

3M COMPANY

Opposer,

-versus-

SUPREMO'S FOOD CORPORATION,
Respondent-Applicant.

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IPC No. 14-2007-00101

Case Filed: 16 April 2007

Opposition to:

Serial No: 4-2003-004446

Filed : 19 May 2003

Trademark: "3M PIZZA PIE"

Decision No. 2008-192

DECISION

Before this Office is an Opposition filed by 3M Company, a corporation duly organized and existing under the laws of the United States of America, with principal office address at 3M Center, 2501 Hudson Road, St. Paul, Minnesota, U.S.A., against the application for registration of the trademark "3M PIZZA PIE" for pizza and pasta under Class 30, with Application Serial No. 4-2003-004446 and filed on 19 May 2003 in the name of Respondent-Applicant, Supremo's Food Corporation with business address at 28 13th Street, New Manila, Quezon City, Philippines.

The grounds upon which the opposition to the registration of the trademark 3M TAKE HOME PIZZA PIE were anchored are as follows:

"1. Opposer is the registered owner of the trademark 3M in the Philippines under Certificate of Registration Nos. 053426, 022353, 066817 and 41998002390 issued by the Intellectual Property Office. Opposer is the first user and prior registrant of the trademark 3M as well as at least fifty (50) variations thereof (the "3M Mark") covering a wide range of goods in all Classes in the United States of America since 1906 and in the Philippines and other countries long before Respondent-Applicant appropriated the confusingly similar mark 3M PIZZA PIE for its own products in Class 30.

"2. Respondent-Applicant's trademark 3M PIZZA PIE so resembles Opposer's 3M Mark because their dominant and distinctive elements ("3M") are identical, as to be likely, when applied to or used in connection with the goods of Respondent-Applicant, to cause confusion, mistake and deception on the part of the purchasing public by misleading them into thinking that Respondent-Applicant's goods either come from Opposer or are sponsored or licensed by it.

"3. Opposer offers a number of products to the general public under the 3M Mark, including home cleaning supplies, office supplies, fabric protectors, first aid products, overhead projectors, car care products, and home improvement products.

"4. Opposer offers many products and solutions designed for and used in the food service industry, including restaurants of the type operated by Respondent-Applicant. These products include but are not limited to: food service cleaning chemical management systems; restaurant floor maintenance products; products for monitoring and maintaining shortening consistency and quality; wireless intercoms and headsets used by restaurants; floor mats and pads that provide safety and comfort for various restaurant applications; griddle cleaning systems and tools; toaster cleaning systems; a wide range of other cleaning tools and supplies for restaurants; and various products used in making indoor and outdoor graphics for restaurants.

- “5. The registration and use by Respondent-Applicant of the trademark 3M PIZZA PIE will diminish the distinctiveness and dilute the goodwill of Opposer’s 3M Mark, which are arbitrary trademarks when applied to Opposer’s products.
- “6. Respondent-Applicant adopted the trademark 3M PIZZA PIE on its own goods after the 3M Mark was already famous and had acquired distinctiveness in the Philippines and worldwide.
- “7. The approval of Respondent-Applicant’s trademark 3M PIZZA PIE is based on the representation that it is the originator, true owner and first user of the trademark, which was merely derived from Opposer’s 3M Mark.
- “8. Opposer is the first user of the 3M Mark in Philippine commerce and elsewhere, having utilized the same extensively for over 40 years in the Philippines. Opposer’s 3M Mark are so popular and have come to be associated with numerous products of the finest quality. Respondent-Applicant’s use of a confusingly similar mark for its own products is likely to cause consumer confusion as to the origin of said goods.
- “9. Respondent-Applicant’s use of the trademark 3M PIZZA PIE infringes upon Opposer’s exclusive right to use the 3M Mark, which are well-known trademarks protected under Sections 147 and 123.1 (d), (e) and (f) of the Intellectual Property Code (“IP Code”), Article 6bis of the Paris Convention and Article 16 of the Agreement on Trade Related Aspects of Intellectual Property Rights to which the Philippines and United States of America adhere.
- “10. The Opposer uses “3M” not only as a trademark but also as trade name – 3M Company. Opposer’s 3M Mark are, therefore, protected by Article 8 of Paris Convention which provides that “a trade name shall be protected in all countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark” as well as by Section 165 of the IP Code which provides that “a name or designation may not be used as a trade name if by its nature or the use to which such name or designation may be put, it is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.” In appropriating 3M PIZZA PIE as a mark, Respondent-Applicant betrayed its awareness of Opposer’s existence and the prior use and renown of Opposer’s 3M Marks. This Office must implement the provisions of the Paris Convention and the IP Code by confirming Opposer’s rightful ownership of its 3M Marks and trade name.
- “11. The registration of the trademark 3M PIZZA PIE in the name of the Respondent-Applicant is contrary to other provisions of the IP Code.

Opposer relied on the following facts to support its contentions in this Opposition:

- “12. Opposer adopted and has been using the 3M Mark for its goods and services since 1906, long before Respondent-Applicant’s unauthorized usage of the confusingly similar trademark 3M PIZZA PIE. Opposer has been commercially using the 3M Mark in the Philippines for almost 40 years before the filing of the application for the registration of the trademark 3M PIZZA PIE by Respondent-Applicant in 2003.
- “13. Opposer is the first user and rightful owner of the 3M Mark. Opposer has also used and registered or applied for the registration of the 3M Mark in many countries worldwide, including the Philippines.

“14. Opposer’s 3M Mark are arbitrary trademarks and are entitled to broad legal protection against unauthorized users like Respondent-Applicant who has appropriated the deceptively similar trademark 3M PIZZA PIE for its own goods.

“15. Opposer is the first user of the 3M Mark in the Philippines and elsewhere. Respondent-Applicant has appropriated the trademark 3M PIZZA PIE for the obvious purpose of capitalizing upon the renown of Opposer’s trademark.

“16. The registration and use of a confusingly similar trademark by the Respondent-Applicant will tend to deceive and/or confuse purchasers into believing that Respondent-Applicant’s products emanate from or are under the sponsorship of Opposer and damage Opposer’s interests for the following reasons:

“17. Opposer uses “3M” not only as a trademark but also as trade name – 3M Company – and therefore, Opposer is protected against the use by others under Article 8 of Paris Convention and Section 165 of the IP Code.

“18. The registration and use of an identical trademark by Respondent-Applicant will diminish the distinctiveness and dilute the goodwill of Opposer’s 3M Mark.

The Notice to Answer dated 23 May 2007 was sent to Respondent-Applicant. Considering that Respondent-Applicant’s Office has moved out from its original address at New Manila, Quezon City, this Office issued another Notice to Answer dated 22 June 2007 to reflect the new address of Respondent-Applicant at No 77 Evangelista Street, Project 4, Quezon City. After granting motions for extension of time to file respondent pleading and other manifestations of Respondent-Applicant to furnish them copies of annexes that were not attached in their copy of Opposer’s Verified Notice of Opposition, Respondent-Applicant finally filed their Answer on 01 January 2008.

Respondent in its Verified Answer with Motion to Expunge interposed the following ADMISSIONS and/or DENIALS:

1. “Paragraph 1 of the Notice of Opposition insofar as it alleges that 3M Company (“Opposer”, for brevity) is the registered owner of the “3M” trademark in the Philippines under Certificate of Registration Nos. 053426, 022353, 066817 and 41998002390 issued by the Intellectual Property Office (“IPO”, for brevity) is DENIED for lack of knowledge or information sufficient to form a belief as to the truth thereof. however, the rest of the allegations are DENIED for being factually conclusory, inaccurate, false and misleading, the truth being Opposer has not presented any verifiable proof that it was the first user of the “3M” mark in the Philippines and/or long before Respondent-Applicant used the “3M Pizza Pie” mark, and the truth being there is no declared “date of first use” in Opposer’s local registration certificates, and the truth being those set forth under the Affirmative Allegations/Defenses.
2. “Paragraph 2 of the Notice of Opposition is DENIED for being false, misleading, and factually and legally conclusory, the truth being the dominant mark of Respondent-Applicant’s “3M Pizza Pie” mark are the words “Pizza Pie” and not the number and word combination of “3M”, and the truth being Respondent-Applicant’s “3M Pizza Pie” mark does not resemble Opposer’s “3M” mark, thus, cannot and will not cause any confusion, mistake and/or deception on the part of the purchasing public, nor mislead the latter into thinking that Respondent-Applicant’s goods either come from Opposer or are sponsored or licensed by it, and the truth being that set forth under the Affirmative Allegations/Defenses.

