



THE UNITED STATES PLAYING
CARD COMPANY,
Opposer,

-versus-

CONSUELO NORA CAROLINA D. PUYAT,
Respondent-Applicant.

X-----X

IPC No. 14-2008-00369

Opposition to:

Appln. Serial No. 4-2008-002794

Date filed: 10 March 2008

TM: "TRICYCLE PINOY SOUVENIR
CARDS CONTAINER DESIGN
CONTAINER DESIGN AND
PACKAGE (LABEL MARK)"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 – 74 dated April 18, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 18, 2012.

For the Director:

Catherine Socorro O. Estrada

Atty. CATHERINE SOCORRO O. ESTRADA
Hearing Officer, BLA

CERTIFIED TRUE COPY
[Signature]
SHARON S. ALGANTARA
Records Officer II
Bureau of Legal Affairs, IPO



**THE UNITED STATES PLAYING
CARD COMPANY,**

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- versus -

**CONSUELO NORA CAROLINA D.
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IPC No. 14-2008-00369

Opposition to:

Appln. Ser. No. 4-2008-002794

Date Filed: 10 March 2008

Trademark: **Tricycle Pinoy
Souvenir Cards Container
Design and Package (Label
Mark)**

Decision No. 2012 - 74

DECISION

The United States Playing Card Company¹ ("Opposer") filed on 15 December 2008 an opposition to Trademark Application Serial No. 4-2008-002794. The application, filed by Consuelo Nora Carolina D. Puyat² ("Respondent-Applicant"), covers the mark TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL MARK) for "*souvenir playing cards*" under Class 28 of the International Classification of Goods³.

The Opposer alleges, among other things, the following:

"7. Opposer is the true owner of the well-known mark BICYCLE as it can trace its ownership and its right to use the said mark for more than a hundred years prior to the filing date of the application subject of this opposition.

"8. Opposer traces its origins as far back as January 1867 when A.O. Russell, Robert J. Morgan, James M. Armstrong and John F. Robinson, Jr. formed a partnership and purchased from the proprietors of The Cincinnati Enquirer what was then known as the Enquirer Job Printing Rooms.

"9. The firm commenced business as Russell, Morgan & Co. and printed theatrical and circus posters, placards and labels. Early in 1880, Mr. Russell proposed to his partners that they embark upon the manufacture of playing cards, an industry monopolized by several east coast companies. The partners agreed and the first deck of playing cards was completed on June 28, 1881. About 20 employees manufactured 1,600 packs per day. In 1981, Russell, Morgan & Co. became the United

¹ A foreign corporation duly organized and existing under the laws of the United States of America, with principal office at 4590 Beech Street, Cincinnati, Ohio, 45212, U.S.A.

² With address at 55 Cayetano Arellano St., Ayala Heights Village, Old Balara, Quezon City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

States Playing Card Company. Thereafter, Opposer acquired other notable companies: The Standard Playing Card Co. (Chicago), Perfection Card Co. (New York) and New York Consolidated Cards.

"10. For more than one hundred years, Opposer has manufactured the world's top brands of playing cards and accessories, its unmatched manufacturing and technical experience yields superior products that are favored by casinos and consumers worldwide including those in the Philippines. Using state-of-the-art technology and techniques that have evolved over a century, Opposer makes cards that last longer and shuffle better than competitor cards.

"11. Today, Opposer is the world's largest manufacturer and distributor of playing cards and a leader in marketing poker chips and sets, collectible tins, puzzles, and card accessories. Opposer is also the largest supplier of premium playing cards to casinos worldwide and its brands include BICYCLE, BEE, HOYLE, and AVIATOR, the best selling playing card brands in the world. Information about Opposer and Opposer's products including those bearing the BICYCLE trademark are available at its website <http://www.usplayingcard.com>

"12. Opposer first used the trademark BICYCLE for playing cards in 1885. Since then, Opposer has been using the BICYCLE trademark. In addition, Opposer's BICYCLE line of cards depicts the joker and kings to be on high-wheeled bikes, which appears as follows:

x x x

"13. Today, the trademark BICYCLE continues to be used on Opposer's playing cards that include: BICYCLE 808 Poker Playing Cards, BICYCLE Braille Playing Cards, BICYCLE Card Games, BICYCLE Canasta, BICYCLE Euchre, BICYCLE Pinochle, BICYCLE Poker, BICYCLE Rummy, BICYCLE Spades, BICYCLE Five Hundred Card Game, BICYCLE Jumbo Index Playing Cards, Miniature BICYCLE Playing Cards, BICYCLE Bridge Size Playing Cards and Big BICYCLE Playing Cards.

