

MISS WORLD LIMITED,
Petitioner,

-versus-

BERNARD ONG GO,
Respondent-Registrant.

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}	IPC No. 14-2015-00548
}	Petition for Cancellation of:
}	
}	Reg. No. 4-2014-00003850
}	Date Issued: 02 April 2015
}	
}	
}	TM: MISS TOURISM WORLD
}	PHILIPPINES

NOTICE OF DECISION

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BERNARD ONG GO
Respondent- Registrant
No. 651 Yuchengco Street,
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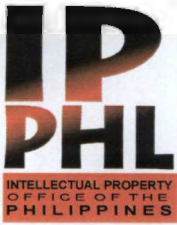
GREETINGS:

Please be informed that Decision No. 2016 - 545 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



MISS WORLD LIMITED,
Petitioner,

-versus-

BERNARD ONG GO,
Respondents.

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} **IPC NO. 14-2015-00548**

} Petition for Cancellation:

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} Cert of Reg. No. 4-2014-00003850

} Date issued: 2 April 2015

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} Trademark: **MISS TOURISM**

} **WORLD PHILIPPINES**

} Decision No. 2016- *545*

DECISION

MISS WORLD LIMITED (Petitioner)¹ filed a Petition for Cancellation of Registration No. 4-2014-00003850. The registration, in the name of BERNARD ONG GO (Respondent-Registrant)², covers the mark “MISS TOURISM WORLD PHILIPPINES”, for use on “Entertainment services, namely beauty pageants, promoting sale of goods and services by others through the medium of a beauty contest; giving others donation, scholarship grants to deserving students and charitable services” under class 41 of the International Classification of Goods³.

The Petitioner filed the instant Petition for Cancellation on the ground that “MISS TOURISM WORLD PHILIPPINES” which is used by Respondent-Registrant for beauty pageants in Class 41 is confusingly similar to Petitioner’s “MISS WORLD”, thus contrary to Sections 147, 147.2, 123.1 (d), (e), (f) and 151.1 (b) of Rep. Act. No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”). Petitioner avers that Respondent-Registrant appropriates “MISS WORLD” which is its corporate name, which constitutes a violation of Section 165 of the IP Code. According to the Petitioner, it has exclusively used and registered its well-known mark MISS WORLD and is entitled to protection under Sec. 168.1 of the IP Code. The Petitioner contends that the use by Respondent-Registrant was a deliberate attempt to confuse the public and ride on the goodwill of its mark.

The Petitioner alleges, among other things, that the Miss World Finals is one of the most publicized beauty contests, witnessed by 2.3 billion in the year 2000 when its 50th anniversary show was broadcast in London. The pageant was created in 1951. The

¹ A foreign corporation duly organized and existing under the laws of Jersey in the Channel islands, with address at 22-26 Albert Embankment, London, SE1, United Kingdom

² Filipino with address at 651 Yuchengco St., Binondo, Manila

³ 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.

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Signature

Petitioner is the franchising entity and operates a regional or country based pageant system with a global final. Each country selects a "Miss" winner that will compete for the annual global final. The Licensing of the Miss World mark is upon the directions of the Petitioner. The Petitioner explains that in the Philippines, CQ Global Quest, Inc. acquired a franchise on 25 January 2011. The Miss World marks are promoted, advertised and registered in various countries abroad for Classes 3, 25 and 41.

To support its petition, the petitioner submitted as evidence the following: Affidavit of Stephen Douglas Anthony Morley; List of trademark registrations of "MISS WORLD" in different countries; samples of advertising materials, brochures, pamphlets and promotional materials of "MISS WORLD"; copies of internet articles featuring MISS WORLD; screenshot of Miss World App; Special Power of Attorney; Minutes of Board of Directors; Board of Directors Resolution; copies of trademark registrations of "MISS WORLD" in the Philippines; Affidavit of Diana Rabanal; Print-out of website of licensee CQ Global Quest, Inc. website; Print-out of Megan Young's social media account; Certificate of Incorporation of Miss World Limited; various media and internet articles; representations of previous winners; and copies of decisions in favor of the petitioner.⁴

The Respondent filed his Answer on 28 January 2016 alleging, among things, that MISS TOURISM WORLD PHILIPPINES was adopted in good faith. He argues that "MISS WORLD" is not confusingly similar to his mark because of distinct components in his mark which includes a logo/ symbol of a beauty queen. He avers that the words MISS and WORLD are common to all who wish to use them.

