

CAMPBELL SOUP COMPANY,
Opposer,

-versus-

MIXLAND FOODS COMPANY,
Respondent-Applicant.

X-----X

IPC No. 14-2011-00399
Opposition to:

Appln. Serial No. 4-2010-012628
Date Filed: 23 November 2010

**TM: CANBELL'S WITH
REPRESENTATION OF A MAN**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 503 dated 23 December 2016 (copy enclosed) was promulgated in the above entitled case.

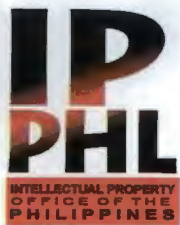
Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 04 January 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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 MIXLAND FOODS COMPANY, }
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IPC No. 14-2011-00399
 Opposition to:
 Application No. 4-2010-012628
 Date Filed: 23 November 2010
 Trademark: "CANBELL'S WITH REPRESENTATION OF A MAN"
 Decision No. 2016- 503

DECISION

CAMPBELL SOUP COMPANY¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2010-012628. The application, filed by Mixland Foods Company² ("Respondent-Applicant"), covers the mark "CANBELL'S WITH REPRESENTATION OF A MAN" for use on "food supplement" under Class 05, "powdered coffee" under Class 30 and "beverage (non-alcoholic), juice" under Class 32 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"The grounds for the opposition are as follows:

- "1. Opposer is the registered owner of the mark CAMPBELL'S RED & WHITE LABEL DESIGN which is covered by Registration No. 4-1994-090420 issued by the Philippine Intellectual Property Office (IPO) on Dec. 14, 2003 for 'soups, dry soup mixes, soups used as ingredients for recipes; soups used to make sauces; edible prepared beans; tomato juice for cooking purposes' under Class 29 as well as of the related mark CAMPBELL'S & DESIGN under Registration No. 4-2006-007033 issued by the Philippines' IPO on April 02, 2007 for 'soups of all types, namely, wet soups and dry soup mixes; broths; stocks; bouillons; stews; chilis and processed beans' under class 29 and 'fruit and vegetable juices and juice drinks' under class 32.
- "2. The mark CANBELL'S WITH REPRESENTATION OF A MAN being applied for registration by respondent is a colorable imitation of, and is confusingly similar to Opposer's registered marks.

¹A foreign company incorporated under the laws of New Jersey, U.S.A., with principal office at 1 Campbell Place, Camden, New Jersey, U.S.A..
²With address on record at #3 Road 13, Pag-asa, Quezon City, Philippines.
³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957

"3. The subject application of respondent should not be given due course and should be denied because it is proscribed by Opposer's prior and existing registration of similar marks, under Sec. 123.1 (d) of Republic Act No. 8293 (the Intellectual Property or IP Code) which provides that a mark cannot be registered if it:

x x x

"4. In light of the confusing similarity of respondent's applied-for mark CANBELL'S WITH REPRESENTATION OF A MAN with Opposer's registered marks CAMPBELL'S RED & WHITE LABEL DESIGN and CAMPBELL'S & DESIGN, the approval of respondent's application will violate Opposer's right to the exclusive use of its aforesaid registered trademarks and will cause it grave and irreparable damage and injury within the meaning of Sec. 134 of the IP Code.

"THE OPPOSER WILL RELY ON THE ABOVE AND FOLLOWING FACTS TO SUPPORT ITS OPPOSITION, RESERVING THE RIGHT TO PRESENT ADDITIONAL OR CONTROVERTING EVIDENCE AS TO OTHER FACTS AS MAY BE NECESSARY IN THE COURSE OF THIS PROCEEDING DEPENDING UPON THE EVIDENCE THAT MAY BE ADDUCED BY RESPONDENT-APPLICANT.

"a) Opposer restates, replays and incorporates all the above allegations, data and information insofar as they may be relevant and material hereto.

"b) Opposer is the creator of the mark CAMPBELL'S RED & WHITE LABEL DESIGN and first registered and used it in Philippine commerce in 1918 on soups, in 1954 on tomato sauce, and in 1963 in beans. Opposer's most recent application for registration of this trademark was filed with this Office on Jan. 10, 1994, and its Certificate of Registration which was issued on Dec. 14, 2003 is in full force and effect until Dec. 14, 2023.

"c) Opposer's application for registration of the related trademark CAMPBELL'S & DESIGN was filed with this Office on June 29, 2006 and its Certificate of Registration which was issued on April 02, 2007 is in full force and effect until April 02, 2017.