"14. Opposer also publishes card game related books under the BICYCLE trademark and has caused the publication of the following: BICYCLE Official Rule of Card Games, Complete Win at Hearts, Complete Win at Spades, Pinochle is the Name of Game and Poker is the Name of the Game.

x x x

"15. Opposer and the mark BICYCLE are well-known internationally and in the Philippines by reason of long and continuous use of the marks for more than a century, and the numerous worldwide applications and registrations of said trademark.

"16. In the Philippines, Opposer was the first to register the trademark BICYCLE and variations thereof. Some of these trademark registrations are as follows:

- a. Reg. No.: 000895
Mark: BICYCLE
Date of Registration: August 22, 1920
Class: 28
- b. Reg. No.: 000950
Mark: 808 BICYCLE
Date of Registration: May 11, 1921
Class: 16
- c. Reg. No.: 4-2002-004978
Mark: BICYCLE
Date of Registration: March 20, 2005

"17. To date, Opposer owns at least 153 trademark registration and applications in at least 56 countries/territories worldwide including but not limited to the following countries: Argentina, Australia, Bahamas, Barbados, Bangladesh, Benelux, Brazil, Bulgaria, Canada, Chile, China, Colombia, Costa Rica, Cuba, Czech Republic, Ecuador, European Community, France, Germany, Hong Kong, Hungary, India, Ireland, Italy, Jamaica, Japan, Malaysia, Mexico, New Zealand, Nicaragua, Pakistan, Panama, Philippines, Poland, Republic of Korea, Romania, Russian Federation, Serbia and Montenegro, Singapore, Slovakia, South Africa, Spain, Sweden, Switzerland, Taiwan, United Kingdom, and the USA.

"18. The BICYCLE trademarks have been extensively used, marketed and advertised by Opposer as well as through Opposer's extensive network of licensees, distributors and dealers on a worldwide basis, including the Philippines. Opposer's BICYCLE trademark was first used in the United States of America in 1885 and in the Philippines in 1921.

x x x

"19. Respondent-Applicant's trademark application for TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL) is clearly confusingly similar with Opposer's registered mark BICYCLE. Respondent-Applicant's trademark application for TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL) is an infringing simulation of Opposer's well-known trademark. Although TRICYCLE differs from BICYCLE in a number of ways i. e. spelling and pronunciation, it is very similar to BICYCLE as both leave an impression of a "wheeled vehicle" and the only difference between the two would be on the number of wheels. That and the fact that said application covers identical goods as that of the Opposer will cause confusion among the purchasing public and hence, will surely dilute the distinctiveness of Opposer's BICYCLE trademark.

"20. What is more, the Respondent-Applicant's mark covers "souvenir playing cards" in class 28. Considering that Opposer's mark covers playing cards in class 28 and 16, among others, and considering

further that Opposer is in the business of manufacturing, marketing and distributing playing cards, there is a very high possibility that the registration of Respondent-Applicant's mark will cause confusion.

"21. With nary a doubt, the manner in which the mark TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL) is used by Respondent-Applicant will lead to confusion of its goods and business with that of Opposer. Indeed, because of the very close resemblance between Respondent-Applicant's mark and Opposer's mark, it is also very likely that the public will be confused into thinking that Respondent-Applicant's mark is associated with or under the sponsorship of Opposer.

"22. There is no denying that Respondent-Applicant is riding on the goodwill and popularity of Opposer's mark, specially since the goods covered are the same. Respondent-Applicant has a boundless choice of words to identify its goods from the Opposer. There is no reason why Respondent-Applicant would choose the mark TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL) for souvenir playing cards in class 28 when the same is confusingly similar to the Opposer's mark BICYCLE which is also used for the same goods.

"23. In addition, by virtue of Opposer's prior and continued use of the mark for more than one hundred (100) years, BICYCLE has become well-known and has established goodwill among consumers.

"24. Indeed, the identity or the confusing similarity between Respondent-Applicant's TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL) mark and the internationally well-known mark BICYCLE of Opposer is very likely to deceive the purchasers of goods on which the mark is being used, not only to the origin or sponsorship of goods but also as to the nature, quality, characteristics of the goods to which the mark is affixed.

"25. The approval of the subject mark for registration will violate the proprietary rights and interest, business reputation and goodwill of the Opposer considering that the same is confusingly similar, if not identical to Opposer's BICYCLE, a mark that is highly distinctive and over which the Opposer has exclusive use and registration in numerous countries worldwide.

"26. Because of opposer's aggressive worldwide sales, promotions and advertising Opposer's trademark BICYCLE is not only well-known in the United States of America but in other parts of the world as well.

"27. Extensive advertising, sale and distribution of Opposer's products bearing the BICYCLE are achieved through the Internet. The relevant Internet websites include the following:

x x x

"28. In November 2008, the search engine "Yahoo!" generated

4,720,000 hits for the keyword BICYCLE PLAYING CARDS. While the www.usplayingcards.com received 774,814 visits from January 2005 up to December 2008.