3. "Paragraph 3 of the Notice of Opposition is DENIED for lack of knowledge sufficient to form a belief as to the truth thereof.
4. "Paragraph 4 of the Notice of Opposition insofar as it alleges that Opposer offers many products and solutions designed for and used in the "food service industry" is DENIED for being false, inaccurate and misleading, the truth being Opposer has not cited nor provided a single product of theirs that is "actually" used on food or a food product by itself, and the truth being that set forth under the Affirmative Allegations/Defenses. On the other hand, the rest of the allegations are DENIED for lack of knowledge sufficient to form a belief as to the truth thereof.
5. "Paragraph 5 of the Notice of Opposition is DENIED for being factually and legally conclusory, the truth being the registration and use of Respondent-Applicant's "3M Pizza Pie" mark will not diminish the distinctiveness and dilute the goodwill, if any, of Opposer's "3M" mark considering that they are neither identical nor confusingly similar marks, and the truth being that set forth under the Affirmative Allegations/Defenses.
6. "Paragraphs 6 and 7 of the Notice of Opposition are DENIED for being false, misleading and factually conclusory, the truth being Respondent-Applicant had been using the "3M Pizza Pie" mark as early as 1969, or long before herein Opposer even used its "3M" mark in the Philippines, the truth also being Respondent-Applicant's "3M Pizza Pie" mark was never derived from Opposer's "3M" mark, and the truth being that set forth under the Affirmative Allegations/Defenses.
7. "Paragraph 8 of the Notice of Opposition is DENIED for being false, inaccurate, misleading, self-serving, and factually and legally conclusory, the truth being Opposer has not presented any verifiable proof that it was the first user of the "3M" mark in the Philippines and/or long before Respondent-Applicant used the "3M Pizza Pie" mark, and the truth being there is no declared "date of first use" in Opposer's local registration certificates, and the truth being that set forth under the Affirmative Allegations/Defenses.
8. "Paragraph 9 of the Notice of Opposition is DENIED for being false, misleading, self-serving and legally conclusory, the truth being the use of the "3M Pizza Pie" mark did not and will not infringe upon Opposer's right to use its "3M" mark, and the truth being set forth under the Affirmative Allegations/Defenses.
9. "Paragraph 10 of the Notice of Opposition insofar as it alleges that Opposer uses "3M" not only as a trademark but also as a trade name is DENIED for lack of knowledge sufficient to form a belief as to the truth thereof. However, the rest of the allegations are DENIED for being false, misleading, self-serving and factually and legally conclusory, the truth being Respondent-Applicant did not betray its awareness of Opposer's existence and the prior use and renown of its trademark as there is nothing in its Certificate of Registration that will show its "actual date of first use" of their "3M" marks, and the truth being that set forth under the Affirmative Allegations/Defenses.
10. "Paragraph 11(1) of the Notice of Opposition is DENIED for being false, misleading, self-serving and factually and legally conclusory, the truth being Opposer has not presented any verifiable proof to support its claim that its good and/or services has been using its "3M" mark since 1906, the truth also being the invoices presented by Opposer to show actual use in the Philippines are very recent in date, and the truth being its Certificate of Registration does not indicate any "date of first actual use", and the truth being that set forth under the Affirmative Allegations/Defenses.

11. "Paragraph 11(2) of the Notice of Opposition insofar as it alleges that Opposer has used and registered or applied for the registration of the "3M" mark in many other countries worldwide is DENIED for lack of knowledge sufficient to form a belief as to the truth thereof. However, the rest of the allegations are DENIED for being false, misleading, and self-serving, the truth being Opposer has not presented any verifiable proof to support its claim that its good and services have been using its "3M" mark as early as 1906, and the truth being the invoices presented by Opposer to show actual use in the Philippines are very recent in date, and the truth being its Certificate of Registration does not show any "date of first actual use", and the truth being that set forth under the Affirmative Allegations/Defenses.
12. "Paragraph 11(3) of the Notice of Opposition is DENIED for being self-serving and factually and legally conclusory, the truth being the "3M Pizza Pie" mark is not deceptively similar to Opposer's "3M" mark, and the truth being that set forth under the Affirmative Allegations/Defenses.
13. "Paragraph 11(4) of the Notice of Opposition is DENIED for being false, misleading, and self-serving, the truth being Opposer has not presented any verifiable proof to support its claim that it was the first user of the "3M" mark in the Philippines and elsewhere, and the truth being the invoices presented by Opposer to show actual first use of its mark in the Philippines are very recent in date, and the truth being its Certificate of Registration does not indicate any "date of first actual use", and the truth being that set forth under the Affirmative Allegations/Defenses.
14. "Paragraph 11(5) (i) of the Notice of Opposition is DENIED for being false, misleading, self-serving, and factually and legally conclusory, the truth being the mark sought to be registered by Respondent-Applicant is not confusingly or deceptively similar to Opposer's "3M" marks and that their dominant and distinctive elements are not identical, and the truth being that set forth under the Affirmative Allegations/Defenses.
15. "Paragraph 11(5)(ii) of the Notice of Opposition is DENIED for being false, misleading, self-serving, and factually and legally conclusory, the truth being Respondent-Applicant's "3M Pizza Pie" mark will not dilute Opposer's reputation and goodwill, if any, among consumers as the products being sold by the former as compared to those of the later are undoubtedly different and categorized as non-competing products, and the truth being that set forth under the Affirmative Allegations/Defenses.
16. "Paragraph 11(5) (iii) of the Notice of Opposition is DENIED for being false, misleading, self-serving, and factually and legally conclusory, the truth being Respondent-Applicant has been using the "3M Pizza Pie" mark as early as 1969 and, therefore, did not use its mark as a self-promoting mark to gain public acceptability through its association with Opposer's "3M" mark, and the truth being that set forth under the Affirmative Allegations/Defenses.
17. "Paragraph 11(5)(iv) of the Notice of Opposition is DENIED for being false, misleading and factually and legally conclusory, the truth being Respondent-Applicant did not, is not, and will not trade on Opposer's goodwill, if any, on its "3M" mark as it has been using its "3M Pizza Pie" mark as early as 1969 or long before Opposer used its "3M" mark(s) here in the Philippines, and the truth being that set forth under the Affirmative Allegations/Defenses.

18. "Paragraph 6 of the Notice of Opposition as it alleges that the "3M" mark is not only used as a trademark but also as a trade name is DENIED for lack of knowledge sufficient to form a belief as to the truth thereof. However, the rest of the allegations are DENIED for being self-serving and legally conclusory, the truth being that set forth under the Affirmative Allegations/Defenses.
19. "Paragraph 7 of the Notice of Opposition is DENIED for being false, misleading, self-serving, and factually and legally conclusory, the truth being the "3M Pizza Pie" mark sought to be registered by Respondent-Applicant is not identical to Opposer's "3M" trademark, and the truth being the use of Respondent-Applicant's "3M Pizza Pie" mark will not diminish the distinctiveness and dilute the goodwill, if any, on its "3M" mark, and the truth being that set forth under the Affirmative Allegations/Defenses.

and by way of affirmative allegations/defenses further stated the following to wit:

20. "3M Pizza Pie" is the first commercialized "Pinoy Pizza" in the Philippines, in fact, it has been in operations since 1969 and, to many, it is not only seen as a business house but an institution. It currently operates various company/dealership outlets spreading all over Metro Manila.
 - 20.1 "With over thirty (30) years of experience in the fast food business, 3M Pizza Pie has made millions of Filipino pizza lovers happy with its crispy thin crust and sweet home-style sauce, a barrage of homegrown ham-squares, and cheddar cheese.
 - 20.2 "With more and more pizza chains in the market today (not to mention, the tight competition), 3M Pizza Pie plans to re-establish itself as one of the leading pizza companies in the Philippines by reinventing the brand and upgrading its image.
21. "3M Pizza Pie was founded by Merlied B. Hemedes ("Merlie" for brevity) sometime in 1969 when she came back to the Philippines from the United States of America and wanted to introduce pizza in the country through practicable channels.
22. "Having been a regular pizza flavor lover in New York, Merlie reinvented her pizza dishes by catering to the sweet taste of Filipinos with a unique sauce and thin crispy crust, topped with ham instead of pepperoni to make it very affordable for the Filipino masses. In her own preference, she used cheddar cheese instead of mozzarella.
 - 22.1 "Merlie's one goal was to make quality pizza available to the Filipinos and her guiding philosophy was that if the taste befits a king and yet its affordable to the poor, then it should have the "3M Pizza Pie" brand.
23. "As its humble beginning in 1969, the first outlet was a small kiosk located outside their toy-shop business located at the Quezon arcade near the Araneta Center in Cubao, Quezon City. Surprisingly, it became an instant success story since it was the first time many Filipinos had ever tasted pizza made here in the Philippines.
 - 23.1 "Even at its inception, 3M Pizza Pie was an automatic big hit. In fact, the constant times of hundreds, if not thousands, of clients at 3M Pizza Pie outlets were seen immediately in the first few months of its operation. The Affidavits of Respondent-Applicant's

employees, Zenaida I. Hebron and Spouses Renato and Leonora Perpetua, attesting to such facts are attached hereto and made integral parts hereof as Exhibit "1-Series".

