

SUYEN CORPORATION, Opposer,	} } }	IPC No. 14-2014-00487 Opposition to: Appln. Ser. No. 01171914
-versus-	}	Date Filed: 25 March 2013
AKTSIONERNO DROUJESTVO "BULGARTABAC-HOLDING", Respondent-Applicant.	} } }	TM: B

NOTICE OF DECISION

MIGALLOS AND LUNA LAW OFFICES

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GREETINGS:

Please be informed that Decision No. 2017 - 403 dated 05 December 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, 11 December 2017.

Bureau of Legal Affairs



SUYEN CORPORATION, Opposer,	FIPC NO. 14-2014-00487 Opposition to:
Opposer,	} Opposition to:
-versus-	}Appln. Ser. No. 01171914
	}Date Filed: 25 March 2013
	}
AKTSIONERNO DROUJESTVO	}Trademark:
"BULGARTABAC-HOLDING",	} "B"
Respondent-Applicant.	}
X	x}Decision No. 2017- <i>403</i>

DECISION

SUYEN CORPORATION, (Opposer)¹ filed an opposition to Trademark The application, filed by AKTSIONERNO Application Serial No. 01171914. DROUJESTVO "BULGARTABAC-HOLDING", (Respondent-Applicant)², covers the mark "", for use on "paper, cardboard and goods made from these materials, printed matter, photographs, plastic materials for packaging (not included in other classes), paper and cardboard packages, especially cigarette packages, boxes or cardboard, wrappings and packages (stationary), packing paper, cigar bands, stationary, forms printed, pamphlets, writing pads, placards of paper, cardboard, posters, decalcomanias, labels not textile, labels not of textile, calendars, catalogues, folders, (stationary), files (office requisites), bags (envelope pouches) of paper or plastics for packaging" under Class 16, "beers, mineral and aerated waters and other non-alcoholic beverages, fruit juices, syrups and other preparations for making beverages" under Class 32, "Tobacco, smoker's articles, matches, cigarettes, cigarillos, lighters for smokers, tobacco raw manipulated or processed, tobacco products, cigarette filters, cigarette paper, ashtrays for smokers" under Class 34 and "Advertising, business management, business administration, office functions etc." under Class 35 of the International Classification of Goods³.

The Opposer anchors its opposition on the ground that it will be damaged by the registration of the mark "B". It avers that the mark is identical to and confusingly similar with Opposer's registered trademarks and will mislead the public into believing that the products bearing the same mark are the same products marketed and sold by the Opposer. The Opposer contends that the registration of the mark of the Respondent-Applicant will

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¹ A domestic corporation duly organized and existing under Philippine laws with principal address at Bench Tower, 30th St. corner Rizal drive, Cresecent Park West 5, Bonifacio Global City, Taguig

² A corporation organized under the laws of Bulgaria with address at "Graf Ignatiev" str. 62, BG-1000 Sofia, Bulgaria

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.

mislead the public into believing that the products bearing the mark are sold by Opposer and that the products originate from the same source.

To support its opposition, the Opposer submitted as evidence the Affidavit of Jude W. Ong dated 23 December 2014, Certified true copies of the trademark registrations of "BENCH"; Advertisements of "BENCH"; Promotional materials of "BENCH"; scanned hangtags of "BENCH"; Print-out of web pages of "BENCH" including "B-LOGO at www.bench.com.ph; Photographs of standees, shopping bags, advertisements of B-LOGO or BENCH.⁴

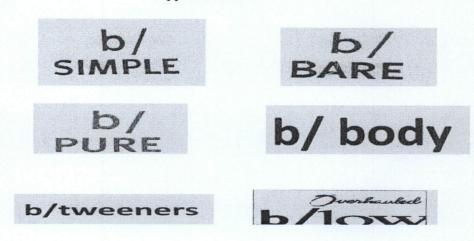
This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 2 February 2015. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 13 August 2015 Order No. 2012-1162 declaring the Respondent-Applicant to have waived its right to file an Answer.

Should the Respondent-Applicant be allowed to register the trademark B?

Records show that at the time Respondent-Applicant filed an applied for registration of the mark "B" the Opposer already registered the marks b/SIMPLE, under certificate of Registration No. 4-1998-003501 issued on 8 December 2005; b/PURE under Certificate of Registration No. 4-1998-003498 issued on 20 November 2005 and b/BARE under Certificate of Registration No. 4-1998-003500 issued on 8 December 2005. The goods covered by the Opposer's trademark registrations are under Class 03, while the Respondent-Applicant's trademark application is for computer services under Classes 16, 32, 34 and 35.