"29. For more than a hundred years, Opposer has extensively used, promoted and marketed its goods bearing the BICYCLE trademark, in the Philippines and elsewhere in the world. Opposer and its affiliate companies have invested substantially in the promotion of its BICYCLE trademark.

"30. Through Opposer's extensive advertising and marketing of its BICYCLE products and the nature and quality of Opposer's goods, Opposer has attained tremendous sales and patronage. Below are the annual sales figures of Opposer for the years 2001 to 2005.

YEAR	Sales Figures in US Dollars
2001	\$26,994,498
2002	\$27,344,314
2003	\$27,255,682
2004	\$32,931,776
2005	\$26,247,504

"31. The fame and well-known status of BICYCLE trademark are likewise attributed to the legal protection obtained by Opposer for the said trademarks in many countries, as well as its efforts at obtaining and maintaining exclusive right to the use and ownership of said trademark.

"32. Opposer is the owner of the well-known mark BICYCLE. Opposer offers a wide variety of products bearing the BICYCLE trademark and these products are mainly related to playing cards,

"33. Opposer and its affiliate companies own approximately 153 trademark applications and registrations in at least 56 countries and/or territories worldwide.

"34. In the Philippines, the marks BICYCLE have been registered with the Bureau of Trademarks since 1920, almost eighty eight years earlier than that of Respondent-Applicant's trademark application. Products bearing the marks have been sold and distributed throughout the Philippines for a number of years. Playing cards bearing the mark BICYCLE have also been widely advertised, marketed and promoted in the country.

"35. Opposer's BICYCLE products are being distributed throughout the Philippines exclusively by Star Paper Corporation.

"36. In the Philippines, total sales figures attained from the sale of BICYCLE goods from 2001 to 2005 are as follows:

YEAR	Sales Figures in US Dollars
2001	\$89,997

2002	\$130,934
2003	\$114,380
2004	\$138,045
2005	\$138,125

The Opposer's evidence consists of the following:

1. Exhibit "A" - Affidavit of Jan Abigail L. Ponce;
2. Exhibit "B" - Special Power of Attorney;
3. Exhibit "C" - Certified true copy of the entire Verified Notice of Opposition together with all Affidavits and Exhibits in IPC No. 14-2006-00015 entitled "*The United States Playing Card Co. v. Star Paper Corporation*";
4. Exhibit "D" - Certified true copy of Opposer's Certificate of Ownership and Merger;
5. Exhibit "E" - Print out of the <http://www.usplayingcard.com> website;
6. Exhibit "F" - Certified true copy of the Affidavit of Joseph Robinette which was submitted in IPC No. 14-2006-00015;
7. Exhibits "G" series - Certified true copies of certificates of trademark registrations from different countries issued in the name of Opposer for BICYCLE and variations thereof;
8. Exhibit "H" - Certified true copy of the 2006 database list of all the BICYCLE trademarks registered around the world;
9. Exhibit "H-1" - Database listing as of 2008 of BICYCLE worldwide trademark applications and registrations;
10. Exhibits "I" to "I-2" - Philippine Certificates of Trademark Registration for BICYCLE and variations thereof issued under the name of Opposer covering goods in Classes 16 and 28;
11. Exhibits "J" series - Print outs of various internet websites featuring Opposer and Opposer's BICYCLE trademark and products;
12. Exhibits "K" to "K-2" - Receipts covering sales of Opposer's BICYCLE playing cards in the Philippines; and
13. Exhibit "L" - Print out of 2007 Annual Report of Jarden Corporation, the parent corporation of Opposer.

The Respondent-Applicant filed on 26 June 2009 a VERIFIED ANSWER, alleging among other things the following:

"2. Respondent denies the allegation in paragraph 7 that Opposer is the true owner of the trademark BICYCLE, for being a conclusion of law. It is further denied, the truth being that under the Intellectual Property Code, the rights in a trademark are acquired through registration made validly in accordance with the said Code, and not through the "use of the mark for more than a hundred years prior to the filing date of the application subject of this opposition", as Opposer claims, and that a certificate of registration, even when issued, is only a prima facie evidence of registrant's exclusive right to use the mark.

"2.1 Respondent further denies the allegation in paragraph 32 that Opposer is the owner of the well-known mark BICYCLE, for likewise being a conclusion of law for the same reasons as

discussed in the immediately preceding paragraph.

x x x

"4. Respondent-Applicant is an avid card collector who has made a hobby out of collecting souvenir cards from various countries in the course of her travels abroad.

