

SUYEN CORPORATION,
Opposer,

-versus-

SOCIETE DES PRODUITS NESTLE S.A.,
Respondent - Applicant.

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}
} **IPC No. 14-2011-00292**
} Opposition to:
} Appln. Serial No. 4-2010-501527
} Date Filed: 31 October 2010
} **TM: "T. IN 'FRAME"**
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}

NOTICE OF DECISION

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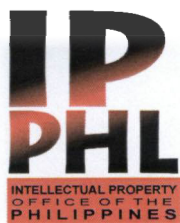
GREETINGS:

Please be informed that Decision No. 2016 - 47 dated February 15, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 15, 2016.

For the Director:


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



SUYEN CORPORATION,
Opposer,

- versus -

SOCIETE DES PRODUITS NESTLE S.A.,
Respondent-Applicant.

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IPC No. 14-2011-00292

Opposition to:

Appln. No. 4-2010-501527

Date Filed: 31 October 2010

Trademark : "T. IN 'FRAME'"

Decision No. 2016 - 47

DECISION

SUYEN CORPORATION ("Opposer"),¹ filed a verified opposition to Trademark Application Serial No. 4-2010-501527. The application, filed by SOCIETE DES PRODUITS NESTLE S.A., ("Respondent-Applicant")², covers the mark "T. IN 'FRAME'" for use on goods under the following classes³ **11:** *heating and cooking apparatus; apparatus and machines, included in this class, for making beverages including tea, coffee and chocolate; tea makers, electric tea machines; [arts and components for all the aforesaid goods; electric machines, included in this class, for the preparation of all types of beverages; refills, cartridges as component parts of these machines and spare parts for such machines; electric tea filters;* **21:** *household or kitchen utensils and containers; (neither of precious metal nor coated therewith); non electric apparatus for the preparation of food and drink; dispenser of capsules; parts and fittings for all the aforesaid goods; glassware, porcelain and earthenware not included in other classes; and, 30:* *tea, tea extracts, preparations and beverages with tea, tea cartridges including tea capsules.*

The Opposer alleges, among others, the following grounds for opposition:

"A. Opposer Suyen will be damaged by the registration of the mark covered by Respondent-Applicant's application. The said mark is identical to and confusingly similar with Opposer's duly registered trademarks. The said mark will also mislead the public into believing that the products bearing the said mark are the same products marketed and sold by Opposer or that the goods originated from the same source.

Respondent-applicant's mark is either the very trademark registered in the name of Suyen or the dominant feature in Suyen's other registered trademarks.

Respondent-applicant's T. IN 'FRAME' mark is visually almost identical to Suyen's registered T Trademarks.

Respondent-applicant's T. IN 'FRAME' mark is visually almost identical to Suyen's registered T Trademarks.

¹ A company duly organized and existing under and by virtue of the laws of the Republic of the Philippines with office located at 2214 Tolentino Street, Pasay City.

² A corporation with business address at 1800, Vevey, Switzerland.

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.

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The use of respondent-applicant's mark will result to a confusion of business.

Suyen will be damaged by the registration and use of respondent-applicant's T. IN 'FRAME' mark."

The Opposer's evidence consists of the following:

1. Affidavit of Suyen's Group Brand Manager, Mr. Dale Gerald G. Dela Cruz;
2. Certified true copies (Ctc) of the Certificates of Registration of the following trademarks: T inside a standing rectangular design, Little T & Device, and T Luxe & Device;
3. Photocopy of the Ctc of the Certificate of Registration for T Studio trademark;
4. Copy of Memorandum of Agreement;
5. Copy of Deeds of Assignment;
6. Copy of letters from TBCI dated 02 June 2010 and 08 June 2010 to Rockwell Land Corporation and Ayala Malls Group, respectively, relative to the said assignment;
7. Photograph of the T Store in Power Plant Mall, Rockwell Center, Makati City;
8. Photographs of the T trademarks displayed at the store;
9. Photographs of various shoes and bags with T trademarks and Little T & Device trademark marketed by Suyen;
10. Photographs of various shoes with T Luxe & Device trademark; and,
11. Photograph of a shoebox with T trademarks.

On 10 December 2012, Respondent-Applicant filed its Verified Answer alleging, among others, the following special and affirmative defenses:

"Respondent-applicant is the first to adopt, use and register its mark; its product is covered by a prior patent registration.

