



LIFETIME PRODUCTS, INC.,
Opposer,

-versus-

KRISALINO SANCHEZ,
Respondent-Applicant.

X-----X

}
} **IPC No. 14-2011-000414**
} Opposition to:
} Appln No. 4-2010-011678
} Date filed: 26 October 2010
} **TM: "LIFETIME"**
}

NOTICE OF DECISION

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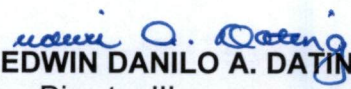
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GREETINGS:

Please be informed that Decision No. 2014 - 316 dated December 10, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 10, 2014.

For the Director:


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



LIFETIME PRODUCTS, INC.,
Opposer,

- versus -

KRISALINO SANCHEZ,
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x ----- x

IPC No. 14-2011-00414

Opposition to:

Appln. No. 4-2010-011678

Date Filed: 26 October 2010

Trademark : "LIFETIME"

Decision No. 2014 - 316

DECISION

LIFETIME PRODUCTS, INC. ("Opposer")¹ filed on 01 October 2011 a verified opposition to Trademark Application Serial No. 4-2010-011678. The application, filed by KRISALINO SANCHEZ ("Respondent-Applicant")², covers the mark "LIFETIME" for use of goods under class 19 namely: *modular partition panel, kitchen modular partition; workstation (i.e. partition panel component);* and, class 20³ namely: *office furniture particularly, office desk, office chair, office file cabinet, conference table and chairs, meeting table and chairs, shelf, computer table, computer chair, workstation (i.e. furniture component), pantry table, pantry plastic chair; wicker and wooden furniture particularly: wicker chair, wooden chair and table, wooden desk, wicker table; home furniture particularly: bed, wardrobe, sofa, dining table, dining chair, glider bench; restaurant furniture particularly: indoor and outdoor tables and chairs, plastic tables and chairs, banquet tables and chairs, folding plastic tables and chairs; storage systems particularly: drawers, cabinets, hanging shelf, storage rack."*

The Opposer alleges the following:

"Lifetime Products Inc. ('Opposer') submits that the approval of the subject application for 'LIFETIME' will damage and prejudice its rights as follows:

"a. The opposed trademark "LIFETIME" is identical and therefore confusingly similar to opposer's trademark "LIFETIME" which has been extensively used and registered worldwide, and hence, the registration of the opposed trademark can be validly prevented by Opposer under Secs. 147.1 and 147.2 of the IP Code, and must be denied under Sections 123.1 (d), 123.1(e), and 123.1 (f) of the IP Code.

"b. 'LIFETIME' is Opposer's corporate name, and hence, under Section 165 of the Intellectual Property Code ('IP Code'), it can no longer be appropriated, used and registered as a trademark by Respondent-Applicant.

"c. Opposer is a holder of numerous certificates of registration for the 'LIFETIME' trademarks issued in various countries and hence, the registration of the opposed trademark will damage Opposer, whose foreign registrations are protected under Section 134 of the IP Code.

¹ A corporation organized and existing under the laws of Utah, U.S.A., with business address at Freeport Center Bldg. D-11, Clearfield, Utah, U.S.A.

² With address at P2 Blk. 54 Lot 34, A. Bonifacio Avenue, Upper Bicutan, Taguig City.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

"d. Opposer has already identified its goods and services in the mind of the public through its well-known goods and services bearing the 'LIFETIME' trademark and hence, it is entitled to protection under Section 168.1 of the IP Code.

"e. The use of 'LIFETIME' by the Respondent-Applicant on the goods described in the subject application will inevitably indicate an association by the public with the goods of Opposer under the same trademark, and thus, its registration is proscribed under 147 of IP Code.

"f. The subject application is filed in bad faith, because there can be no reasonable explanation to the adoption and coinage of the word 'LIFETIME' by Respondent-Applicant as to merit its coinage, and hence, the interference, as held in McDonalds Corp. vs. MacJoyFastfood Corp. and Converse Rubber Corporation vs. Universal Rubber Products, Inc., is that 'LIFETIME' was chosen deliberately by Respondent-Applicant to deceive the public, and as held in Shangri-La International Hotel Management, Ltd. vs. Developers Group of Companies, Inc., to take advantage of the goodwill of Opposer's well-known 'LIFETIME' trademark.

