



ROCKWELL LAND CORPORATION,
Opposer,

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IPC No. 14-2013-00037
Opposition to:
Appln. Serial No. 4-2011-008596
Date Filed: 22 July 2011
TM: "GLOBAL-ESTATE
RESORTS, INC. & LOGO"

-versus-

GLOBAL -ESTATE RESORT, INC.,
Respondent-Applicant.

X-----X

NOTICE OF DECISION

PUNO AND PUNO

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GREETINGS:

Please be informed that Decision No. 2014 - 227 dated September 15, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 15, 2014.

For the Director:


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



ROCKWELL LAND CORPORATION,
Opposer,

-versus-

GLOBAL-ESTATE RESORT, INC.,
Respondent-Applicant.

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IPC No. 14-2013-00037

Opposition to:

Serial No. 4-2011-008596

Date Filed: 22 July 2011

Trademark: **"GLOBAL-ESTATE
RESORTS, INC. & LOGO"**

Decision No. 2014- 227

DECISION

Rockwell Land Corporation¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-008596. The contested application, filed by Global-Estate Resort, Inc.² ("Respondent-Applicant"), covers the mark "GLOBAL-ESTATE RESORTS, INC. & LOGO" for use on *"financing of real estate development projects; land acquisition; sale of real estate service, namely, rental property management; real estate services, namely leasing and management for others of residential condominiums located within hotel developments; real estate services, namely rental brokerage, leasing and management of commercial property, offices and office space; real estate services, namely, property management services for condominium associations, homeowner associations and apartment buildings; real estate services, namely, condominium management services"* and *"real estate development and construction of commercial, residential and hotel property"* under Classes 36 and 37, respectively, of the International Classification of Goods³.

The Opposer maintains that it is the registered owner of the mark "ROCKWELL & LOGO (STYLIZED LETTER R)" under Certificate of Registration No. 4-1995-104847. According to the Opposer, it demanded from the Respondent-Applicant to cease and desist from using the "GLOBAL-ESTATE RESORTS, INC. & LOGO" mark and specifically to change its logo to one that is not confusingly similar to its registered mark; to amend its trademark application and reflect this logo change, as well as to provide it with confirmation by the Intellectual Property Office of the Philippines ("IPOP HL") of the approved logo, among others. The Respondent-Applicant replied to the demand denying that the subjects mark is confusingly similar to the Opposer's.

¹ A corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines with principal address at The Garage at Rockwell, Estrella Street, Makati.

² A corporation duly organized and existing under by virtue of the laws of the Republic of the Philippines with address at 7th Floor, Renaissance Tower, Meralco Avenue, Pasig 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.

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The Opposer asserts that the Respondent-Applicant's mark is used in connection with real estate development business, more particularly in the sale and marketing of "BORACAY NEW COAST", and through the website <http://www.global-estate.ph>. Hence, the parties are engaged in the same line of business wherein the Opposer is a premier property developer for residential and commercial projects in Metro Manila. The Opposer claims to have started its operations in 1995 when it began with the development of an old thermal power plant site in Makati City into an upscale mixed-use community now known as the Rockwell Center and to have completed an office complex as well as launched a new mixed-use community called The Grove in Ortigas and its first townhouse community venture - the 205 Santolan and Proscenium at Rockwell.

The Opposer maintains that it has always delivered its projects with committed quality and that it is associated with exclusivity, high quality living, security and total community experience. It prides in having its projects regularly featured in news articles and its mark being recognized in the Philippines as a major player in the upscale real estate development business. Aside from its reputation, it boasts of its revenue amounting to P6.2B in the year ending 31 December 2011, with a resulting net income of P914.9M, and total assets valuing P18M. It further states that it maintains its own website at <http://www.e-rockwell.com> and is in actual use of its mark since its filing of its application through use in memorandum, brochures, pamphlets, office envelopes, stationary, among others.

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

1. copy of the demand letter dated 31 August 2012;
2. copy of the letter response of Respondent-Applicant dated 28 September 2012;
3. printout of the publication of the subject trademark application;
4. copy of some promotional materials of Boracay Newcoast;
5. copy of the Opposer's certificate of registration;
6. copy of the affidavit of Nestor J. Padilla;
7. copy of the front page of Rockwell's 2011 Annual Report; and
8. copies of the Opposer's pamphlets, envelopes and stationary.⁴

On the other hand, the Respondent-Applicant denies that there is likelihood of confusion between the marks "GLOBAL-ESTATE RESORTS INC. & LOGO" and "ROCKWELL & LOGO" whether applying the Holistic or the Dominancy Test. It argues that the Opposer mistakenly eludes that it copies the octagonal shape of the

⁴ Marked as Exhibits "A" to "J", inclusive.

latter's logo as the shape of the contested logo is a hexagon, closely following the shape of a diamond. It explains the design concept of its logo as follows:⁵

"29.1. The five vertical bars of varying lengths signify the diversity of the structures in GERI' tourism estates and the scope and scale of the company's business and construction activities. Each bar is solid, standing parallel to the other, symbolizing GERI's strength and stability.

