

UNIVERSAL ROBINA CORPORATION,
Opposer,

-versus-

TIVOLI CO. LTD.,
Respondent-Applicant.

X-----X

} **IPC No. 14-2015-00168**
} Opposition to:
} Appln. Serial No. 4-2012-005969
} Date Filed: 18 May 2012

} **TM: TIVOLINA**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 88 dated 21 March 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, 21 March 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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IPC No. 14-2015-00168

Opposition to Trademark

Application No. 4-2012-005969

Date Filed: 18 May 2012

Trademark: **"TIVOLINA"**

Decision No. 2017- 88

DECISION

Universal Robina Corporation¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-005969. The contested application, filed by Tivoli Co. Ltd.² ("Respondent-Applicant"), covers the mark "TIVOLINA" for use on *"almond confectionery, artificial coffee, biscuits, bread, cakes, chocolate, cocoa, coffee, confectionery, cookies, edible ices, fruit jellies (confectionery), honey, macaroons (pastry), pastries, peanut confectionery, rice, rice cakes and tea"* under Class 30 of the International Classification of Goods³.

The Opposer alleges, among others, that since 10 April 1990, its company, which was then known as CFC Corporation, has been in exclusive use of the word "TIVOLI" in connection with the manufacture, distribution and sale of its then existing ice cream products. Later on in 2006, it introduced bite-sized chocolates and chocolate bars which were manufactured, sold and distributed also under the mark "TIVOLI". It then secured registration of the said mark with the Office for goods under Class 30. It thus objects the registration of the mark "TIVOLINA" for being allegedly confusingly similar with "TIVOLI". In support to its opposition, the Opposer submitted the following as evidence:⁴

1. copy of its Articles of Incorporation;
2. photograph of its ice cream products;
3. photographs of its chocolate products;
4. copy of Certificate of Registration No. 4-2014-00500202;
5. copy of the contested mark as published in the IPO E-Gazette;
6. its Annual Report issued in 1997;

¹ A corporation duly organized and existing under the laws of the Philippines, with business address at 110 E. Rodriguez Jr. Avenue, Libis, Quezon City.

² With address at 15-4, Doi 1-Chome, Yugawaramachi, Ashigarashimo-Gun, , Kanagawa 259-0303, Japan.

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.

⁴ Marked as Exhibits "A" to "I".

7. copy of its application for registration of the products with the Bureau of Food and Drugs (BFAD);
8. copy of its internal memo relating to the distribution of "TIVOLI" products; and,
9. copy of the photograph of TV personality with "TIVOLI" chocolates.

On 24 July 2015, A Notice to Answer was served upon the Respondent-Applicant. Despite receipt thereof, the latter did not comply. This prompted the Adjudication Officer to issue Order No. 2016-1326 declaring the Respondent-Applicant in default and submitting the case for decision.

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

Prefatorily, 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.⁵

As culled from available records, the Respondent-Applicant filed the contested application on 18 May 2012. On the other hand, Opposer filed an application for the registration of the mark "TIVOLI" on 15 January 2014. Eventually, Certificate of Registration No. 4-2014-500202 was issued on 26 June 2014. The application for registration of "TIVOLI" products with the BFAD shows that the Opposer adopted the mark as early as 2006.⁶

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the competing marks are shown hereafter for comparison:

⁵ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

⁶ Marked as Exhibit "G".

The word "Tivolina" is written in a highly decorative, cursive script. The letters are interconnected with elaborate flourishes, particularly at the top and bottom of the 'i' and 'n'.The word "TIVOLI" is written in a simple, bold, uppercase serif font. The letters are widely spaced and have a classic, clean appearance.

Opposer's marks

Respondent-Applicant's mark

A perusal of the marks will readily show that they are almost identical and hence, confusingly similar. The Respondent-Applicant merely added the letters "NA" after "TIVOLI" in coming up with its mark. Its attempt to distinguish its mark through a stylized presentation of "TIVOLINA" is not sufficient to requirements of the law. As the marks are visually and phonetically similar, it is impossible not to remember or associate the registered trademark "TIVOLI" when one encounters the Respondent-Applicant's mark "TIVOLINA". 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 purchaser as to cause him to purchase the one supposing it to be the other.⁷

Time and again, it has been held in our jurisdiction that the law does not require that the competing trademarks must be so identical as to produce actual error or mistake. It would be sufficient, for the purposes of the law that similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the new brand for it.⁸ Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.⁹

Noteworthy, the competing marks both cover chocolate products under Class 30. Thus, it is highly likely that the consumers will be lead to believe that Respondent-Applicant's products are allied to, sponsored by or in any way connected with the Opposer. Succinctly, 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

⁷ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁸ American Wire & Cable Co. vs. Director of Patents, G.R. No. L-26557, 18 February 1970.


⁹ Philips Export B.V. vs. Court of Appeals, G.R. No. 96161, 21 February 1992.

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."¹⁰

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-005969 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 21 MAR 2017


Atty. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

¹⁰ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.