



SOCIETE DES PRODUITS NESTLE S.A.,
Opposer,

-versus-

LIWAYWAY MARKETING CORPORATION,
Respondent-Applicant.

}
} **IPC No. 14-2012-00476**
} Opposition to:
} Appln No. 4-2012-008574
} Date Filed: 13 July 2012
} **TM: "MARTY'S"**
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NOTICE OF DECISION

SAPALO VELEZ BUNDANG & BULILAN

Counsel for the Opposer
11th Floor, Security Bank Centre
6776 Ayala Avenue, Makati City

PADLAN SALVADOR COLOMA & ASSOCIATES


Counsel for Respondent-Applicant
Suite 307, 3rd Floor, ITC Building
337 Sen. Gil Puyat Avenue, Makati City

GREETINGS:

Please be informed that Decision No. 2015 - 49 dated April 06, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 06, 2015.

For the Director:


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



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IPC No. 14-2012-00476

Opposition to:

Appln. Serial No. 4-2012-008574

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Trademark: **"MARTY'S"**

X ----- X

Decision No. 2015- 49

DECISION

Societe Des Produits Nestle, S.A.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-008574. The contested application filed on by Liwayway Marketing Corporation² ("Respondent-Applicant") covers the mark "MARTY'S" for use on *"preserved, dried and cooked fruits and vegetables; jellies, jams; eggs; milk and other dairy products; edible oils, fats; preserves, pickles; meat, fish, poultry and game; meat extracts"* under Class 29 and *"coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals, breads, biscuits, cakes, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard; pepper, vinegar, sauces; spices; ice"* under Class 30³.

The Opposer alleges that it first used in the Philippines its mark "SMARTIES" on 15 March 1991 and holds Certificate of Registration Nos. 063865, 4-1998-400853 and 4-2004-003601 issued on 15 November 1996, 06 January 2006 and 22 January 2007, respectively, for its "SMARTIES" marks here in the Philippines. according to the Opposer, it has more or less fifty (50) pending applications and/or existing registrations abroad and that the "SMARTIES" mark is well-known internationally and in the Philippines.

The Opposer now claims that the marks "SMARTIES" and "MARTY'S" are confusingly similar, both comprised of the letters "M", "A", "R" and "T". It contends that despite the Respondent-Applicant's deletion of the letter "S" in the beginning and the substitution of the letter "Y" for the letters "I" and "E", there is no substantial alteration of the applied mark. It asserts that the contending marks sound similar and that the likelihood of confusion and deception is even greater since its goods and that of the Respondent-Applicant are similar and/or related. It alleges that the latter's mark will indicate a connection with the goods covered by "SMARTIES, thus, its interests will likely be damages.

¹ A corporation duly formed under the laws of Switzerland with business address at Vevey, Switzerland.

² With address at 2225 Tolentino Street, Pasay City, Metro Manila, Philippines.

³ Per NICE International Classification of Goods and Services.

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center, 28 Upper McKinley Road, McKinley Hill Town Center
Fort Bonifacio, Taguig City 1634 Philippines

T: +632-2386300 • F: +632-5539480 • www.ipophil.gov.ph

In support of its opposition, the Opposer submitted the following:⁴

1. copy of the 15th Declaration of Actual Use (DAU) for Registration No. 63865;
2. copies of Certificates of Registration Nos. 063865, 4-1998-400853 and 4-2004-003601;
3. printout of the E-Gazette publishing the "MARTY'S" mark;
4. affidavit of Atty. Dennis R. Barot with annexes;
5. printout of advertising and promotional materials including from that of its websites;
6. p compact disc containing television commercials; and
7. copy of its financial statement for 2010 and 2011.

The Respondent-Applicant filed its Answer on 27 May 2013 alleging that was issued Certificate of Registration No. 4-2009-006537 on 01 January 2010 for the mark "MARTY'S". Its present application is merely a re-registration because the registration was cancelled due to non-filing of the requisite Declaration of Actual Use ("DAU"). It avers that it also registered "MARTY'S CRACKLING & DEVICE" under Certificate of Registration No. 4-2008-012898 issued on 16 March 2009 and that it also registered its mark in other countries.

