



CINDERELLA MARKETING CORPORATION, }
 Opposer, }
 }
 -versus- }
 }
 RFM CORPORATION, }
 Respondent –Applicant. }
 X-----X

IPC No. 14-2006-00006
 Opposition to:
 Appln. Serial No. 4-2003-001263
 Filing Date: 11 February 2003
 TM: “CINDERELLA”

NOTICE OF DECISION

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 AND QUINTANA LAW OFFICES**
 Counsel for Respondent-Applicant
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 Pioneer and Sheridan Streets
 Mandaluyong City

GREETINGS:

Please be informed that Decision No. 2014 - 100 dated April 02, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 02, 2014.

For the Director:

Edwin D. Dating
Atty. EDWIN DANILO A. DATING
 Director III
 Bureau of Legal Affairs



CINDERELLA MARKETING
CORPORATION,
Opposer,

IPC No. 14-2006-00006

-versus-

Appln. Serial No. 4-2003-001263
Filing Date: 11 February 2003
Trademark: "CINDERELLA"

RFM CORPORATION,
Respondent-Applicant.

Decision No. 2014 - 100

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DECISION

CINDERELLA MARKETING CORPORATION ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2003-001263. The application, filed by RFM CORPORATION ("Respondent-Applicant")², covers the mark "CINDERELLA" for use on "flour" under class 30 of the International Classification of Goods and Services³.

The Opposer alleges among other things the following:

"5. Opposer believes that it will be damaged by the registration of Trademark Application No. 4-2003-0012634 for the mark 'CINDERELLA' since it is a blatant contravention of the provisions of a subsisting Compromise Agreement between Respondent-Applicant and Opposer duly approved by the then Bureau of Patents, Trademarks and Technology Transfer ('BPTTT').

"5.1. Opposer and Respondent-Applicant were the same parties in Inter Partes Case No. 3679 entitled 'Cinderella Marketing Corporation vs. RFM Corporation' before the then BPTTT. In the said case, Opposer contended that the adoption by Respondent-Applicant of the mark 'CINDERELLA' and the latter's use of said mark in commerce was likely to cause confusion or mistake upon, or deception on, purchasers who could be led to believe that goods of Respondent-Applicant bearing the mark 'CINDERELLA' originate from the Opposer.

"5.2. Subsequently, or on 02 September 1996, Opposer and Respondent-Applicant filed with the BPTTT a Joint Motion for Judgment Based on Compromise Agreement in Inter Partes Case No. 3679.

"5.3. On 08 January 1997, the Director of BPTTT issued an Order approving the Compromise Agreement and dismissing Inter Partes Case No. 3679. Upon Opposer's motion, the said Order dated 08 January 1997 was amended in form in subsequent Orders issued by the Director of BPTTT on 17 February 1997, 24 February 1997 and 23 May 1997 to conform faithfully to the Compromise Agreement. The Order dated 23 May 1997 provides:

'WHEREFORE, Order No. 97-49 dated 08 January 1997 is hereby amended to read as follows particularly paragraph (d) thereof:

¹ A corporation duly organized and existing under the laws of the Republic of the Philippines with business address at 825 Epifanio de los Santos Avenue, Quezon City.
² A corporation duly organized and existing under the laws of Republic of the Philippines with business address at RFM Corporate Center, Pioneer corner Sheridan Streets, Mandaluyong City.
³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

- 1) Opposer and Respondent-Applicant have agreed to settle this case amicably under the following terms and conditions:
 - a) Respondent-Applicant acknowledges Opposer's ownership of the trade/service mark 'CINDERELLA' as registered under Certificate of Registration No. 32965 issued on 25 January 1984 and No. 27254-A issued on 01 October 1990, and as registered and applied for in combination with other words and marks that are existing and pending with this Honorable Office.
 - b) Respondent-Applicant binds itself to limit and restrict its use of the mark 'CINDERELLA' only on flour as applied for in Application Serial No. 71151 filed on 05 March 1990.
 - c) Respondent-Applicant binds itself not to use the mark 'CINDERELLA' singly or in combination with other words or marks on any goods other than for flour.
 - d) Respondent-Applicant binds itself to change the print of the mark 'CINDERELLA' as it appears on the sacks/packages of its flour by adopting capitalized and block letters in printing the mark, e.g. 'CINDERELLA'. Respondent-Applicant further binds itself not to use the color red in printing the said mark or the mark's background.
 - e) Respondent-Applicant binds itself to enlarge the print of its corporate name on the sacks/packages used for its flour such that the dimensions of the print of Respondent-Applicant's corporate name shall be at least three (3) times bigger than of the dimensions of the print of the name 'CINDERELLA' thereby making its corporate name as the dominant feature of the sacks/packages.
 - f) In consideration of the terms and conditions of the compromise agreement, including Respondent-Applicant's acknowledgement of Opposer's ownership of the mark 'CINDERELLA', its undertaking to use type mark 'CINDERELLA' exclusively for flour and not for any other goods, and to amend the print of the mark 'CINDERELLA' and its corporate name on the existing sacks/packages of its flour. Opposer withdraws its opposition to Respondent-Applicant's Application Serial No. 71151 for the registration of the mark 'CINDERELLA' for flour.

