



NEW R-9-7-16

HIJOS DE RIVERA S.A.,	}	IPC No. 14-2012-00281
<i>Opposer,</i>	}	
	}	Opposition to:
	}	Appl. Ser. No. 4-2011-501581
	}	Date Filed: 21 October 2011
-versus-	}	
	}	<b>Title: ESTRELLA DAMM</b>
SOCIEDAD ANONIMA DAMM,	}	
<i>Respondent-Applicant.</i>	}	
x-----x		

NOTICE OF DECISION

HECHANOVA BUGAY VILCHEZ & ANDAYA- RECADIO

Counsel for Opposer  
GF Salustiana D. Ty Tower  
104 Paseo de Roxas Avenue, Makati City

*[Signature]*  
9/1/16

JDF LAW

Counsel for Respondent-Applicant  
1501 One Global Place  
5th Avenue cor. 25th Street  
Bonifacio Global City, Taguig

*[Signature]*  
09-5-16

GREETINGS:

Please be informed that Decision No. 2016 - 291 dated 30 August 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 30 August 2016.

*[Signature]*  
Atty. MARLITA V. DAGSA  
Adjudication Officer  
Bureau of Legal Affairs



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SOCIEDAD ANONIMA DAMM,	}	Title: ESTRELLA DAMM
<i>Respondent-Applicant.</i>	}	
x-----x	x	Decision No. 2016- <u>291</u>

DECISION

HIJOS DE RIVERA S.A.,<sup>1</sup> (“Opposer”) filed a Verified Opposition to Trademark Application Serial No. 4-2011-501581. The application, filed by SOCIEDAD ANONIMA DAMM<sup>2</sup> (“Respondent-Applicant”) covers the mark ESTRELLA DAMM for use on “beers” under Class 32 of the International Classification of goods<sup>3</sup>.

The Opposer alleges the following grounds:

"A. Opposer is the prior adopter, user and true owner of the trademark ESTRELLA GALICIA & DESIGN in the Philippines and elsewhere around the world.

"B. Respondent-Applicant's mark ESTRELLA DAMM is confusingly similar to the ESTRELLA GALICIA & DESIGN trademark.

"C. Being confusingly similar, the registration of the Respondent-Applicant's mark ESTRELLA DAMM should not be allowed, since Opposer's ESTRELLA GALICIA & DESIGN trademark is registered in the Philippines.

"D. Opposer's trademark ESTRELLA GALICIA & DESIGN and its variations are internationally well-known.

"E. Since Opposer's trademark ESTRELLA GALICIA & DESIGN and its variations are internationally well-known, they are entitled to protection against confusingly similar marks covering similar or related goods.

The Opposer's evidence consists of the following:

1. Exhibit "A" - legalized and authenticated Special Power of Attorney
2. Exhibit "B" - Affidavit Testimony of Chrissie Ann L. Barredo;
3. Exhibits "C" to "C-21"- screen captures of the website <http://www.estrellagalicia.es>;

<sup>1</sup> A corporation duly organized and existing under the laws of Spain with address at Pol. Ind. La Grela - C/ Jose Maria Rivera Corral 615008, La Coruna, Spain.

<sup>2</sup> A corporation organized and existing under the laws of Spain with address at C/ Rosello 515 Barcelona 08025, Spain.

<sup>3</sup> 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.

4. Exhibits "D" to "D- 3" - printouts of the facebook and twitter accounts of Opposer;
5. Exhibits "E" and "E-1" - screen captures of the YouTube Channel of Opposer;
6. Exhibits "F" to "F-3" - screenshots of the website www.barcino.com.ph;
7. Exhibit "G" - printout from IPOPHL Trademark Database of the details of TM Registration No. 4-2008-009277 for the mark ESTRELLA GALICIA & DESIGN;
8. Exhibits "H" to "H-2"- printout of search result for the mark ESTRELLA GALICIA community trademark registered with OHIM;
9. Exhibits "I" to "I-17 " - printouts of the search result by OHIM TMView for ESTRELLA GALICIA mark;
10. Exhibits "J" and "J-1" - printouts of search result for the mark ESTRELLA GALICIA in Australian IPO online system;
11. Exhibit "K" and "K-1" - printout of search result for ESTRELLA GALICIA from UK IPO;
12. Exhibit "L" to "L-3" printout of search result for ESTRELLA GALICIA from USPTO's TESS;
13. Exhibit "M" - Certified copy of Trademark Registration No. 4-2008-09277 for the mark ESTRELLA GALICIA & DESIGN;
14. Exhibits "N" to "N-8" - Affidavit of Gladies G. Nepomuceno with Annexes; and
15. Exhibits "O" to "O- 107" - Affidavit of Antonio Viejo Puga with Annexes.

This Bureau issued on 18 September 2012 a Notice to Answer and served to the Respondent-Applicant's counsel on 24 September 2012. After two motions for extension, the Respondent-Applicant filed the Verified Answer on 26 December 2012, alleging the following affirmative allegations and defenses:

"4. The registration of the mark 'ESTRELLA DAMM' in the name of Respondent-Applicant will cause neither grave and irreparable injury nor damage to the Opposer for which reason the said application must be allowed registration based on the grounds set forth hereunder:

"A. Respondent-Applicant is the prior adopter, user and owner of the mark 'ESTRELLA DAMM' and its variants in Spain and elsewhere around the world.

"B. Respondent-Applicant's mark 'ESTRELLA DAMM' is not confusingly similar to Oposer's trademark 'ESTRELLA GALICIA & DESIGN'.

"C. Respondent-Applicant's 'ESTRELLA DAMM' is internationally well-known.

"D. Since Respondent-Applicant's 'ESTRELLA DAMM' and its variants are internationally well-known, the mark is entitled to be allowed registration in the Philippines.

