

JAPAN TOBACCO, INC.,

Opposer,

-versus-

BENSON & HEDGES (OVERSEAS) LIMITED,

Respondent-Applicant.

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IPC No. 14-2013-00380

Opposition to:

Appln. Ser. No. 4-2013-004046

Date Filed: 10 April 2013

TM: ALWAYS TRUE

X-----X

NOTICE OF DECISION

CRUZ MARCELO AND TENEFRANCIA

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GREETINGS:

Please be informed that Decision No. 2017 - 333 dated 07 September 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.

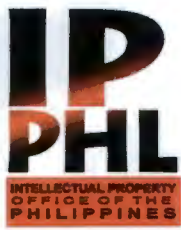
Taguig City, 07 September 2017.

MARILYN F. RETUAL
IPRS IV

Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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 TM: ALWAYS TRUE
 Decision No. 2017- 333

DECISION

JAPAN TOBACCO, INC. ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2013-004046. The application filed by BENSON & HEDGES (OVERSEAS) LIMITED.² ("Respondent-Applicant"), covers the mark "ALWAYS TRUE" for use on "*cigarettes; tobacco; tobacco products; lighters; matches; smoker's articles*" under Class 34 of the International Classification of Goods.

The Opposer alleges that in 2003, it started using the word "TRUE" as an element of several of its slogans and taglines like "TRUE AMERICAN FLAVOR" and "STAY TRUE STAY YOU" in advertising campaigns. Its "TRUE" concept has been advertised in ELLE, Playboy and Cosmopolitan magazines. In 2012, it launched its "STAY TRUE" mark. Opposer filed on 24 October 2012 a trademark application for the "STAY TRUE" mark through the Madrid Protocol and was accorded Registration No. 1141730. According to Opposer, Respondent-Applicant's mark ALWAYS TRUE is aurally similar to its mark STAY TRUE because of the "TRUE" component of the mark. Opposer also posits that Respondent-Applicant's mark is also conceptually similar because "STAY TRUE" connotes "a quality that will remain real or genuine" while Respondent-Applicant's "ALWAYS TRUE" mark refers to a similar attribute of genuineness, hence, there is a likelihood that confusion will arise.

Opposer's evidence consists of the following:

1. Copy of Certificate of Registration No. 1141730 (IR/1141730) for the mark STAY TRUE from WIPO;
2. Copy of Trademark Application No. 4-2013-004046 for the mark ALWAYS TRUE; and
3. Copies of the registration profiles of the WINSTON, CAMEL, SALEM, MILD SEVEN marks of the IPO;

This Bureau issued on 04 December 2013 a Notice to Answer and personally served a copy thereof to Respondent-Applicant's counsel Quisumbing Torres Law Offices on 10 January 2014. After several motions for extension of time, Respondent-Applicant filed its Answer on 21 April 2014, alleging, among others, the following Defenses:

¹ A corporation duly established and existing in accordance with the laws of Japan with principal address at 2-2-1 Toranomon, Minato-Ku, Tokyo, Japan.

² A corporation duly established and existing in accordance with the laws of United Kingdom with principal address at lobe House 4, Temple Place London, WC2R 2PG England.

"The Opposer's claim that it has exclusive and prior rights over to the "TRUE" word mark for class 34 goods has no factual and legal basis.

"The Respondent's ALWAYS TRUE mark is not confusingly similar to the Opposer's STAY TRUE mark.

"The Opposer's STAY TRUE mark is not a 'strong' mark that is entitled to wide protection.

"There is no likelihood of confusion between the Respondent's ALWAYS TRUE mark and the Opposer's STAY TRUE mark.

"There is emerging precedence affirming that the Respondent's ALWAYS TRUE mark and Opposer's STAY TRUE mark are not confusingly similar."

The Respondent-Applicant's evidence consists of the following:

1. Affidavit of Stuart Paul Aitchison;
2. Copies of sample certificate of registrations for the mark ALWAYS TRUE in many jurisdictions;
3. True copy of the Appeal Decision together with the copy of the Spanish Registry Decision dated 03 September 2013 with English translation;
4. True copy of the decision of Swiss Court dated 15 January 2014 (Case No. C/22778/2013; ACJC/49/2014);
5. Russian decision dated 03 December 2013 (Case No. A40-104639/13);
6. Affidavit of Frederick August I. Jose;
7. Photocopy of Certificate of Registration for the mark "TRUE TASTE FILTER" under Registration No. 4-2012-011378;
8. Webpage extract from IPOPHL Trademark Database obtained on 10 April 2014 showing marks with "TRUE" word in class 34; and
3. Legalized Special Power of Attorney of Stuart Paul Aitchison.