"5. Her interest in souvenir cards has sparked the realization that in the Philippines, no single set of souvenir cards exist which would cater to the Overseas Filipino Workers (OFW) market, "balikbayans" or returning Filipino citizens, and tourists similarly interested in collecting Filipino tokens.

"6. The foregoing circumstances motivated Respondent-Applicant to create her own set of Filipino souvenir cards. From August 2007 to November 2007, Respondent-Applicant took pains to design a deck of souvenir cards with attributes distinctly Filipino; which she aptly named "Tricycle Pinoy Souvenir Cards".

"7. For instance, each King, Queen and Jack character of Respondent-Applicant's deck of cards possesses a unique Filipino characteristic. The King is clothe in a traditional tribal costume reminiscent of the garments worn by earlier Filipino chieftains otherwise known as "datus". Respondent-Applicant's Queens are robed in the classic Maria Clara attire and each Jack wears a conventional Barong Tagalog.

"8. The Joker in Respondent-Applicant's deck of cards is a carabao donning a jester's hat, representative of the domesticated subspecies of the water buffalo commonly found in the Philippines.

"9. The backside of each of Respondent-Applicant's cards is designed with an enumeration of Filipino dishes such as "Adobo", "Sinigang" and "Kare-Kare", displayed in circular layers with a centered image of a plate, spoon, and fork and the words "Kain Na".

"10. The very logo detailed in several of Respondent-Applicant's trademark application is a tricycle, representative of the three-wheeled vehicle commonly used as a means of public transport in the Philippines. The same tricycle logo distinguishes Respondent-Applicant's Ace of Spades.

"11. Each of the foregoing characters has been the subject of individual trademark applications filed by Respondent-Applicant. To date, Respondent-Applicant has obtained fifteen (15) Certificates of Registration from the Intellectual Property Office for the following marks, more specifically detailed below:

	Trademark	Registration Number	Date of Registration
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1.	KAIN NAI WITH PLATE DEVICE AND THE WORDS ADOBO. SINIGANG. KARE-KARE. DINUGUAN. MECHADO. KRISPYPATA. MENUDO. APRITADA. BULALO. LECHON. PANSIT; LONGGANISA. TAPA. TOCINO. TUYO. DANGGIT. DILIS. TINAPA; HALO-HALO. BIBINGKA. PUTO BUMBONG. SAPIN-SAPIN. PALITAW RENDERED IN A CIRCULAR MANNER	4-2008-002788	September 15, 2008
2.	KING OF DIAMONDS WITH FIGURE IN TRIBAL COSTUME	4-2008-002801	September 15, 2008
3.	QUEEN OF SPADES DEVICE	4-2008-002808	September 15, 2008
4.	JOKER AND DEVICE	4-2008-002809	September 15, 2008
5.	KING OF HEARTS WITH FIGURE IN TRIBAL COSTUME	4-2008-002804	September 15, 2008
6.	KING OF SPADES WITH FIGURE IN TRIBAL COSTUME	4-2008-002802	September 15, 2008
7.	QUEEN OF CLOVERS DEVICE	4-2008-002805	September 15, 2008
8.	QUEEN OF DIAMONDS DEVICE	4-2008-002806	September 15, 2008
9.	QUEEN OF HEARTS DEVICE	4-2008-002807	September 15, 2008
10.	KAIN NAI BACK PANEL (LABEL MARK)	4-2008-002793	September 15, 2008
11.	JACK OF DIAMONDS WITH FIGURE IN BARONG DEVICE	4-2008-002796	September 15, 2008
12.	JACK OF HEARTS WITH FIGURE IN BARONG DEVICE	4-2008-002797	September 15, 2008
13.	JACK OF SPADES WITH FIGURE IN BARONG DEVICE	4-2008-002798	September 15, 2008
14.	JACK OF CLOVERS WITH FIGURE IN BARONG DEVICE	4-2008-002799	September 15, 2008

15.	JACK OF CLOVERS WITH FIGURE IN TRIBAL COSTUME	4-2008-002800	September 15, 2008
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Original copies of each Certificate of Registration are attached as Exhibits "A-1" to "A-15" to the Verified Answer filed for IPC No. 14-2008-00366, dated 26 June 2009. Photocopies of such Certificates of Registration are likewise attached hereto as Exhibits "A-1" to "A-15".

"12. In November 2007, Respondent-Applicant completed production of the first set of Tricycle Pinoy Souvenir Cards. As her intent was to market the cards as souvenir items, Respondent-Applicant distributed her cards to a limited clientele of family and personal friends at a retail price of One Hundred Pesos (PHP 100.00) per deck.

