

GENTRO ITN'L. PRODUCTS, INC.,
Opposer,

-versus-

MCLANE GROUP INT'L., L.P.,
Respondent-Applicant.

X-----X

IPC No. 14-2014-00190

Opposition to:

Appln. Serial No. 4-2011-015148

Date Filed: 20 December 2011

TM: LADY LIBERTY

NOTICE OF DECISION

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GREETINGS:

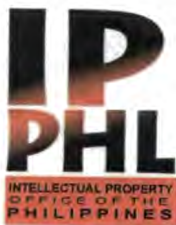
Please be informed that Decision No. 2016 - 388 dated October 21, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 21 October 2016.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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MCLANE GROUP INTL., L.P.,
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IPC No. 14-2014-00190

Opposition to:

ApplN. Serial No. 4-2011-015148

Date Filed: 20 December 2011

Trademark: "**LADY LIBERTY**"

Decision No. 2016- 388

DECISION

Genfro International Products, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-015148. The contested application, filed by McLane Group International, L.P.² ("Respondent-Applicant"), covers the mark "T-KING" for use on *"applesauce; baked beans; canned beans; canned cooked meat; canned fish; canned or bottled fruits; canned or bottled vegetables; canned peanuts; canned pork and beans; canned processed olives; canned, cooked or otherwise processed tomatoes; cut fruits; cut vegetables; diced tomatoes; evaporated milk; pickles; prepared nuts; preserved fruits; processed asparagus; processed beans; processed meat; processed mushrooms; processed nuts; processed olives; processed oranges; processed peaches; processed peanuts; processed stuffed olives; processed vegetables and fruits; pulses; roasted nuts; sliced fruits; tuna fish; processed fruits"* and *"cheese flavored puffed corn snacks; cheese flavored snacks, namely, cheese curls; cheese flavored snacks, namely, puffed cheese balls; corn-based snack foods; honey; microwave popcorn; oatmeal; puffed corn snacks; relish"* under Classes 29 and 30, respectively, of the International Classification of Goods³.

The Opposer alleges, among others, that it is the first to adopt, use, apply for and register the mark "LIBERTY" in the Philippines for goods under Classes 29 and 30. Since it first used "LIBERTY" in August 1998, it has promoted the same, including through free food tasting in supermarkets and other stores selling its products. Its products are currently sold and distributed nationwide. Thus, the Opposer asserts that there is likelihood of confusion between "LADY LIBERTY" and its own mark. It contends that the Respondent-Applicant uses the applied mark to goods similar to that carrying the "LIBERTY" trademark, specifically canned cooked meat, canned or bottled fruits, canned or bottled vegetables, canned pork and

¹ A domestic corporation with office address at Suite 809, State Centre Bldg., 333 Juan Luna Street, Binondo, Manila.

² With known address at 16607 Centrak Green Blvd., Suite 400, Houston, Texas 77032, United States of America.

³ The 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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beans, processed meat, and tuna fish. It claims that the Respondent-Applicant merely wishes to exploit and capitalize on the goodwill and reputation of its mark. In support of its Opposition, the Opposer submitted the following as evidence:⁴

1. affidavit of Harry A. Ko, its General Manager, with annexes;
2. certified true copy of the Notice of Opposition for IPC Case No. 14-2014-00178;
3. sample product and photographs of sample products bearing the mark "LIBERTY";
4. photographs of its free food tasting promotions; and,
5. photographs of stores where the products bearing the mark "LIBERTY" are actually sold.

A Notice to Answer was issued and served upon the Respondent-Applicant on 21 July 2014. The latter, however, did not file an Answer. Thus, on 12 August 2015, the Hearing Officer issued Order No. 2015-1197 declaring the Respondent-Applicant in default and requiring the Opposer to submit the original or certified true copies of its exhibits, if the same were not attached to the Verified Opposition. On 06 October 2015, the Opposer complied. After which, the case is deemed submitted for resolution.

The issue to be resolved is whether the Respondent-Applicant's mark "LADY LIBERTY" should be allowed registration.

Section 123.1. (d) of R.A. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that a mark cannot be registered if it:

"xxx

(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 show that at the time the Respondent-Applicant filed its trademark application, the Opposer already has a valid and existing registration for the mark "LIBERTY" under Certificate of Registration No. 4-1998-005613 issued on 18 February 2006.

⁴ Marked as Exhibits "A" to "E", inclusive.

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



Opposer's marks



Respondent-Applicant's mark

A practical approach to the problem of similarity or dissimilarity is to go into the *whole* of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a 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.⁵ Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

The manifest similarity between the contending marks is the word "LIBERTY". The term "LIBERTY", however, is a common English word. As such, what will determine whether the marks are confusing are the words and/or device that accompany the same and also the design or style of the marks. In this case, the Respondent-Applicant's mark is comprised of the phrase "LADY LIBERTY" cast in a rectangular background, a half-body image of the Lady of Liberty and three lines forming half ovals each at the top and bottom portion of the rectangle. What will come to mind when one encounters the Respondent-Applicant's mark is the Lady of Liberty as clearly depicted by incorporation the image thereof in the mark and the phrase "LADY LIBERTY". On the other hand, the Opposer's mark consists of the word "LIBERTY" alone with a stylized font. The word "LIBERTY" alone has a different connotation or meaning as opposed to "LADY LIBERTY". Hence, confusion, mistake, much less deception, is unlikely.

⁵ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

Moreover, the Trademark Registry of this Office reveals several other trademarks involving goods under Class 29 and/30, belonging to different proprietors, including:

Liberty

Reg. No. 4-2011-012725



Reg. No. 4-2015-504015



Reg. No. 4-2011-004614

Hence, similarity in this aspect alone is not enough to prevent a junior user registration of its mark provided that the later mark is endowed with other distinguishing features and characteristics such as that of the Respondent-Applicant's.

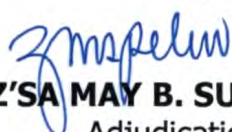
Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market 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 met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-015148 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **21, OCT 2016**


ATTY. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.