24. "In 1971, Merlie's sisters, Minerva B. Miller and Milagros B. Villar, joined her and founded M (Cube) Enterprises, Inc. A few years later another sister Leandra B. Pascual, joined the company and helped in its management and operation.
 - 24.1 "Between the years 1970 to 1980, 3M Pizza Pie branches spouted in various location, such as, but not limited to, Mabini, Padre Faura, España, Marphidia, Fiesta Carnival, San Lazaro, Vito Cruz, Luneta, Green Valley and Domestic Airport.
 - 24.2 "On the other hand, between the years 1980 to 1990, 3M Pizza Pie branches sprouted in more locations, among others were, at the Las Pinas Mall, Metromall, Metropolis, Baclaran, Alabang and at the Isetann Mall located in Recto, Manila. 3M Pizza Pie's presence practically covered the entire Metropolitan Manila area.
 - 24.3 "During this era, 3M Pizza Pie would become a rave not only among adults, more importantly, among kids and/or teenagers. A copy of the Manila Bulletin Article dated 14 July 2004 attesting to such fact is attached hereto and made an integral part hereof as Exhibit "2".
25. "By 1996, M3 (Cube) was dissolved when Milagros decided to leave the company and agreed to divide all outlets among the four sisters. The outlets of the three sisters who stayed together have then reincorporated under the name Supremo's Food Corporation and operated over twenty-five (25) company and dealership outlets all over Metro Manila.
26. "On 17 September 2006, which coincidentally was also the thirty-seventh (37th) year anniversary of the very first (1st) established 3M Pizza Pie store, the torch was passed on to four (4) dynamic entrepreneurs who succeeded ownership of the Corporation.
 - 26.1 "Under new management, 3M Pizza Pie plans to re-establish itself as the leading quick-serve pizza, pasta & snacks in the country by reinventing the brand and upgrading its image.
27. "At present, 3M Pizza Pie serves regular pizzas, in Mini or Mega sizes, in various flavors such as, but not limited to, "Ham & Cheese", "Hawaiian Delight", "Pepperoni Feast" and "Cheeseburger". On the other hand, 3M Pizza Pie likewise serves special pizza flavors, also in Mini or Mega sizes, in various flavors such "Mushroomania", "Bell Pepper & Onion", "Gardener's Delight", "Beefy Mea Sauce", "Pinoy Combo", "Meat Galore", "3M Supreme" and "Tuna Special".
 - 27.1 "Aside form its regular and specially flavored pizza, 3M Pizza Pie likewise offers pastas such as Spaghetti and Lasagna and Pizzadogs. Of course, 3M Pizza Pie also serves softdrinks and coffee to its consumers.
28. "Thus, it comes as a complete surprise to Respondent-Applicant that herein Opposer objects and/or opposes the registration of the former's "3M Pizza Pie" mark when, in truth and in fact, it has been used and still being used by the Corporation as early as 1969 and is likewise widely known and/or popular to the Filipino community as the very first original "Pinoy Pizza".

and averred further by way of arguments/discussions the following:

29. "Be that as it may, a scholarly perusal and appraisal of the Notice of Opposition would readily reveal that it should be dismissed by the Honorable Office based on various grounds and/or reasons.

29.1 "In order that the Honorable Office would be able to get a clear picture of the facts, circumstances and events relevant to the instant case, these grounds and/or reasons shall be discussed in seriatim.

30. "As discussed earlier, for failure to comply with the provisions of the Regulations and Office Order No. 79, the Notice of Opposition must be expunged from the record.

31. "In fact, it has been well-settled that without being duly authorized by a resolution of the board of the corporation, one cannot simply sign the verification and certificate against forum-shopping accompanying the Notice of Opposition, Petition or any other document, for that matter.

32. "A similar ruling was reached in the case of Santiago Eslaban, Jr. vs. Clarita Vda. De Onorio (G.R. No. 146062, 28 June 2001) where it was held that:

"In this case, the petition for review was filed by Santiago Eslaban, Jr., in his capacity as Project Manger of the NIA. However, the verification and certification against forum-shopping were signed by Cesar E. Gonzales, the administrator of the agency. The real party-in-interest is the NIA, which is a body corporate. Without being duly authorized by resolution of the board of the corporation, neither Santiago Eslaban, Jr. nor Cesar E. Gonzales could sign the certificate against forum-shopping accompanying the petition for review. Hence, on this ground alone, the petition should be dismissed."
(Underscoring and emphasis supplied)

33. "Additionally, in the case of Tam Wing Tak v. Hon. Ramon P. Makasiar (G.R. No. 29 January 2001), it was enunciated that:

"Second, it is not disputed in the instant case that Concord, a domestic corporation, was the payee of the bum check, not petitioner. Therefore, it is Concord, as payee of the bounced check, which is the injured party. Since petitioner was neither a payee nor a holder of the bad check, he had neither the personality to sue nor a cause of action against Vic Ang Siong. Under Section 36 of the Corporation Code read in relation to Section 23, it is clear that where a corporation is an injured party, its power to sue is lodged with its board of directors or trustees. Note that petitioner failed to show any proof that he was authorized or deputized or granted specific powers by Concord's board of director to sue Victor Ang Siong for and on behalf of the firm. Clearly, petitioner as a minority stockholder and member of the board of directors had no such power or authority to sue on Concord's behalf. Nor can we uphold his act as a derivative suit. For a derivative suit to prosper, it is required that the minority stockholder suing for and on behalf of the corporation must allege in his complaint that he is suing on a derivative cause of action on behalf of the corporation and all other stockholders similarly situated who may wish to join him in the suit. There is no showing that petitioner has complied with the

foregoing requisites. It is obvious that petitioner has not shown any clear legal right which would warrant the overturning against Vic Ang Siong. A public prosecutor, by the nature of his office, is under no compulsion to file a criminal information where no clear legal justification has been shown, and no sufficient evidence of guilt nor prima facie case has been presented by the petitioner. No reversible error may be attributed to the court a quo when it dismissed petitioner's special civil action for mandamus." (Underscoring and emphasis supplied)

34. "Neither can Plaintiff harp on substantial compliance as held in the case of BPI Leasing Corporation vs. Court of Appeals (G.R. No. 127624, 18 November 2003), viz:

"The argument of substantial compliance deserves no merit, given the Court's ruling in Mendigorin v. Cabantog:

. . . The CA held that there was substantial compliance with the Rules of Court, citing Dimagiba vs. Montalvo, Jr. [202 SCRA 641] to the effect that a lawyer who assumes responsibility for a client's cause has the duty to know the entire history of the case, especially if any litigation is commenced. The view, however, no longer holds authoritative value in the light of Digital Microwave Corporation vs CA [328 SCRA 286], where it was held that the reason the certification against forum shopping is required to be accomplished by petitioner himself is that only the petitioner himself has actual knowledge of whether or not he has initiated similar actions or proceedings in other courts or tribunals. Even counsel of record may be unaware of such fact. To our mind, this view is more in accord with the intent and purpose of Revised Circular No. 28-91." (Underscoring and emphasis supplied)

35. "Equally important is the case of Efren O. Loquias, et. al. v. Office of the Ombudsman, et. al. (G.R. No. 139396, 15 August 2000) where the Supreme Court aptly ruled that:

"At the outset, it is noted that the Verification and Certification was signed by Antonio Din, Jr., one of the petitioners in the instant case. In this case, the petition for review was filed by Santiago Eslaban, Jr., in his capacity as Project Manager of the NIA. However, the verification and certification against forum-shopping were signed by Cesar E. Gonzales, the administrator of the agency. The real party-in-interest is the NIA, which is a body corporate. Without being duly authorized by resolution of the board of the corporation, neither Santiago Eslaban, Jr. nor Cesar E. Gonzales could sign the certificate against forum-shopping accompanying the petition for review. Hence, on this ground alone, the petition should be dismissed." (Underscoring and emphasis supplied)

36. "It is therefore as clear as day that there is no other recourse but for the Honorable Office to expunge the instant Notice of Opposition from the records of the instant case.
37. "Section 123.1(d) of Republic Act No. 8293 otherwise known as the Intellectual Property Code of the Philippines ("RA No. 8293", for brevity) provides for the marks that cannot be registered with the Intellectual Property Office ("IPO", for brevity). It states that:

“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;

- e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;”

- f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are nor similar to those with respect to which registration is applied for:

x x x

- 38. “Applying the stringent requirements provided in the afore-quoted provisions of RA No. 8293, Respondent-Applicant humbly submits that its “3M Pizza Pie” mark should be allowed registration by the Honorable Office since it does not violate sections d, e and f of RA No. 8293.

- 39. “First of all, even a simple of cursory perusal of Respondent-Applicant’s “3M Pizza Pie” mark vis-à-vis Opposer’s marks registered under Certificate of Registration Nos. 053426, 022353, 066817 and 41998002390, makes evident that they are not similar and/or identical as to confuse the purchasing general public. A side-by-side comparison of Respondent-Applicant’s mark and Opposer’s mark is attached hereto and made an integral part hereof as Exhibit “3”.

- 40 “More importantly, aside from having a big difference in the spelling of their correspondingly marks, even the fonts and/or designs used by both the Opposer and the Respondent-Applicant are different from each other as shown by the side-by-side comparison (cf. Exhibit “3”).