"g. The registration of 'LIFETIME' in favor of Respondent-Applicant will result in trademark dilution as it will diminish the distinctiveness of Opposer's well-known 'LIFETIME' mark.

x x x

"The origin and the first use of the 'LIFETIME' trademark of the Opposer.

"14. Opposer is the first to use the name 'LIFETIME' since 1986, the time Opposer adopted the name LIFETIME PRODUCTS, INC. It has been in use since then and has also been seen in products distributed all over the world.

"15. To date, Opposer has the following trademark registrations worldwide.

x x x

"16. Opposer's earliest registration is for the mark LIFETIME PRODUCTS filed in Canada on November 16, 1990 and issued on November 29, 1991.

"17. The mark 'LIFETIME' has become internationally well-known by reason of its long record of continued use, the numerous trademark applications and registrations which issued for the said trademark in many countries worldwide, and their publicity and promotion.

x x x

"Fame and notoriety of LIFETIME arising from extensive use and advertising and from its overwhelming global patronage.

"20. To maintain the goodwill and fame of the LIFETIME, Opposer continues to advertise said trademarks. The worldwide popularity and reputation of LIFETIME preceded the filing by Respondent-Applicant of the subject application.

x x x

"23. Because of Opposer's aggressive worldwide sales, promotions and advertising, Opposer's trademarks LIFETIME is not only well-known in the US but in other parts of the world as well.

"24. Opposer also operates the websites www.lifetime.com and www.buylifetime.com. Visitor's to these websites include Internet users and customers from all parts of the world

including the Philippines. The said websites serve as powerful advertising media for the trademarks LIFETIME.

"25. Opposer has also prominently and consistently advertised the LIFETIME trademark in numerous media and publications include television, print media and Internet.

The Opposer's evidence consists of the following:

1. Exhibit "A" - Affidavit of Brent R. Allen, Vice-President of Operations of Lifetime Products, Inc.;
2. Exhibit "B" - Affidavit of Amando S. Aumento Jr., an Associate Lawyer of Federis & Associates Law Offices;
3. Exhibit "C" - Legalized Special Power of Attorney executed by Opposer;
4. Exhibit "D" - Legalized Articles of Incorporation and Amendments;
5. Exhibit "E" - Legalized certificate of existence of Lifetime;
6. Exhibit "F" - Certificates of trademark registrations for Lifetime in China, USA, Mexico, Canada, Brazil, Korea, Australia, Argentina, Japan and with the OHIM;
7. Exhibit "G" - List of Lifetime's distributors worldwide;
8. Exhibit "H" - List of Lifetime's distributors in the USA;
9. Exhibit "I" - Printouts of the website of Lifetime (www.lifetime.com) ;
10. Exhibits "J"- "J-1"- Copies of Philippine Certificates of Trademark Application Nos. 4-2011-001872 (LIFETIME) and 4-2011-001869 (LIFETIME DESIGN) issued by the IPOPhl;
11. Exhibit "K" - Photographs of genuine Lifetime products;
12. Exhibit "L" - Actual receipt covering purchase of Lifetime products;
13. Exhibit "M" - Product Catalogue/brochure of Lifetime products;
14. Exhibit "N" - Sales Invoices showing that Lifetime's products have been continually shipped, sold and marketed in the Philippines; and,
15. Exhibit "O" - Copies of magazines, internet articles and other publications of the mark LIFETIME.

On 14 February 2012, Respondent-Applicant filed its Answer containing among others the following allegations:

"Opposer's Opposition should be dismissed for failure to file a verified opposition.

"20. Opposer's Verification is defective for the following reasons:

20.1. The verification was signed by a person not properly authorized by Opposer.

x x x

20.2. Opposer's counsel has no personal knowledge of the facts alleged in the Opposition.

x x x

20.3. From the foregoing, the Opposition should be dismissed for failure to sufficiently comply with the requirements laid down in Section 7 (a) of the Office Order No. 99, Series of 2011 of this Honorable Office.

