



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

SUYEN CORPORATION,
Opposer,

-versus-

ACCOLADE WINES AUSTRALIA LIMITED,
Respondent- Applicant.

x-----x

}
} **IPC No. 14-2015-00458**
} Opposition to:
} Appln. Serial No. 4-2015-008407
} Date Filed: 28 July 2015
} TM: "BENCHMARK"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 432 dated December 22, 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHEL 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, January 03, 2018.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

SUYEN COPORATION,
Opposer,

-versus-

IPC No. 14-2015-00458
Opposition to Trademark
Application No. 4-2015-008407
Date Filed: 28 July 2015

ACCOLADE WINES AUSTRALIA LIMITED, Trademark: **"BENCHMARK"**
Respondent-Applicant.

X ----- X Decision No. 2017- 432

DECISION

Suyen Corporation¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2015-008407. The contested application, filed by Accolade Wines Australia Limited² ("Respondent-Applicant"), covers the mark "BENCHMARK" for use on "*wines*" under Class 33 of the International Classification of Goods³.

According to the Opposer, it was incorporated in 1985 as manufacturing company dealing in clothing apparel, garments and accessories. At present, it is in the business of manufacturing, marketing, advertising, distributing and selling apparel and lifestyle products carrying different brands and trademarks, including its flagship brand "BENCH". It initially offered only men's t-shirts and then expanded business to a complete range of apparel and lifestyle products. Together with its sister companies, it now provides services in connection with the internet café industry, furniture industry, food industry, beauty salon and skin care industry. It also pioneered in franchising business.

The Opposer maintains as part of its continuous effort of promoting and marketing its "BENCH" trademarks and products, it launched "BENCHMARK" in February 2014, the official magazine of the "BENCH" group of companies. The magazines are available in all "BENCH" stores worldwide. Then on 03 December 2013, it filed an application for "BENCHMARK", which was eventually issued registration on 19 June 2014. It thus contends that the Respondent-Applicant's mark "BENCHMARK" is identical or confusingly similar to its own registered trademark. In support of their Opposition, the Opposer submitted the affidavit of its Assistant Vice-

¹ A corporation organized and existing under the laws of the Republic of the Philippines with office address at Bench Tower, 30th Street corner Rizal Drive, Crescent Park West 5, Bonifacio Global City, Taguig 1634.

² With office address at Reynell Road, Reynella 5161, South Australia.

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.

President – Brand Marketing for local brands, Mr. Dale Gerald G. Dela Cruz, with annexes.⁴

The Respondent-Applicant filed its Answer on 11 April 2016 alleging, among others, that it traces its roots to a wine company called Thomas Hardy and Sons, which was founded by Thomas Hardy in 1853. It owns a broad portfolio of wine brands, which includes several prestigious and commercially successful brands. The "BENCHMARK" range is a sub-brand of its "GRANT BURGE" brand of wines, which traces its pedigree as far back as 1855. To protect its intellectual property rights, it applied for or obtained trademark registrations for "BENCHMARK" in several countries. In the Philippines, it has had presence as early as 2010 through its key distributor, Wine Warehouse. It asserts that there is no confusing similarity between its mark and that of the Opposer's. The Respondent-Applicant's evidence consists of the affidavit of Julie Anne Ryan, its Company Secretary and Associate General Counsel, with annexes, and copies of its trademark registrations.⁵

Pursuant to Office Order No. 154, s. 2010, the case was referred to mediation. The parties, however, refused to mediate. On 24 November 2016, the Preliminary Conference was conducted wherein the parties were directed to submit their respective position papers within ten days therefrom. After which, with or without submission, the case is deemed submitted for decision.

The issue to be resolved in this case is whether the Respondent-Applicant's trademark application for "BENCHMARK" should be allowed.

Records reveal that at the time the Respondent-Applicant filed its application on 28 July 2015, the Opposer has valid and existing registrations of its "BENCHMARK" trademark issued on 19 June 2014.

There is no question that the competing marks are identical. Both consist of the compound word, "BENCHMARK" in plain lettering. Consequently, they are similar in spelling and pronunciation. Be that as it may, this Adjudication Officer finds that the Respondent-Applicant's mark may be allowed registration. Section 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that:

"123.1. A mark cannot be registered if it:

(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

⁴ Marked as Exhibits "A" to "P", inclusive.

⁵ Marked as Exhibits "1" to "4", inclusive.

- (ii) Closely related goods or services, or*
(iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion; xxx" (Emphasis supplied.)

Confusion, much more deception, is highly unlikely in this case because of the disparity of the goods involved. The Opposer's "BENCHMARK" covers "magazine, catalogue, news letter, book". Not only are these obviously unrelated to wines, which the Respondent-Applicant uses or intends to use its mark, the target consumers and channels of trade are different. Noteworthy, the Opposer itself claims that its "BENCHMARK" magazine is available in its "BENCH" stores. Therefore, the consumers of one will not be confused, misled and/or deceived that the Opposer's print materials are in any way related or connected to the Respondent-Applicant's wines.

Moreover, it is noteworthy that the Respondent-Applicant's goods are the types which are thoughtfully chosen by its target consumers. Cast in this particular controversy, the ordinary purchaser is not the "completely unwary consumer" but is the "ordinarily intelligent buyer" considering the type of product involved. The definition laid down in *Dy Buncio v. Tan Tiao Bok* is better suited to the present case. There, the "ordinary purchaser" was defined as one "accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The simulation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."⁶

Furthermore, 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.⁷ The Respondent-Applicant's mark sufficiently met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2015-


⁶ *Victorio P. Diaz vs. People of the Philippines*, G.R. No. 180677, 18 February 2013.

⁷ *Pribhdas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 November 1999.

008047 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **22 DEC 2017**


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