



E. REMY MARTIN & CO.,
Opposer,

-versus-

EMPERADOR DISTILLERS INC.,
Respondent- Applicant.

X-----X

} IPC No. 14-2012-00608
} Opposition to:
} Appln. Serial No. 4-2012-009299
} Date Filed: 30 July 2012
} TM: "SAN MARTIN BRANDY"
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NOTICE OF DECISION

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EMPERADOR DISTILLERS, INC.,
Respondent-Applicant
7/F, 1880 Eastwood Avenue Building
Eastwood City Cyberpark
Bagumbayan, Quezon City

GREETINGS:

Please be informed that Decision No. 2014 - 185 dated July 14, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 14, 2014.

For the Director:


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



E. REMY MARTIN & C°,

Opposer,

-versus-

EMPERADOR DISTILLERS INC.,

Respondent-Applicant.

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IPC No. 14-2012-00608

Opposition to Trademark

Application No. 4-2012-009299

Date Filed: 30 July 2012

Trademark: **"SAN MARTIN
BRANDY"**

Decision No. 2014- 185

DECISION

E. Remy Martin & C°¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-009299. The contested application, filed by Emperador Distillers Inc.,² ("Respondent-Applicant"), covers the mark "SAN MARTIN BRANDY" for use on "*alcoholic beverages*" under Class 33 of the International Classification of Goods³.

The Opposer maintains its ownership over the "REMY MARTIN" marks, which it has allegedly been using for two hundred fifty (250) years or since 1724. It claims to have built superior quality image and substantial reputation among the public through its long use thereof. It avers that it exerts strict control over the use of its marks by persons authorized to do so and in fact, has been repeatedly recognized by "Superbrands", an international organization which functions as an independent authority and arbiter on branding. It stresses that it has applied and registered its mark in various jurisdictions. In the Philippines, it was issued the following certificates of registrations for goods under Class 33:

- (a) Registration No. 4-1995-099875 for "LOUIS XIII DE REMY MARTIN", issued on 13 December 1999;
- (b) Registration No. 043673 for "REMY MARTIN", issued on 10 April 1989 and renewed on 10 April 2009;
- (c) Registration No. 039001 for "REMY MARTIN AND CENTAUR DEVICE", issued on 13 May 1988 and renewed on 13 May 2008;
- (d) Registration No. 4-1997-125895 for "DECANTER DESIGN INSIDE OF WHICH ARE WORDS REMY MARTIN AND THE REPRESENTATION OF A CENTAUR", issued on 08 July 2004;

¹ A corporation organized and existing under the laws of France, with principal office at 20 rue de la Societe Vinicole, 16100 Cognac, France.

² With known address at 7/F 1880 Eastwood Ave. Bldg., Eastwood City Cyberpark, Bagumbayan Quezon City, Philippines.

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.

- (e) Registration No. 039173 for "CLUB REMY MARTIN", issued on 12 February 1988 and renewed on 12 February 2008;
- (f) Registration No. 4-2006-008227 for "DECANTER DESIGN OF WHICH ARE THE WORDS REMY MARTIN AND THE REPRESENTATION OF A CENTAUR", issued on 11 June 2007; and
- (g) Registration No. 4-2005-002075 for "DECANTER DESIGN INSIDE OF WHICH ARE THE WORDS REMY MARTI AND THE REPRESENTATION OF A CENTAUR", issued on 13 May 2007.

The Opposer insists that Respondent-Applicant's mark "SAN MARTIN BRANDY" is confusingly similar to its own "REMY MARTIN" marks" asserting that the latter was in bad faith with the intent of riding on the popularity and goodwill of its registered marks. It cites Decision No. 2008-71 of this Bureau in Inter Partes Case No. 14-2006-00131, entitled "Remy Martin & Co. vs. Consolidated Distillers of the Far East, Inc.", which held that "HENRI MARTIN LABEL MARK" is confusingly similar to "REMY MARTIN".

In support of its opposition, the Opposer submitted the following as evidence:

1. affidavit of Jean-Christian Lamborelle;
2. copy of advertisements showing Opposer's mark;
3. 31 March 2012 financial statement of Remy Cointreau Group;
4. copy of the Official Top 500 2012 by Superbrands;
5. copy of Decision No. 2008-71
6. certified true copies of the invoices showing the first date of the use of the mark in the Philippines;
7. certified true copy of France Trademark Registration No. 1 366 153 and its English translation;
8. certified true copy of the US Trademark Registration No. 749501;
9. certified true copy of Great Britain & Northern Ireland Trademark Registration No. 1016597;
10. certified true copy of the Madrid (WIPO) Trademark Registration No. 508 092 and its English translation;;
11. certified true copy of Taiwan Trademark Registration No. 328853 and its English translation;
12. certified true copy of Singapore Trademark Registration No. 60522;
13. certified true copy of Japan Trademark Registration No. 14127774;
14. certified true copy of Hongkong Trademark Registration No. 19750084;
15. certified true copy of Malaysia Trademark registration No. M/065286; and
16. certified copies of invoices that indicate and prove long and continued use of the mark in various countries.⁴

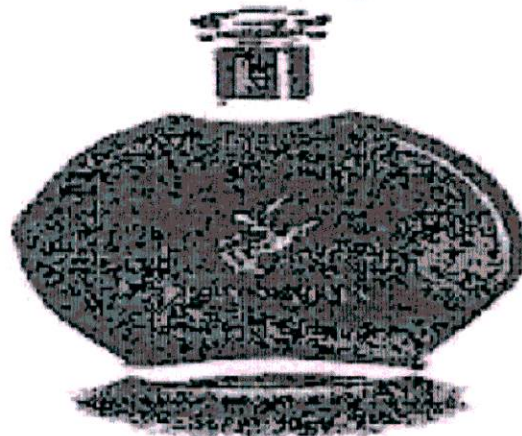
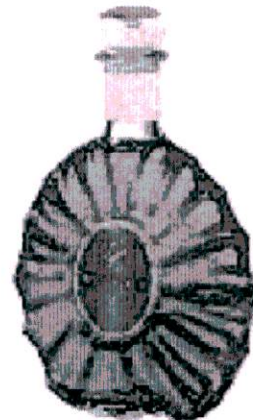
⁴ Marked as Exhibits "A" to "S".

