BRITISH AMERICAN TOBACCO (BRANDS) LIMITED, Opposer,	}	**IPC No. 14-2013-00422** Opposition to: Appln Serial No. 4-2013-00006640 Date Filed: 07 June 2013 **TM: "FLAME DEVICE"**
-versus-	}	
LUDOVICUS JOSEPHINE F. TIMMERMANS, Respondent-Applicant.	}	

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 173 dated September 01, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 01, 2015.

For the Director:

MARILYN S. RETUTAL
IPRS IV, Bureau of Legal Affairs

BRITISH AMERICAN TOBACCO (BRANDS) LIMITED, Opposer,	}	IPC No. 14-2013-00422 Opposition to:
-versus-	}	Appln.No. 4-2013-00006640 Date Filed: 07 June 2013
LUDOVICUS JOSEPHINE F. TIMMERMANS, Respondent-Applicant.	}	Trademark: **"FLAME DEVICE"** Decision No. 2015 - 173

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DECISION

BRITISH AMERICAN TOBACCO (BRANDS) LIMITED ("Opposer"),[1] filed an opposition to Trademark Application Serial No. 4-2013-00006640. The application, filed by LUDOVICUS JOSEPHINE F. TIMMERMANS ("Respondent-Applicant"),[2] covers the mark "FLAME DEVICE" for use on goods under the following classes[3]: **34** namely*: tobacco; cigarettes, cigarillos and cigars (whether electronic or not); tobacco pipes (whether electronic or not); bulbs, cartridges and filters for the aforementioned goods; smokers' articles, especially packets of tobacco, packets of cigarettes, packets of cigarillos, packets of cigars; electric cigarettes, electric cigars, electric cigarillos and electric pipes; bulbs and cartridges for electric cigarettes, electric cigars, electric cigarillos and electric pipes; storage bags for the aforementioned goods;* **35** namely: *retail services in selling and business intermediary services for the sales of the goods listed in class 34.*

The Opposer alleges the following grounds for opposition:

"(a) The Opposer is the prior user and the applicant of the 'O (stylized)' trademark, which was filed before the filing date of the Published Mark (filed only on 7 June 2013). x x x The 'O (stylized)' trademark is also incorporated in some of the Opposer's other applications.

"(b) The Opposer has also applied for the registration and registered the 'O (Device) mark in various jurisdictions worldwide. The Opposer's registrations and applications for the 'O (Device)' mark cover goods identical to that applied for in Respondent's application - tobacco products in Class 34.

"(c) The registration of the Published Mark is therefore contrary to the provisions of Section 123.1 (d) and (g) of Republic Act No. 8293, as amended. In fact there shall be a presumption that a likelihood of confusion will result if what is used is an identical sign for identical goods. On this score, a cursory examination of the competing marks would show that the Respondent's Published Mark is nearly identical and confusingly similar to the Opposer's 'O (stylized)' trademark.

"(d) Visually, the Published Mark is confusingly similar, if not nearly identical, to the Opposer's 'O (stylized)' trademark. x x x

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1 A company organized under the laws of United Kingdom/England and Wales, having principal place of business at Globe House, 4 Temple Place, London, WC2R 2PG, England.

2 With registered address at C. Beersmansstraat 36, B-2018 ANTWERPEN, Belgium.

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.

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"(e) The registration of the Respondent's published mark will work to impede the natural expansion of the Opposer's use of its 'O (stylized)' trademark in the Philippines;

"(f) The registration and consequent use of the Respondent's Published Mark will result in confusion of source or reputation, which is proscribed under the IP Code and applicable precedents; and

"(g) Other provisions of the IP Code and related international agreements or conventions on the subject of intellectual property rights warrant the denial by this Honorable Office of the Respondent's trademark application."

The Opposer submitted the following evidence:

1. Original Verified Notice of Opposition / Affidavit of Opposer's Authorized Attorney Mr. Stuart Paul Aitchison;
2. List of Opposer's registrations for the "O (Device)" in various jurisdictions worldwide;
3. List of Opposer's applications for the "O (Device)" in various jurisdictions worldwide;
4. French Trademark Registration No. 1.662.492 currently protects said mark; and,
5. Original legalized and notarized Certificate and Power of Attorney signed by Stuart Paul Aitchison.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 06 January 2014. Respondent-Applicant however, did not file an answer. Thus, he is declared in default and this case is deemed submitted for decision.[4]

Should the Respondent-Applicant be allowed to register the trademark FLAME DEVICE?

It is 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 out into the market a superior 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]

The instant case is anchored on the ground that the trademark application is contrary to the provision of Sec. 123.1 (d) R.A. No. 8293, otherwise known as the Intellectual Property Code ("IP Code"), which provides:

A mark cannot be registered if it:

x x x

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

(i) The same goods or services, or
(ii) Closely related goods or services, or
(iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

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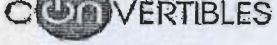
4 Order No. 2014-619 dated 12 May 2014.

5 Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 07 June 2013, the Opposer already has an existing registration for the mark 'O (stylized)' under Registration No. 4-2012-013545 issued on 14 April 2013 covering goods under class 34 for cigarettes, tobacco, tobacco products, lighters, matches, and smoker's articles.

The competing marks are hereby reproduced for comparison:

Opposer's Marks	Respondent's Mark
	
-as also incorporated in the following marks:  	

The Opposer's marks consist of or mainly of a vertical line intersecting a circle at twelve o'clock position. The mark applied for registration by the Respondent-Applicant also consists of a vertical line intersecting a circle, although the intersection is at six o'clock position. From the visual standpoint, the Respondent-Applicant's mark appear to be an inverted version of the Opposer's. In this regard, confusion is likely because the aforementioned marks are used on goods that are similar or closely related to each other, which flow on the same channels of trade and both, particularly falling under Classes 34 and 35. Thus, it is likely that the consumers will have the impression that these goods or products originate from a single source or origin. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:[6]

> 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. Hence, 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 which, in fact does not exist.

The public interest, therefore, requires that the two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that the function of 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

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

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.[7]

Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why, of the million of terms and combination of letters and designs available, the Respondent-Applicant had to 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.[8]

In contrast, Respondent-Applicant did not give sufficient explanation in adopting and using the subject trademark. The said mark is unique and highly distinctive with respect to the goods it is attached with. It is incredible for the Respondent-Applicant to have come up with the same mark practically for similar goods by pure coincidence.

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED.** Let the filewrapper of Trademark Application Serial No. 4-2013-00006640 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 01 September 2015.

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

7 Pribhdas J.Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.
8 American Wire & Cable Company v. Director of Patents, G.R. No. L-26557, 18 February 1970.