Pursuant to Office Order No. 154, s. 2010, the case was referred to the Alternative Dispute Resolution ("ADR") for mediation on 23 April 2014. However, the parties refused to mediate. On 18 March 2015, the preliminary conference was terminated and the parties were directed to file their respective position papers. On 06 April 2015, Respondent-Applicant filed its Position Paper while Opposer did so on 15 April 2015.

Should Respondent-Applicant be allowed to register its mark ALWAYS TRUE?

Section 123.1 (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"), as amended, provides:

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.

The records show that at the time the Respondent-Applicant filed its application for the mark ALWAYS TRUE on 10 April 2013, the Opposer already has an existing registration for the trademark STAY TRUE issued on 27 March 2014. As such, the certificate of registration in its name is a *prima facie evidence* of the validity of the registration, ownership of the mark and its exclusive right to use the mark in connection with the goods and/or services and those that are related thereto, pursuant to Section 138 of the IP Code.

But are the marks of the parties confusingly similar as to likely cause confusion, mistake or deception on the consumers?

The marks of the parties are herein reproduced:

STAY TRUE

Opposer's Mark

ALWAYS TRUE

Respondent-Applicant's Mark

It is clear that the manifest similarity of the marks is the presence of the word "TRUE". However, the adoption by Respondent-Applicant of the word "TRUE" as its mark does not automatically makes it confusingly similar with that of Opposer's. The word "TRUE" is a common English word which basically means "in accordance with a fact or reality". Thus, when used as a trademark, it is considered a weak mark. A weak trademark has no capacity to identify strongly a single original or source of goods or services. In this case, when we hear the word TRUE it does not exclusively suggest that it comes from Opposer or it refers only to Opposer's products only. Rather, when the word "true" is used in a mark, it suggests that the characteristics or qualities of the goods is what it is claimed to be.

That is why, based on the Trademark Database of this Office, Opposer has not solely appropriated the word "TRUE" to the exclusion of others. This Office has registered various marks adopting the word "true" as a standalone mark or in combination with other word/words under different classes of goods. In fact, Respondent-Applicant has also secured a registration for its mark TRUE TASTE FILTER under Class 34 on 06 October 2016, wherein the word "TRUE" is a composite part of the mark. As such, the mere presence of the word "TRUE" in Respondent-Applicant's mark is insufficient to establish a finding of confusing similarity between the competing marks to sustain the opposition. It also underscores the fact that the word "TRUE" is widely used as a trademark and taken alone is not very distinctive as to effectively identify the source of goods or services. Hence, what will determine whether the competing trademarks are confusingly similar are the other words or symbols present in the marks. Respondent-Applicant's mark also contains the word "ALWAYS" to form the mark ALWAYS TRUE in contrast to Opposer's mark STAY TRUE. Opposer has not adopted the word "ALWAYS" in any of its marks. Thus, the marks of the parties are not confusingly similar to each other.

Furthermore, while the marks of the parties are used on identical goods such as *cigarettes; tobacco; tobacco products; lighters; matches; smoker's articles*, it does not necessarily follow that confusion on the part of the public is inevitable. It must be pointed out that the likelihood of

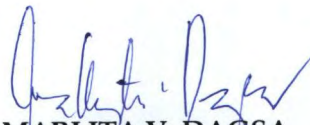
confusion, mistake or deception is on the part of the consumer is very remote. Cigarettes or tobacco products are goods that are purchased according to the consumers liking or preference of taste or familiarity of the product and brand. When a smoker buys Opposer's product and start to have liking for it, he will not get confused and get Respondent-Applicant's cigarette instead when he goes to a store. The "purchaser" in this case is not the "completely unwary consumer" but is the "ordinarily intelligent buyer" considering the type of product involved. He is "accustomed to buy, and therefore to some extent familiar with, the goods in question. "³

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 and therefore can be registered.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-004046, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 07 SEP 2017


MARLITA V. DAGOSA
Adjudication Officer
Bureau of Legal Affairs

³ Mighty Corporation and La Campana Fabrica De Tabaco, Inc. v. E. & J. Gallo Winery et. G.R. No. 154342. July 14, 2004
⁴ Pribhdas J. Mirpuri v. Court of Appeals, G. R. No. 114508, 19 Nov. 1999.