

SHELL BRANDS INTERNATIONAL AG,
Opposer,

-versus-

ALTACROP PROTECTION CORPORATION,
Respondent-Applicant.

X-----X

IPC No. 14-2013-00448

Opposition to:

Appln. Serial No. 4-2011-00011764

Date Filed: 30 September 2011

**TM: "SHELTER TRUSTED
SHELL-BLEND 2, 4-D"**

NOTICE OF DECISION

BARANDA & ASSOCIATES

Counsel for the Opposer
Suite 1002-B Fort Legend Towers
3rd Avenue corner 31st Street
Bonifacio Global City, 1634 Taguig City

FELICILDA & ASSOCIATES [CildaLaw]

Counsel for Respondent-Applicant
Unit 1902 -A Philippine Stock Exchange (PSE)
Centre-East Tower, Exchange Road
Ortigas Center, Pasig City

GREETINGS:

Please be informed that Decision No. 2016 - 17 - dated January 06, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 06, 2016.

For the Director:


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

SHELL BRANDS INTERNATIONAL AG, } **IPC NO. 14-2013-00448**
Opposer, } Opposition to:
-versus- } Appln. No. 4-2011-00011764
} Date filed: 30 September 2011
} **ALTACROP PROTECTION CORPORATION,** } **Trademark: "SHELTER**
Respondent-Applicant. } **TRUSTED SHELL- BLEND**
} **2,4-D"**
x-----x } Decision No. 2016- **17**

DECISION

SHELL BRANDS INTERNATIONAL AG, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2011-00011764. The application, in the name of ALTACROP PROTECTION CORPORATION (Respondent-Applicant)², covers the mark "SHELTER, TRUSTED SHELL-BLEND 2, 4-D", for use on "fertilizers" under Class 1 and "insecticides, fungicides, and molluscicides, herbicide-pre-emergent herbicide of excellent control of commonly occurring broadleaf weeds, grasses and edges in transplanted and direct seeded rice" under Class 5 of the International Classification of Goods³.

In support of the opposition, the Opposer relies on the following grounds:

"3. The Opposer will be damaged by the registration of the application and respectfully submits that the Application will be denied for the reasons set forth below.

"4. The Opposer is entitled to the benefits granted to foreign nationals under Section 3 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ('IP Code'): xxx

¹ A corporation duly organized and existing under the laws of Switzerland with address at Baarermatte, 6340 Baar, Switzerland

² A domestic corporation duly organized and existing under Philippine laws with business address at Unit 403 Marcelita Building, 2560 National Highway, Brgy. Real, Calamba, Laguna

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

"5. The Opposer is the registered owner of several SHELL marks and SHELL DEVICE in the Philippines, and is thereto entitled to the exclusive use of the mark. Section 138 of the IP Code States:

Section 138. 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 of 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.

" The registration of the Application violates Section 123.1 (a), (d), (e) and (f) of the IP Code which expressly prohibit the registration of a mark if it is:

"6.1. Consists of

"6.2. 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 (ii) closely related goods or services, or (iii) if it nearly resembles a mark as to be likely to deceive or cause confusion (section 123.1. (d) of the IP Code);

"6.3. Identical with, or confusingly similar to, or constitutes a translation of a mark with which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark (section 123.1 (e) of the IP Code);

"6.4. Identical with or confusingly similar to, or constitutes a translation of a mark, considered well known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods and services which are not similar to those with respect to which registration is applied for: *Provided*, that the use of the mark in relation to the goods or services would indicate a connection between those goods or services, and the owner of the registered mark: *Provided* further, that the interests of the owner of the registered mark are likely to be damaged by such use.

"7. In addition, both the Philippines and the Switzerland, where the Opposer was organized and registered, are members of the Paris Convention for the Protection of Industrial Property and the WTO Trips Agreement. xxx

"8. The WTO TRIPS Agreement widens the scope of protection of well-known marks by enjoining unauthorized use of these marks on dissimilar goods/service: xxx"

The Opposer relies among others, on the following facts and discussion:

"27. The Shell group holds about 8,000 registrations and applications for its SHELL marks in different jurisdictions worldwide. Details of the registrations for SHELL printed in the online websites of the respective Intellectual Property Offices in the United States, Singapore, Europe, Australia and Hong kong are attached.xxx

The earliest registration for the MUSSEL SHELL DEVICE which includes the text mark SHELL was in the United Kingdom with the following details:

Mark	:	SHELL AND DEVICE
Registration No.	:	233532
Registration Date	:	10 October 1900
Filing Date	:	10 October 1900
Goods/Services	:	Oils for illuminating, heating and lubricating, all for sale in the United Kingdom of Britain and Northern Island only

"28. In the Philippines, the Opposer owns the following registrations for SHELL marks xxx

"30. In IPC No. 14-2007-00356, the Bureau of Legal Affairs found that the dominant feature of the mark SHELL 2, 4-D AMINE is SHELL, which is registered mark of the Opposer. Therefore, SHELL 2, 4-D AMINE cannot be allowed registration.