"13. Respondent-Applicant also sold the cards for the same price, at village bazaars held in her residential subdivision. During her recent visit to a bed and breakfast establishment located in Tagaytay, in the province of Cavite, Respondent-Applicant likewise consigned there twenty (20) decks for sale. Respondent-Applicant likewise consigns her cards, at a wholesale price of Ninety-Five Pesos (PHP 95.00) per deck, with a local company which owns a chain of local souvenir shops located in various Philippine transport terminals and malls around Metro Manila.

x x x

"14. Opposer cites Section 123.1 (d), (e), (f) and Section 147 of the Intellectual Property Code to bar the registration of Respondent's mark TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL MARK). In relation to the foregoing, Opposer further contends that: (a) the use and registration of the applied for mark by Respondent-Applicant will mislead the public as to the origin, nature, quality and characteristics of the goods on which it is affixed; and (b) Respondent-Applicant's application for registration is tantamount to fraud as it seeks to register and obtain legal protection for an identical or confusingly similar mark that clearly infringes upon the established rights of the Opposer over its registered and internationally well-known mark.

"15. To be unregistrable under Section 123.1 (d) of the said Code, the mark subject of an application must: (a) be identical to a registered mark or a mark with an earlier filing date; or (b) nearly resemble such a mark as to be likely to deceive or cause confusion. The pertinent provision states: x x x

"16. Under Sections 123.1 (e) and (f) of the Intellectual Property Code, a mark is not registrable if it 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.

"17. Section 147 of the Code further provides that the owner of a

registered mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of the trade, identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered, where such use would result in a likelihood of confusion. The foregoing Section likewise provides that the exclusive right of the owner of a well-known mark defined under Section 123.1 (e), which is registered in the Philippines, shall extend to goods and services which are not similar to those in respect of which the mark is registered.

x x x

"18. At the outset, it should be noted that Opposer's claim that the mark BICYCLE is well-known in the Philippines, should be established according to any of the following criteria or any combination thereof, as provided in Rule 102 of the Rules and Regulations on Trademarks: x x x

"19. As held by the Supreme Court in the case of *Sehwani v. In-N-Out Burger*⁴, the question of whether or not trademarks are considered "well-known" is factual in nature, involving as it does the appreciation of evidence adduced before the BLA-IPO (Bureau of Legal Affairs of the Intellectual Property Office). In view of the foregoing, the burden of proof lies on Opposer, to prove that in fact its mark BICYCLE is indeed a well-known mark within the purview of the Intellectual Property Code.

x x x

"20. The registration of Respondent-Applicant's mark is not barred under the Intellectual Property Code. Respondent-Applicant's mark TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL MARK) is not identical to Opposer's mark BICYCLE. Nor does it bear any resemblance to such mark as to be likely to deceive or cause confusion.

"21. The Intellectual Property Code, in Section 123.1 (d), unequivocally provides that the mark must also be identical to a registered mark belonging to a different proprietor or a mark with an earlier priority date.

"22. The competing marks must be more than just similar, they must be identical. That is, the mark sought to be registered for the same or similar goods or services must be exactly the same as the one already registered or with an earlier filing or priority date. The TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL MARK) mark is far from identical to the BICYCLE mark.

"23. A visual presentation of the marks serves to show that the marks are not identical. x x x

⁴ G. R. No. 171053, 15 October 2007 (citation by Respondent-Applicant).

"24. From a mere brief and casual comparison of the TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL MARK) and BICYCLE marks, it is clear that their general and overall appearances are far from similar, much less confusingly so. x x x

"25. Considering the patent differences in the appearances as well as in the features of the BICYCLE and the TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL MARK) marks, it is clear that the said marks do not resemble each other so as to confuse or deceive the ordinary purchaser. Any similarity arising from Opposer's use of the word BICYCLE, and Respondent-applicant's use of the word TRICYCLE, is lost in the substantial differences in the designs and general appearance.

x x x

"26. To reiterate, Opposer claims that the registration of TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL MARK) mark will mislead the public as to the origin, nature, quality and characteristics of the goods on which it is affixed; and that Respondent-applicant's application for registration is tantamount to fraud as it seeks to register and obtain legal protection for an identical or confusingly similar mark that clearly infringes upon the established rights of the opposer over its registered and internationally well-known mark.

"27. In trademark cases, particularly in ascertaining whether one trademark is confusingly similar to another, no set rules can be deduced because each case must be decided on its merits². Indeed, likelihood of confusion is a relative concept to be determined only according to the particular, and sometimes, peculiar, circumstances of each case. The complexities attendant to an accurate assessment of likelihood of confusion require that the entire panoply of elements constituting the relevant factual landscape be comprehensively examined.³

"28. In determining similarity and likelihood of confusion, jurisprudence has developed two tests, the dominance test and the holistic test. The dominance test focuses on the similarity of the prevalent features of the competing trademarks that might cause confusion or deception. In contrast, the holistic test requires the court to consider the entirety of the marks as applied to the products, including the labels and packaging, in determining confusing similarity. It must be emphasized, however, that the aforementioned tests are not to supersede each other, but that they apply to a specific case under consideration. In this case, whether it is the dominance or holistic test which is applied, the conclusion is inescapable – the two marks are entirely different and

² *McDonald's Corp. vs. MacJoy Fastfood Corp.*, G.R. No. 166115, 2 February 2007 (Citation by Respondent).

