



THE UNITED STATES PLAYING CARD CO.,
Opposer,

-versus-

FERNANDO G. MONTEVERDE,
Respondent-Applicant.

X-----X

}
} IPC No. 14-2011-00466
} Opposition to:
} Appl. Serial No. 4-2011-750028
} Filing Date: 16 June 2011
} TM: "BEE & LOGO"
}

NOTICE OF DECISION

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FERNANDO G. MONTEVERDE

Respondent-Applicant
2138 A. Luna St. Pasay City

GREETINGS:

Please be informed that Decision No. 2013 – 14 dated January 24, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 24, 2013.

For the Director:

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



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IPC NO. 14-2011-00466
Opposition to:

Appln. Serial No. 4-2011-750028
(Filing Date: 16 June 2011)
TM: "BEE & LOGO"

Decision No. 2013- 14

DECISION

THE UNITED STATES PLAYING CARD CO.¹ ("Opposer") filed on 19 December 2011 an opposition to Trademark Application Serial No.4-2011-750028. The application, filed by FERNANDO G. MONTEVERDE² ("Respondent-Applicant"), covers the mark "BEE & LOGO" for use on "*sporting goods and services*" under class 28 of the International Classification of Goods and Services³. The Opposer alleges, among other things, that:

1. it is the true originator and rightful owner of the marks "BEE" and the "Bee Design";
2. the mark applied for registration by the Respondent-Applicant is confusingly similar to the Opposer's "BEE" and "BEE TUCK CASE", which it claims to be well-known marks;
3. the goods indicated in the Respondent-Applicant's application are within the logical and potential expansion of the Opposer's business; and
4. the Respondent-Applicant's trademark application was filed in bad faith.

To support its opposition, the Opposer submitted⁴:

1. the pertinent page of "IPO e-gazette" which lists among other things the Respondent-Applicant's trademark application;
2. printouts of the webpages of various websites;
3. certified true copies of the certificates of trademark registration Nos. 054525 and SR-8795;
4. samples of advertisements in Japan and purchases; and
5. certified true copy of the Opposer's trademark registrations in the United States of America and in Japan.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 19 January 2012. On 21 February 2012, this Bureau received a letter, dated 13 February 2013 and bearing the name and purported signature of Fernando G. Monteverde. The letter, mailed on 15 February 2012, was apparently in response to the abovementioned Notice to Answer. A scrutiny of the letter, however, shows that it was not verified as required under Rule 2, Sec. 9 of the Amended Rules and Regulations on Inter Partes Proceedings (promulgated

¹ A corporation duly organized and existing under and by virtue of the laws of Kentucky, United States of America ("U.S.A."), with principal office address at Beech Street, Park Avenue, Cincinnati, Ohio, U.S.A.

² With address at 2138 A. Luna Street, Pasay City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement concerning the International Classification of goods and services for the purpose of the Registration of marks concluded in 1957.

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

via Office Order No. 99, s. 2011). Under the rules, and as explicitly stated in the Notice to Answer, non-compliance with the requirements shall be deemed a failure to file the answer. With the failure of the Respondent-Applicant to file the Answer, the case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the mark BEE?

But do the marks, as shown here, resemble each other that confusion, even deception, is likely to occur?

Opposer

Respondent-Applicant



(Reg. No. 054525)



(Reg. No. 8795)



The defining feature in the Opposer's marks and in the mark applied for registration by the Respondent-Applicant is the word "BEE". The depiction of an insect is also connected with the concept or idea conveyed by the word bee. This Bureau notices that the style of the word BEE in the Respondent-Applicant's mark is identical to that of in the Opposer's mark covered by Reg. No. 8795.

In this regard, it must be emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁵ Thus, Sec. 123.1 (d) of the IP Code provides that a mark cannot be registered if its is identical with a registered mark belonging to a different proprietor or a mark with an 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 a mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed his trademark application on 16 June 2011, the Opposer already has existing trademark registrations in the Philippines for "BEE" under Reg. No. 054525 issued on 26 February 1993 and "BEE TUCK CASE" under Reg. No.

⁵ *Pribhdas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

8795 issued on 02 April 1993. These trademark registrations cover "playing cards" under Class 16.

But are the goods indicated in the Respondent-Applicant's trademark application closely related to those covered by the Opposer's trademark registrations? According to the Supreme Court, the factors in determining whether goods are related are:

- a) the classification of the goods;
- b) the nature of the goods;
- c) the descriptive properties, physical attributes or essential characteristics of the goods with reference to their form, composition, texture or quality; and
- d) style of distribution and marketing of goods, including how the goods are displayed and sold.⁶

There is no doubt that the Respondent-Applicant's goods are of different classification from the Opposer's. However, this Bureau finds merit in the Opposer's arguments, to wit:

"25. Respondent-Applicant is applying for registration of the mark for sporting goods/articles which are closely related to Opposer's 'playing cards' under Class 16. Sporting goods/articles flow through the same channels of trade as playing cards, and said goods are likely to be found in the same stores selling items related to games, hobbies and sports and recreational activities. In fact a local store, Cutting Edge, which retails 'BEE' playing cards in the Philippines, sells products identical or similar to goods covered by Respondent-Applicant's application, i.e. outdoor gadgets, games and hobbies products, even billiard product. x x x

"26. Respondent-Applicant seeks to use the mark 'BEE & LOGO' on Class 28 goods for sporting goods/articles, such as tennis balls, shuttlecocks, and backgammon games. Considering that Opposer's 'BEE' and 'BEE TUCK CASE' marks are associated with playing cards, to allow Respondent-Applicant to use the confusingly similar mark 'BEE & LOGO' on Class 28 will undoubtedly lead to confusion that they come from the same source. Since the marks are confusingly similar, the public will necessarily make the link, association, or affiliation between Opposer and Respondent-Applicant when there is none.

"27. Further, the target consumers are similar. The same demographic of consumers, i.e. those seeking to engage in sports and recreational activities, would purchase the goods on which the marks 'BEE & LOGO' of Respondent-Registrant (sic) and Opposer's registered 'BEE' and 'BEE TUCK CASE' marks are found. The confusing similarity between the marks and the close relation between the goods on which they are to be used would likely cause consumers to draw the connection between the goods and/or sources or origin of the goods."⁷

Succinctly, the Respondent-Applicant's mark could be seen as just a variation of the Opposer's. Thus, information, assessment, perception or impression about the Respondent-Applicant's goods bearing the mark BEE may unfairly be cast upon or attributed to the Opposer, and *vice-versa*.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for

⁶ See *Mighty Corporation v. E. & J. Gallo Winery*, 478 Phil. 615 (2004) and *Societe Des Produits Nestle, S.A. v. Court of Appeals, et al G.R.* No. 172276, 08 Aug. 2010.

⁷ Verified Notice of Opposition, pp. 13-14.

purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.⁸ The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:⁹

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

Accordingly, this Bureau finds that 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. 4-2011-750028 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 24 January 2013.



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

⁸ *American Wire and Cable Co. v. Director of Patents et al.*, (31 SCRA 544) G.R. No. L-26557, 18 Feb. 1970.

⁹ *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.