The competing marks are reproduced below:

Opposer's marks



Exhibits "B" inclusive of submarkings

And

⁴ Exhibits "A" to "K", inclusive of submarkings.



Respondent-Applicant's mark



At the outset, we note that the Opposer has a pending application for "B" LOGO. Opposer alleged that it used the "B" LOGO, and has secured registrations for its "BENCH" trademarks and "b/SIMPLE", "b/PURE", "b/BARE", "Overhauled b/low", "b/body" and "b/tweeners" marks. Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur. As seen, the Respondent-Applicant's B mark is a device or logo, creatively designed with what appears to be depiction of a star or an X mark in the middle, that forms the letter B. The result is a unique mark that represents the letter B, which is the first letter of the "BULGARTABAC", a part of the Respondent-Applicant's name. In addition, the stylized letter B, is frequently used as a trademark as seen the IPO Phil trademark database.

More importantly, the Opposer uses "b/" and/or B logo goods consisting of body spray products for females, denim jeans, personal care, shoes, bag, clothing products under classes 3, 25, 18 and 35. On the other hand, the Respondent-Applicant's mark "B" is applied on Paper, cardboard, printed materials and the like, Beers, Tobacco products, and advertising and business management, among other things". Considering the diversity of the products of the parties, no confusion is likely even if the contending marks contain a common element, the letter "B".

The Supreme Court in the case of Philippine Refining v. Ng Sam held that:

A rudimentary precept in trademark protection is that "the right to a trademark is a limited one, in the sense that others may use the same mark on unrelated goods." Thus, as pronounced by the United States Supreme Court in the case of *American Foundries vs. Robertson* ², "the mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description."

Such restricted right over a trademark is likewise reflected in our Trademark law. Under Section 4(d) of the law, registration of a trademark which so resembles another already registered or in use should be denied, where to allow such registration could likely result in confusion, mistake or deception to the

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⁶ http://www.wipo.int/branddb/ph/en/

consumers. Conversely, where no confusion is likely to arise, as in this case, registration of a similar or even identical mark may be allowed.

The term "CAMIA" is descriptive of a whole genus of garden plants with fragrant white flowers. Some people call the "CAMIA" the "white ginger plant" because of its tuberous roots, while children refer to it as the butterfly flower because of its shape. Being a generic and common term, its appropriation as a trademark, albeit in a fanciful manner in that it bears no relation to the product it Identifies, is valid. However, the degree of exclusiveness accorded to each user is closely restricted.

In Canon Kabushiki Kaisha v. Court of Appeals and NSR Rubber Corporation, the Supreme Court held:

Here, the products involved are so unrelated that the public will not be misled that there is the slightest nexus between petitioner and the goods of private respondent.

In cases of confusion of business or origin, the question that usually arises is whether the respective goods or services of the senior user and the junior user are so related as to likely cause confusion of business or origin, and thereby render the trademark or tradenames confusingly similar. Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores.

Thus, in Esso Standard Eastern, Inc. vs. Court of Appeals, this Court ruled that the petroleum products on which the petitioner therein used the trademark ESSO, and the product of respondent, cigarettes are "so foreign to each other as to make it unlikely that purchasers would think that petitioner is the manufacturer of respondent's goods" Moreover, the fact that the goods involved therein flow through different channels of trade highlighted their dissimilarity, a factor explained in this wise:

"The products of each party move along and are disposed through different channels of distribution. The (petitioner's) products are distributed principally through gasoline service and lubrication stations, automotive shops and hardware stores. On the other hand, the (respondent's) cigarettes are sold in sari-sari stores, grocery store, and other small distributor outlets. (Respondent's) cigarettes are even peddled in the streets while (petitioner's) 'gasul' burners are not. Finally, there is a marked distinction between oil and tobacco, as well as between petroleum and cigarettes. Evidently, in kind and nature the products of (respondent) and of (petitioner) are poles apart."

Undoubtedly, the paints, chemical products, toner and dyestuff of petitioner that carry the trademark CANON are unrelated to sandals, the product of private respondent. We agree with the BPTTT, following the Esso doctrine, when it noted that the two classes of products in this case flow through different trade channels. The products of petitioner are sold through special chemical stores or distributors while the products of private respondent are sold in grocery stores, sari-sari stores and department stores. Thus, the evident disparity of the products

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of the parties in the case at bar renders unfounded the apprehension of petitioner that confusion of business or origin might occur if private respondent is allowed to use the mark CANON.

Apart from the striking difference between the physical appearance and commercial presentation of the marks, the marks are also applied on totally unrelated goods/services thus confusion is unlikely.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 01171914 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **V5 DEC 2017**

Atty. ADORACION U. ZARE, LL.M.

Adjudication Officer Bureau of Legal Affairs