"31. In a decision in Greece Case No. 6925/2007, Zois Efstathiou Shipping Items Tradeing Co Et Al applied to register the trademark SHELLBACKS for pleasure craft products and was opposed by Shell. The court stated that the Opposer's SHELL mark is well-known and enjoined the applicant from using the trademark SHELLBACKS.

"32. In Taiwan case no. 479110, Lui Ying Min applied to register the mark SHELL AND DEVICE for spectacles and spectacles for short-sightedness and was opposed by Shell International Petroleum Group Limited. The Registry held that the SHELL marks are generally recognised by consumers as belonging to Shell. The applicant's mark was deemed likely to cause confusion to the public. xxx

"37. The remaining components of the mark are therefore SHELTER and SHELL. The term 'SHELTER' is confusingly similar with the

Opposer's well-known mark SHELL as it contains the prevalent features of the mark. The first four letters of 'SHELTER' are exactly the same as those of 'SHELL'. When the words 'SHELTER' and 'SHELL' are said aloud, the aural effect is closely alike. xxx

"42. The goods covered by the Application are also identical and/or related to the goods covered by the Opposer's business. The Opposer has obtained registrations in the Philippines and worldwide for various marks covering 'chemicals for use in agriculture, horticulture and forestry'. xxx

"44. The goods covered by Respondent-Applicant's mark flow through the same channels of trade as that of the Opposer's marks as both relate to chemicals in the field of agriculture, horticulture and forestry. The risk of confusion is aggravated by the fact that Opposer's SHELL marks, products and services have been in the market for many years in the Philippines and have established a strong reputation in the chemicals and oil industry. xxx

The Respondent-Applicant has filed the mark SHELTER, TRUSTED SHELL-BLEND 2, 4-D for goods in classes 1 and 5 in bad faith

"58. It is evident that Respondent-Applicant has copied the SHELL mark from the Opposer and the Respondent-Applicant is aware of the Opposer's SHELL trademarks and goods. In fact, one of the Incorporators and Directors of the Respondent-Applicant and now its current President, Wendell T. Garcia, is a former employee of Opposer's subsidiary Shell Chemicals Company of the Philippines.

"59. Mr. Garcia was hired by Shell Chemicals Company of the Philippines in 23 November 1982 and his last payroll date was 19 September 1994 as shown in the document below: xxx

"60. The incorporation of the Opposer's mark SHELL in Respondent-Applicant's mark SHELTER, TRUSTED SHELL-BLEND 2, 4-D is not a mere coincidence but is a blatant attempt to ride on the goodwill of the Opposer and its SHELL marks. xxx"

To support its opposition, the Opposer submitted as evidence the following:

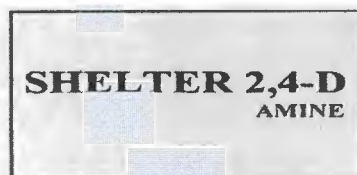
1. Verified Notice of Opposition dated 3 January 2014;
2. Special Power of Attorney dated 4 December 2013;
3. Affidavit of Robert James Carter dated 6 December 2013
4. Print-out of websites showing facts, history, business, products and services of Shell Group;

5. Compilation of Interbrand rankings;
6. List of SHELL applications and registrations worldwide;
7. Website print-out of registrations in the United States, Singapore, OHIM, Australia, Hongkong, Philippines;
8. Copy of decisions on enforcement of SHELL marks in the Philippines, Greece, Taiwan;
9. Amended Articles of Incorporation and General Information Sheet of Respondent-Applicant; and
10. Payroll of Mr. Wendell T. Garcia⁴

The Respondent-Applicant filed its Answer on 16 April 2014, alleging among other things, the following affirmative and special defenses:

“7. The subject application - SHELTER, TRUSTED SHELL-BLEND 2, 4-D- is a reiteration, simulation and in a sense a derivation, i.e. a 'derivative mark' from Respondent's existing trademark- SHELTER 2, 4-D AMINE trademark, shown below:

SHELTER 2, 4-D AMINE under
Certificate of Registration No. 4-2007-010899 shown below:



“9. In line with the current branding and marketing practices of any commercial venture expanding its business, a corporation such as Respondent herein, would devise, adopt and appropriate a reiteration, simulation or derivation of a previously registered mark (SHELTER 2, 4-D AMINE) to create a derivative mark or a submark, herein SHELTER, TRUSTED SHELL-BLEND 2, 4-D/SHELTER MARK and apply the same on another range of products and/or sub-products, in this case, a new set of fertilizers, herbicides, insecticides, fungicides and molluscides.