20.4. The Supreme Court has had occasion to rule that the nature of a verification being a formal not jurisdictional requirement, does not detract from the fact that it is

nevertheless a requirement. A party's reliance on liberal construction of the rules does not justify utter disregard of the same. The case states, thus:

"Respondent-Applicant's IPO application for the trademark 'LIFETIME' should not be denied on the grounds found under Sections 123.1 (d), 123.1 (e) and 123.1 (f) of the IP Code.

"Respondent-Applicant's 'LIFETIME' is not identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date. [Sec. 123.1 (d) of the IP Code].

"Opposer's applications should be suspended. [Rule 605 of the Trademark Regulations: Order of Trademark Applications].

"Respondent-Applicant's 'LIFETIME' trademark is not identical with or confusingly similar to a well-known mark. [Section 123.1 (e)].

"Respondent-Applicant's 'LIFETIME' trademark is not identical with or confusingly similar to a well-known trademark registered in the Philippines. [Section 123.1 (f) of the IP Code]

"LIFETIME is not the Opposer's Corporate Name nor Tradename.

"Section 134 of the IP Code is not one of the grounds provided for by law for the denial of the registration of application of the Respondent-Applicant.

"Opposer does not have a protected goodwill over the LIFETIME mark, and as such, is not entitled to protection under Section 168.1 of the IP Code.

"Opposer is not the registered owner of the 'LIFETIME' and Opposer has not established that it is the owner of well-known mark.

"Respondent-Applicant's application for registration of the trademark 'LIFETIME' was filed in good faith.

"Registration of Respondent-Applicant's 'LIFETIME' trademark will not cause the dilution of the Opposer's alleged trademark."

The Respondent-Applicant's evidence consists of the following:

1. Exhibit "1" - Certificate of Registration No. 4-2009-008903 for the mark LIFETIME dated 03 December 2010;
2. Exhibit "2" - Registrability Report, Paper No. 02 for the mark LIFETIME; and,
3. Exhibit "2-1" - Paper No. 04 for the mark LIFETIME.

In this connection, Position Papers were submitted by parties on 20 September 2012. Hence, this case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark LIFETIME?

Firstly, the Respondent-Applicant raised the issue that the instant opposition should be dismissed on the ground that the notice of opposition was not verified by the Opposer. According to the Respondent-Applicant, the person who executed the Verification and Certification Against Forum

Shopping was signed by a person not properly authorized by herein Opposer, without personal knowledge of the facts alleged in this instant opposition.⁴

The records show that Brent R. Allen, the Vice President of Operations for herein Opposer LIFETIME PRODUCTS, INC., executed a duly authenticated and legalized Special Power of Attorney⁵ in favor of the FEDERIS & ASSOCIATES Law Offices or any of its assigned lawyers. In this regard, Amando S. Aumento Jr., Associate Attorney of FEDERIS & ASSOCIATES Law Offices, executed the verification and non-forum shopping certification of the instant Notice of Opposition. He likewise executed an affidavit stating among others to have studied and examined the facts and issues in this instant case, made researches from office records, public records and pertinent internet information.⁶

In the case of *Canan v. Evangelical Free Church of the Philippines*⁷, the Supreme Court upheld the subsequent submission of the authority granted to respondent's counsel to sign the certification as substantial compliance. It ruled that:

"Circular 28-91 was prescribed by the Supreme Court to prohibit and penalize the evils of forum shopping. We see no circumvention of this rationale if the certificate was signed by the corporation's specifically authorized counsel, who had personal knowledge of the matters required in the Circular. x x x

Indeed, while the requirement as to certificate of non-forum shopping is mandatory, nonetheless the requirements must not be interpreted too literally and thus defeat the objective of preventing the undesirable practice of forum shopping."

