

**FOSTER BRANDS LIMITED,**  
*Opposer,*

**-versus-**

**UY MASUY WINE FACTORY, INC.,**  
*Respondent-Applicant.*

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**IPC No. 14-2013-00248**  
Opposition to:  
Appln. Serial No. 4-2012-12840  
Date Filed: 18 October 2012

**TM: F**

**NOTICE OF DECISION**

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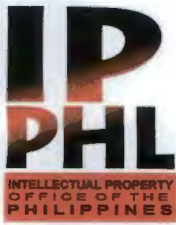
**GREETINGS:**

Please be informed that Decision No. 2016 - 539 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, 11 January 2017.

  
**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs



<b>FOSTER BRANDS LIMITED,</b>	} <b>IPC NO. 14-2013-00248</b>
Opposer	} Opposition to:
	}
-versus-	} Appln. Ser. No. 4-2012-12840
	} Date Filed: 18 October 2012
	}
<b>UY MASUY WINE FACTORY, INC.,</b>	} Trademark: "F"
Respondent-Applicant.	}
x-----x	} Decision No. 2016- 539

**DECISION**

FOSTER'S BRANDS LIMITED. (Opposer)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2012-12840. The application, filed by TUY MASUY WINE FACTORY (Respondent-Applicant)<sup>2</sup>, covers the mark "F", for use on "wines and other alcoholic beverages" under Class 33 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its opposition on the ground that the opposed 'F' for wines and alcoholic beverages is not eligible for registration for being confusingly similar to Opposer's registered 'F-logo' trademark, as well as Opposer's 'FOSTER'S & F' trademark contain the dominant element 'F' used on related goods, namely 'beer' pursuant to Sec. 123.1 (d) and (g). Sec. 123.1 of Republic Act. 8293, particularly (d) and (g) thereof provide, in part, that 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.

xxx

- (g) Is likely to mislead the public, particularly as to the nature, quality, characteristics, geographical origin of the goods and services.

<sup>1</sup> A corporation organized and existing under the laws of the United Kingdom with address at SABMiller House Church Street West, Woking, Surrey, United Kingdom, GU21 6HS

<sup>2</sup> A corporation duly organized and existing under Philippine law with address at 2041 MJ Cuenco Avenue, Mabolo Cebu City

<sup>3</sup> The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

In addition, the Opposer states that the Respondent-Applicant's application was filed in bad faith as there is no plausible explanation for the use of the choice of the letter "F" as trademark. It contends that since Opposer's marks are well-known in the Philippines, the registration will violate Opposer's rights under Section 123.1 (f) which states:

Sec. 123.1. Registrability. A mark cannot be registered if:

xxx

- (f) Is identical with or confusingly similar to, or constitutes a translation of a mark, considered well known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods and services which are not similar to those with respect to which registration is applied for: Provided, that the use of the mark in relation to the goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, that the interests of the owner of the registered mark are likely to be damaged by such use."

According to the Opposer, it is the subsidiary of SABMiller plc., which is the world's second largest brewing group. It has been in business in Australia using the "F" logo since 1888. The first "FOSTERS" branded lager was produced in 1887 and on the lager was the letter "F" a short-cut for "FOSTER'S". It obtained registration for the mark in several countries and in the Philippines, it registered the "F logo" under Registration No. 4-2008-013409 on 9 March 2009; "FOSTERS & F" under Registration No. 4-2004-005592 on 23 April 2007; and "FOSTER'S" under Registration No. 4-1982-407853; for the goods under Class 32, namely "beer".

The Opposer submitted as evidence the following: Affidavit and Special Power of Attorney of Mathew Jordan O'Keefe; certified copy of Certificate of Incorporation; database print-out of trademark registrations and applications of Opposer; certified copies of trademark registrations/registration details for the "F" logo; "FOSTER'S & F" and "FOSTER'S" in other jurisdictions; Director Certificate by Lama Helena van Spiegel-Breytenbach; Affidavit of Diana F. Rabanal; Print-out of website of Opposer, <http://www.fosterbeer.com/#/home>; facebook page of opposer, <http://www.facebook.com/fosterbeer>; certified copies of Philippine Registration No. 4-2008-013409; Registration No. 4-2004-005592; and Registration No. 4-1982-407853; Pictures and articles on promotions of use of the Opposer's mark/products; Advertising images of 'Foster's' as sponsor at the Olympic games and CD of TV commercial of Opposer.<sup>4</sup>

The Respondent-Applicant filed its Answer on 24 October 2013, alleging that it has been in the business of manufacturing and selling wine products since 1912. As early as 1952, it has manufactured 'FIGHTER WINE'. According to the Respondent-Applicant, the mark "F" represents the first letter of its most famous brand, "Fighter"

<sup>4</sup> Exhibits "A" to "O" inclusive of submarkings

brand. It maintains that the mark "F" is not confusingly similar to the "FOSTER'S" mark. The Opposer's beer is identified with Australia and is imported from abroad while its product is locally produced.