x x x

"5.4 Despite the foregoing, Respondent-Applicant filed the subject application for a mark containing the word 'CINDERELLA' in lower case letters. Above the word 'CINDERELLA' is a green leaf-like pattern forming an arc and inside the arc is a sketch of a woman in color red.

"5.4.1. Respondent-Applicant bound itself under the Compromise Agreement to adopt only capitalized and block letters in printing the marks, e.g. 'CINDERELLA'. Respondent-Applicant's application for registration of the subject mark which consists in part of the word 'CINDERELLA' in lower case letters written in script is a violation of the Compromise Agreement and the Order dated 23 May 1997.

"5.4.2. Respondent-Applicant bound itself under the Compromise Agreement not to use the color red in printing the said mark or the mark's background. Respondent-Applicant's use of the color red in the sketch of a woman inside an arc placed above the word 'CINDERELLA' is equivalent to the use of the color red in the mark's background and is therefore in violation of the Compromise Agreement and the Order dated 23 May 1997."

The Opposer's evidence consists of the following

1. Exhibit "A" - Order dated 08 January 1997; and,
2. Exhibit "B" - Order dated 23 May 1997.

This Bureau, in Resolution No. 2007-19 dated 04 July 2007, granted the Motion for Reconsideration of Respondent-Applicant after presentation of the Declaration of Actual Use which was actually filed on 23 December 2005 or within the three (3) year reglementary period. Thus, Order No. 2006-43 dated 18 May 2006 dismissing the instant case is set aside, and consequently submitting the same for decision on the merits.

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

Records show that on 08 January 1997, in an Inter Partes Case No. 3579, the Bureau of Patents, Trademarks and Technology Transfer ("BPTTT")⁴ through its Director, Emma C. Francisco issued Order No. 97-49⁵. The dispositive portion of which states that the Compromise Agreement entered and executed by the same Opposer and Respondent-Applicant in this instant case is APPROVED; and thus, the case is DISMISSED as all issues of facts and laws affecting the subject trademark 'CINDERELLA' have become moot and academic and application bearing Serial No. 71151 for the trademark 'CINDERELLA' shall be GIVEN DUE COURSE, subject to the terms and conditions of the said agreement. Thereafter, on 23 May 1997 in Order No. 97-419, further amendment to the mentioned Order was executed and approved by Director Emma Francisco.⁶

It is now alleged by the Opposer that Respondent-Applicant violated the terms and conditions of the said Compromise Agreement when it subsequently filed an application for registration of herein subject mark "CINDERELLA" which is described as: "A LADY IN HALF BODY IS OUTLINED IN RED, TWO (2) GREEN WHEAT STALKS, ONE ON EACH SIDE OF THE LADY FORMING AN ARCH OVER HEAD. THE WORD 'CINDERELLA' IS IN LUCINDA WRITING FONT IN GREEN COLOR."⁷ The pertinent provisions of the agreement are as follows:

- a) Respondent-Applicant hereby acknowledges Opposer's ownership of the trade/service mark 'CINDERELLA' as registered under Certificate of Registration No. 32965 issued on 25 January 1984 and No. 27254-A issued on 01 October 1990, and as registered and applied for in combination with other words and marks that are existing and pending with this Honorable Office.
- b) Respondent-Applicant binds itself to limit and restrict its use of the mark 'CINDERELLA' only on flour as applied for in Application Serial No. 71151 filed on 05 March 1990.
- c) Respondent-Applicant binds itself not to use the mark 'CINDERELLA' singly or in combination with other words or marks on any goods other than for flour.
- d) Respondent-Applicant binds itself to change the print of the mark 'CINDERELLA' as it appears on the sacks/packages of its flour by adopting capitalized and block letters in

⁴ Sec. 234, IP Code.

