

GENTRO INTL. PRODUCTS, INC.,
Opposer,

-versus-

MCLANE GROUP INTL., L.P.,
Respondent- Applicant.

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IPC No. 14-2014-00178
Opposition to:
Appln. Serial No. 4-2011-015147
Date Filed: 20 December 2011
TM: "LADY LIBERTY"

NOTICE OF DECISION

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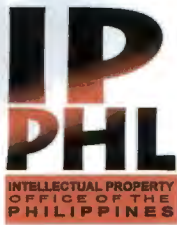
GREETINGS:

Please be informed that Decision No. 2017 - 310 dated August 10, 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, August 11, 2017.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



GENTRO INTL. PRODUCTS, INC.,
Opposer,

-versus-

MCLANE GROUP INTL., L.P.,
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x ----- x

IPC No. 14-2014-00178

Opposition to:
Appln. Serial No. 4-2011-015147
Date Filed: 20 December 2011
Trademark: "LADY LIBERTY"

Decision No. 2017- 310

DECISION

Gentro International Products, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-015147. The application, filed by McLane Group International, L.P.² ("Respondent-Applicant"), covers the mark "LADY LIBERTY" for use on "applesauce; baked beans; canned beans; canned cooked meat; canned fish; canned or bottled fruits; canned or bottled vegetables; canned peanuts; canned pork and beans; canned processed olives; canned, cooked or otherwise processed tomatoes; cut fruits; cut vegetables; diced tomatoes; evaporated milk; pickles; prepared nuts; preserved fruits; processed asparagus; processed beans; processed meat; processed mushrooms; processed nuts; processed olives; processed oranges; processed peaches; processed peanuts; processed stuffed olives; processed vegetables and fruits; pulses; roasted nuts; sliced fruits; tuna fish; processed fruits" under Class 29 and "cheese flavored puffed corn snacks; cheese flavored snacks, namely, cheese curls; cheese flavored snacks, namely, puffed cheese balls; corn-based snack foods; honey; microwave popcorn; oatmeal; puffed corn snacks; relish" under Class 30 of the International Classification of Goods³.

The Opposer alleges the following grounds for opposition:

"1. The Opposer is first to adopt, use, apply for and register the mark "LIBERTY" trademark in the Philippines for goods under Classes 29 and 30. Therefore, it enjoys under Section 147 of Republic Act (R.A.) No. 8293 the right to exclude others from registering or using an identical or confusingly similar mark such as Respondent-Applicant's 'LADY LIBERTY' mark.

"2. The Opposer's 'LIBERTY' trademark is well-known in the Philippines, taking into account the knowledge of the relevant sector of the public, rather than the public at large, as being trademarks expressly and directly referring to and owned by the Opposer.

"3. There is likelihood of confusion between Opposer's 'LIBERTY' trademark and Respondent-Applicant's 'LADY LIBERTY' mark because the latter's mark is identical and/or confusingly similar in sound, spelling and appearance to the former's 'LIBERTY' trademark as to likely cause confusion, mistake or deception to the public.

¹ A domestic corporation with office address at Suite 809, State Centre Bldg., 333 Juan Luna Street, Binondo, Manila.

² A limited partnership with address at 16607 Central Green Blvd., Suite 400, Houston, Texas 77032, United States of America.

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. Respondent-Applicant, by adopting the 'LADY LIBERTY' mark for its goods, is likely to cause confusion, or to cause mistake, or to deceive as to affiliation, connection, or association or with the Opposer, or as to origin, sponsorship, supervision, authorization or approval of its products by the Opposer, for which it is liable for false designation of origin, false description or representation under Section 169 of R.A. No. 8293."

In support of the opposition, Opposer submitted the following pieces of evidence:

1. Judicial Affidavit of Harry A. Ko;
2. Certified copy of Registration No. 4-1998-005613 for the mark LIBERTY;
3. Copy of Certificate of Filing of Amended Articles of Incorporation of Gentro International Products, Inc.
4. Photographs of Opposer's products and product labels bearing the mark LIBERTY;
5. Duplicate original of representative Sales Invoices issued by Opposer;
6. Photographs of Opposer's free food tasting in supermarkets of its products bearing the mark LIBERTY;
7. Photograph of LIBERTY products on display in a supermarket rack; and
8. Photocopies of Certificates recognizing Opposer's LIBERTY products.

On 08 July 2014, this Bureau issued a Notice to Answer (NTA). On 17 July 2014, the NTA was served on Respondent-Applicant's counsel. However, no answer was filed by Respondent-Applicant. As a consequence, the Respondent-Applicant was declared in default pursuant to Order No. 2015-954 issued on 26 June 2015 and Opposer was directed to submit the original or certified true copies of its exhibits. On 12 August 2015, the preliminary conference was terminated after a comparison of the Opposer's documentary evidence. Thus, the case is now submitted for resolution.

The sole issue to be resolved in this case is whether or not Respondent-Applicant's LADY LIBERTY mark should be registered.

Section 123.1 (d) of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines", as amended, provides for the grounds for registration of a mark, to wit:

Section 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;

Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, said mark cannot be registered.

Records will show that at the time Respondent-Applicant filed his trademark application for LADY LIBERTY, Opposer already has an existing registration for LIBERTY issued in 18 February 2006 under Certificate of Registration No. 4-1998-005613. As such, pursuant to Section 138 of the IP Code, Opposer's certificate of registration is a prima facie evidence of the its ownership of the mark,

and its exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto.

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

LIBERTY

Opposer's Mark

LADY LIBERTY

Respondent-Applicant's Mark

The manifest similarity between the two marks is the presence of the word "LIBERTY". Opposer's mark is the word "LIBERTY" itself written in stylized upper case letters while Respondent-Applicant's mark contains the words "LADY LIBERTY" written in plain upper case letters also. While there are observable differences between them, these differences are not sufficient to veer away from a finding of confusingly similarity because the word "LIBERTY" is the prominent or main feature of the mark.

Indeed, 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 ingenious 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 other⁴. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article⁵.

The determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, 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 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 The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:⁷

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 confusion of business. Here, though the goods of the parties are

⁴ *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

⁵ *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

⁶ *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

⁷ *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.


In this case, both marks imply the same meaning or connotation. The term "LIBERTY" means "freedom" while "LADY LIBERTY" is a symbolism of "freedom". Opposer's LIBERTY mark has gained popularity and reputation among consumers in the Philippines from the time it was used in commerce since 1998 through its predecessor Uni-Gain International Product, Inc. up to the present through herein Opposer. As such, when a consumer encounters Respondent-Applicant's mark, there is a likelihood that he/she will be confused, mistaken or deceived into believing that the said mark is merely a variation of Opposer's mark. There is also a likelihood that the public will be deceived into thinking that Respondent-Applicant's goods comes from, manufactured, originated or sourced from Opposer or that any impression or perception on the Respondent-Applicant's goods may be unfairly attributed to Opposer.

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 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.⁸ In this case, the Respondent-Applicant's mark does not met this function.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-015147 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 10 AUG 2017.


MARLITA V. DAGOSA
Adjudication Officer
Bureau of Legal Affairs

⁸ *Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.*