³ *Societe Des Produits Nestle, S.A., et al. v. Court of Appeals*, G.R. No. 112012, 4 April 2001 (Citation by Respondent-Applicant)

are not confusingly or deceptively similar.

"28.1. As earlier stated, there are substantial and glaring differences in the two marks that eliminate identity, similarity, and any likelihood of confusion.

"28.2. In appearance and sound, there is no confusing similarity. Indeed even if only the words BICYCLE and TRICYCLE are compared, oppose itself admitted that TRICYCLE differs from BICYCLE in a number of ways i.e. spelling and pronunciation."⁴

"28.3. The purchasers of the goods involved in this case are likewise of different target markets and ought to be credited with sufficient intelligence as the type knowledgeable in respect of their specific purchases. To reiterate, Respondent-applicant is marketing her cards as souvenir items for the Overseas Filipino Workers (OFW) market, "balikbayans" or returning Filipino citizens, and tourists. Opposer's cards, on the other hand, are playing cards, and the other products on which the mark BICYCLE is used pertain specifically to card-game related items such as the following publications enumerated in the Opposition: (a) BICYCLE Official Rule of Card Games; (b) Complete Win at Hearts; (c) Complete Win at Hearts; (d) Pinochie is the Name of the Game; and (e) Poker is the Name of the Game.

"28.4. Respondent-applicant's channels of trade differ substantially from that of opposer in that Respondent-applicant's souvenir cards are distributed to a limited clientele of family, personal friends and select souvenir outlets; while opposer's cards cater principally to casinos and consumers interested in traditional card games.

"28.5. Other factors, considered, Respondent-Applicant's pricing and such limited clientele further resolves the question of similarity and confusion in favor of Respondent-Applicant.

"29. To stress further, in determining whether two trademarks are confusingly similar, the two marks in their entirety as they appear in the respective labels must 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 on both labels. As demonstrated earlier, the TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL MARK) mark is distinctive and has features which serve to adequately distinguish it from the mark BICYCLE.

"30. As has been counseled in cases decided by the Supreme Court including but not limited to *Mighty Corp. vs. E. & J. Gallo Winery*,⁵ it is likewise important to examine the commercial impression likely to be

⁴ Paragraph 19 of Verified Notice Of Opposition

conveyed by the trademarks when used in conjunction with the respective goods of the parties. A practical approach to the problem of similarity and dissimilarity is to go into the whole of the two trademarks in their manner of display. Inspection should be undertaken from the viewpoint of the purchaser. The trademarks should be compared and contrasted with the purchaser's memory of the trademark. Some such factors as sound, appearance, form, style, shape, size or format, color, ideas connoted by the marks, as well as setting in which words appear may be considered. For this purpose, what confronts the consumer and the public must be considered and calls for a further comparison of the packaging of each of Respondent-applicant's and opposer's deck of cards.

"30.1. To facilitate comparison, a facsimile of the BICYCLE mark, as appearing on Opposer's pack of playing cards, is shown below:
x x x

"30.2. The facsimile of the TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL MARK) package likewise reproduced below: x x x

"31. It should be noted that the features of the foregoing packages **are strikingly different** in every respect, to wit:

"a. The BICYCLE package consists of the words "BICYCLE", the "RIDER BACK" and "PLAYING CARDS." On the other hand, the TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL MARK) package consists of the words "TRICYCLE PINOY SOUVENIR CARDS", below the figure of a traditional Filipino tricycle with the "Kain Na" back panel.

"b. The designs of the words are in **very dissimilar fonts**.

"c. In the BICYCLE package, the word "BICYCLE" is placed atop of a Spade with a figure of a woman, with the words "RIDER BACK" and "PLAYING CARDS" below. To reiterate, the TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL MARK) package has the words "TRICYCLE", "PINOY" and "SOUVENIR CARDS", each one placed on top of the other, all below the figure of a traditional Filipino tricycle, settled between two stars at each end of the package and three rays of the mythical sun identical to that found on the Philippine flag. The same mythical sun appears as the letter "O" in the word "PINOY". The back panel of the package contains the aforementioned "Kain Na" design.

"32. Considering the glaring differences in the overall appearances as well as in the features of the TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL MARK) and the BICYCLE packages, it is clear there is no confusing similarity

⁵ G.R. No. 154342, 14 July 2004 (Citation by Respondent-Applicant).

between the marks.