“10. The trademark SHELTER 2, 4-D AMINE is registered for Class 5 (herbicides) and has actual commercial use since 2007. Good patronage of SHELTER 2, 4-D AMINE herbicide products prompted the Respondent

⁴ Exhibits "A"-"WW"

Altacrop protection Corp. to launch another range of fertilizer, herbicides, insecticides, fungicides and molluscicides products under the SHELTER, TRUSTED SHELL-BLEND 2, 4-D trademark.

“11. The sound and pronunciation of the SHELTER , TRUSTED SHELL-BLEND 2, 4-D is simply derived, simulated, replicated and/or taken from the SHELTER 2, 4-D AMINE, a previously registered trademark under the name of the Respondent itself.

“12. SHELTER 2, 4-D AMINE is also a current and live trademark with the Bureau of Trademarks which this Honorable Office can take judicial notice of.

“13. The SHELTER , TRUSTED SHELL-BLEND 2, 4-D trademark and the products covered by the same- fertilizers, herbicides, insecticides, fungicides, and molluscicides- are therefore, but a natural, normal and customary consequence of an expanding product line and consequently, increasing trademark portfolio of any thriving business such as the Respondent.xxx

“15. In fact, the Registrability Report of herein trademark application attached as marked herein as 'Exhibit '8') never cited the reportedly internationally well-known 'Shell trademark of Opposer Shell Brands International AG xxx

“16. The SHELTER word mark (from SHELTER , TRUSTED SHELL-BLEND 2, 4-D) is clearly different in sound, pronunciation, spelling even in definition or connotation as against Opposer’s Shell mark. Also, by definition, reference or connotation, Shell and Shelter have different meanings or reference. ‘Shell’ is commonly defined by dictionaries as ‘a hard outer covering’ i.e. a nutshell, the shell of a tortoise seashell’. On the other hand, ‘SHELTER’ when applied to fertilizers and herbicides, fungicides and molluscicides is a word/mark meant to represent a ‘place that gives protection from the weather or safety from danger’.

“17. As the brand or mark for Respodent's fertilizers and herbicides products, the latter -SHELTER- provides protection and safety against unwanted pests, weeds, crop diseases in a farmer's land or lot, hence, the distinctive mark 'SHELTER'.

“18. Also, Opposer's 'Shell' mark is represented by a Pecton Device similar to sea shells one finds on beach sand. Arguably, the Shell mark and its Pector/Shell Device is generally recognized by consumers or the

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MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

public as belonging to Opposer, with that consumers or public having in mind oil, gas, diesoline, fuel and its derivative products NOT to fertilizers, herbicides, insecticides, fungicides, molluscicides products for which the Respondent's SHELTER applied for.

"19. There is no concrete evidence on record that the Filipino consumers or the public identify the Shell mark of the Opposer to fertilizers, herbicides, insecticides, fungicides, molluscicides products much more , to every goods, products or even any and all services offered in the market.

"20. In fact most, if not all, the documentary evidence of the Opposer in this Opposition relates and/or deals with oil (also natural gas) and oil derivative products (fuel and lubricants), service stations and hyped global stature and repute. xxx

"33. A generic or descriptive word may be part of a composite mark or trade name. That does not make the generic or descriptive word necessarily non-generic or non-descriptive. For this reason, the use of a generic word which forms part of a trademark or trade name is always subject to the limitation that the registrant does not acquire the exclusive right to the descriptive or generic term or word.xxx"

"35. For the information of the Opposer, Respodent is simply seeking the registration of the mark-SHELTER- in the subject application and for its peace of mind, the 'Trusted', 'Shell-blend' and '2, 4-D' elements are hereby disclaimed.xxx

"No bad faith in the adoption and prosecution of the SHELTER mark by herein Respondent Altacrop

"42. It must be re-emphasized that Respondent Altacrop is the owner-registrant of a previously registered mark- SHELTER 2, 4-D AMINE for herbicides under Class 5.