"d) The trademark CANBELL'S WITH REPRESENTATION OF A MAN being applied for registration by respondent is confusingly similar to Opposer's registered trademarks CAMPBELL'S RED & WHITE LABEL DESIGN and CAMPBELL'S & DESIGN applying the Dominancy Test used by the Supreme Court in numerous cases and which is now incorporated explicitly into law in Sec. 155.1 of the IP Code. The dominant and essential feature of Opposer's mark is the word/name 'CAMPBELL'S' which is Opposer's company name. Respondent merely copied this dominant and essential feature of the mark, including the apostrophe 'S', slightly modifying it into 'CANBELL'S' and adopted and used this modified word/name as the dominant and essential feature of its mark.

"e) The dominant and essential feature of respondent's mark - 'CANBELL'S'- has exactly the same number of syllables as the dominant and essential feature of Opposer's marks - 'CAMPBELL'S' - and almost the same number of letters. The dominant and essential feature of the marks have the same pronunciation, thus, applying the principle of idem sonans, they are confusingly similar. Considering the overall similarity in the aural and visual impressions created by respondent's marks

compared to that of Opposer's, the former is a colorable imitation of the latter, and there is confusing similarity.

"f) Moreover, respondent's mark CANBELL'S WITH REPRESENTATION OF A MAN is used on goods in classes 5, 30 and 32, which is either similar or closely related to the goods in classes 29 and 32 covered by Opposer's marks CAMPBELL'S RED & WHITE LABEL DESIGN and CAMPBELL'S & DESIGN, the products flow through the same channel of trade.

"g) The uncanny similarity in the marks and use of respondent's mark on identical and/or related goods makes it very obvious that respondent is riding on the international popularity of Opposer's marks CAMPBELL'S RED & WHITE LABEL DESIGN and CAMPBELL'S & DESIGN and that respondent is passing off its goods to the buying public as those of Opposer.

"h) Moreover, the use and registration of the mark CANBELL'S WITH REPRESENTATION OF A MAN by respondent will likely cause the dilution of the advertising value and excellent image of Opposer's marks CAMPBELL'S RED & WHITE LABEL DESIGN and CAMPBELL'S & DESIGN and will surely weaken their power of attraction.

"i) Under the circumstances, the use and registration of the mark CANBELL'S WITH REPRESENTATION OF A MAN by respondent will amount to a violation of the proprietary rights of Opposer over its registered trademarks CAMPBELL'S RED & WHITE LABEL DESIGN and CAMPBELL'S & DESIGN, will cause great and irreparable injury to Opposer, and will likely prejudice the public who might mistakenly believe that respondent's goods are those of Opposer or sponsored by, originated from or are related to Opposer.

The Opposer's evidence consists of the sworn statement of Jill N. Johnston, Deputy General Counsel of CAMPBELL SOUP COMPANY; a copy of Trademark Reg. No. 4-1994-090420 for the mark CAMPBELL'S & DESIGN issued on 14 December 2003; and a copy of Trademark Reg. No. 4-2006-007033 for the mark CAMPBELL'S & DESIGN issued on 02 April 2007.⁴

This Bureau issued a Notice to Answer and sent a copy thereof upon Respondent-Applicant on 16 November 2011. The Respondent-Applicant filed their Answer on 13 February 2012. On 13 April 2015, the case was referred to mediation. The Alternative Dispute Resolution (ADR) Services of this Bureau submitted on 27 April 2015 a Mediator's Report indicating the non-appearance by Respondent-Applicant despite due notice. Upon motion filed by Opposer, Respondent-Applicant was declared in default for failure to appear for mediation.

Should the Respondent-Applicant be allowed to register the trademark CANBELL'S WITH REPRESENTATION OF A MAN?

⁴Marked as Exhibits "A" to "C".

The Opposer anchors its opposition on Sections 123.1, paragraph (d) and 134 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

Sec. 123. Registrability. - 123.1. A mark cannot be registered if it:

x x x

(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;"

Sec. 134. *Opposition.* - Any person who believes that he would be damaged by the registration of a mark may, upon payment of the required fee and within thirty (30) days after the publication referred to in Subsection 133.1, file with the Office an opposition to the application. Such opposition shall be in writing and verified by the oppositor or by any person on his behalf who knows the facts, and shall specify the grounds on which it is based and include a statement of the facts relied upon. Copies of certificates of registration of marks registered in other countries or other supporting documents mentioned in the opposition shall be filed therewith, together with the translation in English, if not in the English language. For good cause shown and upon payment of the required surcharge, the time for filing an opposition may be extended by the Director of Legal Affairs, who shall notify the applicant of such extension. The Regulations shall fix the maximum period of time within which to file the opposition.