- 41. “Thus, for this reason alone, Respondent-Applicant’s “3M Pizza Pie” mark should be allowed registration by and with the Honorable Office.

42. "In Bristol Myers Company v. Director of Patents and United American Pharmaceuticals, Inc. (G.R. No. L-21587, 19 May 1966), the thrust of therein petitioner's contention was that the registration of the applicant's trademark "BIOFERIN" would violate its rights and interest in its registered trademark "BUFFERIN" as well as mislead and confuse the public as to the source and origin of the goods covered by the respective marks. In view of the allegedly almost same spelling, pronunciation and letter type design of the two (2) trademarks covering goods of the same class. However, the Supreme Court was not convinced and aptly enunciated that:

"In determining whether two trademarks are confusingly similar, the test is not simply to take their words and compare the spelling and pronunciation of said words. Rather, it is to consider the two marks in their entirety, as they appear in the respective labels, in relation to the goods to which they are attached. Said rule enunciated by this Court through Justice Felix Bautista Angelo in Mead Johnson & Co., vs. N.V.J. Van Dorp, Ltd., L-17504, April 27, 1963, thus:

'It is true that between petitioner's trademark 'ALACTA' and respondent's 'ALASKA' there are similarities in spelling, appears and sound for both are composed of six letters of three syllables each and each syllable has the same vowel, but in determining if they are confusingly similar a comparison of said words is not the only determining factor. The two marks in their entirety as they appear in the respective labels must also be considered in relation to the goods to which they are attached. The discerning eye of the observer must focus not only on the predominant words but also on the other features appearing in both labels in order that he may draw his conclusion whether one is confusingly similar to the other. . . . '

"Applying this test to the trademarks involved in this case, it is at once evident that the director of Patents did not err in finding no confusing similarity. For through the words "BIOFERIN" and "BUFFERIN" have the same suffix and similar-sounding prefixes, they appear in their respective labels with strikingly different backgrounds and surroundings, as to color, size and design.

"Accordingly, taken as they will appear to a prospective customer, the trademarks in question are not apt to confuse. Furthermore, the product of the applicant is expressly stated as dispensable only upon doctor's prescription, while that of Oppositor does not require the same. The chances of being confused into purchasing one for the other are therefore all the more rendered negligible. Although Oppositor avers that some drugstores sell "BIOFERIN": without asking for a doctor's prescription, the same if true would be an irregularity not attributable to the applicant, who has already clearly stated the requirement of a doctor's prescription upon the face of the label of its product." (Underscoring and emphasis supplied)

43. "Just like the case at bar, although there is one (1) letter and one (1) number similar in Opposer's mark and that of Respondent-Applicant's mark, the marks are still clearly different in spelling as Opposer's marks simply show the number

and letter combination “3M” on its lonesome or the number and letter combination hyphenated with the word “Matic”, e.g., “3M-Matic”.

44. “On the other hand, Respondent-Applicant’s mark is clearly different from Opposer’s mark in that it uses or utilizes the words “Pizza Pie” appended to the word “3M” to point out that it merely serves, markets and/or sells pizza pies and not any other goods or services such as those being marketed, manufactured and sold by herein Opposer.

45. “Thus, it submitted that Opposer’s argument that Respondent-Applicant’s trademark 3M PIZZA PIE so resembles Opposer’s 3M Mark because their dominant and distinctive elements (“3M”) are identical, as to be likely, when applied to or used in connection with the goods of Respondent-Applicant, to cause confusion, mistake and deception on the part of the purchasing public” does not stand on terra firma.

45.1 It must be further noted that the Bristol Myers case involved products belonging to the same class. The instant case, as quite evident from the Notice of Opposition, does not involve the same products.

46. “In addition, the landmark case of American Cyanamid Company v. Director of Patents (G.R. No. L-23954, 29 April 1977) finds application in the instant case where the Supreme Court held that:

“The problem therefore to be resolved is whether or not petitioner correctly claims that respondent’s trademark SULMETINE was copied from its trademark SULMET giving rise to a confusing similarity between the two in violation of Republic Act 166 otherwise known as the Trade-Mark Law.

“We find petitioner’s submittal devoid of merit and hold that there is no infringement of trademark which justify a cancellation of respondent’s registered trademark SULMETINE.

1. An examination of the documentary evidence submitted by the parties confirms the findings of the Director of Patents that there are striking differences between the two labels, Exhibits B and C, which preclude the possibility of the purchasing public confusing one product with the other. Said labels are entirely different in size, background, colors, contents, and pictorial arrangement; in short, the general appearances of the labels bearing the respective trademarks are so distinct from each other that petitioner cannot assert that the dominant features, if any, of its trademark were used or appropriated in respondent’s own.

xxx

(c) The printed matter on the label: A very important point of difference between the labels of the parties is found in the contents of the printed matter. In the label Exhibit B, the product is described in bold green letters as ‘Drinking Water Solution’ xxx

47. “On the other hand, even granting but without necessarily conceding that Respondent-Applicant’s mark resembles or is similar to that of Opposer’s mark, nonetheless, the latter has no right to prohibit the registration of the former’s mark based on existing jurisprudence.

48. "It is well-settled that when a trademark is used by a party for a product in which the other party does not deal, the use of the same trademark on the latter's product cannot be validly objected to.
49. "An identical ruling was reached by no less than the Supreme Court in the popular case of Canon Kabushiki Kaisha v. Court of Appeals (G.R. No. 120900, 20 July 2000) where it was held that:

"xxx. However, when a trademark is used by a party for a product in which the other party does not deal, the use of the same trademark on the latter's product cannot be validly objected to.

"xxx. The certificates of registration for the trademark CANON in other countries and in the Philippines as presented by Petitioner, clearly showed that said certificates of registration cover goods belonging to class 2 (paints, chemical products, toner, dyestuff), private respondent can use the trademark CANON for its goods classified as class 25 (sandals). Clearly, there is a world of difference between the paints, chemical products, toner, and dyestuff of petitioner and the sandals of private respondent." (Underscoring and emphasis supplied; citations omitted)

50. "Therefore, following the ratio decidendi in the afore-quoted Canon Kabushiki Kaisha case and granting arguendo that Opposer's "3M" marks are similar and/or identical to Respondent-Applicant's 3M Pizza Pie mark, as long as the goods in which the latter will be using its mark is not the same or closely related to the goods of the former, then "the use of the same trademark on the latter's product cannot be validly objected to" by herein Opposer or any other person or entity for that matter.
51. "In the instant case, Opposer's "3M" marks only covers the following goods, to wit" (a) under Registration No. 53426 – "adhesive substance used in industry"; (b) under Registration No. 022353 – "face masks"; (c) under Registration No. 066817 – "machines for applying adhesive tape to boxes"; and (d) under Registration No. 41998002390 – "coated abrasives".
52. "On the other hand, Respondent-Applicant's "3M Pizza Pie" mark would only cover food products, more particularly, pizza pies. Thus, it cannot, and will not, by any stretch of one's imagination, cover goods similar any even closely related to those being manufactured, marketed and/or sold by herein Opposer. The Affidavit of Mr. Emmanuel Sun, Business Development Director of Respondent-Applicant, attesting to such facts is attached hereto and made an integral part hereof as Exhibit "4".
53. "To make matters more interesting, Respondent-Applicant seeks to have its "3M Pizza Pie" mark registered under class 30 of the Nice Classification. On the other hand, Opposer's "3M" marks are registered under classes 1, 3, 7 and 9 of the Nice Classification. Therefore, the goods being offered and/or marketed by both the Opposer and the Respondent-Applicant are not only different, but unquestionably belong to a different class of goods.

53.1 Without a doubt, there is a world of difference between "adhesive substances used in industry", "face masks", "machines for applying adhesive tape to boxes" and "coated abrasives" to that of

the “pizza pies” that herein Respondent-Applicant sells, produces and/or markets to the general public.

54. “More importantly, it cannot be overemphasized that Respondent-Applicant’s goods are marketed and/or sold through a different channel of trade from that of the goods of herein Opposer. Respondent-Applicant humbly submits that the following pointers should be taken into account by the Honorable Office in deciding the instant case:
- (a) Respondent-Applicant’s goods cater to those persons who want to eat or who are hungry while opposer’s goods cater to those persons who want to work, probably clean, or do something clerical, industrial or some type of office work;
 - (b) Respondent-Applicant’s goods are sold through stalls conspicuously located along busy streets or small kiosks inside malls while Opposer’s goods are sold through department stores and/or book stores;
 - (c) Respondent-Applicant’s goods are priced in such a way that anyone and everyone can afford it. On the other hand, Opposer’s goods, being sold in hardwares, do-it-yourself shops, department stores and/or book stores, fetches a higher price; and
 - (d) Respondent-Applicant’s goods easily spoil when not taken care of or placed in proper temperature or room condition while Opposer’s goods need not be refrigerated or to kept in tight or specific temperature or room conditions, thus, the former’s goods are for immediate consumption as differentiated from the latter’s goods.
55. “Thence, it is readily clear that persons who want to purchase “3M Pizza Pies” would not enter and go to department stores and/or book stores to purchase one as distinguished from one that would want to purchase “adhesive substances used in industry”, “face masks”, “machines for applying adhesive tape to boxes” and “coated abrasives”
56. “It is humbly submitted that the registration of Respondent-Applicant’s “3M Pizza Pie” mark should be, as it ought to be, granted by the Honorable Office as the goods of both parties cater to different sectors of the general public.
57. “As held in the recent case of Mighty Corporation and La Campana Fabrica De Tabaco, Inc. v. E. & J. Gallo Winery and The Andersons Group, Inc. (G.R. No. 154342, 14 July 2004), to wit:
- “In resolving whether goods are related, several factors come into play:
- (a) the business (and its location) to which the goods belong
 - (b) the class of product to which the goods belong
 - (c) the product’s quality, quantity, or size, including the nature of the package, wrapper or container
 - (d) the nature and cost of the articles
 - (e) the descriptive properties, physical attributes or essential characteristics with reference to their form, composition, texture or quality
 - (f) the purpose of the goods
 - (g) whether the article is bought for immediate consumption, that is, day-to-day household items
 - (h) the fields of manufacture
 - (i) the conditions under which the article is usually purchased and

- (k) the channels of trade through which the goods flow, how they are distributed, marketed, displayed and sold

“A very important circumstance though is whether there exists a likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the source of the goods in question. The ‘purchaser’ 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 questionxxx.... The test is not found in the deception, or the possibility of deception, f 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’.

“Hence, in the adjudication of trademark infringement, we give due regard to the goods’ usual purchaser’s character, attitude, habits, age, training and education.

“Applying these legal precepts to the present case, petitioner’s use of the GALLO cigarette trademark is not likely to cause confusion or mistake, or to deceive the ‘ordinarily intelligent buyer’ of either wines or cigarettes or both as to the identity of the goods, their source and origin, or identity of the business of petitioners and respondents.

“Obviously, wines and cigarettes are not identical or competing products. Neither do they belong to the same class of goods. respondents’ GALLO wines belong to Class 33 under Rule 33 under Rule 84[a] Chapter III, Part II of the Rules of Practice in Trademark Cases while petitioners’ GALLO cigarettes fall under Class 34” (Underscoring and emphasis supplied)

58. “The Supreme Court, in sustaining the registration of the mark of the respondent-applicant therein, further held in the same Mighty Corporation and La Campana Fabrica De Tabaco case (supra) that:

“In this regard, we adopted the Director of Patents’ finding in Philippine Refining Co., Inc. vs. Ng Sam and the Director of Patents:

“In his decision, the Director of Patents enumerated the factors that set respondent’s products apart from the goods of petitioner. He opined and we quote:

‘I have taken into account such factors as probable purchaser attitude and habits, marketing activities, retail outlets, and commercial impression likely to be conveyed by the trademarks if used in conjunction with the respective goods of the parties, I believe that ham on one hand, and lard, butter, oil, and soap on the other are products that would not move in the same manner through the same channels of trade. They pertain to unrelated fields of manufacture, might be distributed and marketed under dissimilar conditions, and are displayed separately even though they frequently may be sold through the same retail food establishments. Opposer’s products are ordinary day-to-day household items whereas ham is not necessarily so. Thus, the goods of the parties are not of a character which purchasers would likely attribute to a common origin.’

“The observations and conclusion of the Director of Patents are correct. The particular goods of the parties are so unrelated that consumers, would not, in any probability mistake one as the source of origin of the product of the other.

“The same is true in the present case. Wines and cigarettes are non-competing and are totally unrelated products not likely to cause confusion vis-à-vis the goods or the business of the petitioners and respondents.

“Wines are bottled and consumed by drinking while cigarettes are packed in carton or packages and smoked. There is a whale of difference between their descriptive properties, physical attributes or essential characteristics like form, composition, texture and quality.

“GALLO cigarettes are inexpensive items while GALLO wines are not. GALLO wines are patronized by middle-to-high-income earners while GALLO cigarettes appeal only to simple folks like farmers, fishermen, laborers and other low-income workers. Indeed, the big price difference of these two products is an important factor in proving that they are in fact unrelated and that they travel in different channels of trade. There is a distinct price segmentation based on vastly different social classes of purchasers.

“GALLO cigarettes and GALLO wines are not sold through the same channels of trade. GALLO cigarettes are Philippine-made and petitioners neither claim nor pass off their goods as imported or emanating from Gallo Winery. GALLO cigarettes are distributed, marketed and sold through ambulant and sidewalk vendors, small local sari-sari stores and grocery stores in Philippine rural areas, mainly in Misamis Oriental, Pangasinan, Bohol and Cebu. On the other hand, GALLO wines are imported, distributed and sold in the Philippines through Gallo Winery’s exclusive contracts with a domestic entity, which is currently Andresons. By respondents’ own testimonial evidence, GALLO wines are sold in hotels, expensive bars and restaurants, and high-end grocery stores and supermarkets, not through sari-sari stores or ambulant vendors.”
(Underscoring and emphasis supplied)

59. “Moreover, the goods and/or services being offered to the general consuming public of both Opposer and herein Respondent-Applicant are non-competing goods, thus, the likelihood of confusion on the part of the purchaser is bleak, if not nil. To repeat, they do not even belong to the same class of goods, they are unrelated!
60. “As similarity held in a case where the products being marketed and sold by the two (2) contending parties were briefs on hand and after shave lotion, shaving cream, deodorant, talcum powder, and toilet soap on the other, the Supreme Court ruled in *Faberge, Inc. vs. Intermediate Appellate Court* (G.R. No. 71189, 4 November 1992) that:

“Withal, judging from the physical attributes of petitioner’s and private respondent’s products, there can be no doubt that confusion or the likelihood of deception to the average purchaser is unlikely since the goods are non-competing and unrelated
Xxx. (Underscoring and emphasis supplied)
61. “Equally important is the case of *Philippine Refining Co., Inc. v. Ng Sam* (G.R. No. L-26676, 30 July 1982) where it was enunciated that:

“The observation and conclusion of the Director of Patents are correct. The particular goods of the parties are so unrelated that

consumers would not in any probability mistake one as the source or origin of the product of the other. 'Ham' is not a daily food fare for the average consumer. One purchasing ham would exercise a more cautious inspection of what he buys on account of its price. Seldom, it ever, is the purchase of said food product delegated to household helps, except perhaps to those who, like the cooks, are expected to know their business....xxxx

"In addition, the goods of petitioners are basically derived from vegetable oil and animal fats, while the product of respondent is processed from pig's legs. A consumer would not reasonably assume that petitioner has so diversified its business as to include the product of respondent.

"Mr. Runolf Callman, in Section 80.3, VOL. I, p. 1121 of his book, Unfair Competition and Trade Marks, declares:

'While confusion of goods can only be evident where the litigants are actually in competition, confusion of business may arise between non-competitive interests as well. This is true whether or not the trademarks are registered. Sec. 16 of the Trademark Act, in referring to 'merchandise of substantially the same descriptive properties, embraces competitive and non-competitive trademark infringement but it is not so extensive as to be applicable to cases where the public would not reasonably expect the plaintiff to make or sell the same class of goods as those made or sold by the defendant.'

"In fine, We hold that the business of the parties are non-competitive and their products so unrelated that the use of identical trademarks is not likely to give rise to confusion, much less cause damage to petitioner." (Underscoring and emphasis supplied)

62. "Besides, there can be no likelihood for the consumers of Respondent-Applicant's "Pizza Pies" to confuse its source as anyone but Respondent-Applicant.
63. "It should be pointed out that in majority, if not all, of its marketing labels, posters and/or flyers, Respondent-Applicant attaches and/or make mentions the name of the corporation behind "3M Pizza Pie", that is – Supremo Food Corporation – which is certain to catch the eye of the class of consumers to which it caters. Samples of Respondent-Applicant's marketing labels, posters and/or flyers are attached hereto and made integral parts hereto as Exhibits "5-Series".
64. "In fact, the very same ruling was reached in the case of Philippine Refining Co., Inc. v. Ng Sam (supra) where no less than the Supreme Court ruled that:

"The observation and conclusion of the Director of Patents are correct. The particular goods of the parties are so unrelated that consumers would not in any probability mistake one as the source or origin of the product of the other. 'Ham' is not a daily food fare for the average consumer. One purchasing ham would exercise a more cautious inspection of what he buys on account of its price. Seldom, it ever, is the purchase of said food product delegated to household helps, except perhaps to those who, like the cooks, are expected to know their business. Besides, there can be no likelihood for the consumer of respondent's ham to confuse its source as anyone but respondent. The facsimile of the label attached by him on his product, his business name "SAM'S HAM AND BACON

FACTORY” written in bold white letters against a reddish orange background, is certain to catch the eye of the class of consumers to which he caters.”
(Underscoring and emphasis supplied)

65. “Thus, Opposer’s contention that the use of Respondent-Applicant’s “3M Pizza Pie” mark “will tend to deceive and/or confuse purchasers into believing that Respondent-Applicant’s products emanates from or are under the sponsorship of Opposer and damage Opposer’s interests has no factual, legal and/or jurisprudential basis. It is, to say the least, imaginary.

65.1 Clearly, by indicating the name of the Corporation behind the “Pizza Pies” and/or products that Respondent-Applicant produces, sells and/or markets, there is no imaginable why how an “ordinarily intelligent buyer” may think that these products came from, or are sponsored by, herein Opposer. Naturally, a contrary argument would defy not only logic but also what is obvious and apparent.

66. “As pointed out earlier, Respondent-Applicant seeks to have its “3M Pizza Pie” mark registered under Class 30 of the Nice Classification. However, as likewise mentioned above, Opposer’s marks are registered (a) under Registration No. 53426 – “adhesive substance used in industry”; (b) under Registration No. 022353 – “face masks”; (c) under Registration No. 066817 – machines for applying adhesive tape to boxes”; and (d) under Registration No. 41998002390 – “coated abrasives”.

67. “Thus, considering that Opposer’s marks clearly state under what classifications they are registered and the goods and/or services covered thereby, then, without any evidence or indication that Opposer will expand or intended its business to production, manufacturing, marketing and selling of “pizza pies” in the Philippines, it cannot have exclusive rights to use the “3M” mark in any and all products which it could imagine.

67.1 Besides, as admitted by no less than the Opposer in its Notice of Opposition, it had already been using the “3M” mark as early as 1902 and, yet, for over 100 years since it started utilizing said mark and up to the present, Opposer has yet to engage in the business of selling any food product, more particularly, “pizza pies”, bearing and/or using any of its “3M” trademarks.

68. “Simply put, Opposer’s exclusive right to use its various “3M” marks should be limited only to what was/were enumerated in its Certificates of Registration, that is – (a) “adhesive substances used in industry”, (b) “face masks”, (c) “machines for applying adhesive tape to boxes” and (d) “coated abrasives” and nothing more.

69. “Needless to state, a contrary ruling would be fraught with dangerous consequences since certificates of registration would be deemed to have included goods and/or services not specified therein and any and all persons and/or entities would be tempted to register a trademark on any and all goods which his/her mind may conceive even if he/she never intended to use the trademark for said goods and/or services. Truly a dangerous consequence.

70. “A similar ruling was reached in *Mighty Corporation and La Campana Farbica De Tabaco, Inc. v. E. & J. Gallo Winery and The Andersons Group, Inc.* (supra) citing

the case of Sterling Products International Inc. vs. Farbenfabriken Bayer (27 SCRA 1214 [1969]) where it was held that:

“Really, if the certificate of registration were to be deemed as including goods not specified therein, then a situation may arise whereby an applicant may be tempted to register a trademark on any and all goods which his mind may conceive even if he had never intended to use the trademark for the said goods. We believe that such omnibus registration is not contemplated by our Trademark Law.” (Underscoring and emphasis supplied)

71. “In the same *Mighty Corporation and La Campana Fabrica De Tabaco, Inc. v. E. & J. Gallo Winery and The Andersons Group, Inc.* (supra), it was further enunciated that:

“We also note that the GALLO trademark registration certificates in the Philippines and in other countries expressly state that they cover wines only, without any evidence or indication that registrant Gallo Winery expanded or intended to expand its business to cigarettes.

“Thus, by strict application of Section 20 of the Trademark Law, Gallo Winery’s exclusive right to use the GALLO trademark should be limited to wines, the only product indicated in its registration certificates.” (Underscoring and emphasis supplied)

72. “This strict statutory limitation on the exclusive right to use trademarks was amply clarified in the highest tribunal’s ruling in *Faberge, Inc. vs. Intermediate Appellate Court* (supra) where it was aptly ruled that:

“Having thus reviewed the laws applicable to the case before us, it is not difficult to discern from the foregoing statutory enactments that private respondent may be permitted to register the trademark “BRUTE” for briefs produced by it notwithstanding petitioner’s vehement protestations of unfair dealings in marketing its own set of items which are limited to: after-shave lotion, shaving cream, deodorant, talcum powder and toilet soap. In as much as petitioner has not ventured in the production of briefs, an item which is not listed in its certificate of registration, petitioner can not and should not be allowed to feign that private respondent had invaded petitioner’s exclusive domain....xxxx.” (Underscoring and emphasis supplied)

73. “Therefore and as a logical consequences thereto, Respondent-Applicant humbly submits that its “3M Pizza Pie” mark should already be allowed for registration with the Honorable Office.

74. “In the popular case of *Levi Strauss & Co. and Levi Strauss (Phils.), Inc. v. Clinton Apparelle, Inc.* (G.R. No. 138900, 20 September 2005), it was aptly held that:

“Trademark dilution is the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of: (1) competition between the owner of the famous mark and other parties; or (2) likelihood of confusion, mistake or deception. Subject to the

principles of equity, the owner of a famous mark is entitled to an injunction 'against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark'. This is intended to protect famous marks from subsequent uses that blur distinctiveness of the mark or tarnish or disparage it.

"Based on the foregoing, to be eligible for protection from dilution, there has to be a finding that: (1) the trademark sought to be protected is famous and distinctive; (2) the use by respondent of 'Paddocks and Design' began after the petitioners' mark became famous; and (3) such subsequent use defames petitioner's mark. In the case at bar, petitioners have yet to establish whether 'Dockers and Design' has acquired a strong degree of distinctiveness and whether the other two elements are present for their cause to fall within the ambit of the invoked protection. The Trends MBL Survey Report which petitioners presented in a bid to establish that there was confusing similarity between two marks is not sufficient proof of any dilution that the trial court must enjoin." (Underscoring and emphasis supplied)

75. "Thus, to be eligible for protection from dilution, Opposer has to show and prove by competent and verifiable evidence that: (a) its "3M" mark is famous and distinctive in the Philippines; and (b) the use by Respondent-Applicant of its "3M Pizza Pie" mark began after the Opposer's mark became famous; and (3) such subsequent use defames Opposer's mark.
76. "Sadly, Opposer miserably failed to prove majority, if not all, of the above.
77. "First, Opposer miserably failed to prove that its "3M" mark is famous in accordance with rule 102 of the Rules and Regulations on Trademarks, Service Marks, Tradenames and Marketed or Stamped Containers, viz:

"Rule 102. Criteria for determining whether a mark is well-known. – In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and

owned by persons other than the person claiming that his mark is a well-known mark.”

78. “Opposer cannot even rely on the foreign Decisions it had attached to its Notice of Opposition to prove that its “3M” mark is a well-known mark due to various reasons, to wit:

(a) The Decision in “3M Company vs. 3M Incorporated” promulgated by the United States District Court of Ohio:

- (i) The copy attached to Opposer’s Notice of Opposition is not a certified true copy;
- (j) The copy does not bear the signature of the Presiding Judge showing that it was indeed actually approved by him;
- (k) It is just a Confidential Settlement Agreement and not an actual Decision on the merits of the case;
- (l) The copy of the Confidential Settlement Agreement is not notarized;
- (m) It was merely signed and executed in the year 2002 or long after Respondent-Applicant had started to use its “3M Pizza Pie” mark in the Philippines.

(b) The Decision in Minnesota Mining and Manufacturing Company v. Michigan Magnetics, Inc.”:

- (i) It is just a Settlement Agreement and not an actual Decision on the merits of the case;
- (j) The products at issue thereat were “magnetic recording heads” v. “magnetic recording tapes”, products which are clearly of the same goods and/or flows through the same channels of trade unlike herein Opposer’s goods and Respondent-Applicant’s “Pizza Pies”;

(c) The Decision in “Minnesota Mining and Manufacturing Company v. 3M Electric Corporation”:

- (i) It is just a Settlement Agreement and not an actual Decision on the merits of the case;
- (j) The products at issue thereat were “electrical contracting services” v. “electrical products”, products which are clearly of the same goods and/or flows through the same channels of trade unlike herein Opposer’s goods and Respondent-Applicant’s “pizza pies”;

(d) Finally, the other foreign Decisions cited by Opposer are likewise of no value for purposes of proving that its “3M” mark is a well-known mark since they are all of recent date, e.g., 1999 and 2004.

79. “Moreover, Opposer has miserably failed to point out or show any decision and/or ruling by any competent authority in the Philippines declaring its “3M” mark a well-known mark.

80. “Secondly, granting arguendo Opposer’s mark is a well-known mark in the Philippines, it failed to prove that the use by Respondent-Applicant of its “3M Pizza Pie” mark began after its mark became famous.

81. “As exhaustively discussed earlier, Respondent-Applicant has been using the “3M Pizza Pie” as early as 1969. However, what Opposer can only show this

Honorable Office are the following: (a) yearly net sales of products using the “3M” marks from the year 1973 to 2006; and (b) various invoices showing sales in the Philippines, the earliest being only from the year 1975.