Respondent-Applicant's evidence consists of the following:

1. Exhibit "1" - Special Power of Attorney;
2. Exhibit "2" and sub-markings - Affidavit of Marta Gil Muro;
3. Exhibit "3" and sub-markings - Affidavit of Jennifer D. Fajelagutan;



4. Exhibit "4" and sub-markings - copies of old advertisements, posters, mugs and other promotional materials and first beer bottle used by Respondent-Applicant.

5. Exhibit "5" and sub-markings - screenshot of the news page of the Gruppo Damm website [www.damm.es](http://www.damm.es);

6. Exhibit "6" and sub-markings - printout of 1876 page in the Estrella Damm website;

7. Exhibit "7" and sub-markings - screenshots of the "Music" and "Artist" page of Estrella Damm website; and

8. Exhibit "8" and sub-markings - copy of decisions from Chile, Paraguay and Japan.

Pursuant to Office Order No. 154, s. 2010, the case was referred to the Alternative Dispute Resolution ("ADR") for mediation on 26 February 2013. On 16 April 2013, the Bureau's ADR Services submitted a report that the parties refused to mediate the case. On 29 May 2013, the preliminary conference was terminated and the parties were directed to submit position papers. On 10 June 2013, the parties submitted their respective Position Papers.

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

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.<sup>4</sup>

Section 123.1 (d) of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines" ("IP Code) 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;

The above-cited provision prohibits the registration of a mark which is identical or confusingly similar to a registered mark or a mark with an earlier filing date or priority date.

The records show that at the time the Respondent-Applicant filed its application for the mark ESTRELLA DAMM on 27 August 2010, the Opposer already has an existing registration for its mark ESTRELLA GALICIA & DESIGN issued on 09 February 2009. Respondent-

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<sup>4</sup>See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

Applicant's mark is used on "beers" under Class 32 which is covered by Opposer's "*beers; mineral and aerated waters; fruit drinks and fruit juices; syrups*".

But are the marks of the parties identical or confusingly similar as to likely cause confusion, mistake or deception on the part of the purchasing public? The marks are hereunder reproduced:



Opposer's Marks

**ESTRELLA DAMM**

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.<sup>5</sup> 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.

A comparison of the marks of the parties shows that they are not confusingly similar. While the competing marks contain the word "ESTRELLA" which means "star", there is no other similarity between the marks. Respondent-Applicant's ESTRELLA DAMM mark is plainly written in upper case letter while that of Opposer's ESTRELLA GALICIA is written in stylized letters with a six-pointed star circumscribed within two concentric circles all on dark background. The difference in the font used and the way the marks are presented or depicted makes it easy to distinguish Respondent-Applicant's mark from that of Opposer's. Also, the second word "DAMM" in Respondent-Applicant's ESTRELLA DAMM mark refers to the name of its brewer Sociedad Anonima Damm and the company's founder August Kuensmann Damm, who founded the beer company way back in 1876. On the other hand, the second word "GALICIA" in Opposer's ESTRELLA GALICIA refers to City of Galicia in Spain where the

<sup>5</sup> *Etepha A.G. v. Director of Patents, G.R. No. L-20635, 31 March 1966.*

A handwritten signature in blue ink, consisting of a large, stylized initial 'A' followed by a vertical line and a small flourish at the bottom.

company that produces the Estrella Galicia beers which was founded by Jose Maria Rivera del Corral in 1906. As such, it is unlikely that the public will be misled or mistaken into believing that the ESTRELLA DAMM is the same as ESTRELLA GALICIA or that there is some connection between the two.

Further, the word "ESTRELLA", its English equivalent "STAR" or the device of a star is commonly used as a component of a mark in a various classes of goods. As such, it is considered a weak mark and taken alone is not very distinctive as to effectively identify the source of goods or services. Hence, what will determine whether the competing trademarks are confusingly similar are the other words or symbols present in the marks. As already pointed out, Respondent-Applicant's mark also contains the word "DAMM" to form the mark "ESTRELLA DAMM" while Opposer's mark contain the word "GALICIA" to form the mark "ESTRELLA GALICIA.

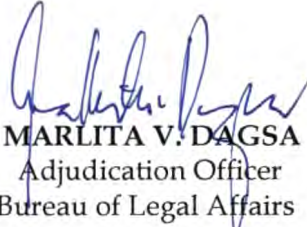
In addition, the products involved are beers. Definitely, the discerning eye of the relevant public would notice the dissimilarity between the two contending marks, the class of purchasers of consumers of beer is, to some extent, discriminating in terms of taste and preferences such that any variation in the appearance especially when early discernible in sound, words and appearance will not likely affect their buying decision. If they will prefer more of Respondent-Applicant's product it will not be because they are confused or deceived, but because they find the competing product to their taste. The buyer is inclined to be more cautious and discriminating in and would prefer to mull over his purchase. Confusion and deception, then, is less likely. Thus, in the case of *Asia Brewery vs. C.A. and San Miguel Corporation*<sup>6</sup>, the Supreme Court held that the ruling in *Del Monte* would not apply to beer which is not usually picked up from a store shelf but ordered by brand by the beer drinker himself from the storekeeper or waiter in a pub or restaurant which is the case in Opposer's beer.

Finally, whether Respondent-Applicant did not use the mark ESTRELLA DAMM from the inception of its company is of no moment. It does not change the findings of this Bureau that ESTRELLA DAMM and ESTRELLA DE GALICIA are not confusingly similar.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-501581, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, **30 AUG 2016**

  
**MARLITA V. DAGSA**  
Adjudication Officer  
Bureau of Legal Affairs

<sup>6</sup> GR No. 103543, July 5, 1993