



PHILIP MORRIS PRODUCTS, S.A.,
Opposer,

-versus-

BRITISH AMERICAN TOBACCO
(BRANDS) LIMITED,
Respondent-Applicant.

} **IPC No. 14-2013-00063**
}
}**Opposition to:**
}**Appln. Serial No.4-2012-011287**
}**Date filed: 13 September 2012**
}**TM: "CLICK & ROLL"**

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 145 dated July 14, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 14, 2015.

For the Director:


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



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**BRITISH AMERICAN TOBACCO
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IPC No. 14-2013-00063

Opposition to Trademark
Application No. 4-2012-011287
Date Issued: 13 September 2012

Trademark: **"CLICK & ROLL"**

Decision No. 2015- 145

DECISION

Phillip Morris Products, S.A.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-011287. The contested application, filed by British American Tobacco (Brands) Limited² ("Respondent-Applicant"), covers the mark "CLICK & ROLL" for use on "*cigarettes; tobacco; tobacco products, lighters, matches; smokers' articles*" under Class 35 of the International Classification of Goods.³

The Opposer anchors its Opposition on Section 123.1 (j) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), alleging that the mark "CLICK & ROLL" is non-registrable for being descriptive. It alleges that the said mark is intended to be used on a type of cigarettes, which, as their significant feature or characteristic, will be operated by a clicking and rolling action to activate the flavor in the capsule located in the filter. It contends that "CLICK & ROLL" describes the very operation or the significant feature of the type of cigarettes which the mark seeks to designate. It claims to be a manufacturer of such type of cigarettes and therefore has an equal right to use "CLICK" for its own click-activated capsule, and the rolling action which further allows adjustment of the activated flavor should it give its own version of this cigarette such a feature. It relies on Resolution No. 0000359 of the Dominican Republic issued on 29 June 2011 ruling that "CLICK" lacks distinctiveness.

In support of its opposition, the Opposer submitted the following as evidence:⁴

¹A corporation organized and existing under the laws of Switzerland with principal address at Quai Jeanrenaud 3, 2000 Neuchatel, Switzerland.

² A foreign entity with address at Globe House 4, Temple Place London, WC2R 2PG England.

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 "CC".

1. certified copy of the decision of the Dominican Republic PTO and the corresponding English translation;
2. affidavit of Jan Abigail L. Ponce;
3. certification of Mr. Markus Mueller;
4. certified true copy of the Extract from the Commercial Register of the Opposer issued by Companies Registry of the Canton of Neuchatel and the corresponding English translation;
5. article regarding the Respondent-Applicant and/or Kent and/or Lucky Strike cigarettes;
6. photographs of Lucky Strike, Kent and/or Kool cigarettes sold in different countries;
7. printout of the website http://www.ajcigarettes.com/index.php?route=product/product&product_id+75;
8. video uploaded at <http://www.buycigarettesonlinecheap.com/lucky-strike-click-roll-cigarette-review>; and
9. printout of the website <http://www.sulit.com.ph/index.php/view+classifieds/id/3736619/Collectible+LUCKY+STRIKE+Click+%26+Roll+Edition+Cigarettes+FOR+SALE%21>.

The Respondent-Applicant filed its Answer on 30 July 2013 alleging that the "CLICK & ROLL" does not directly call to mind cigarettes, tobacco, tobacco products, lighters, matches and smokers' articles. According to the Respondent-Applicant, the mark is distinctive. It avers that its registrations and/or pending applications for the mark in different jurisdictions are proof that the same is not descriptive. It also argues that the resolution in the Dominican Republic cited by the Opposer has little or no persuasive value and was arrived at without its participation.

The Respondent-Applicant's evidence consists of the notarized affidavit of Stuart Paul Aitchison with annexes.⁵

During the Preliminary Conference conducted and terminated on 20 November 2013, the parties were directed to file their respective Position Papers within ten days therefrom.

The issue to be resolved is whether Respondent-Applicant's applied mark "CLICK & ROLL" should be allowed registration.

A trademark is any distinctive word, name, symbol, emblem, sign, or device, or any combination thereof, adopted and used by a manufacturer or merchant on his goods to identify and distinguish them from those manufactured,

⁵ Marked as Exhibits "2" to "2-D".

sold, or dealt by others. Inarguably, it is an intellectual property deserving protection by law.

A trademark must, first and foremost, be capable of distinguishing one's goods apart from the other. The Opposer's main contention is that the mark "CLICK & ROLL" is descriptive. In this regard, Section 123.1 (j) of the IP Code provides that a mark cannot be registered if it:

*"(j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services;
x x x"*

The Supreme Court explained in **Societe des Produits Nestle vs. Court of Appeals**⁶, thus:

"Generic terms are those which constitute 'the common descriptive name of an article or substance,' or comprise the 'genus of which the particular product is a species'" or are 'commonly used as the name or description of a kind of goods,' or 'imply reference to every member of a genus and the exclusion of individuating characters,' or 'refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular product,' and are not legally protectable. On the other hand, a term is descriptive and therefore invalid as a trademark if, as understood in its normal and natural sense, it 'forthwith conveys the characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is,' or 'if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods,' or if it clearly denotes what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination." (Emphasis supplied.)

When one sees or hears the mark "CLICK & ROLL", it does not immediately come into mind that it pertains to cigarettes and/or tobacco products. It is unlikely that one would have the idea that the said mark pertains to cigarettes. The said terms do not describe the goods the mark covers. At the very least, the words "CLICK" and "ROLL" can be considered suggestive of the "technology" used in this type of cigarette product and therefore, as a suggestive mark, still registrable.

The Opposer failed to adduce substantial evidence to prove or show that the mark "CLICK & ROLL" is descriptive. It only presented articles and pictures of the Respondent-Applicant's products incorporating the said feature which even bolsters the fact that the latter has been extensively using the same. While it

⁶ G.R. No. 112012, 04 April 2001.

claims that the said mark is descriptive, it did not show that "CLICK & ROLL" is being used by other cigarette and/or tobacco companies apart from the Respondent-Applicant, not even its own. It is settled that the one who alleges has the burden of proof.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Registration No. 4-2012-011287 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 14 July 2015.


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