The Respondent-Applicant submitted as evidence the following: Print-out of IPO database of status of the marks "FIGHTER WINE WITH MAN DEVICE", "FIGHTER 50" "FIGHTER", "WALAY MAKALUPIG SA FIGHTR", "BUHAGAY SA FIGHTER", "FORZA", "RED FALCON MALLORCA", "DEVICE OF A FALCON" and "F".<sup>5</sup>

The Preliminary Conference was held on 26 March 2014 wherein the parties were directed to file their respective position papers. Both parties submitted their position papers on 7 April 2014.

Should the Respondent-Applicant be allowed to register the trademark F?

The records show that at the time Respondent-Applicant applied for registration of the mark "F" on 18 October 2012 for goods under Class 33, the Opposer already registered its marks "F logo" under Registration No. 4-2008-013409 on 9 March 2009; "FOSTERS & F" under Registration No. 4-2004-005592 on 23 April 2007; and "FOSTER'S" under Registration No. 4-1982-407853; for the same Class 33, namely "beer".

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

Opposer's mark

Respondent-Applicant's mark



Even if the marks of the parties are identical in the use of the letter "F", the Opposer's mark is decoratively encased in two oblong devices. In effect, the over-all commercial impression is distinct. In making a comparison of the whether the competing marks are similar, the appearance, connotation, meaning or suggestion is also considered. Verily, the use of one letter as a trademark, in the instant case, is to stand or represents another word. Opposer's mark "F LOGO" and "FOSTER'S & F"<sup>6</sup> marks conveys the first letter of the word "FOSTER'S", while Respondent-Applicant's mark connotes the first letter of its most famous brand, "FIGHTER". Amongst its registrations, most carry

<sup>5</sup> Exhibits "1" to "9"

<sup>6</sup> Exhibit "I"

the word “fighter”, namely: FIGHTER MAN WITH WINE DEVICE under Registration No. 41999008543<sup>7</sup> issued on 17 January 2005; FIGHTER 50 under Registration No. 4-2012-004055<sup>8</sup> issued on 30 March 2012; and FIGHTER under Registration No. 42012004054<sup>9</sup> issued on 14 June 2012; and WALAY MAKALUPIG SA FIGHTER under Registration No. 42012005538<sup>10</sup> issued on 22 September 2012.

Moreover, the kind or nature of goods upon which the marks are to be applied must be considered in determining the likelihood of confusion. The Opposer uses its mark on “beer”, while the Respondent-Applicant uses its mark on “wine”. Thus, it is unlikely that on account of the identity of the letter “F”, the public would be vulnerable to confusion much less deception.

In the case of Emerald Garment Manufacturing v. Court of Appeals<sup>11</sup>, the Supreme Court held:

Second, like his beer, the average Filipino consumer generally buys his jeans by brand. He does not ask the sales clerk for generic jeans but for, say, Levis, Guess, Wrangler or even an Armani. He is therefore, more or less knowledgeable and familiar with his preference and will not easily be distracted.


Finally, in line with the foregoing discussions, more credit should be given to the ‘ordinary purchaser’. Cast in this particular controversy, the ordinary purchaser is not the ‘completely unwary consumer’ but is the ‘ordinary intelligent buyer’ considering the type of product involved.

The ordinary consumer will order or buy his drink, by brand. Thus, he will not be confused or misled as to the origin of the goods “F” or think that all drinks with the letter “F” are related to or are affiliated with the Opposer.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-12840 is hereby **DISMISSED**. 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. ADORACION U. ZARE, LL.M.  
Adjudication Officer  
Bureau of Legal Affairs

<sup>7</sup> Exhibit “1”

<sup>8</sup> Exhibit “2”

<sup>9</sup> Exhibit “3”

<sup>10</sup> Exhibit “4”

<sup>11</sup> G.R. No. 100098, 29 December 1995