

KERRY GROUP PLC,
Opposer,

-versus-

KUOK REGISTRATIONS LIMITED,
Respondent- Applicant.

x-----x

}
} IPC No. 14-2011-00035
} Opposition to:
} Appln. Serial No. 4-2009-010628
} Date Filed: 19 October 2009
} TM: "KERRY"

NOTICE OF DECISION

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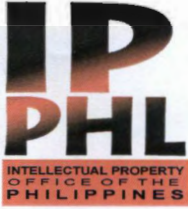
GREETINGS:

Please be informed that Decision No. 2016 - 134 dated May 03, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 03, 2016.

For the Director:


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



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KUOK REGISTRATIONS LIMITED, <i>Respondent-Applicant.</i>	}	Title: KERRY
	}	
x-----x	}	Decision No. 2016- <u>134</u>

DECISION

KERRY GROUP PLC¹ (“Opposer”) filed a Verified Opposition to Trademark Application Serial No. 4-2009-010628. The application, filed by KUOK REGISTRATIONS LIMITED² (“Respondent-Applicant”) covers the mark **KERRY** for use on “*financial services; insurance services; stocks and bonds brokerage; estate agency; real estate development project management; sale and leasing management for real estate; trading, underwriting, management and advising on securities, currencies, commodities, futures, contracts, options, swaps, negotiable instruments, precious metals and forward contracts and other hedging instruments; financial management of real estate development project; advisory services relating to all the aforesaid services*” under Class 36 and for use on “*flour milling, sugar refining and edible oils refining, material treatment*” under Class 40 of the International Classification of goods³.

The Opposer alleges the following grounds:

"6. The trademark KERRY being applied for by Respondent-Applicant is confusingly similar to opposer's trademark KERRY, as to be likely, when applied to or used in connection with the goods of the respondent-applicant, to cause confusion, mistake and deception on the part of the purchasing public.

"7. The registration of the trademark KERRY in the name of respondent-applicant will violate Section 123.1 subparagraph (d) of the Intellectual Property Code of the Philippines, to wit:

x x x

¹ A corporation duly organized and existing under the laws of the Ireland with business address at Prince's St. Tralee County Kerry, Ireland.
² A foreign corporation with address at Level 1, Central Bank of Samoa Bldg. Beach Road, APLA Western Samoa.
³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

"8. The registration of the trademark KERRY in the name of respondent-applicant will violate Section 123.1 (e) of the Intellectual Property Code of the Philippines.

x x x

"9. The registration of the trademark KERRY in the name of respondent-applicant is also contrary to Section 123.1, subparagraph (f) of the Intellectual Property Code of the Philippines, as follows:

x x x

"10. Being the owner of the internationally well-known mark KERRY, opposer's right to file the instant opposition case against respondent-applicant is specifically provided for in Section 131.1 of the Intellectual Property Code of the Philippines, to wit:

x x x

"11. The mark KERRY of opposer Kerry Group plc is 'well-known internationally' and falls squarely within or completely satisfies the criteria for determining whether a mark is well-known under Rule 102 of the Rules and Regulations on Trademarks, Servicemarks, Tradenames and Marked or Stamped Containers dated October 29, 1998, as follows:

x x x

"12. The registration of the trademark KERRY in the name of respondent-applicant will also violate Section 6bis of the Paris Convention for the Protection of Industrial Property, to which the Philippines and the Republic of Seychelles are both parties, as follows:

x x x

"13. The registration and use by respondent-applicant of the trademark KERRY will diminish the distinctiveness and dilute the goodwill of opposer's internationally well-known trademark.

"14. The registration of the trademark KERRY in the name of respondent-applicant is contrary to other provisions of the Intellectual Property Code of the Philippines."

The Opposer's evidence consists of the following:

1. Exhibit "A" - Trademark portfolio of opposer Kerry Group plc for the mark KERRY;
2. Exhibit "B" - authentication page of the Certificates of Registration attached to the Verified Opposition as Annexes "BB" to "JJJJ";
3. Exhibit "C" to "KKKK"- Certificate of Registrations for the Opposer's various

