



GINEBRA SAN MIGUEL, INC.,
Opposer,

-versus-

ASIA BREWERY, INC.,
Respondent-Applicant.

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IPC No. 14-2014-00349
Opposition to:
Appln. Serial No. 4-2014-004216
Date Filed: 04 April 2014

TM:



NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 235 dated 20 June 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, 20 June 2017.

MARILYN F. RETUAL
IPRS IV

Bureau of Legal Affairs

Republic of the Philippines

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DECISION

GINEBRA SAN MIGUEL, INC. ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2014-004216. The application filed by ASIA BREWERY, INC.² ("Respondent-Applicant"), covers the mark  for use on "beer" under Class 32 of the International Classification of Goods.

The Opposer alleges the following:

"4.1. Opposer is the true, lawful owner, and prior owner of the 'FIST BUMP' device mark as used on various goods and services;

"4.2 Respondent-Applicant's mark depicting the 'FIST BUMP DEVICE', which is identical or confusingly similar to the Opposer's mark showing the 'FIST BUMP DEVICE', and is used on identical or similar goods as that of the Opposer's cannot be registered in accordance with Section 123.1(d) of the IP Code;

"4.3. Opposer will suffer substantial and incalculable damage due to the use and registration of Respondent-Applicant's trademark as it is confusingly similar with Opposer's key 'FIST BUMP' visual and variants considering that they are all used on identical goods."

Opposer's evidence consists of the following:

1. Copies of the list of activities of Opposer from 2012-2014 and list of aired TV materials which shows the 'FIST BUMP' visual;
 2. Printout of relevant pages of Opposer's website <http://ginebrasanmiguel.com/alcoholic.php>;
 3. Advertisement of Opposer in print and video showing the 'FIST BUMP';
- and
4. Copy of Respondent-Applicant's Colt 45 "Sanib Pwersa" TV advertisement.

¹ A domestic corporation with principal office address at 3rd & 6th Floors, San Miguel Properties Centre, St. Francis Street, Mandaluyong City.

² A domestic corporation with address at 6/F Allied Bank Building, Ayala Avenue, Makati City.



This Bureau issued on 16 October 2014 a Notice to Answer and served a copy thereof to Respondent-Applicant on 13 November 2014. After a motion for extension of time, Respondent-Applicant filed its Answer on 13 January 2015, alleging that Opposer's mark is not confusingly similar with the mark sought to be registered. According to Respondent-Applicant, while the conceptual image of a "fist bump" appears in both marks, each of the representation of the "fist bump" is unique and they are totally distinct from each other. Also, Respondent-Applicant posits that Opposer has no exclusive ownership of each and every "fist bump" image. To support its claim, Respondent-Applicant submitted copies of advertisements of Colt 45 Sanib Pwersa.

Pursuant to Office Order No. 154, s. 2010, the case was referred to the Alternative Dispute Resolution ("ADR") for mediation on 02 March 2015. However, the parties failed to settle their dispute. The preliminary conference was terminated on 08 July 2015 and the parties were directed to submit position papers. On 20 July 2015, the parties filed their respective Position Papers.

Should Respondent-Applicant's mark  be registered?

Opposer anchors its opposition on Section 123.1 (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code") which provides:

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;

Pursuant to the above provision, a mark cannot be registered if it is identical or confusingly similar to a registered mark; to a mark which has earlier or prior filing date.

The records will show that at the time Respondent-Applicant filed its application for registration of its mark  on 04 April 2014, Opposer already has an existing registration for the mark LAHING GINEBRA IKAW NA! issued on 09 January 2014. But are the marks of Opposer and Respondent-Applicant

identical or confusingly similar so as to prevent the registration of the latter's mark? The competing marks are reproduced below for comparison:



Opposer's Mark



Respondent-Applicant's Mark

Opposer's composite mark consists of the word LAHING GINEBRA IKAW NA! with a picture of a fist bump with one hand clasping or holding a bottle. On the other hand, Respondent-Applicant's mark merely consist of an image of a fist bump. Thus, from the comparison of the competing marks, the common element that can be found in both marks is the FIST BUMP image/device. But does the adoption of the "fist bump" mark of the Respondent-Applicant as its mark likely create or cause confusion, deception or mistake on the part of the public?

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademark pictured in their manner of display. Inspection should be undertaken from the viewpoint of the 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.³ Thus, confusion is likely between marks only if their overall presentation as to sound, appearance or meaning would make it possible for consumers to believe that the goods or products, to which the marks are attached, comes from the same source or are connected or associated with each other.

In this case, in Opposer's composite mark LAHING GINEBRA IKAW NA!, what strikes the eye or what sticks to the mind of the consumers is really the word GINEBRA which is a household name for alcoholic beverages. As such, the use of Respondent-Applicant of the "FIST BUMP" image will not likely cause confusion or deception on the part of the buying public. When a consumer sees the "FIST BUMP" mark of Respondent-Applicant, it will not be confused into thinking that it is Opposer's GINEBRA alcoholic beverage.

Moreover, the goods involved in this case are alcoholic beverages that are bought according to the preference of the consumers' taste and loyalty to a certain

³ *Elepha A.G. v. Director of Patents*, G.R. No. L-20635, 31 March 1966.

brand. A consumer who has been accustomed to buying Opposer's alcoholic beverage will not be confused into buying Respondent-Applicant's beer instead.

Aptly, 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.⁴ Respondent-Applicant's mark met this function.

Finally, whether the use of Respondent-Applicant of the "fist bump" as its trademark for its beer product is a circumvention or violation of the copyright of Opposer is not a proper issue in an opposition case.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2014-004216, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 20 JUN 2017


MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.