According to the Respondent-Applicant, "MARTY'S" is visually, aurally and conceptually different from the Opposer's "SMARTIES" mark. The latter begins with the letter "S" and that the average consumer will more likely remember the first letter of the mark. It asserts that the letter "S" produces a distinctive and striking sound. While the "S" is sometimes dropped or is inaudible, it is inconceivable that "SMARTIES" will be pronounced as "MARTIES" as the said word is obviously derived from the English word "SMART". It furthers that for its mark, the root word is "MARTY" which is a known name for males. It also cites the decision of the United Arab Emirates Intellectual Property Office ("UAE IPO") which dismissed a similar opposition filed by the Opposer of the "MARTY'S" trademark on the ground that there was no confusing similarity between the marks.

The Respondent-Applicant also contends that the Opposer's mark "SMARTIES" is known to be used only with respect to sugar-coated chocolate confectionery and no other while its "MARTY'S" mark is for snack food. It also maintains that both products prominently display the name of their respective manufacturers. It alleges that its marks "MARTY'S" and "MARTY'S CRACKLING & DEVICE" are among the popular trademarks for snack food it markets in the

⁴ Marked as Exhibits "A" to "I".

Philippines and abroad under its house mark "OISHI". It used its mark in the Philippines as early as November 2008; in Canada since July 2009; in Israel since November 2009; in United States since February 2010; in China since September 2010; and, in Italy since September 2010. According to the Respondent-Applicant, the mark "MARTY'S" is so extensive that its goods are on sale nationwide in big, medium or small groceries and department stores and that the same is widely advertised and promoted.

The Respondent-Applicant's evidence consists of:⁵

1. affidavit of Mr. Salvador C. Aguilar;
2. certified true copy of the Certificate of Filing of Amended Articles of Incorporation and Amended By-Laws of Liwayway Marketing Corporation;
3. printouts from the website wikipilipnas.com showing the history and other information of its company;
4. printouts from <http://oishi.com.ph> depicting samples of various snack food products of the Respondent-Applicant;
5. copy of Certificate of Registration No. 4-2008-012898;
6. copy of Certificate of Registration No. 4-2009-006537;
7. sample of "MARTY'S" trademark packaging material;
8. sample of sales invoice showing local sales of its "MARTY'S" products for years 2008-2012;
9. advertisement and promotional materials for its products;
10. copies of its trademark registrations in Australia, Canada, Cambodia, Laos, Myanmar, UAE and Taiwan; and
11. copy of the decision of UAE IPO (Department of Trademarks) and the certified true and correct English translation of the said decision.

The issue to be resolved is whether the Respondent-Applicant's mark "MARTY'S" should be allowed registration.

Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that a mark cannot be registered if it:

"(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

(i) The same goods or services, or

⁵ Marked as Exhibit "2" to "13", inclusive.

- (ii) Closely related goods or services, or
(iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion; x x x"*

Records reveal that at the time Respondent-Applicant filed its application for registration of the contested mark "MARTY'S" on 13 July 2012, the Opposer already has a valid and existing registrations for its "SMARTIES" trademarks under Certificate of Registration Nos. 063865, 4-1998-400853 and 4-2004-003601 issued on 15 November 1996, 06 January 2006 and 22 January 2007, respectively.

For comparison, the competing marks are reproduced below:



S M A R T I E S

SMARTIES

Opposer's marks

MARTY'S

Respondent-Applicant's mark

When one looks at the Opposer's mark "SMARTIES", the adjective "SMARTY" or "SMART" is what is retained in the eyes and in the mind. This is because of the prominence and the stress given to the letter "S" before the letter "M". the letter "S" alone comprises a syllable itself, which clearly confer visual and aural juxtaposition which could easily be distinguished from "MARTY'S". On the other hand, the Respondent-Applicant's mark gives the impression that the product is "of Marty" or "by Marty". The name "MARTY" is the prevalent feature thereof and no connection can likely be assumed with the "SMARTIES" mark of the Opposer's. Thus, despite the fact that the competing marks both includes the

letters "MART", the same pale in significance. Overall, "SMARTIES" and "MARTY'S" are easily and readily distinguishable visually, aurally as well as in connotation.

As to the Opposer's claim that its mark is well-known, this is now immaterial in this case. The protection accorded to well-known marks applies only when there is a finding of confusing similarity between the competing marks.

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.⁶ The Respondent-Applicant's mark substantially met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application No. 4-2012-008574 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 06 April 2015.


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

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.