

WORLD TRADE CENTERS ASSOCIATION, INC., }
Opposer, }

-versus-

PEPGROUP, INC., }
Respondent-Applicant. }

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IPC No. 14-2013-00404
Opposition to:
Appln. Serial No. 4-2012-010944
Date Filed: 07 September 2012

**TM: WOFEX TRADE WORLD TRADE
CENTER and MAP DESIGN**

NOTICE OF DECISION

SANTOS PILAPIL AND ASSOCIATES

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PEPGROUP, INC.

Respondent- Applicant
39C Esteban Abada Street,
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GREETINGS:

Please be informed that Decision No. 2017 - 160 dated 19 May 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, 22 May 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

**WORLD TRADE CENTERS
ASSOCIATION, INC.,**

Opposer,

- versus -

PEPGROUP, INC.,
Respondent-Applicant.

IPC NO. 14-2013-00404

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Trademark. **"WOFEX
TRADE WORLD TRADE
CENTER and Map Design"**

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DECISION NO. 2017 - 160

DECISION

WORLD TRADE CENTERS ASSOCIATION INC. (Opposer)¹, filed an Opposition to Trademark Application Serial No. 4-2012-010944. The application filed, by PEPGROUP, INC., (Respondent-Applicant)², covers the mark "WOFEX TRADE WORLD TRADE CENTER and Map Design" for "Advertising; Business Management" under Class 35 of the International Classification of Goods.³

The Opposer's based its Opposition on the following grounds:

1. The subject application is proscribed by Opposer's prior and existing registrations of similar mark and because Opposer's marks are world famous, which is also recognized ground for denial of later filed applications for registration of marks under the provisions of Republic Act No. 8293 (the Intellectual Property Code or the IP Code), Sec 123.1 (d) and (e).
2. The approval of the subject application will violate Opposer's right to the exclusive use of registered trademarks and will cause it grave and irreparable damage and injury, within the meaning of Sec 134 of the

¹ A corporation organized under the laws of Philippines with business address at 4th Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines.

² A corporation organized under Philippine law with address at Suite 407, Greenhills Mansion, 37 Annapolis Street, North East Greenhills, San Juan City, Metro 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.

IP Code by diluting and misappropriating the tremendous goodwill and brand value of Opposer's registered trademarks.

The Opposer's material allegations are quoted as follows:

1. Opposer is the creator and registered owner of the mark WORLD TRADE CENTER covered by Registration No. 4-2009-007875 issued on December 17, 2009 by the Philippines Intellectual Property Office (IPO) for various services in classes 35, 36, 38, 41, 42, and 45.
2. The words WORLD TRADE CENTER which comprise Opposer's mark has acquired fame through its long term and continuous use by its network of members belonging to the World Trade Center Association (WTCA) which was organized in 1969 to promote international business and trade among its members, and which has grown to over 300 WTCA members in 100 countries. Aside from the fact that the words WORLD TRADE CENTER have also become notoriously famous in the whole world after the September 11, 2001 terrorist bombing of the twin tower buildings known as WORLD TRADE CENTER which once stood proudly in New York City, New York, U. S. A. which is presently being rebuilt.
3. It must be noted that the marks WORLD TRADE CENTER and MAP DESIGN LOGO both in class 42 were previously registered with then Bureau of Patents, Trademarks and Technology Transfer (now IPO) under Reg. 55484 issued on June 21, 1993 and Reg. No. 55510 issued on July 2, 1993, respectively, but were allowed to lapse to cover expanded services.
4. Opposer is also the creator and registered owner of the MAP DESIGN LOGO "composed of stylized illustrations of the different continental groupings of the world, subdivided into three (3) groups and framed within three semi-oval geometric shapes" covered by registration No. 4-2009-007876 issued on December 17, 2009 by the Philippines' IPO for goods / services in classes 35, 36, 38, 41, 42 and 45.
5. The mark WOFEX TRADE WORLD TRADE CENTER and Map Design being applied for registration by respondent is a colorable imitation of, and confusingly similar to Opposer's registered marks WORLD TRADE CENTER and MAP DESIGN LOGO as to be likely when applied to or used in connection with respondent's services, to cause confusion or mistake and deceive the public, or the public may be led to believe that the services of respondent are those of Opposer, or originated from or sponsored by Opposer, or that respondent is a member of Opposer's network of World Trade Center facilities, when it is not.