"33. It is also worthy to note that the Supreme Court has invariably held that, in determining confusing similarity, the level of sophistication of the "ordinary purchaser" of the goods must be considered.

"33.1. In *Philip Morris, Inc. V. Fortune tobacco Corp.*,⁶ the Supreme Court held that a comparison of the trademarks is just one of the appreciable circumstances in determining likelihood of confusion. The Supreme Court expressly stated that **due regard must be given to the "ordinary purchaser."**

"33.2. The character, training and education of the usual purchasers of the goods in question must be considered. Such purchasers are not ignorant and impressionable, but are intelligent and presumed to **already have a degree of familiarity with the goods.** This was explained by the Supreme Court in *Mighty Corp. vs. E. & J. Gallo Winery*⁷, to wit: x x x

"34. Considering that the ordinary and regular purchasers of Respondent-applicant's souvenir cards belong to an entirely different market as opposer's target market for its playing cards, and are presumed to be sophisticated, educated and discriminating consumers being tourists, "balikbayans" and traveled Overseas Filipino Workers, there can be no likelihood of confusion between the TRICYCLE PINOY SOUVENIR CARDS CONTAINER DESIGN AND PACKAGE (LABEL MARK) mark and the BICYCLE mark.

"35. The foregoing discussion clearly debunks Opposer's assertion that Respondent-applicant's application for registration is tantamount to fraud as it seeks to register and obtain legal protection for an identical or confusingly similar mark that clearly infringes upon the established rights of the Opposer over its registered and internationally well-known mark. It cannot be emphasized enough that Respondent-applicant's mark is in no way identical to or confusingly similar to that of opposer's, as argued in detail above.

"36. There is likewise no basis for the claim that Respondent-applicant's mark intends to mislead the public as to the origin, nature, quality and characteristics of the goods on which it is affixed.

"37. In *Philip Morris*⁸, the supreme Court held that if the allegedly infringed mark **does not point out the origin and/or ownership of the goods** to which the mark is affixed, **there can be no likelihood of confusion.**

⁶ G.R. No. 158589, 27 June 2006 (citation by Respondent-Applicant).

⁷ G.R. No. 154342, 14 July 2004 (Citation by Respondent-Applicant).

⁸ *Infra* (Citation by Respondent-Applicant).

"37.1 In the said case, the petitioner alleged that respondent's **MARK** mark was confusingly similar to its **MARK VII**, **MARK TEN** and **LARK** marks.

"37.2 The Supreme Court ruled that, even if the dominancy test was applied, there could not be any confusingly similarity between the said marks as since the words or devices in the petitioner's mark did not point out the ownership or origin of the goods. Thus: x x x

"38. Since the BICYCLE mark consists only of a generic and descriptive word that does not point out the origin or ownership of the playing cards and related items opposer uses the mark for, the ordinary consumer cannot possibly be deceived that respondent-applicant's souvenir cards belongs to opposer.

x x x

"39. Opposer likewise files its Opposition on the following grounds: (a) the approval of respondent-applicant's trademark application will cause grave and irreparable damage and injury to opposer; (b) The registration of the trademark in the name of respondent-applicant will violate proprietary rights and interest, business reputation and goodwill of the opposer over its trademark considering that the distinctiveness of the BICYCLE trademark will be diluted and hence, would be in violation of Section 168.1⁹ of the Intellectual Property Code; (c) The registration for the applied-for mark will not only prejudice the opposer, but will also cause respondent-applicant to unfairly profit from the goodwill, fame and notoriety of opposer's trademark registrations; and (d) Respondent-applicant's registration and use of the trademark in connection with goods under Class 28 will weaken the uniqueness and distinctiveness of Opposer's BICYCLE and will tarnish or dilute the distinctive quality of opposer's trademark which will result in the gradual attenuation of whittling way of value of Opposer's trademark, in violation of Opposer's proprietary rights.

"40. To reiterate, Respondent-Applicant's souvenir cards cater to the Overseas Filipino Workers (OFW), "balikbayans" or returning Filipino citizen, and tourists interested in collecting Filipino tokens. To date, Respondent-Applicant's limited clientele consists of her family and personal friends; participants in village bazaars held in her residential subdivision; and selected souvenir outlets.

"41. On the other hand, Opposer's cards are primarily marketed as "playing cards." As admitted by Opposer, their products may be purchased online and are distributed principally to casinos. They are of interest to consumers intended in traditional card games and for use in

⁹ 168.1. A person who has identified in the mind of the public the goods he manufactures or deals in, his business or services from those of others, whether or not a registered mark is employed, has a property right in the goodwill of the said goods, business or services so identified, which will be protected in the same manner as the other property rights.

actual game play considering the quality of their product. Respondent-Applicant's product is not intended for actual or extensive play but to be kept as a Philippine souvenir, that is why its channel of trade differs substantially from Opposer and negates any likelihood of confusion.

