

SAN MIGUEL BREWERY INC. and ICONIC BEVERAGES, INC.,
Opposer,

-versus-

FRASER AND NEAVE, LIMITED,
Respondent- Applicant.

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IPC No. 14-2013-00354
Opposition to:
Appln. Serial No. 4-2013-002352
Date Filed: 01 March 2013
TM: "ICE MOUNTAIN"

NOTICE OF DECISION

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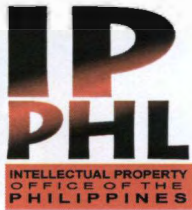
GREETINGS:

Please be informed that Decision No. 2016 - 219 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 30, 2016.

For the Director:

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



SAN MIGUEL BREWERY INC. and ICONIC BEVERAGES, INC.,

Opposers,

-versus-

FRASER AND NEAVE, LIMITED,
Respondent-Applicant.

IPC No. 14-2013-00354

Opposition to Trademark
Application No. 4-2013-002352

Date Filed: 01 March 2013

Trademark: **"ICE MOUNTAIN"**

X ----- X

Decision No. 2016- 219

DECISION

San Miguel Brewery Inc. and Iconic Beverages, Inc.¹ ("Opposers") filed an opposition to Trademark Application Serial No. 4-2013-002352. The contested application, filed by Fraser and Neave, Limited² ("Respondent-Applicant"), covers the mark "ICE MOUNTAIN" for use on *"pure drinking water, being a non-alcoholic drink included Class 32; waters (beverages), table-waters, mineral and aerated waters and other non-alcoholic drinks, fruit juices and fruit drinks, fruit concentrates for use in preparation of carbonated and non-carbonated soft drinks for use in preparation of carbonated soft drinks, syrups and other preparations for making beverages; all in Class 32"* under Class 32 of the International Classification of Goods³.

The Opposers allege, among other things, that the Opposer Iconic Beverages, Inc. ("IBI") is the registered owner of "BLUE ICE & DEVICE" covered by Certificate of Registration No. 4-1994-096538 for goods under Class 32. On the other hand, the Opposer San Miguel Brewery Inc. ("SMB") holds the license from IBI to manufacture and distribute products bearing the latter's trademarks, including "BLUE ICE & DEVICE". As early as November 1994, beer products under "BLUE ICE & DEVICE" were already commercially distributed within the Philippines. Both the Opposers are subsidiaries of San Miguel Corporation. The San Miguel group of companies is engaged in the production and commercial distribution of, among others, various beverage products such as water and non-alcoholic beverages as well as hard liquor and beer for the domestic and international markets.

The Opposers aver that the Respondent-Applicant's "ICE MOUNTAIN" mark nearly resembles their "BLUE ICE & DEVICE". According to the Opposers, their mark consists of the words "Blue Ice" and a representation of a mountain on top of the

¹ Both are domestic corporations with office address at No. 40 San Miguel Avenue, Mandaluyong City.

² A foreign company with business address at #21-00 Alexandra Point, 438 Alexandra Road, Singapore.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and services 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.

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words, all rendered in light blue color. They claim that "ICE" is dominant because of the bigger font size. They assert that the Respondent-Applicant's mark looks and sounds similar because of the dominant term "ICE" and a representation of a mountain also on top of the said word. They believe that the consumers will likely be confused because the goods covered by the marks are closely related and flow within the same trade channels and are distributed, marketed, displayed and sold in similar locations. By their nature, the goods are similarly classified as beverages. They assert that the applied mark will prevent them from using "BLUE ICE & DEVICE" for goods within their normal expansion of business. In support of the Opposition, the Opposers submitted the following:⁴

1. printout of the Respondent-Applicant's application;
2. judicial affidavit of Group Brand Manager of SMB, Lory Anne L. Gimenez, with annexes; and
3. printout of Certificate of Registration No. 4-2003-8371 for "CALI ICE LABEL".

The Respondent-Applicant filed its Answer on 04 February 2014 alleging, among others, that the competing marks are not similar. It explains that the Opposers' mark includes the words "BLUE ICE" with a small mountain ridge on top of the word blue in addition to two cascading curves while its mark consists of mountain ridges above the words "ICE MOUNTAIN". It insists that the dominant feature of the Opposers' mark is the word "ICE" while that of its own mark is the mountain ridges above the words "ICE MOUNTAIN". It also claims that the letterings and fonts used in its mark are very stylized. The Respondent-Applicant points out that the only common thread between the marks is the word "ICE", which is disclaimed in the Opposer's registration. It thus denies that the registration of "ICE MOUNTAIN" will cause confusion. The Respondent-Applicant's evidence consists of copies of trademark registrations issued abroad.⁵

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. This Bureau's Alternative Dispute Resolution Services, however, submitted a report that the parties refused to mediate. Accordingly, a Preliminary Conference was conducted on 24 June 2014. Upon termination thereof on the same day, the Hearing Officer directed the parties to submit their respective position papers. After which, the case is then deemed submitted for resolution.

The issue to be resolved is whether the Respondent-Applicant's mark "ICE MOUNTAIN" should be registered.

⁴ Marked as Exhibit "D" to "L", inclusive.

⁵ Marked as Exhibits "A" to "J".

Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that:

"123.1. 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

(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 the Respondent-Applicant filed an application for registration of the contested mark on 01 March 2013, the Opposers already have valid and existing registration of its "BLUE ICE" which was issued on 31 December 2006 under Certificate of Registration No. 4-1994-096538.

The Opposers' prior registrations notwithstanding, this Bureau sees no cogent reason to deny the Respondent-Applicant the registration of the mark "ICE MOUNTAIN". The marks are depicted below as follows:



Opposers' marks



Respondent-Applicant's mark:

The word "ICE" and the figure of a mountain on top thereof are the features that are common to the competing marks. This Bureau finds that the competing marks are not confusingly similar. The word "BLUE" is prominently positioned in between the word "ICE" and the mountain figure in the Opposer's marks. The same also incorporates two curved patterns below "ICE". These elements are absent in the Respondent-Applicant's mark. In addition, the latter mark includes the word "MOUNTAIN" aside from the figure thereof. Even in respect of aural and conceptual projection, mistake is remote to occur. This is especially because the registrations for "BLUE ICE" only states that the same shall be used on beers, which is not covered by the Respondent-Applicant's application.

Noteworthy, the word "ICE" is a common English word and is widely used in beverages. In fact, the Trademark Registry shows that there are other registered

marks belonging to different proprietors that use the same word. These marks include "ICE POWER", "POP ICE", "COLT ICE" and "ICE SPRING PURE WATER" under Certificates of Registration Nos. 4-2015-010235, 4-2009-009289, 4-2005-001131 and 4-2014-008689, respectively, all of which pertain to beverages under Class 32. In the same manner, there are also other registered marks for the same class which incorporate mountains in their logo such as:



Reg. No. 4-2003-001509



Reg. No. 4-2011-009103

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 In this case, the Respondent-Applicant's mark sufficiently met this function.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2013-002352 is hereby **DISMISSED**. 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, 30 JUN 2016


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.