82. “In short, Opposer has not presented competent evidence that would show that its “3M” mark was a well-known mark here in the Philippines even before the year 1969, or the first time Respondent-Applicant used its “3M Pizza Pie” mark. To repeat, there is no competent allegation that the status of being a well-known mark preceded the use by Respondent-Applicant of the mark “3M Pizza Pie”.
83. “Needless to states, Opposer has likewise miserably failed to show this Honorable Office the following, among others: (a) any advertisement and/or promotion dating before 1969; (b) yearly net sales of products using the “3M” marks in the Philippines before 1969; (c) invoice showing sales in the Philippines before 1969.
84. “At best, these documents presented by Opposer only shows and prove that, possibly, its “3M” mark may be deemed and/or considered to be a well-known mark here in the Philippines only sometime in 1975 and not long before Respondent-Applicant had used or made use of its “3M Pizza Pie” mark. Moreover, at best, the very same documents only goes to show and/or prove the extensive use of Opposer’s “3M” mark in the Philippines from 1975 to the present but not before the “3M Pizza Pie” mark was used by herein Respondent-Applicant.
85. “Thus, it is readily clear that Mr. Gregorio B. Serrano has no factual, legal and/or jurisprudential bases when he concluded, in the most speculative manner, in his Affidavit that “Respondent-Applicant’s use and registration of the trademark 3M Pizza Pie will lead the public to believe that the Respondent-Applicant’s goods bearing the trademark 3M Pizza Pie originate from the Company or are under the Company’s sponsorship and license, and will result in confusion and/or deception of the public as to the origin of those goods”.
86. “Finally, in *Pagasa Industrial Corporation v. Court of Appeals* (G.R. No. L-54158, 19 November 1982), no less than the Supreme Court had the occasion to rule that:

“It appears that it was only after more than seven (7) years when respondent sought the cancellation of the trademark. An unreasonable length of time had already passed before respondent asserted its right to the trademark. There is a presumption of neglect already amounting to “abandonment” of a right after a party had remained silent for quite a long time during which petitioner had been openly using the trademark in question. Such inaction on the part of respondent entitles petitioner to the equitable principle of laches.” (Underscoring and emphasis supplied)

87. “Equally important is the case of *Mighty Corporation and La Campana Fabrica De Tabaco, Inc. v. E. & J. Gallo Winery and The Andersons Group, Inc.* (supra) where it was likewise held that:

“Each trademark infringement case presents a unique problem which must be answered by weighing the conflicting interests of the litigants.

“Respondents claim that GALLO wines and GALLO cigarettes flow through the same channels of trade, that is, retail trade. If respondents’ assertion is true, then both goods co-existed peacefully for a considerable period of time. It took respondents almost 20 years to know about the existence of GALLO cigarettes and sue petitioners for trademark infringement. Given, on one hand, the long period of time that petitioners were engaged in the manufacture, marketing, distribution and sale of GALLO cigarettes and, on the other, respondents’ delay in enforcing their rights (not to mention implied consent, acquiescence or negligence) we hold that equity, justice and fairness require us to rule in favor of petitioners the scale of conscience and reason tip far more readily in favor of petitioners than respondents.” (Underscoring and emphasis supplied)

88. “Applying the principles enunciated in the afore-quoted Pagasa Industrial Corporation and Mighty Corporation cases, it is readily clear that the goods and/or products of Respondent-Applicant and Opposer co-existed (not to mention in different channels of trade) peacefully for a considerable period of time, that is close to forty (40) years or since 1969, thus, it is obvious that there was indeed no dilution of Opposer’s goodwill, if any, on its “3M” mark nor was there any confusion as to the origin of the goods on the goods on the part of the general consuming public.
89. “Needless to state, if Opposer’s arguments were true, accurate and correct, then they should have taken action already (even as early as 1969) against the use of the “3M Pizza Pie” mark even without for herein Respondent-Applicant’s attempt to have the same registered with the Honorable Office.
90. “Thus, given, on one hand, the long period of time that Respondent-Applicant’s was, and still is, engaged in the preparation, marketing, distribution and sale of “3M Pizza Pie” and, on the other hand, Opposer’s delay in enforcing its rights (not to mention implied consent, acquiescence or negligence), Respondent-Applicant humbly submits that equity, justice and fairness require the Honorable Office to rule in its favor.
91. “Finally, taking into consideration the foregoing arguments and discussion, it is humbly submitted that the Opposer’s “3M” mark, or the products and/or services that uses the same, will not incur any economic or business injury or damage by reason of the use and registration of Respondent-Applicant’s “3M Pizza Pie”.
92. “In view of the foregoing, it is readily clear that the instant Notice of Opposition is bereft of any factual, legal and/or jurisprudential merit.

From receipt of the Answer, a Reply was subsequently filed by Opposer 3M Company and a Rejoinder to Opposer’s Reply was filed by Respondent-Applicant. A Preliminary Conference of the instant suit was held on 13 August 2008 and terminated on same date. By virtue of Order No. 2008-1302, Opposer and Respondent-Applicant were directed to file their respective position paper within non-extendible period of ten (10) days.

For consideration in particular is the propriety of Application Serial No. 4-2003-004446. Resolution is called for on the following issues:

1. Whether or not there is confusing similarity between Opposer’s 3M trademark for use on adhesive substances and abrasives vis-à-vis Respondent-Applicant’s mark, 3M PIZZA PIE, for pizza and pasta under class 30;

2. Whether or not Respondent-Applicant's trademark application for the mark 3M TAKE HOME PIZZA PIE should be granted registration;

Respondent-Applicant's Answer within Motion to Expunge alleged inter alia, the following:

"12. In the case at bar, it is evident that there was no valid authorization at all issued by the corporation in favor of the Representative. In fact, what was merely presented before this Honorable Office was a Special Power of Attorney ('SPA', for brevity) interestingly signed also by the Representative himself and in favor of Opposer's counsel in the Philippines, e.g. the law firm of Sycip Salazar Hernandez and Gatmaitan, its partners and associates ("Opposer's Counsel", for brevity)

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14. Indubitably, the instant Notice of Opposition is fatally defective and, as an unavoidable but logical consequence thereto, it is deemed as if there is no Opposer in the first place and "the same shall not be considered as having been filed". It is a mere scrap of paper which does not be considered as having been filed". It is a mere scrap of paper which does not produce any legal effect!"

Before dwelling on issues about confusing similarity and priority in adoption and registration in the case at bar, this Bureau finds it imperative to delve on or first determine the verification issue/s. The verification issues were already raised and resolved after Respondent's filed their Verified Answer with Motion to Expunge. This Bureau issued Order No. 2008-894 dated 11 June 2008 resolving the verification issues and stated, thus:

"Moreover, it bears emphasis that this Bureau, as an administrative body, is not strictly bound by the technical rules of evidence and should, as much as possible, decide based on the merits of the case. Well-entrenched is the principle that rules of procedure should promote, not defeat, substantial justice and should not therefore be applied in a very rigid and technical sense.

In this case, the notice of opposition was actually verified. What is only lacking is the proof that the signatory of the verification page, Mr. Robert W. Sprague, is authorized to sign the same in behalf of the Opposer. The want of proof of authority of the signatory was, however, rectified by Opposer's subsequent submission of an authenticated Certificate of Incumbency showing that Mr. Robert W. Sprague is duly authorized by the Board of Directors of Opposer company to sign agreements and other documents on its behalf. The said submission was in fact made well within the period allowed for Opposer to file its Reply and wherein it can submit or attach additional documents.

In light of the foregoing premises, Respondent-Applicant's Motion to Expunge (Notice of Opposition dated 06 March 2007) is denied for lack of merit."

This Bureau is convinced that Opposer has complied with the verification requirement upon submission of the said authenticated Certificate of Incumbency at the time it file their Reply to Respondent's Answer. What was deficient at the time it filed the Notice of Opposition was substantially complied when it filed said Certificate within the time allowed to file Opposer's Reply.

As to the main issue/s of the instant suit or opposition proceeding, it is undeniable that the competing marks of Opposer and Respondent-Applicant both bear the "3M" mark. Although as established in several jurisprudence, that the mere adoption and use of one person of a trademark will not automatically prevent another from adopting and using the same trademark, a careful review and consideration of the facts and evidence presented should be taken in

determining whether confusing is likely to arise by the adoption of the same or substantially similar trademark.