Applying the same in the instant case, the documents consisting of the Affidavit⁸ and the Special Power of Attorney⁹ executed by Brent R. Allen, and the verification and certification executed by Atty. Aumento Jr.,¹⁰ amounts to substantial compliance which calls for the relaxation of the rules of procedure.¹¹

Going to the merits of the case, the contending marks are obviously identical, both carrying the trademark LIFETIME, without any substantial difference in their font, device and manner of display. Moreover, the Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's, which flow on the same channels of trade and both, particularly that falling under Class 20, and the relatedness of Classes 20 and 28. Thus, it is likely that the consumers will have the impression that these goods or products originate from a single source or origin. 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, to wit:¹²

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. Hence, 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

⁴ pp. 5-7, Verified Answer.

⁵ Dated 18 March 2011; Exhibit "B" of Opposer.

⁶ Exhibit "B" of Opposer.

⁷ G.R. No. 157573, 11 February 2008, citing *BA Savings Bank v. Sia*, 336 SCRA 484 (2000).

⁸ Exhibit "A" of Opposer.

⁹ Id. at 4.

¹⁰ Id. at 5.

¹¹ *Mary Louise Anderson v. Enrique Ho*, G.R. No. 172590, 07 January 2013.

¹² *Converse Rubber Corporation v. Universal Rubber Products Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

would then be deceived either into that belief or into belief that there is some connection between the plaintiff which, in fact does not exist.

The public interest, therefore, requires that the 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. 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.¹³

It is stressed that the Philippines implemented the TRIPS Agreement when the IP Code took into force and effect on 01 January 1998. Art. 15 of the TRIPS Agreement reads:

Section 2: Trademarks
Article 15
Protectable Subject Matter

1. Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words, including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration of trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, members may make registrability depend on distinctiveness acquired through use. Member may require, as a condition of registration, that signs be visually perceptible.
2. Paragraph 1 shall not be understood to prevent a Member from denying registration of a trademark on other grounds, provided that they do not derogate from the provision of the Paris Convention (1967).
3. Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application.
4. The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to registration of the trademark.
5. Members shall publish each trademark either before it is registered or promptly after it is registered and shall afford a reasonable opportunity for petitions to cancel the registration. In addition, Members may afford an opportunity for the registration of a trademark to be opposed.

Article 16 (1) of the TRIPS Agreement states:

1. The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

¹³

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

The rights prescribed above shall not prejudice any existing prior rights, not shall they affect the possibility of Members making rights available on the basis of use.

Significantly, Sec. 121.1 of the IP Code adopted the definition of the mark under the old Law on Trademark (Rep. Act No. 166), to wit:

121.1. "Mark" means any visible sign capable of distinguish the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods; (Sec. 38, R.A. No. 166a)

Sec. 122 of the IP Code states:

Sec. 122. How Marks are Acquired. - The rights in a mark shall be acquired through registration made validly in accordance with the provision of this law. (Sec. 2-A, R.A. No. 166a)

There is nothing in Sec. 122 which says that registration confers ownership of the mark. What the provision speaks of is that the rights in a mark shall be acquired through registration, which must be validly in accordance with the provision of the law.

Corollarily, Sec. 138 of the IP Code provides:

Sec. 138. Certificates of Registration. - A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate. (Emphasis Supplied)

Clearly, it is not the application or the registration that confers ownership of a mark, but it is ownership of the mark that confers the right to registration. While the country's legal regime on trademarks shifted to a registration system, it is not the intention of the legislators not to recognize the preservation of existing rights of trademark owners at the time the IP Code took into effect.¹⁴ The registration system is not to be used in committing or perpetrating an unjust and unfair claim. A trademark is an industrial property and the owner thereof has property right over it. The privilege of being issued a registration for its exclusive use, therefore, should be based on the concept of ownership. The IP Code implements the TRIPS Agreement and therefore, the idea of "registered owner" does not mean that ownership is established by mere registration but that registration establishes merely a presumptive right of ownership. That presumption of ownership yields to superior evidence of actual and real ownership of the trademark and to the TRIPS Agreement requirement that no existing prior rights shall be prejudiced. In *E.Y. Industrial Sales, Inc. and Engracio Yap v. Shen Dar Electricity Machinery Co. Ltd.*¹⁵, the Supreme Court held:

RA 8293 espouses the "first-to-file" rule as stated under Sec. 123.1(d) which states:

x x x

Under this provision, the registration of a mark is prevented with the filing of an earlier application for registration. This must not, however, be interpreted to mean that ownership should be based upon an earlier filing date. While RA 8293 removed the previous requirement of proof of actual use prior to the filing of an application for registration of a mark, proof of prior and continuous use is necessary to establish ownership of a mark. Such ownership constitutes sufficient evidence to oppose the registration of a mark.

