are related to those covered by Opposer’s registered marks “BEE” and “BEE TUCK CASE”.
3. Opposer’s registered marks “BEE” and “BEE TUCK CASE” are well-known marks that are protected against use and/or registration by third parties even with respect to goods or services which are not similar;
4. In any event, Respondent-Applicant’s application for the mark “BEE KILLERSPIN AND LOGO” cannot be granted as it covers goods which are within the logical

<sup>1</sup> Corporation duly organized and existing under and by virtue of the law of Kentucky, U.S.A.

<sup>2</sup> With registered address at 2138 A. Luna St., Pasay 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.

potential expansion of the business of the Opposer for its registered marks "BEE" and "BEE TUCK CASE"; and

5. Respondent-Applicant's application should be denied for having been filed in bad faith.

To support its opposition, the Opposer submitted the following:

1. Exhibit "A" – the pertinent page of IPO e-Gazette which lists among other things the Respondent-Applicant's trademark application;
2. Exhibits "B" and "C" – Printouts of the web pages of various website;
3. Exhibits "D" and "E" – Certified true copies of Trademark Reg. No. 54525 for the mark "BEE" and Reg. No. SR-8795 for the mark "BEE TUCK CASE";
4. Exhibits "F" to "M" – Samples of advertisements; and
5. Exhibits "N" to "O" – Copies of Opposer's trademark registrations in the United States of America and Japan.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 03 May 2012. On June 04 2012 this Bureau received a letter dated 26 May 2012 and bearing the name and purported signature of Fernando G. Monteverde and was apparently in response to the above-mentioned Notice to Answer. A scrutiny of the letter, however, shows that it was not verified as required under Rule 2, Sec. 9 of the Amended Rules and Regulations on Inter Partes Proceedings (promulgated via Office Order No. 99, s. 2011). Under the rules and is explicitly stated in the Notice to Answer, non-compliance with the requirements shall be deemed a failure to file the Answer. With the failure of the Respondent-Applicant to file the Answer, the case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the mark BEE KILLERSPIN AND LOGO?

The marks shown below resemble each other that confusion, even deception is likely to occur.

*Opposer*

*Respondent-Applicant*

**BEE**

(Reg. No. 054525)



(Reg. No. 8795)



The defining feature in the Opposer's marks and in the mark applied for registration by the Respondent-Applicant is the word "BEE". The depiction of an insect is also connected with the concept or idea conveyed by the word bee. This Bureau notices that the style of the word BEE in the Respondent-Applicant's mark is identical to that of in the Opposer's mark covered by Reg. No. 8795.

In this regard, it must be 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 an different article as his product.<sup>4</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.

Records show that at the time Respondent-Applicant filed his trademark application on 04 November 2011, the Opposer already has existing trademark registrations in the Philippines for "BEE" under Reg. No. 054525 issued on 26 February 1993 and "BEE TUCK CASE" under Reg. No. 8795 issued on 02 April 1993. These trademark registrations cover "playing cards" under Class 16.

But are goods indicated in the Respondent-Applicant's trademark application closely related to those covered by the Opposer's trademark registrations? According to the Supreme Court, the factors in determining whether goods are related are:

- (a) the classification of the goods;
- (b) the nature of the goods;
- (c) the descriptive properties, physical attributes or essential characteristics of the goods with reference to their form, composition, texture or quality; and
- (d) style of distribution and marketing of goods, including how the goods are displayed and sold.<sup>5</sup>

There is no doubt that the Respondent-Applicant's goods are of different classification from the Opposer's. However, this Bureau finds merit in the Opposer's arguments, to wit:

"25. Respondent-Applicant is applying for registration of the mark for sporting goods/article which are closely related to Opposer's 'playing cards' under Class 16. Sporting goods/articles flow through the same channels of trade as playing cards, and said goods are likely to be found in the same stores selling items related to games, hobbies and sports and recreational activities. In

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

<sup>5</sup> See Mighty Corporation v. E & J Gallo Winery, 478 Phil. B15 (2004) and Societe Des Produits Nestle S.A. v. Court of Appeals et.al. G.R. No. 1722, 08 August 2010.

fact a local store, Cutting Edge, which retails "BEE" playing cards in the Philippines, sells products identical or similar to goods covered by Respondent-Applicant's application, i.e. outdoor gadgets, games and hobbies products, even billiard product. x x x

"26. Respondent-Applicant seeks to use the mark "BEE & LOGO" on Class 28 goods for sporting goods/articles, such as tennis balls, shuttlecocks and backgammon games. Considering that Opposer's "BEE" and "BEE TUCK CASE" marks are associated with playing cards, allow Respondent-Applicant to use the confusingly similar mark "BEE & LOGO" on Class 28 will undoubtedly lead to confusion that they come from the same source. Since the marks are confusingly similar, the public will necessarily make the link, association, or affiliation between Opposer and Respondent-Applicant when there is none.

"27. Further, the target consumers are similar. The same demographic of consumers, i.e. those seeking to engage in sports and recreational activities, would purchase the goods on which the marks "BEE & LOGO" of Respondent-Registrant (sic) and Opposer's registered "BEE" and "BEE TUCK CASE" marks are found. The confusing similarity between the marks and the close relation between the goods on which they are to be used would likely cause consumers to draw the connection between the goods and/or sources or origin of the goods."<sup>6</sup>

Succinctly, the Respondent-Applicant's mark could be seen as just a variation of the Opposer's. Thus, information, assessment, perception or impression about the Respondent-Applicant's goods bearing the mark BEE may unfairly be cast upon or attributed to the Opposer, and *vice-versa*.

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:<sup>8</sup>

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 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

<sup>6</sup> Verified Notice of Opposition, pp.13-14.

<sup>7</sup> American Wire and Cable Co. v. Director of Patents, et.al. (3 SCRA 544) G.R. No. L-26557, 18 Feb. 1970.

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

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.

In IPC No. 14-2011-00466, which involves the same parties and a variation of the mark subject of this opposition case, this Bureau in its Decision No. 2013-14 promulgated on 24 January 2013, sustained the opposition pursuant to Sec. 123.1 (d) of the IP Code. Accordingly, this Bureau finds no cogent reason to deviate from the ruling in the earlier case.

**WHEREFORE**, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-750088 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 19 February 2014.



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

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