To support its case, the Opposer submitted the following as evidence:

1. Exhibit "A" – Duly Authenticated Sworn Statement of Lindsay Kassof;
2. Exhibit "B" – IPOPHL Certification of the existence and validity of the certificate of registration of the mark "WORLD TRADE CENTER" of registrant WORLD TRADE CENTER ASSOCIATION, INC.;
3. Exhibit "C" – Copy of the Declaration of Actual Use;
4. Exhibit "C-1" – Copy of the Grant of Declaration of Actual Use issued by IPOPHL;
5. Exhibit "D" – List of Members;
6. Exhibit "E" – IPOPHL Certification of the existence and validity of the certificate of registration of the mark "MAP DESIGN LOGO" of registrant WORLD TRADE CENTER ASSOCIATION, INC.;
7. Exhibit "F" – Copy of the Declaration of Actual Use;
8. Exhibit "F-1" – Copy of the Grant of Declaration of Actual Use issued by IPOPHL;
9. Exhibit "G" – Copy of the Certificate of Registration of the mark WORLD TRADE CENTER with Registration No. 55484 dated June 21, 1993;
10. Exhibit "H" – Copy of the Certificate of Registration of the mark MAP LOGO with Registration No. 55510 dated July 2, 1993;
11. Exhibit "I" – Copy of the Secretary Certificate showing the authority of Ms. Lindsay Kassof as representative of the WORLD TRADE CENTER ASSOCIATION, INC.; and
12. Exhibit "G" – Copy of the Power of Attorney appointing the law firm Santos Pilapil & Associates as the company's attorney.

This Bureau served a Notice to Answer to the Respondent-Applicant on 10 December 2013, requiring the Respondent-Applicant to file a Verified Answer within thirty (30) days from receipt. However, the Respondent-Applicant failed to file an Answer. In view thereof, an Order dated 2 April 2014 was issued declaring the Respondent-Applicant in default. Consequently, this case was deemed submitted for decision.

The issue to resolve in the instant case is whether the Respondent - Applicant should be allowed to register the trademark "WOFEX TRADE WORLD TRADE CENTER and Map Design"

Our records show that when the Respondent-Applicant filed its application for its trademark "Wofex Trade World Trade Center and Map Design" on 7 September 2012, the Opposer herein already has a prior and

existing trademark registration for its "World Trade Center" wordmark and its Map trademark.

The competing marks are reproduced below for comparison:



Opposer's Trademarks⁴

Respondent-Applicant's
Mark⁵

A perusal of the trademarks and the evidence submitted, this Bureau finds the Opposition meritorious.

A simple examination of the contending marks readily show that the registered trademarks owned by the Opposer form part of the trademark being applied by Respondent-Applicant. Even though there are other design elements on the Respondent-Applicant's mark, the inclusion of the "World Trade Center" and the "Map" marks create a dominant impression and corresponding confusion on the part of the public.

Without the permission of the registered owner for the use of the "World Trade Center" and the "Map" mark, the trademark application of the respondent-applicant cannot be allowed. Otherwise, there is a great likelihood that the products or the services being offered by the Respondent-Applicant will be confused with the Opposer's. There is also high probability that the public may also be deceived in believing that the Respondent-Applicant's products and services originated from the Opposer, or there is a connection between the parties and/or their respective goods or services.

It has been consistently held in our jurisdiction that our law does not require that the competing trademarks must be so identical as to produce actual error or mistake. It would be sufficient, for purposes of the law that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.⁶ Our law does not require actual confusion, it being sufficient that confusion is likely to occur.⁷

⁴ Trademark Registration Nos. 4-2009-007875 and 4-2009-007876

⁵ Trademark Application No. 4-2012-010944

⁶ American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970


⁷ Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992

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WHEREFORE, premises considered, the instant Opposition to Trademark Application Serial No. 42012010944 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 42012010944 be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 19 MAY 2017


Leonardo Oliver Limbo
Adjudication Officer
Bureau of Legal Affairs