Filed as evidence for the Opposer, based on the records, are the following:

1. Verified and Authenticated Notice of Opposition - *Annex "A"*
2. Notarized Affidavit of Mr. Gregorio B. Serrano - *Annex "B"*
 - (a) Opposer's local registration certificates mark - *Exhibit "A"*
 - (b) Redacted License Agreement Between 3M Company and 3M Philippines - *Exhibit "B"*
 - (c) 1902 Articles of Incorporation of 3M Company - *Exhibit "C"*
 - (d) 1929 Articles of Incorporation of 3M Company - *Exhibit "D"*
 - (e) The 2002 name change document from "Minnesota Mining and Manufacturing Company" to "3M Company" - *Exhibit "E"*
 - (f) Original commercial invoices showing sales of the products bearing 3M Company's 3M Marks to different outlets - *Exhibit "F"*
 - (g) Local advertising/promotional Materials for 3M Company's Products bearing 3M Mark - *Exhibit "G"*
 - (h) Certificates of Registration for the 3M Mark - *Exhibit "H"*
 - (i) Certified and Legalized copies of 3M Company's US Trademark Registration Certificate Nos. 2220588 and 221014 - *Exhibit "I and J"*
3. Affidavit of Mr. Robert Sprague - *Annex "C"*
 - (a) 3M Company's 2005 Community Giving Report, Annual Reports From 1928, 1941, 1959, 1977, 2002, 2003 to 2005 - *Exhibit "A"*
 - (b) Publications, official newsletters, products and advertisements - *Exhibit "B"*
 - (c) Screenshots of a website providing evidence of 3M Company's NASCAR sponsorship - *Exhibit "C"*
 - (d) List of countries where 3M Company's 3M Marks are registered - *Exhibit "D"*
 - (e) 3M Company's 2002-2004 Product Service Directory - *Exhibit "E"*
 - (f) Advertising materials from around the world promoting 3M Company's products - *Exhibit "F"*
 - (g) True and accurate print-outs from

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|-----|--|---|--------------------|
| | 3M Company's website | - | <i>Exhibit "G"</i> |
| (h) | True and accurate print-outs from 3M Philippines' website | - | <i>Exhibit "H"</i> |
| (i) | Sample clippings of advertisements and articles from newspapers... | - | <i>Exhibit "I"</i> |
| (j) | The August 5, 2002 edition of Business Week magazine | - | <i>Exhibit "J"</i> |
| (k) | Decision in 3M Company vs. 3M Incorporated promulgated by the United States District Court of Ohio | - | <i>Exhibit "K"</i> |
| (l) | Decisions where 3M Company won cases against parties | - | <i>Exhibit "L"</i> |
| (m) | Brazilian Curt decision | - | <i>Exhibit "M"</i> |
| (n) | Chart showing the evolution of the 3M Mark over the evolution of the 3M Mark over the last Century | - | <i>Exhibit "N"</i> |

Filed likewise for Respondent-Applicant were the following: The Affidavits of Respondent-Applicant's employees: Zenaida I. Hebron and Spouses Renato and Leonora Perpetua (*Exhibit "1-Series"*); Copy of the Manila Bulletin Article dated 14 July 2004 (*Exhibit "2"*); Side-by-side comparison of Respondent-Applicant's mark and Opposer's mark (*Exhibit "3"*). The Affidavit of Mr. Emmanuel Sun, Business Development Director of Respondent-Applicant (*Exhibit "4"*); Samples of Respondent-Applicant's marketing labels, posters and/or flyers (*Exhibit "5-Series"*);

The above issue requires a careful comparison and scrutiny of the marks involved; to determine the points where these labels as they appear on the goods to which they are attached are similar, in spelling, sound and manner of presentation or general appearance. There can be no doubt that the competing marks are similar in their adoption of the mark 3M. However, both marks bearing the word 3M are printed and presented differently. Below is a side-by-side comparison of the competing marks:



Opposer's 3M trademarks
 Registration Nos. 053426, 41998002390 &
 42007012693

Respondent-Applicant's 3M mark
 Application No. 42003004446

Although 3M appears in both labels of the contending parties, the presentation of the labels is totally different. Opposer's 3M trademark was printed and stylized in complete variation to the mark 3M of Respondent-Applicant. Note that the mark 3M of Respondent-Applicant has included the words PIZZA PIE vis-à-vis Opposer's trademark, which is simply the letter M written before the number 3, printed in bold letters and written in horizontal form without any accompanying word/s or logo, hence, comparing both marks in plain view there certainly is a marked difference. Having shown the distinct styles adopted by the parties in the printing of their labels, we now delve on the matter of confusion of goods which certainly has decisive effects in the adjudication of the case.

The goods of the contending parties do not move in the same channels of trade and the possibility appears remote that purchasers will confuse one product with the other because the goods are not similar nor are they related. It can not be said that the other classes of goods which Opposer applied using the same trademark 3M are related in any way to the goods of Respondent-Applicant which are food items, of the pizza and pasta variety of recipes in particular. Opposer's goods consist mainly of industrial tapes, adhesive and abrasive products whereas Respondent-Applicant's goods are food products. The fact that Opposer's 3M trademarks are applied on products which Respondent-Applicant does not deal negates the probability of confusion among prospective purchasers.

Opposer's goods are limited to adhesive substances and abrasives under Class 30 as specified in their trademark application. On the other hand, Respondent-Applicant has likewise limited its food selection to pizza and pasta recipes. At this juncture, emphasis is placed on Section 20 of the old Trademark Law or Art. 138 of R.A. 8293, which is the pertinent provision to resolve this particular issue, thus:

“SECTION 20. Certificates of registration prima facie evidence of validity. – A certificate of registration of a mark or trade-name shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark or trade-name, and of the registrant's exclusive right to use the same in connection with the goods, business or services specified in the certificate, subject to any conditions and limitations stated therein.”

Opposer's goods are simply adhesives, nowhere in Opposer's trademark application and/or registration in the Philippines appeared or showed that it has an intention to include food or food ingredients in its list of products, simply because it has limited its goods to adhesive and abrasive products. Clearly in this respect, their goods are not competitive nor related. The Supreme Court in ESSO Standard Eastern, Inc. vs. Court of Appeals, et. al, 201 Phil 803, defined what are essentially closely related goods under the trademark law as:

“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, biscuits were held related to milk because they are both food products.”

Hence, no confusing similarity exists between the subject trademarks as well as in the general appearance, presentation and packaging of their goods. The facts of the instant suit so closely resemble the circumstances obtaining in the case of Faberge, Incorporated vs. Intermediate Appellate Court, et al, G.R. No. 71189, November 04, 1992, that the application of the ruling in said case to the one at bar becomes unavoidable and compelling. The Supreme Court ruled, thus:

“In short, paraphrasing Section 20 of the Trademark Law as applied to the documentary evidence adduced by petitioner, the certificate of registration issued by the Director of Patents can confer upon petitioner the exclusive right to its own symbol only to those goods specified in the certificate, subject to any conditions and limitations stated therein.”

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The case likewise of Philippine Refining Co., Inc. vs. Ng Sam, 201 Phil 61, is one case relevant to and decisive of this Particular point when the court ruled:

“The trademark “CAMIA” is used by petitioner on a wide range of products; lard, butter, cooking oil, abrasive detergents, polishing materials and soap of all kinds. Respondent desires to use the same on his product, ham. While ham and some of the products of petitioner are classified under Class 47 (Foods and Ingredients of Food), this alone cannot serve as the decisive factor in the resolution of whether or not they are related goods. Emphasis should be on the similarity of the products involved and not on the arbitrary classification or general description of their properties or characteristics.”

Respondent-Applicant has no intention to ride on the goodwill Opposer may have had for the long, uninterrupted and exclusive use of its trademark 3M. It has no reason to do such things considering that Respondent-Applicant’s mark 3M PIZZA PIE is so distinct and distinguishable from Opposer’s mark 3M. The fact is that Respondent-Applicant, in adopting the trademark 3M PIZZA PIE, aims to identify its 3M PIZZA PIE mark as and we quote: *“the first time many Filipinos had ever tasted pizza made here in the Philippines”* (par. 23 of Respondent-Applicant’s Verified Answer) from the great effort of the three (3) sisters whose first names bear the letter M, Merlie B. Hemedes, Minerva B. Miller and Milagros B. Villar. (Exhibit “1”, Respondent-Applicant)

Opposer further argues that Opposer’s registered trademark 3M is popular all over the world and/or well-known citing provision for the protection of well-known marks for goods or services which are either identical or similar as contained in Section 123.1 (e) of the Intellectual Property Code of the Philippines (R.A. 8293).

Before evidence showing well-knownness of the mark is assessed and evaluated, there must be shown or established confusing similarity of the trademarks in question. Inasmuch as this Bureau finds no confusing similarity between the subject trademarks in the light of discussions of the evidence adduced and/or presented to this Bureau, the issue of well-knownness of the mark has become unnecessary.

All told, confusion or deception to the purchasing public or the apprehension, if at all, that the public may be misled into believing that there is some connection or association between Opposer’s goods using its 3M trademark and Applicant’s 3M PIZZA PIE, the likelihood that these goods may be mistaken as coming from the same origin, is far-fetched.

Based on the foregoing and despite allegation by Opposer that the marks involved are identical and/or confusingly similar, this Bureau resolves to grant protection to Respondent-Applicant’s 3M mark, the two marks not being confusingly similar.

WHEREFORE, based on the foregoing facts and the evidence, the Notice of Opposition filed by herein Opposer is, as it is, hereby DENIED. Accordingly, application bearing Serial No. 4-2003-004446 for the mark “3M PIZZA PIE” filed on 19 May 2003 for use on pizza and pasta under Class 30 is hereby GIVEN DUE COURSE.

Let the filewrapper of 3M PIZZA PIE, subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Makati City, 23 October 2008.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office