

CHRYSLER GROUP LLC,
Opposer,

-versus-

MICHAEL SWEENEY,
Respondent- Applicant.

X-----X

} **IPC No. 14-2014-00396**
}
} Opposition to:
} Appln. No. 4-2014-006883
} Date Filed: 30 May 2014
} **TM: "SUPERJEEP COCONUT**
} **FUELED AND DEVICE"**
}
}
}

NOTICE OF DECISION

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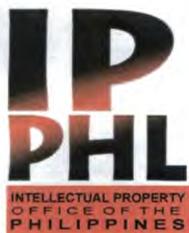
GREETINGS:

Please be informed that Decision No. 2016 - 180 dated June 22, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 22, 2016.

For the Director:


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



CHRYSLER GROUP LLC
Opposer,

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MICHAEL SWEENEY,
Respondent-Applicant.

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IPC NO. 14-2014-00396

Opposition to:
Appln. Ser. No. 4-2014-006883
Date Filed: 30 May 2014
Trademark: **SUPERJEEP Coconut
Fueled and Device**
Decision No. 2016 - 180

DECISION

CHRYSLER GROUP LLC¹ ("Opposer") filed on an Opposition Trademark Application Serial No. 4-2014-006883. The application filed by MICHAEL SWEENEY² ("Respondent-Applicant") covers the mark SUPERJEEP COCONUT FUELED AND DEVICE for use on "custom type jeep class vehicle, 4 x 4 and upgraded to run on standard or pure coconut oil fuel" under Class 12 of the International Classification of goods³.

The Opposer alleges the following grounds:

"3. The mark 'SUPERJEEP coconut fueled and Device' applied for by herein Respondent-Applicant, when used in relation to the goods of Respondent-Applicant, is likely to cause confusion, mistake and deception on the part of the purchasing public considering that said mark has been applied for the same class of goods, i.e., Class 12 of the Nice International Classification of Goods and Services, as those of Opposer's trademark JEEP under Class 12, which is a world famous trademark being continually in use since seventy (70) years ago all over the world including the Philippines up to the present, and whose registration is continually effective up to the present here in the Philippines and in most of the countries worldwide.

"4. The registration of the mar 'SUPERJEEP coconut fueled and Device' applied for registration by Respondent-Applicant is contrary and will violate Section 123.1 (d) and (e) of the Republic Act No. 8293, the Intellectual Property Code of the Philippines, which provides:

x x x

"5. The registration and continued use by the Respondent-Applicant of the mark 'SUPERJEEP coconut fueled and Device' will work to diminish the distinctiveness and dilute the goodwill of the trademark JEEP of herein Opposer, thus will cause grave and irreparable injury and damages to the Opposer."

¹ A corporation duly organized and existing under the laws of the State of Delaware, U.S.A. with address at 1000 Chrysler Drive, City of Auburn Hills, State of Michigan 48326 U.S.A.

² A Filipino resident with address at MBG Offices, 2nd Floor Regency Lagoon, Main Road Station 2, Boracay Island, Malay, Aklan.

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.

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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The Opposer submitted the following evidence:

1. Exhibit "A" and "A-1"- certified copy of the Certificate of Renewal of Registration No. 2101 for the mark JEEP registered on 29 August 1958 and renewed on 12 October 1979;
2. Exhibit "A-2" - certified copy of the Certificate of Renewal of Registration No. 2101 for the mark JEEP renewed on 12 October 2009; and
3. Exhibit "B" and sub-markings - Affidavit of Donna L. Berry with Annexes.

This Bureau issued on 20 January 2015 a Notice to Answer and personally served a copy thereof to the Respondent-Applicant's representative on 24 January 2015. After two motions for extension of time to file answer, Respondent-Applicant filed the Verified Answer on 24 April 2015 alleging, among others, that Respondent-Applicant's 'SUPERJEEP coconut fueled and Device' is different from Opposer in the overall presentation. Respondent-Applicant also claims that the word "jeep" is a generic term for jeep-inspired motor off-road vehicles. Respondent-Applicant also adds that "jeep" is synonymous to "owner type jeep" and "jeepney" which is the common or most popular transportation in the Philippines.

Pursuant to Office Order No. 154, s. 2010, the case was referred to the Alternative Dispute Resolution ("ADR") for mediation on 06 July 2015. On 06 August 2015, the Bureau's ADR Services submitted a report that the parties refused to settle the dispute. During the preliminary conference on 15 November 2015, the preliminary conference was terminated and the Opposer was directed to submit its position paper. Respondent-Applicant's right to submit position paper was deemed waived for his failure to attend the preliminary conference. However, Opposer did not submit its position paper.

Should the Respondent-Applicant's mark **SUPERJEEP COCONUT FUELED AND DEVICE** be allowed registration?

Opposer anchors its opposition on Section 123.1 (d) and (e) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code") which provides:

Section 123.Registrability. - 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

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark 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 knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

The prohibition under the above-quoted provision applies only if the competing marks are identical or confusingly similar. In this regard, the marks of the parties are depicted below for

comparison:

JEEP

Opposer's Mark



Respondent-Applicant's Mark

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademark pictured in their manner of display. Inspection should be undertaken from the viewpoint of the 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 considered.⁴ Thus, confusion is likely between marks only if their overall presentation as to sound, appearance or meaning would make it possible for consumers to believe that the goods or products, to which the marks are attached, comes from the same source or are connected or associated with each other.

Respondent-Applicant is different and distinct from Opposer's mark. Opposer's mark consist of the word "JEEP" plainly written in uppercase letters. Respondent-Applicant's mark is different from Opposer as it consists of the word "SUPERJEEP" with a representation of letter "S" inside a circle device. It also contains the phrase "coconut fueled" in stylized format below the word superjeep. While Respondent-Applicant's mark uses the word "jeep" in its mark, nonetheless, its mark can easily be distinguished from that of Opposer's. Because of these noticeable differences observed in the respective marks, Respondent-Applicant's mark cannot be said to be confusingly similar to Opposer's.

Also, it bear stressing that in the Philippines, the word "jeep" commonly refers to the mass transportation here in the country, the so called "public utility jeep". It is used interchangeably with the word "jeepney" which is a twin-benched jitney bus, seating about a dozen passengers.⁵ It is known for its crowded seating and kitsch decorations, which have become an ubiquitous symbol of Philippine culture and art.⁶ As such, the word "jeep" when used alone is not very distinctive as to effectively identify the source of goods or services.

Furthermore, the kind of goods upon which the mark is used makes the likelihood of confusion or mistake on the part of the consumer so improbable. While true that both marks are used in automobiles, it does not necessarily follow that confusion on the part of the public is inevitable. On the contrary, the likelihood of confusion, mistake or deception is on the part of the consumer is very remote. Automobiles are not ordinary consumer products that are bought every day. When a consumer buys an automobile, substantial amount of money or savings is involved. A person who wishes to buy a vehicle is very discerning as to what brand or kind of car will he spend his hard earned money with. That is why, when one chooses to buy a certain kind of car, he goes to the dealer who caters or deals with the specific brand making confusion or deception improbable.

Aptly, the essence of trademark registration is to give protection to the owners of

⁴ *Etepha A.G. v. Director of Patents, G.R. No. L-20635, 31 March 1966.*

⁵ <http://www.dictionary.com/browse/jeepney>

⁶ <https://en.wikipedia.org/wiki/Jeepney>

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 Respondent-Applicant's mark met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2014-006883, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City **22 JUN 2016**


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

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