"43. Said SHELTER 2, 4-D AMINE has been registered since 23 march 2009, whose herbicide products have been in actual commercial use since 2007. The same is a current and live trademark with the Bureau of Trademarks.

"44. Respondent's expanding fertilizer and herbicide business necessarily demands an expanding trademark line or portfolio, hence, the adoption, filing and prosecution of herein reiteration, simulation and

derivative mark- SHELTER, TRUSTED SHELL-BLEND 2, 4-D- for another range of Class 1 and Class 5 products.

To support its Answer, the Respondent-Applicant submitted as evidence the following:

1. Affidavit of Wendell T. Garcia dated 31 March 2014;
2. Amended Articles of Incorporation of Altacrop Protection Corporation;
3. Certificate of Incorporation of Altacrop Protection Corporation;
4. Certified true copy of Trademark Registration No. 4-2007-010899 for the mark "SHELTER 2, 4-D AMINE" issued to Altacrop Protection Corporation on 23 March 2009;
5. Sample label of "SHELTER 2, 4-D AMINE";
6. Registrability Report issued by the Bureau of Trademarks dated 21 November 2011; and
7. Notice of Allowance dated 2 August 2013⁵

The Preliminary Conference was held on 10 September 2014 wherein the parties were directed to file their position papers. Both parties submitted their position papers on 23 September 2014.

Should the Respondent-Applicant be allowed to register the trademark SHELTER, TRUSTED SHELL-BLEND 2, 4-D ?

Records show that at the time the Respondent-Applicant applied for a mark on 30 September 2011, the Opposer secured its registration for the mark "SHELL" under Registration No. 4-2002-984⁶ under class 01. The Respondent -Applicant secured Registration No. 4-2007-010899 for its SHELTER 2, 4-D AMINE trademark 23 March 2009⁷.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

Opposer's marks

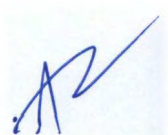
SHELL



⁵ Exhibits "1" to "7"

⁶ Exhibit "C"

⁷ Exhibit "4"



Respondent-Applicant's mark

SHELTER , Trusted Shell-Blend 2, 4-D

Anent the Opposer's argument that SHELTER TRUSTED SHELL-BLEND 2, 4-D is similar to its SHELL and PECTON/SHELL device, this Bureau finds that the differences between the marks are sufficient to distinguish one from the other, thus avoiding the likelihood of confusion. The alpha numeric code "2, 4-D" is irrelevant as this is descriptive or indicative of the active ingredients of the products. "TRUSTED SHELL-BLEND" have been disclaimed. Succinctly, SHELL is monosyllabic, while SHELTER is composed of two syllables. The syllable "TER" has rendered the word SHELTER, visual and aural properties that are so distinct from the word SHELL. It is improbable for a consumer to believe that SHELTER 2, 4-D is the same product under the mark SHELL 2, 4-D. The concept or idea of SHELTER is different from SHELL. SHELL is defined as a "hard, rigid usually largely calcareous covering or support of an animal"⁸, while SHELTER means "something that gives protection, such as a building or a tent or the protection provided."⁹

Lastly, generic or descriptive terms are not registrable as trademarks. However, when common words are used in an arbitrary sense, these words can be valid trademarks. At any rate, the word "TRUSTED" has been disclaimed by the Respondent-Applicant, which means it does seek exclusive proprietary rights over the said word. As regards to the word "SHELTER", the Respondent-Applicant has sufficiently proven that it is the originator and user of the mark. It previously registered the SHELTER 2, 4-D AMINE mark in 2009 under Certificate of Registration No. 4-2007-010899¹⁰ and has submitted labels¹¹ to show its commercial use of the same. Assuming that Respondent-Applicant's president, Wendell T. Garcia, used to be under the employ of a "Shell Chemicals Company of the Philippines" is not an indication of or tantamount to bad faith in choosing the word "SHELTER" as part of its company's product lines. As previously discussed, the words "SHELL" and "SHELTER" are visually and aurally different with different etymology and meaning, hence, there is no likelihood of confusion in the contemporaneous use of the marks in the market.

⁸ www.merriam-webster.com/dictionary/shell

⁹ dictionary.cambridge.org/us/dictionary/english/shelter

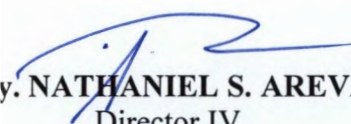
¹⁰ Exhibit "4"

¹¹ Exhibit "5"

WHEREFORE, premises considered, the instant Notice of Opposition of Trademark Registration No. 4-2011-00011764 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 6 January 2016.


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