"42. In view of the foregoing, Opposer's assertion that the registration of Respondent-applicant's mark will cause grave and irreparable injury to Opposer which may violate its proprietary rights, interests, business reputation thereby enabling Respondent-Applicant to unfairly profit commercially from such trademark registration becomes utterly baseless.

"43. Opposer and Respondent-Applicant are competing in entirely different markets and it cannot be emphasized enough that Respondent-Applicant's clientele is quite specialized. Respondent-Applicant's cards are also distinctly Filipino. Even assuming an overlap in the market, in view of the significant differences in the marks that have been discussed above, no reasonable consumer would attribute Respondent-Applicant's cards with that of Opposer's so as to accuse Respondent-Applicant of riding on Opposer's goodwill."

The Opposer filed a Reply on 09 July 2009. The Respondent-Applicant in turn submitted a Rejoinder on 20 July 2009. The Preliminary Conference was terminated on 04 November 2009.

Should Trademark Application Serial No. 4-2008-002794 be allowed?

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 R. A. 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 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.

The records show that the Opposer had registered the mark BICYCLE for use on playing cards as early as 22 August 1950. The registration, No. 000895, was continuously renewed and is still subsisting up to the present.

But, do the competing marks, as shown below, resemble each other that mistake or confusion is likely to occur?

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



Opposer's mark



Respondent-Applicant's mark

The competing marks are not identical. However, the feature in the Respondent-Applicant's mark that immediately draws the eyes and the ears is the word "TRICYCLE". The eminence or prominence of the word "TRICYCLE" obviously makes it the "product identifier" with or without the other accompanying features and ornaments. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the trademark or conveys information thereon, the mark is referred to verbally as "TRICYCLE".

In this regard, there are similarities between the words "BICYCLE" and "TRICYCLE" in looks, sound and meaning. "BICYCLE" and "TRICYCLE" are land vehicles, the only difference is with respect to the number of wheels, hence, the suffixes, "bi" for two (2) and "tri" for three (3). This difference, as well as the presence of the other features with respect to the Respondent-Applicant's mark, is of no moment because in this kind of marks, what is crucial is the impact that the marks leave or impress upon the senses and the psyche of the consumers. "BICYCLE" as a brand name or trademark for playing cards is a very unique and highly distinctive mark. It is an arbitrary mark, which is composed of an ordinary word or words but whose meaning has no relation entirely to the goods to which it is attached.

Aptly, the records and evidence point to the notoriety of the "BICYCLE" playing cards. And, as the name of a type of a land vehicle - "BICYCLE" - is an unusual brand or mark for playing cards, another trademark which also consists mainly and essentially of the name of another land vehicle ("TRICYCLE"), which for that matter look and sound similar to the former, confusion, mistake, or even deception is likely to happen. Consumers may assume that one mark is just a variation of the other - a sort of a "local version" - or that the Respondent-Applicant's playing cards originate from or sponsored by the Opposer, or believe that there is a connection between them. The likelihood of confusion would subsist not only on the purchaser's perception of goods but also on the origins thereof as held by the Supreme Court:⁶

⁶ See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 Jan. 1987.

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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist.

It is inconceivable for the Respondent-Applicant to have come up with the mark "TRICYCLE" for use on playing cards without having been inspired by or motivated by an intention to imitate the mark "BICYCLE". It is highly improbable for another person to come up with an identical or nearly identical mark for use on the same or related goods purely by coincidence. 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 clearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁷

In this regard, confusion cannot be avoided by merely dropping, adding or changing one of the letters of a registered mark.⁸ 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 purchaser as to cause him to purchase the one supposing it to be the other.⁹ The conclusion (of similarity) created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term.

It is stressed that the laws on Trademarks and Tradenames is based on the principle of business integrity and common justice. This law, both in letter and spirit is laid upon the premise that, while it encourages fair trade in every way and aims to foster, and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing other's business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another.¹⁰

⁷ See *American Wire and Cable Co. v. Director of Patents, et. al.*, G. R. No. L-26557, 18 February 1970.

⁸ *Continental Connector Corp. v. Continental Specialties Corp.*, 207 USPQ.

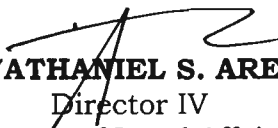
⁹ *Societe Des Produits Nestle, S. A. v. Court of Appeals*, G. R. No. 112012, April 4, 2001.

¹⁰ See *Baltimore Bedding Corp. v. Moses*, 182 Md. 229, 34A (2d) 338.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2008-002794 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 18 April 2012.


Atty. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs 