



ABS-CBN PUBLISHING, INC.,
Opposer,

-versus-

JOSE MIGUEL S. MANALO,
Respondent- Applicant.

X-----X

IPC No. 14-2013-00015
Opposition to:
Appln. No. 4-2011-013587
Date Filed: 11 November 2011
TM: "HOY! METRO"

NOTICE OF DECISION

CRUZ MARCELO & TENEFRANCIA
Counsel for the Opposer
9th, 10th, 11th and 12th Floors, One Orion
11th Avenue corner University Parkway
Bonifacio Triangle, Bonifacio Global City
Metro Manila

MANALO JOCSON & ENRIQUEZ LAW OFFICES
Counsel for Respondent- Applicant
7th Floor, The Infinity
26th Street, Bonifacio Global City
Taguig City

GREETINGS:

Please be informed that Decision No. 2016 - 263 dated July 28, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 28, 2016.

For the Director:

Edwin O. Datin
Atty. EDWIN DANILO A. DATIN
Director III
Bureau of Legal Affairs

ABS-CBN PUBLISHING, INC.,
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IPC No. 14-2013-00015

Opposition to Trademark
Application No. 4-2011-013587
Date Filed: 11 November 2011
Trademark: "**HOY! METRO**"

Decision No. 2016- 263

DECISION

ABS-CBN Publishing, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-013587. The contested application, filed by Jose Miguel S. Manalo² ("Respondent-Applicant"), covers the mark "HOY! METRO" for use on "*printed matter; newspaper*" and "*entertainment; providing online electronic publications, not downloadable*" under Classes 16 and 41, respectively, of the International Classification of Goods³.

The Opposer alleges, among others things, that it is the owner of the marks "METRO HOME" and "METROWEAR". It uses its "METRO HOME" mark on its Metro Home & Entertaining magazines, the first issue of which was published in July 2003. The said magazines are also digitally available through Zinio since their August/September 2010 issue. It also features the said magazine through broadcast media, print advertisements and online features. As to the mark "METROWEAR", the Opposer claims to have staged fashions events under the said mark. It thus contends that the Respondent-Applicant's mark is confusingly similar to "METRO HOME" and "METROWEAR", especially as the goods covered are identical or related. In support of its Opposition, the Opposers submitted the following:⁴

1. printout of Certificate of Registration Nos. 4-2007-001243 and 4-2007-003071;
2. printout of Trademark Application No. 4-2011-013587;
3. copies of the front cover and front inner flap of the first issue of Metro Home & Entertaining magazine;
4. list of outlets distributing Metro Home & Entertaining magazine;

¹ A domestic corporation with office address at 8th Floor, ELJ Communications Center, Eugenio Lopez Street, Quezon City.

² A Filipino with address at 27 Tacloban Street, Alabang Hills Village, Cupang, Muntinlupa City.

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.

⁴ Marked as Exhibit "A" to "I", inclusive.

5. printouts of pages of Zinio;
6. screenshots of the show where the editor-in-chief talks about the magazine;
7. copies of the invitation, exhibit label sample and photos during the Tree of Life event; and
8. Facebook page of the Metro Home & Entertaining magazine.

The Respondent-Applicant filed its Answer on 23 May 2013 alleging, among others, that the contending marks are distinct and easily distinguishable from each other. It asserts that the common element "METRO" is not sufficient to mislead the public. It contends that the Opposer's magazines are lifestyle magazines which generally cater the elite and cover homes, entertainment and fashion while "HOY! METRO" is applied to tabloid, which has the purpose of dissemination of news and current events, and is expected to appeal the masses and middle class. It also posits that "METRO" cannot be subject of the Opposer's exclusive appropriation since the word merely describes the extent of covered news or geographical coverage. The Respondent-Applicant's evidence consists of the following:⁵

1. copy of the 16 January 2012 issue of "HOY! METRO";
2. list of "METRO" marks granted by the Trademarks Office of United Kingdom; and
3. copy of Manila Bulletin "METRO NEWS", Philippine Daily Inquirer "METRO" and Philippine Star "METRO" sections;

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. This Bureau's Alternative Dispute Resolution Services submitted a report that the parties failed to mediate. Accordingly, a Preliminary Conference was conducted on 05 May 2016 where only for the Opposer appeared. Thus, the Respondent-Applicant is considered to have waived its right to submit position paper.

The issue to be resolved is whether the Respondent-Applicant's mark "HOY! METRO" should be registered.

Section 123.1 (d) of the 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 Exhibits "1" to "5".

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

Records reveal that at the time the Respondent-Applicant filed an application for registration on 17 November 2011, the Opposer has a valid and existing registrations of "METROWEAR" under Certificate of Registration No. 4-2007-003071 issued on 11 November 2011 and "METRO HOME" under Certificate of Registration No. 4-2007-001243 issued on 10 March 2008.

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

Opposers' marks include:

METROWEAR **METRO**
HOME

Respondent-Applicant's mark:



The competing marks all appropriate the word "METRO". Be that as it may, this Bureau finds that confusion, much less deception, is unlikely in this case. The eyes can easily distinguish the Respondent-Applicant's mark from the Opposer's. The word "METRO" is a common English word. As such, the words and/or figures that accompany the said word will determine whether the marks are confusingly similar. The mark "METROWEAR" connotes apparel and/or fashion with the word "WEAR" compounding "METRO". As to the mark "METRO HOME", it gives away the idea that the same pertains to houses. The use of the word "HOME" after "METRO" manifestly indicates that the mark covers a specialized publication that caters those with interests in home construction, decoration and/or improvement.

The Respondent-Applicant's mark, on the other hand, clearly indicates that the same prints news with the phrase "BALITANG NASA ORAS" below the word "METRO". Therefore, it is highly unlikely for one who encounters the mark "HOY! BALITA" to confuse or mistake the said mark with any of the Opposer's marks; and vice-versa.

Moreover, it is noteworthy that the goods involved are the types which are thoughtfully chosen by their target consumers. Cast in this particular controversy, the ordinary purchaser is not the "completely unwary consumer" but is the "ordinarily intelligent buyer" considering the type of product involved. The definition laid down in *Dy Buncio v. Tan Tiao Bok* is better suited to the present case. There, the "ordinary purchaser" was defined as one "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 simulation, 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."⁶

Furthermore, the Trademark Registry of this Office shows that there are other marks appropriating the word "METRO" for Classes 16 and/or 41 including: "METRO" under Certificate of Registration No. 4-2000-002584 issued on 25 June 2006, "METRO CONFLICT" under Certificate of Registration No. 4-2015-008020 issued on 17 December 2015 and "METRO GOLDWYN MAYER AND LION LOGO" under Certificate of Registration No. 4-1996-111670 issued on 01 March 2001.

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.⁷ The Respondent-Applicant's mark sufficiently met this function.

⁶ *Victorio P. Diaz vs. People of the Philippines*, G.R. No. 180677, 18 February 2013.

⁷ *Pribhdas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-013587 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, **28 JUL 2016**


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