- KERRY Marks issued in many countries around the world;
4. Exhibits "LLLL" to "LLLL-26" - copies of articles published in newspapers, magazines and other publications;
 5. Exhibits "MMMM" to "MMMM-5" - copies of advertisements, press releases, write-ups, photos or print outs from the internet featuring the KERRY mark
 6. Exhibits "NNNN" to "NNNN-3" - lists of Kerry Group's sponsored events featuring the mark KERRY;
 7. Exhibits "OOOO" to "OOOO-1" - press statements relating to the award of Kerry Group plc;
 8. Exhibit "PPPP" to "PPPP-1" - copy of Check Out Ireland magazine showing that Kerry Group plc is among the top 100 Grocery Brand's List in 2003;
 9. Exhibit "QQQQ" to "QQQQ-1" - Sales Invoices issued by Opposer;
 10. Exhibit "RRRR" - Report on the Global Sales into the Philippines of Opposer's products;
 11. Exhibit "SSSS" - printout of the Opposer's website www.kerrygroup.com;
 12. Exhibit "TTTT" - copy of Decision No. 28146 dated 13 July 2010 issued by the Trademark Office in Kuwait;
 13. Exhibit "UUUU" - Affidavit Testimony of Brian Durran; and
 14. Exhibits "VVVV" to "HHHHH" - Annexes in Brian Durran's Affidavit-Testimony.

This Bureau issued on 22 March 2011 a Notice to Answer and served to the Respondent-Applicant's counsel on 31 March 2011. After several motions for extension to file answer, Respondent -Applicant filed the Verified Answer on 29 July 2011 alleging, among others, the following Affirmative Allegations and Defenses:

"3. Respondent-Applicant, a company whose main operations are based in Hong Kong, is one of Hong Kong's largest property investment and developments companies, with most of its portfolio of assets spanning Hong Kong and mainland China. xxx

"4. In the Philippines, Respondent-Applicant partners with Kerry-Aboitiz Logostics, Inc. with respect to its local operations and clientele. xxx

"5. Respondent-Applicant has an extensive global presence with various offices and agents worldwide. xxx

"6. In view of its extensive presence and operations and quality services, Respondent-Applicant has consistently been the recipient of various industry awards. xxx

"7. To protect its proprietary interests over its 'KERRY' marks, Respondent-Applicant secured registrations therefor from and/or filed applications for registrations thereof with, various jurisdictions worldwide. xxx

"8. In the Philippines, apart from the trademark application which is the subject of this instant opposition case, Respondent-Applicant secured the following registrations for its 'KERRY' marks with this Honorable Office:

"8.1 Registration No. 4-1994-096964 for the mark 'KERRY' in Class 39 issued on 08 May 2001;

"8.2 Registration No. 4-1994-096962 for the mark 'KERRY' in Class 35 issued on 25 July 2000;

"8.3 Registration No. 4-1994-006382 for the mark 'KERRY' in Classes 35 and 39 issued on 17 August 2006;

"8.4 Registration No. 4-1994-096960 for the mark 'Chinese Characters' in Class 39 issued on 21 October 2002;

"8.5 Registration No. 4-1994-096959 for the mark 'Chinese Character' in Class 36 issued on 21 October 2002;

"8.6 Registration No. 4-2009-010688 for the mark 'KERRY in Chinese Characters' Class 40 issued on 20 May 2010; and

"8.7 Registration No. 4-2001-004418 for the mark 'KERRY LOGISTICS NETWORK LIMITED Logo Device' in Classes 35 and 39 issued on 11 March 2004;

"9. On the other hand, Opposer claims that its right to oppose the herein Respondent-Applicant's trademark application stems from, among others, its local registration for the mark 'KERRY'. Based on the documents attached to the Opposition and this Honorable's Office online trademark database, it appears that Opposer's only active registration for its 'KERRY' mark is Registration No. 4-2004-002691 covering the mark 'KERRY Corporate Logo' which was issued by this Honorable Office on 31 October 2005. Said registration covers various goods under Classes 01, 02, 03, 29, 31 and 30, all of which are related to food and food-related products.

"10. We respectfully call the attention of this Honorable Office to the fact that Respondent-Applicant's use and registration of the subject mark 'KERRY' will not damage or prejudice Opposer's alleged interests and goodwill over its mark, for the following reasons:

"10.1. Respondent-Applicant's 'KERRY' marks are used on totally unrelated and non-competing services to that of the Opposer. It is clear that Respondent-Applicant is the business of providing logistical services, warehousing, financial consultancy, real estate development and consultancy, project development and consultancy, and other related non-food services, whereas Opposer is engaged in the production of food items and other food-related products and nothing else. As such, no sector of the purchasing public will be confused as to the source or origin of Respondent-Applicant's services, as the same will not be mistaken as being sponsored by, or having originated from, the Opposer.

"10.2. Most of the Respondent-Applicant's Philippine registrations for its 'KERRY' trademarks were issued way before the registration date accorded to Opposer's Philippine registration for its 'KERRY' mark.

"11. Moreover, Opposer incessantly repeats that its mark 'KERRY' is an internationally well-known mark. Needless to say, the term 'internationally well-known mark' has a technical meaning under the IP Code and its implementing rules and regulations.