29.2. The horizontal wave is a symbol of dynamism, growth and innovation. Visually, the wave represents water or nature, an important element in the company's developments. GERI values sustainability. It works in harmony with nature to create communities that reoect and interact with the environment. The wave intersects vertical bars in the center in smooth and fluid motion. This signifies the importance of seamlessly integrating different lifestyle components in one setting. The company's various tourism estates are multifaceted. In these communities, residential, recreational, hospitality, retail, retirement, wellness and nature offerings come together as a cohesive whole.

29.3. Taken from the blue color of a clear sky and a bright horizon, the logo's color represents big ideas and new perspectives. Blue symbolizes GERI's philosophy of discovering unique opportunities in the industry and doing things in a fresh new way that excites the market."

Also, the Respondent-Applicant believes that considering the class of goods covered by the marks and the magnitude of the expense involved, purchasers employ extraordinary care and prudence in their selection. It thus insists that the standard to be used is that of the ordinary intelligent buyer, one who is familiar with what he seeks to purchase.

Furthermore, the Respondent-Registrant avers that its company is the tourism development arm of the Alliance Global, Inc. ("AGI") with a vision to create integrated master-planned communities that set new standards in the country's tourism. It avows that with three thousand (3,000) hectares of prime land strategically located tourism hot spots such as Boracay, Tagaytay and Batangas, it is well-positioned to promote the country in the global scale ad drive the contribution of tourism in the growth of the economy. Currently, its projects include the Boracay blue Coast and the Twin Lakes in Tagaytay. It notes that it is marketed with clear indication of affiliation with AGI and Megaworld Corporation while the Opposer with the Lopez group. With the stark divide between the two companies, it posits that this makes it clear that they are no way connected to each other.

The evidence of the Respondent-Applicant consists of the copies of the competing marks and the news articles regarding its company.⁶

⁵ See Verified Answer to the Oppositin, p. 9.

⁶ Marked as Exhibits "1" to "3", inclusive.

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. The parties, however, refused to mediate. Accordingly, the Hearing Officer conducted a preliminary conference and the same was terminated on 31 March 2014. The parties were directed to submit their respective position papers after which, the case is deemed submitted for decision.

The records show that at the time the Respondent-Applicant filed its trademark application the Opposer already has an existing registration for "ROCKWELL & LOGO (Stylized Letter R)" issued on 28 April 2003 under Registration No. 4-1995-104847. Also, the contending marks are used on similar and/or related goods or services.

But are the marks, as shown below, confusingly similar?



ROCKWELL

Opposer's mark



GLOBAL-ESTATE RESORTS, INC.

Respondent-Applicant's mark

A practical approach to the problem of similarity or dissimilarity is to go into the *whole* of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear" may be considered.⁷ Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

The only similarity manifest in the competing marks is that they both appropriate vertical lines. Such similarity, however, is not sufficient to conclude that confusion is likely to occur. The consumers can easily distinguish the two marks. The Opposer's mark consists of six vertical lines that form an octagon. The two innermost lines form a letter "R", which is obvious and evident, that stands for the name of its company Rockwell. The Respondent-Applicant, on the other hand is

⁷ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

composed of six vertical lines that form a diamond. In addition, the latter employs several creative elements such as a wave-like horizontal line traversing the vertical lines and the use of color blue. More importantly, the competing logos are complemented with the respective names of the companies below the same, thus making the confusion even more unlikely.

Moreover, the Trademark Registry of this Office reveals several other trademarks involving real estate products and services that employ vertical lines in their trademarks. Hence, similarity in this aspect alone is not enough to prevent a junior user registration of its mark provided that the later mark is endowed with other distinguishing features and characteristics such as that of the Respondent-Applicant's. Further noteworthy, Opposer's products are not inexpensive items such that they can easily be confused with that of Respondent-Applicant's. The competing companies are engaged in real estate business and thus, their target market is discerning consumers knowledgeable of the properties involved as well as the companies they deal with making confusion, much more deception, improbable.

Finally, it is 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 and different article as his product.⁸

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-008596 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 15 September 2014.


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

⁸ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.