¹⁴ See Sec. 236, IP Code.
¹⁵ G.R. No. 184850, 20 October 2010.

Sec. 134 of the IP Code provides that "any person who believes that he would be damaged by the registration of a mark x x x" may file an opposition to the application. The term "any person" encompasses the true owner of the mark, the prior and continuous user.

Notably, the Court has ruled that the prior and continuous use of a mark may even overcome the presumptive ownership of the registrant and be held as the owner of the mark. As aptly stated by the Court in Shangri-la International Hotel Management, Ltd. v. Developers Group of Companies, Inc.

Registration, without more, does not confer upon the registrant an absolute right to the registered mark. The certificate of registration is merely a prima facie proof that the registrant is the owner of the registered mark or trade name. Evidence of prior and continuous use of the mark or trade name by another can overcome the presumptive ownership of the registrant and may very well entitle the former to be declared owner in an appropriate case.

In this instance, the Opposer proved that it is the owner of the contested mark. It has submitted evidence relating to the origin of its LIFETIME trademark since 1986, long before the filing of the Respondent-Applicant's trademark application. Among the pieces of evidence are the affidavit of its witness¹⁶, Articles of Incorporation and Amendment¹⁷, Certificates of existence of LIFETIME in good standing with registered date on 17 March 1986, and dated 17 March 2011¹⁸, Certificates of trademark registration in various foreign countries¹⁹, Print-outs of LIFETIME website²⁰, product Catalogue/brochure²¹, and articles on magazines and other publications²² where the mark LIFETIME appears and which are all prior to Respondent-Applicant's trademark application. More importantly, Opposer has proved its actual presence and operation in the Philippines, evidenced by the Sales Receipts²³ covering the purchase of LIFETIME products, and the Sales Invoices,²⁴ showing the continuous shipment, sales and marketing of its products bearing the trademark LIFETIME.

In addition, this Bureau concurs with the contention of herein Opposer that the subject mark LIFETIME appears prominent in Opposer's tradename²⁵, LIFETIME PRODUCTS, INC. As such, Sec. 165 of the IP Code protects the prior user, which in this case is the Opposer, even prior to or without registration of said tradename, to wit:

165.1. A name or designation may not be used as a trade name if by its nature or the use to which such name or designation may be put, it is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

165.2. (a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

¹⁶ Exhibit "B" of Opposer.

¹⁷ Exhibit "D" of Opposer.

¹⁸ Exhibit "E" of Opposer.

¹⁹ Exhibit "F" of Opposer.

²⁰ Exhibit "I" of Opposer.

²¹ Exhibit "M" of Opposer.

²² Exhibit "O" of Opposer.

²³ Exhibit "L" of Opposer.

²⁴ Exhibit "N" of Opposer.

²⁵ Sec. 121.3, IP Code 'Tradename' means the name or designation identifying or distinguishing an enterprise.

In contrast, the Respondent-Applicant's explanation in adopting and using the trademark LIFETIME, giving a "lifetime warranty" on four (4) sets of its products,²⁶ is not supported by any evidence. The mark LIFETIME is unique and highly distinctive with respect to the goods it is attached with. It is incredible for the Respondent-Applicant to have come up with the same mark practically for similar goods by pure coincidence.

Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why, of the million of terms and combination of letters and designs available, the Respondent-Applicant had to 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 mark.²⁷

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-011678 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, 10 December 2014.


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

²⁶

par. 54, p. 26, Verified Answer.

²⁷

American Wire & Cable Company v. Director of Patents, G.R. No. L-26557, 18 February 1970.