"Respondent-applicant's T. IN 'FRAME' mark is well-known internationally.

"There is no confusing similarity between Respondent-Applicant's T. IN 'FRAME' mark and Opposer's T Trademarks.

"Respondent-applicant's T. IN 'FRAME' mark and Opposer's T Trademarks are different in terms of appearance, style, and presentation.

"Subject marks cover different goods/services under different classes.

"Products bearing the subject marks are sold through different channels of trade and to different types of purchasers.

"Respondent-applicant's SPECIAL. T Tea Machines are more expensive as compared to Opposer's clothing accessories."

Respondent-Applicant's evidence consists of the following:

1. Affidavit of Atty. Dennis R. Barot;
2. Photocopy of Atty. Barot's Official Identification Card;
3. Pertinent pages of the "Philippines 5000", 2003 edition indicating Nestle as ranked 7th of the top 5000 companies in the Philippines;
4. Article regarding Nestle's combination of machine technology and pioneering capsule innovation;
5. Copy of Patent Registration No. 1-2004-500867 for capsule technology bearing the

- T. IN FRAME trademark;
6. Protection List covering registrations and pending applications for registration covering the T. IN "FRAME" trademark in various countries including the Philippines;
 7. Sample invoices of product sales with T. IN "FRAME"; and,
 8. Respondent-Applicant's website featuring its Special T tea machines with T. IN "FRAME" trademark.

Thereafter, the preliminary conference was held and terminated; and the parties submitted their respective position papers. Hence, this decision.

Should the Respondent-Applicant be allowed to register the trademark T. IN "FRAME"?

As culled from the records and evidence, the Opposer has valid and existing registration for its marks, T Studio, T inside a standing rectangular design, Little T & Device, and T Luxe & Device as early as 2006 and 2007⁴. On the other hand, Respondent-Applicant has shown to have filed its application for the mark T. IN "FRAME" only on 31 October 2010⁵. It also submitted Protection List containing enumerations of international registration and application for registration of the subject mark in various countries.⁶

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



Opposer's Trademarks



Respondent-Applicant's Trademark

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

⁴ Exhibits "C", "D", "E" and "F" of Opposer.

⁵ Filewrapper records.

⁶ Annex "E" of Exhibit "1" of Respondent-Applicant.

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 eyes can see that the marks are different. The similarity between the marks manifests in the use of identical letter "T". Such resemblance, however, is not sufficient to conclude that confusion is likely to occur. The appearance of Respondent-Applicant's stylized letter "T" with a punctuation mark - period (.), and claiming the color "gold" makes the mark easily distinguishable to that of the Opposer's mark comprising of either a narrow letter "T" alone or combined with the words, "Studio", "Little" or "Luxe".

Moreover, confusion or mistake, much less deception, is unlikely in this instance because the goods or service covered by Opposer's trademark registration are far different from that of the Respondent-Applicant's. The Opposer's brand in Trademark Registration Certificate Nos. 4-2002-004767 covers class 35; and, 4-2006-010207, 4-2007-002066, and 4-2007-002067, all cover classes 18 and 25⁸. These products include ladies' apparel, bags, footwear and accessories. On the other hand, the Respondent-Applicant's goods cover classes 11, 21 and 30 which include cooking apparatus, machines for the preparation of beverages, household or kitchen utensils and containers, and beverages made with tea. Thus, the parties' respective goods/service neither flow in the same channels of trade nor target the same market as to result to any confusion. A consumer could easily discern that there is no connection between the two marks where the Opposer's goods with its brands are substantially different to Respondent-Applicant's specialized products. Buyers of branded and particular products are highly aware of the channels of trade either to make a purchase, or for the repair and maintenance of the same.

Corollarily, the enunciation of the Supreme Court in the case of *Mighty Corporation vs. E. & J. Gallo Winery*⁹ aptly states that:

"A very important circumstance though is whether there exists likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the source of the goods in question. The 'purchaser' is not the 'completely unwary consumer' but is the 'ordinarily intelligent buyer' considering the type of product involved. He is 'accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The situation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

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.¹⁰ This Bureau finds that the Respondent-Applicant's mark meets this function.

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

⁸ *Id.* at 4.

⁹ G.R. No. 154342, 14 July 2004.

¹⁰ *Pribhdas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-501527 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 15 February 2016.


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