



**BENSON & HEDGES (OVERSEAS) LTD.,**  
Opposer,

**-versus-**

**MIGHTY CORPORATION,**  
Respondent- Applicant.

X-----X

} **IPC No. 14-2013-00134**  
} Opposition to:  
} Appln. Serial No. 4-2012-008579  
} Date Filed: 13 July 2012  
} **TM: "LUCKY STAR"**

**NOTICE OF DECISION**

**QUISUMBING TORRES LAW OFFICES**  
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26<sup>th</sup> Street corner 3<sup>rd</sup> Avenue  
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Taguig City

**MIGHTY CORPORATION**  
Respondent-Applicant  
No. 55 Mc Arthur Highway  
Bo. Tikay, Malolos City

**GREETINGS:**

Please be informed that Decision No. 2016 - 132 dated May 03, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 03, 2016.

For the Director:

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

**BENSON & HEDGES (OVERSEAS) LTD.,**

Opposer,

-versus-

**MIGHTY CORPORATION,**

Respondent-Applicant.

IPC No. 14-2013-00134

Opposition to Trademark

Application No. 4-2012-008579

Date Filed: 13 July 2012

Trademark: "**LUCKY STAR**"

X ----- X Decision No. 2016- 132

**DECISION**

Benson & Hedges (Overseas) Limited<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-008579. The contested application, filed by Mighty Corporation<sup>2</sup> ("Respondent-Applicant"), covers the mark "LUCKY STAR" for use on "*cigarettes*" under Class 34 of the International Classification of Goods<sup>3</sup>.

The Opposer maintains that it is the owner and prior user of "LUCKY STRIKE" word mark and related marks as well as the mark "LUCKY". It claims to have registered its marks in the Philippines and in various jurisdictions worldwide. It contends that the Respondent-Applicant's mark "LUCKY STAR" is visually and aurally similar with its "LUCKY STRIKE" marks, especially that both are used for tobacco products under Class 34. According to the Opposer, "LUCKY STAR" is the dominant element in the Respondent-Applicant's mark and is confusingly similar to the "LUCKY STRIKE" element of its mark. Also, it asserts that the applied mark completely appropriated its registered mark "LUCKY".

In support of its opposition, the Opposer submitted the following:<sup>4</sup>

1. affidavit of Stuart Paul Aitchison, with annexes;
2. copy of Trademark Application Nos. 4-2012-007793, 4-2012-010911 and 4-2012-011384;
3. copy of Trademark Registration Nos. 4-1998-007417, 4-1994-94157, 4-2004-009962, 4-2004-009963 and 4-2007-013632; and
4. copy of Certificate of Renewal Registration No. 4-1988-050327.

<sup>1</sup> A company organized and existing under the laws of United Kingdom/England and Wales, having principal place of business at Globe House, 4 Temple Place, London, WC2R 2PG, England.

<sup>2</sup> With known address at 1706 Jose Abad Santos Avenue, Tondo, Manila.

<sup>3</sup> 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.

<sup>4</sup> Marked as Exhibits "B" to "K", inclusive.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 20 July 2013. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued on 24 October 2013 Order No. 2013-1500 declaring the Respondent-Applicant in default and the case submitted for decision.

The issue to be resolved in this case is whether the trademark "LUCKY STAR" should be allowed registration.

The records reveal that the Opposer is the registered owner of the mark "LUCKY STRIKE", which it registered as early as 30 April 1991 under Certificate of Registration No. 050327. Also, it registered the mark "LUCKY" under Certificate of Registration No. 4-2007-013632 issued on 22 September 2008. The Respondent-Applicant, on the other hand, filed the contested application on 13 July 2013.

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

***"Section 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"***

When one looks at the Opposer's mark, what is impressed and retained in the eyes and mind is the word "LUCKY", alone or in conjunction with the word "STRIKE". This is the dominant feature of the mark that identifies the product and the source thereof. The Respondent-Applicant's mark also appropriates the word "LUCKY" combined with "STAR". The similarities of the competing marks are even more highlighted by the fact that the words that succeed "LUCKY" both start with the same letter. Therefore, their difference with respect to the second word notwithstanding, the competing marks confusingly similar visually, aurally and in connotation. After all, confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchased as to cause him to purchase the one supposing it to be the other.<sup>5</sup> This Bureau also quotes with favor the ruling of the Supreme Court in the case of **Del Monte Corporation vs. Court of Appeals**<sup>6</sup>, thus:

<sup>5</sup> Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

<sup>6</sup> G.R. No. L-78325, 25 January 1990.

***"The question is not whether the two articles are distinguishable by their label when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods is the touchstone."***

Noteworthy, the Opposer's and the Respondent-Applicant's respective marks is used or to be used for cigarettes. Thus, it is highly probable that the purchasers would be led to believe that Respondent-Applicant's mark "LUCKY STAR" is a mere variation of or in any way connected with the Opposer's mark "LUCKY STRIKE". Withal, the protection of trademarks as intellectual property is intended not only to preserve the goodwill and reputation of the business established on the goods bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods.<sup>7</sup>

The likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. Callman notes two types of confusion. The first is the *confusion of goods* "in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other." In which case, "defendant's goods are then bought as the plaintiff's, and the poorer quality of the former reflects adversely on the plaintiff's reputation." The other is the *confusion of business*: "Here though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff, and the public would then be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."<sup>8</sup>

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.<sup>9</sup> Based on the above discussion, Respondent-Applicant's trademark fell short in meeting this function. The latter was given ample opportunity to defend its trademark application but Respondent-Applicant did not bother to do so.

<sup>7</sup> Skechers, USA, Inc. vs. Inter Pacific Industrial Trading Corp., G.R. No. 164321, 23 March 2011.

<sup>8</sup> Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 1772276, 8 August 2010.

<sup>9</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-008579 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 03 MAY 2016



**ATTY. NATHANIEL S. AREVALO**  
Director IV  
Bureau of Legal Affairs