RAUCH FRUCHTSAFTE GMBH, Opposer, **-versus-** **FERRARELLE S.P.A.,** Respondent-Applicant.	}	**IPC No. 14-2011-00287** Opposition to: Appln. Serial No. 4-2011-002410 Date Filed: 03 March 2011 Trademark: **"NATIA"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 – 166 dated September 03, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 03, 2012.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs

CERTIFIED TRUE COPY

MARILYN F. RETUTAL

RAUCH FRUCHTSAFTE GMBH,
Opposer,

- versus -

FERRARELLE S.P.A .,
Respondent-Applicant.
x----------x

IPC No. 14-2011-00287
Opposition to:

Appln. Serial No. 4-2011-002410
Date Filed: 03 March 2011
TM: "NATIA"

Decision No. 2012 - 166

DECISION

RAUCH FRUCHTSAFTE GMBH ("Opposer")[1] filed on 18 July 2011 an opposition to Trademark Application Serial No. 4-2011-002410. The application, filed by FERRARELLE S.P.A ("Respondent-Applicant")[2], covers the mark "NATIA" for use on "*Beers, mineral and aerated waters and non – alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages*" under Class 32 of the International Classification of goods.[3]

The Opposer anchors its case on Sec.123.1 (d) of Rep. Act No.8293, also known as the Intellectual Property Code of the Philippines ("IP Code") which provides that a mark cannot be registered if it is identical with a registered mark belonging to different proprietors or a mark with an earlier filling or priority date in respect of the same goods or services or closely related goods or services, or if it nearly resembles such a mark as to be likely to device or cause confusion. In support of its opposition, the Opposer submitted the following:

1. Exh. "A": Legalized Affidavit of Jurgen Rauch, the General Manager of Rauch Fruchtsafte GmbH;
2. Exh. "A-1": copy of Philippine Trademark Application No. 4-202-002259 for NATIVA as it appears in the IPOPHL database;
3. Exh. "A-2": print-out of the website http://www.rauch.cc/en/company/history/;
4. Exh."A-3": printout of the website http://www.rauch.cc/en/brands-ads/nativa/;
5. Exh. "A-4": photos of NATIVA products and advertisements bearing the NATIVA mark as used internationally and in the Philippines over the year;
6. Exh. "A-5": list of worldwide registrations and applications for NATIVA;
7. Exh. "A-5a" and "A-5b": certified copies of Austria Trademark Reg. Nos. 191437 and 191178 for NATIVA;

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1 A corporation duly organized under and by virtue of the laws of Austria, with principal place of business at Langgase 1 A-6830 Rankweil, Austria.
2 J4, Via Di Portapeneiana, Rome Italy.
3 The Nice Classification is a classification of goods and services for the purpose of registering the trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement concerning the International Classification of goods and services for the purpose of the Registration of marks concluded in 1957.

9. Exh. "A-5c" and "A-5d": certified copies of World Intellectual Property Organization Trademark Reg. Nos. 697010 and 743278 for NATIVA; and
11. Exh. "A-5e": certified copy of U.S. Trademark Reg. No. 3,799,571 for NATIVA.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 22 August 2011. The Respondent-Applicant filed motions for extension of the period to file Answer to the opposition, which this Bureau granted. However, the Respondent-Applicant did not file an Answer.

Should the Respondent-Applicant's trademark application be allowed?

It is emphasized that the essence of trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; to secure to him who has been instrumental in bringing into the market a superior article of merchandise; the fruit of his industry and skill; to assure to the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product[4]. Thus, Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such, mark as to be likely to deceive or cause confusion.

Records and evidence show that at the time the Respondent-Applicant filed its trademark application in the Philippines, the Opposer has already registered its mark NATIVA under Reg. No. 4-2002-002259 on 17 January 2005 for "*beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juice; syrups and other preparations for making beverages, vegetable drinks, juices, non-alcoholic energy drinks*" under class 32. The goods indicated in the Respondent-Applicant's application are similar to the goods covered by the Opposer's trademark registration.

But, are the marks as shown below, identical or resemble each other such that confusion or even deception is likely to occur?

NATIVA	**NATIA**
Opposer's mark	*Respondent-Applicant's mark*

Jurisprudence says that a practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of

4 *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 115508, 19 Nov. 1999.

display. Inspection should be undertaken from the viewpoint of the prospective buyer. The trademark complained should be compared and contrasted with the purchaser's memory of the trademark said to be infringed. Some factors such as sound; appearance; form, style shape, size or format; color, idea connoted by the mark; the meaning, spelling and pronunciation of the words used; and the setting in which the words used; may be considered for indeed, trademark infringement is a form of unfair competition.[5]

The competing marks are simple word marks each consisting of three (3) syllables. The only difference between the marks is the presence of the letter "V" in the Opposer's mark. The additional letter, however, failed to confer on the Respondent-Applicant's mark visual and aural properties sufficient to prevent the likelihood of said mark being confused with the Opposer's. Even the sound created by the letter "V" is not so distinctive - the similarities in terms of spelling and syllabication of the marks make them aurally similar. Confusion cannot be avoided by merely adding, removing or changing same letters of a registered mark. Confusing similarity exists, when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchasers as to cause him to purchase the one supposing it to be the other.[6]

That confusion or even deception is likely is amplified by the fact that the Respondent-Applicant's goods are covered by the Opposer's trademark registration. This Bureau noticed that the goods are not only purchased in groceries and stores but are consumed in bars, hotels, restaurants and places of entertainment and relaxation - in environments where customers could probably be prone to or vulnerable to confusion or deception in respect of drinks and beverages served.

Aptly, the field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of letters available, the Respondent-Applicant had come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.[7]

Accordingly, this Bureau finds that the registration of the Respondent-Applicant's Trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby SUSTAINED. Let the file wrapper of Trademark Application Serial No. 4-2011-002410 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 03 September 2012.

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

5 *Clark v. Mariela Candy Co.* 36 Phil. 100, 106; *Co Tiong Sa v. Dir. of Patents* 95 Phil. 1,4.
6 *Societe Des Products Nestle, S.A. v. Court of Appeals*, G.R. No. 112012, 4 April 2001.
7 *American Wire and Cable Co. v. Director of Patents et. al*, G.R. No. L-26557, 18 Feb. 1970.