

ROTARY INTERNATIONAL,
Opposer,

-versus-

PEGROUP, INC.,
Respondent-Applicant.

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}	IPC No. 14-2013-00177
}	Opposition to:
}	Appl. Serial No. 4-2012-010959
}	Date Filed: 07 September 2012
}	
}	
}	TM: FOODMACH

NOTICE OF DECISION

VERALAW (Del Rosario & Raboca Gonzales Graspasil)

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PEPGROUP, INC.

Respondent- Applicant
39C Esteban Adaba Street,
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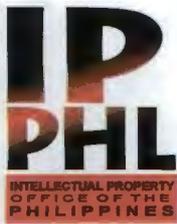
GREETINGS:

Please be informed that Decision No. 2017 - 01 dated 04 January 2017 (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



ROTARY INTERNATIONAL,
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PEGROUP, INC.,
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X ----- X

IPC No. 14-2013-00177

Opposition to:
Serial No. 4-2012-010959
Date Filed: 07 September 2012
Trademark: "**FOODMACH**"

Decision No. 2017- 01

DECISION

Rotary International¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-010959. The contested application, filed by Peggroup, Inc.² ("Respondent-Applicant"), covers the mark "FOODMACH" for use on "*advertising, business management*" under Class 35 of the International Classification of Goods³.

According to the Opposer, it is an international organization that has been constantly providing services to the members of its Rotary Clubs all throughout the world. The first Rotary Club was founded on 23 February 1905 in Chicago, Illinois, United States of America. The association later expanded worldwide, reaching the Philippine territory. The first Rotary Club in the Philippines was chartered in Manila on 01 June 1919. To date, there are over eight hundred thirty (830) Rotary Clubs in the Philippines. It has caused various trademark registrations of its marks, specifically the "ROTARY INTERNATIONAL AND DESIGN", in approximately seventy-seven (77) countries, including the Philippines. It also owns over eight hundred (800) internet domain names consistent with the use of its marks.

The Opposer alleges that the "ROTARY INTERNATIONAL AND DESIGN" is used as a symbol to associate it internationally with goodwill, peace and humanitarian service. It avers that such trademark represents the entire organization, signifying its ideals and principles and that the members of its organization are encouraged to display the logo in their Rotary club activities. The Opposer contends that the Respondent-Applicant's trademark application falsely suggests a connection or possible confusion with its allegedly well-known mark. In support of its Opposition, the Opposer submitted the print-out of the Respondent-

¹ A corporation duly organized and existing under and by virtue of the laws of United States of America with principal address at 1560 Sherman Avenue, Evanston, Illinois 60201.

² With known address at 39C Esteban Abada Street, Loyola Heights, Quezon City.

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.

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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Applicant's trademark and the affidavit of Jomarie B. Fredericks, its Deputy General Counsel and Chief Intellectual Property Counsel, with annexes.⁴

A Notice to Answer was issued and served upon the Respondent-Applicant on 10 July 2013. The latter, however, did not file an Answer. Thus, on 25 October 2013, the Hearing Officer issued Order No. 2013-1473 declaring the Respondent-Applicant in default and the case submitted for decision.

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

The records show that at the time the Respondent-Applicant filed its trademark application, the Opposer already has a valid and existing registrations of the marks "ROTARY" and "ROTARY INTERNATIONAL AND DESIGN" under Certificate of Registration Nos. 047054 and 048388 issued on 23 November 1989 and 13 June 1990, respectively.

The Opposer anchors its opposition on Section 123.1 subparagraphs (a) and (e), which provides that a mark cannot be registered if it:

"(a) Consists of immoral, deceptive or scandalous matter, or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute;

x x x

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark; x x x"

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

⁴ Marked as Exhibits "C" and "D", inclusive.

ROTARY



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 mark "FOODMACH" is obviously different and distinct from the mark word mark "ROTARY" whether in sound, appearance or connotation. Vis-à-vis the Opposer's "ROTARY INTERNATIONAL AND DESIGN" and the subject mark, the only manifest similarity is that they both appropriate a gear-like device. Such similarity, however, is not sufficient to conclude that confusion is likely to occur. The consumers can easily distinguish the two marks. The Respondent-Applicant's mark employs two gear-like devices, which was used in substitution of the two letter "O's"

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

in the word "FOODMACH". On the other hand, the Opposer's "ROTARY INTERNATIONAL AND DESIGN" trademark employs the gear-like design with the words "ROTARY" and "INTERNATIONAL" clearly written inside the same. There can be no confusion as what is impressed in the eyes and mind when one encounters the Opposer's and the Respondent-Applicant's marks are "FOODMACH" and "ROTARY", respectively. In view thereof, it is highly improbable that the consumers associate the Opposer's marks with that of the Respondent-Applicant's; and vice-versa.

Moreover, the Trademark Registry of this Office reveals several other trademarks involving Class 35 that likewise employ gear-like designs in their trademarks, belonging to different proprietors, including:



Reg. No. 4-2001-008025



Reg. No. 4-2016-500184



Reg. No. 4-2013-004090



Reg. No. 4-2015-503776

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. Finding no confusing similarity, there is no necessity for the determination whether the Opposer's mark is well-known.

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

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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. 4-2012-010959 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 04 JAN 2017 .


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.