⁵ Exhibit "A" of Opposer.

⁶ Exhibit "B" of Opposer.

⁷ File wrapper records.

printing the marks, e.g. 'CINDERELLA'. Respondent-Applicant further binds itself not to use the color red in printing the said mark or the mark's background.

- e) Respondent-Applicant binds itself to enlarge the print of its corporate name on the sacks/packages used for its flour such that the dimensions of the print of Respondent-applicant's corporate name shall be at least three (3) times bigger than that of the dimensions of the print of the name 'CINDERELLA' thereby making its corporate name as the dominant feature of the sacks/packages.

x x x"

Section 134 of Republic Act No. 8293, also known as the Intellectual Property ("IP Code") states:

Any person who believes that he would be damaged by the registration of a mark may, upon payment of the required fee and within thirty (30) days after the publication referred to in Subsection 133.2, file with the Office an opposition to application. x x x

This Bureau finds the probability of damage to the Opposer in case the subject trademark is registered. The compromise agreement entered into by the parties had the force of law and was conclusive between them. A judicial compromise, once stamped with judicial approval, becomes more than a mere contract binding upon the parties, and having the sanction of the court and entered as its determination of the controversy, it has the force and effect of any other judgment.⁸

The BPTTT's issuance of Order Nos. 97-49 and 97-419 which approved the Joint Motion for Judgement Based on Compromise Agreement⁹, and dismissed all issues of facts and laws affecting the case has the effect of res judicata. Res judicata means a matter adjudged, a thing judicially acted upon or decided; a thing or matter settled by judgment. The doctrine of res judicata provides that a final judgment, on the merits rendered by a court of competent jurisdiction is conclusive as to the rights of the parties and their privies and constitutes an absolute bar to subsequent actions involving the same claim, demand, or cause of action.¹⁰ The elements of res judicata are (a) identity of parties or at least such as representing the same interest in both actions; (b) identity of rights asserted and relief prayed for, the relief being founded on the same facts; and (c) the identity in the two (2) particulars is such that any judgment which may be rendered in the other action will, regardless of which party is successful, amount to res judicata in the action under consideration.¹¹

A compromise once approved by final orders of the court has the force of res judicata between the parties and should not be disturbed except for vices of consent or forgery.¹² In the instant case, this Bureau finds that the aforestated compromise agreement has established the elements of res judicata.

The contending marks are hereby reproduced:

Cinderella

Cinderella


cinderella

Opposer's Trademarks

⁸ Benjamin D. Ynson v. Court of Appeals, et al., G.R. Nos. 117018-19 & 117327, August 8, 2002.

⁹ Exhibits "A" and "B" of Opposer.

¹⁰ Jesus Lanuza, et al. V. Court of Appeals, et al., G.R. No. 131394, March 28, 2005.

¹¹ Id.

¹² Golden Donuts, Inc. and Leopoldo Prieto v. NLRC, et al., G.R. Nos. 113666-68, January 19, 2000.

AS



Respondent-Applicant's Trademark

The contending marks show a number of similarities and violations of the compromise agreement. The marks appear in a writing font known as Lucinda handwriting which consists of an upper case letter followed by lower case letters. The font adopted by Respondent-Applicant is in violation of the provision in the agreement to adopt capitalized and block letters. Moreover, the logo depicting half-body of Princess Cinderella in Respondent-Applicant's mark, which is in full body illustration of the Opposer's mark, is printed in red color ink which is likewise prohibited in the said agreement.

Thus, taking into account the identity of parties, the similarity of marks, and the violation of the terms of the Compromise Agreement, this Bureau finds the likelihood of damage and finds necessary to enforce the mentioned Order on Compromise Agreement. To allow the registration of Respondent-Applicant's trademark is contrary to public order or morality.¹³

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the file wrapper of Trademark Application Serial No. 4-2003-001263 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 02 April 2014.


ATTY. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs

¹³ Sec. 123.1(m), IP Code.