"11.1 It must be remembered that the IP Code and the Trademark Regulations, specifically Rule 102 thereof, requires that a well-known mark must be specifically declared as such by competent authority. The same cannot be merely surmised or inferred from general wordings, as the term 'well-known mark' has a technical meaning under the law. A clear example where this Honorable Office and the Supreme Court declared a mark as well-known is in the case of *Sehwani Inc. v. In-N-Out Burger, Inc.*

x x x

"11.2. Notably, the afore-quoted case, in no uncertain terms, officially declared the mark involved as well-known without resort to words like 'popular' and 'widely used' which Petitioner baselessly equates with a declaration of a well-known status.

"11.3. In the instant case, Opposer, although presenting several documents to support its claim, failed to present any evidence showing that its mark 'KERRY' was declared by competent authority as well-known mark. Opposer's claim of unilaterally declaring its mark 'KERRY' as an internationally well-known mark is a purely baseless and self-serving allegation."

Respondent-Applicant's evidence consists of the following:

1. Exhibit "1" - Company History of Respondent-Applicant extracted from its website <https://www.kerryprops.com>;
2. Exhibit "2" - short description/profile of Respondent-Applicant's operation in the Philippines;
3. Exhibit "3" - Respondent-Applicant's Company Profile entitled "Asia Based, China Focus, Global Network";
4. Exhibit "4" - summary of the awards and citations received by Respondent-Applicant in 2010;
5. Exhibit "5" - List of Respondent-Applicant's worldwide trademark portfolio for its "KERRY" marks.

Pursuant to Office Order No. 154, s. 2010, the case was referred to the Alternative Dispute Resolution ("ADR") for mediation on 08 August 2011. On 11 August 2011, Opposer filed a Reply. On 16 December 2011, the Bureau's ADR Services submitted a report that the parties failed to settle their dispute. The preliminary conference was terminated on 21 February 2012 and the parties were directed to submit position papers. On 29 February 2012, Opposer filed its Position Paper while Respondent-Applicant did so on 02 March 2012.

Should the Respondent-Applicant be allowed to register the mark "KERRY"?

Opposer anchors its opposition on Section 123.1 (d) of the IP Code which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date in respect of the same goods or services or closely related goods or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The competing marks are reproduced hereunder:



Opposer's Mark

KERRY

Respondent-Applicant's Mark

There is no doubt that Opposer's and Respondent-Applicant's mark are similar as they both use the word KERRY. However, similarity in the marks does not automatically prevent one from registering its mark when such mark is used on unrelated, dissimilar or non-competing goods. In *Philippine Refining Co., Inc. vs. Ng Sam and The Director of Patents*⁴, the Court ruled:

A rudimentary precept in trademark protection is that the right to a trademark is a limited one, in the sense that others may use the same mark on unrelated goods." Thus, as pronounced by the United States Supreme Court in the case of *American Foundries vs. Robertson*, "the mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description."

Section 138 of the R.A. No. 8293, otherwise known as the Intellectual Property Code of the Philippines (IP Code) provides, to wit:

SECTION 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 of 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.

In this regard, a certificate of registration gives the registrant the right to exclusively use its mark only in connection with the goods/services as specified in the registration and those related thereto. Opposer's mark KERRY is used on *food products and ingredient of food products* under Classes 1, 2, 3, 29, 30 and 31. On the other hand, Respondent-Applicant's mark KERRY is being applied for use on "*financial services; insurance services; stocks and bonds brokerage; estate agency; real estate development project management; sale and leasing management for real estate; trading, underwriting, management and advising on securities, currencies, commodities, futures, contracts, options, swaps, negotiable instruments, precious metals and forward contracts and other hedging instruments; financial management of real estate development project; advisory services relating*

⁴ G.R. No. L-26676, July 30, 1982

to all the aforesaid services" under Class 36 and for use on "flour milling, sugar refining and edible oils refining, material treatment" under Class 40 of the International Classification of goods. Thus, the goods or businesses of the parties non-competitive and their products so unrelated that the use of similar trademarks is not likely to give rise to confusion, mistake or deception the public, much less cause damage to Opposer.


Noteworthy also is the fact that as between Opposer and Respondent-Applicant, the latter applied and registered its mark earlier than the former. Respondent-Applicant applied for its mark KERRY sometime in 1994 and was issued a registration in 2001 for goods/services under Class 35. On the other hand, Opposer applied for registration in 2004 and was only issued its registration in 2005. As such, it cannot be said that Respondent-Applicant adopted the similar trademark to ride on the popularity of Opposer's mark.

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.⁵ This Bureau finds that the Respondent-Applicant's mark meets this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2009-010628, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 03 MAY 2016


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

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.