This Bureau issued and served on 15 March 2013 a Notice to Answer upon the Respondent-Applicant. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued on 25 October 2013 Order No. 2013-1472 declaring the Respondent-Applicant in default and the case submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark "SAN MARTIN BRANDY"?

Records reveal that at the time Respondent-Applicant applied for registration of the mark "SAN MARTIN BRANDY" on 30 July 2012, the Opposer has already registered in the Philippines its "REMY MARTIN" marks. In addition, the mark "REMY MARTIN" has worldwide presence as shown by the certificates of registration issued by different jurisdictions. Thus, the registration of the mark "REMY MARTIN" preceded the adoption by the Respondent-Applicant of the mark "SAN MARTIN BRANDY". What is left to be determined is whether the competing marks, depicted below, are confusingly similar.

Opposer's marks:



Handwritten signature or initials in blue ink, located in the bottom right corner of the page.

REMY MARTIN

Respondent-Applicant's mark:

SAN MARTIN B R A N D Y

Perusing the contending marks, it is manifest that all are composite marks, which makes use of the term "MARTIN" as a second word. However, the substitution of the word "SAN" in Respondent-Applicant's mark for the "REMI" in the Opposer's makes little difference, if at all, in eliminating the possibility of confusion between the marks. They still make a similar impression in the eyes and mind of the consuming public. After all, 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 purchased as to cause him to purchase the one supposing it to be the other.⁵

The Opposer cites the case of **E. Remy Martin & Co. vs. Consolidated Distillers of the Far East Inc.** In that case, this Bureau held:

"Upon the foregoing, this Bureau finds the word 'MARTIN', as appearing in opposer's Philippine Certificate of Registration Nos. 43673 and 14252 for the mark 'REMY MARTIN' (Exhibits 'D' and 'D-1') and likewise evident in respondent-applicant's file wrapper of the applied mark 'HENRI MARTIN', as the dominant feature in the contending marks. The word 'MARTIN' is identical visually and aurally.

Undeniably, what attracts and catches the eye of the ordinary purchaser is the word 'MARTIN' which could be taken as a second or a paired name of 'HENRI and 'REMY', both having two-syllables would produce the same cadence when spoken, or the application of the idem sonams rule, as illustrated in the case of Marvex Commercial Co., Inc. vs. Hawpia & Co, 18 SCRA 117, which states that the 'similarity of sound or pronunciation and spelling may be sufficient to make two marks confusingly similar when applied to merchandise of the same descriptive properties.'

⁵ Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

Relative to the goods covered by the contending marks, opposer's 'REMY MARTIN' covers goods under class 33 namely wine, sparkling wine, cider, hard liquor, brandies, liquers and other spirits. On the other hand, respondent-applicant's 'HENRI MARTIN MARK' as indicated in the file wrapper of this instant case, covers the same class 33, for wines. Obviously, the aforementioned goods are identical, related and competing. They belong to the same class, possess the same and/or almost the same descriptive properties, physical attribute and essential characters as to form, composition, texture or quality. They also serve the same purpose and flow through the same channels of trade leading to confusion between the two trademarks in the mind of the prospective buyers. Thus, confusion of goods is established.

This Bureau adheres to the observation that the contending marks have various distinctions, as seen in actual labels, such as the difference in font as marked in variety of bottle shapes and used on a variety of alcoholic beverages. However, these distinctions cannot cause to independently distinguish one product from another. The presence of the dominant feature of 'MARTIN' in relation to the goods caused the likelihood of deception to consumers, and the belief of some business association between the parties which, in fact is absent."

In the instant case, the point of contention is the Respondent-Applicant's use of the word "MARTIN" as part of its mark or wine products. As this Bureau aptly ratiocinated in the above-cited decision, the use of the word "MARTIN" by both parties produces the likelihood that the consumers will have the impression that these goods or products originate from a single source or origin as both the Opposer's and Respondent-Applicant's marks pertain to alcoholic beverages. It only follows that they have the same target market and that they flow in the same channels of trade. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court in **Skechers, U.S.A., Inc. vs. Interpacific Industrial Trading Corp.**⁶, to wit:

"Relative to the question on confusion of marks and trade names, jurisprudence has noted two (2) types of confusion, viz.: (1) confusion of goods (product confusion), where the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other; and (2) confusion of business (source or origin confusion), where, although the goods of the parties are different, the product, the mark of which registration is applied for by one party, is such as might reasonably be assumed to originate with the registrant of an earlier product, and the public would then be deceived either into that belief or into the belief that there is some connection between the two parties, though in-existent."

⁶ G.R. No. 164321, 23 March 2011.

On a final note, it is emphasized that the function of 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.⁷ Respondent-Applicant's mark failed to meet this function.

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

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-009299 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 14 July 2014.


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

⁷ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 November 1999.