Respondent-Registrant submitted as evidence the following: Notice of Allowance, representative samples of Certificates of Registrations and IPO trademark database of status of marks with the words "MISS" and "WORLD"; and Affidavit of Bernard Ong Go.⁵

The Preliminary Conference was held on 14 September 2016 where the parties were directed to submit their position papers. The Petitioner and Respondent-Registrant filed their position papers on 26 September 2016 and 13 October 2016, respectively.

Should the Respondent-Registrant's trademark registration for "MISS TOURISM WORLD PHILIPPINES" be cancelled?

Records show that at the time Respondent registered the mark "MISS TOURISM WORLD PHILIPPINES" on 2 April 2015, the Petitioner already obtained Certificate of Registration No. 040044 for the mark "MISS WORLD" for "entertainment services namely conducting beauty competitions" on 22 July 1988.⁶

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

⁴ Exhibits "A" to "CC" inclusive

⁵ Exhibits "1" to "10"

⁶ Exhibits "I"

Petitioner's mark

Respondent-Registrant's mark

MISS WORLD



Section 151 of the IP Code provides:

Section 151. Cancellation – 151.1. A petition to cancel a registration of a mark under this Act may be filed with the Bureau of Legal Affairs by any person who believes that he is or will be damaged by the registration of a mark under this Act as follows:

- (a) Within five (5) years from the date of registration of the mark under this Act.
- (b) At any time if the registered mark becomes the generic name for the goods or services or a portion thereof, for which it is registered or has been abandoned, or its registration obtained fraudulently, or contrary to the provisions of this Act, or if the registered mark is used by, or with the permission of the registrant so as to misrepresent the source of the goods or services or in connection with which the mark is used.

The Petitioner alleges that it is the owner of the well known mark MISS WORLD. A perusal of the contending marks show that Petitioner uses a word mark while the Respondent-Registrant's mark includes a device/ with a symbol of a beauty queen in the middle. The word TOURISM and PHILIPPINES are also included in his mark. These features are unique and creative which are sufficient to distinguish his mark from that of Petitioners. As regards to the words, the Respondent-Registrant apart from using the words, MISS and WORLD, also uses the words, TOURISM and PHILIPPINES in his mark. In the case of *Taiwan Kolin Corporation, Ltd. v. Kolin Electronics, Co., Inc.*⁷, the Supreme Court held:

While both marks refer to the word 'KOLIN' written in upper case letters and in bold font, the Court at once notes the distinct visual and aural differences between them: Kolin Electronics' mark is italicized and colored black while that of Taiwan Kolin is white in pantone red color background. The differing features between the two, though they may appear minimal, are sufficient to distinguish one brand from the other.

It is also noted that "MISS" is descriptive, as the contestants in the pageants would be female. The word "world" is generic which connotes the scope of the proclamation of the winner in such pageant. There is a limited way to describe or connote how or what a pageant contestant winning. It would be unfair if others are disallowed to describe in appropriate terms, or descriptions their contests.

⁷ G.R. No. 209843, March 25, 2015

The Supreme Court in *Philippine Refining Co. Inc. v. Ng Sam*⁸ held that common words are trademarks whose protection are weak:

The term "CAMIA" is descriptive of a whole genus of garden plants with fragrant white flowers. Some people call the "CAMIA" the "white ginger plant" because of its tuberous roots, while children refer to it as the butterfly flower because of its shape. Being a generic and common term, its appropriation as a trademark, albeit in a fanciful manner in that it bears no relation to the product it identifies, is valid. However, the degree of exclusiveness accorded to each user is closely restricted.

Finally, as correctly argued by the Respondent-Registrant, the IPOPhil trademark database reveals registrations using the words "MISS" in beauty and other types of pageants and contests, which proves that the Petitioner does not have a monopoly over the use of the word MISS to distinguish its service/goods.⁹ The marks, MISS CHINA TOWN WORLD; MISS BIKINI PHILIPPINES WORLD etc. exists. As long as the concocted terms are distinct and unique, the words "Miss" and "World" may be used as part of valid trademarks without the likelihood of confusion among the public. Thus, both may co-exist as long as elements that distinguish each mark are present.

WHEREFORE, premises considered, the instant Petition to Cancel Trademark Registration No. 4-2014-00003850 is hereby **DENIED**. 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

⁸ GR. No. L-26676 July 30, 1982

⁷ G R. 120900 July 20, 2000

⁹ Exhibits "2" - "8"