Records show that at the time the Respondent-Applicant filed its trademark application on 23 November 2010, the Opposer has existing trademark registrations for the mark CAMPBELL'S & DESIGN under Trademark Reg. No. 4-1994-090420 issued on 14 December 2003 and Trademark Reg. No. 4-2006-007033 issued on 02 April 2007. The registrations cover "soups, dry soup mixes, soups used as ingredients for recipes; soups used to make sauces; edible prepared beans; tomato juices for cooking purposes" under Class 29 and "soups of all types, namely, wet soups and dry soup mixes; broths; stocks; bouillons, stews, chills and processed beans" also in Class 29 and "fruit and vegetable juices and juice drinks" under Class 32. This Bureau noticed that the products indicated in the Respondent-Applicant's trademark application, i.e. food supplement (powdered health soup), powdered coffee, beverage (non-alcoholic), juice under Classes 05, 30 and 32 are similar and/or closely-related to the Opposer's.

But, are the competing marks, as shown below, resemble each other such that confusion, or even deception is likely to occur?





Opposer's trademark



Respondent-Applicant's mark

Confusion is likely in this instance because of the close resemblance between the marks and that the goods covered by the competing marks are similar or closely-related as they are both soups, beverages and juice drinks. The fact that the Respondent-Applicant's word mark CANBELL'S is accompanied with an image of man is of no moment. The distinctive feature of Respondent-Applicant's mark is the word CANBELL'S which closely resembles Opposer's trademark CAMPBELL'S. Respondent-Applicant's mark CANBELL'S WITH REPRESENTATION OF A MAN appears and sounds almost the same as Opposer's trademark CAMPBELL'S & DESIGN. Respondent-Applicant merely changed the fourth and fifth letters in Opposer's mark CAMPBELL'S with the letter "N" to come up with the mark CANBELL'S WITH REPRESENTATION OF A MAN. It could result to mistake with respect to perception because the marks sound so similar. Under the idem sonans rule, the following trademarks were held confusingly similar in sound: "BIG MAC" and "BIG MAK"⁵, "SAPOLIN" and LUSOLIN"⁶, "CELDURA" and "CORDURA"⁷, "GOLD DUST" and "GOLD DROP". The Supreme Court ruled that similarity of sound is sufficient ground to rule that two marks are confusingly similar, to wit:

Two letters of "SALONPAS" are missing in "LIONPAS": the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance...."SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties.⁸

It is emphasized that 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

⁵ *MacDonalds Corp, et. al v. L. C. Big Mak Burger*, G.R. No. L-143993, 18 August 2004.

⁶ *Sapolin Co. v. Balmaceda and Germann & Co.*, 67 Phil, 705.

⁷ *Co Tiong SA v. Director of Patents*, G.R. No. L- 5378, 24 May 1954; *Celanes Corporation of America vs. E. I. Du Pont de Nemours & Co.* (1946), 154 F. 2d 146 148.)

⁸ *Marvex Commerical Co., Inc. v. Petra Hawpia & Co., et. al.*, G.R. No. L-19297, 22 Dec. 1966.



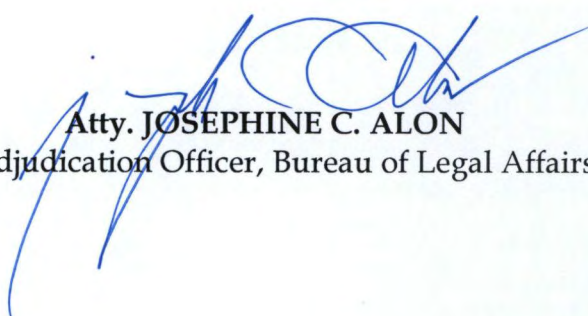
sale of an inferior and different article as his product.⁹ This Bureau finds that the mark applied for registration by the Respondent-Applicant does not meet this function.

In conclusion, the subject trademark application is covered by the proscription under Sec. 123.1(d) (iii) of the IP Code.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-012628 is hereby SUSTAINED. 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, 23 DEC 2016.


Atty. JOSEPHINE C. ALON
Adjudication Officer, Bureau of Legal Affairs

⁹ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepe v. Director of Patents, supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).