

**EMILIO BERNARDO AND JEFFREY TAN,**  
Petitioners,

**-versus-**

**EDWARD LIAO CANTOR,**  
Respondent- Registrant.

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**IPC No. 14-2013-00113**  
Petition for Cancellation:  
Registration No. 4-2005-003376  
Date Issued: 19 February 2007  
**TM: "PLANET EARTH"**

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**NOTICE OF DECISION**

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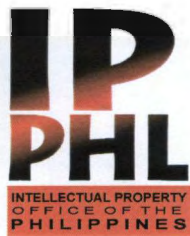
**GREETINGS:**

Please be informed that Decision No. 2016 - 143 - dated May 11, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 11, 2016.

For the Director:

**MARILYN F. RETUTAL**  
IPRS IV  
Bureau of Legal Affairs



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-versus-

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IPC No. 14-2013-00113

Petition for Cancellation  
Registration No. 4-2005-003376  
Date Issued: 19 February 2007

Trademark: **"PLANET EARTH"**  
Decision No. 2016- 143

**DECISION**

Emilio Bernardo and Jeffrey Tan<sup>1</sup> ("Petitioners") filed a petition to cancel Trademark Registration No. 4-2005-003376. The registration, issued on 19 February 2007 to Edward Liao Cantor<sup>2</sup> ("Respondent-Registrant"), covers the mark "PLANET EARTH" for the use on *"clothing, namely, shirts, pants, socks, underwear, and jacket; footwear, headgear"* all under Class 25 of the International Classification of Goods.<sup>3</sup>

The facts according to Petitioners are as follows:

"1. The trademark PLANET is owned by the Petitioner for footwear and other products under Class 25. Initially, an application for registration of the said mark was filed in this Honorable Office on 27 December 1996 under Application No. 4-1996. The same was declared Abandoned due to non-compliance of certain requirements. This, another application was filed on 28 April 2003 and was issued Certificate of Registration No. 4-2003-3810 on 19 November 2005.

2. On the other hand, the trademark PLANET EARTH was registered in the name of the Respondent under Certificate of Registration No. 4-2005-003376 on 19 February 2007 based on an application filed on 14 April 2005. The said registration covers slippers and other products under Class 25.

3. The mark PLANET EARTH of the Respondent so resembles the trademark PLANET owned by Petitioner as the word PLANET forms part of Respondent's mark-PLANET EARTH that confusion is very likely. Both registrations cover goods under Class 25. The products of the competing marks are sold in the same channels of trade, i.e. Department stores and in particular footwear section.

4. The incorporation of the word EARTH should not be a reason to rule that the mark PLANET EARTH is different from the mark PLANET specially when the goods covered by the competing marks are the same- footwear. Otherwise, a dangerous

<sup>1</sup> With address at 1556 Gen. Luna St., Paco, Manila.

<sup>2</sup> With address at 162 Northwest Ipil St., Marikina Heights, City of Marikina, Metro Manila.

<sup>3</sup> 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.

Republic of the Philippines

INTELLECTUAL PROPERTY OFFICE

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precedent will be established which can pave the way for the registration (among others):

- a) LEVI'S EARTH for clothes;
- b) MAGNOLIA EARTH for ice cream;
- c) MCDONALDS EARTH for hamburgers.

5. The registration of the mark PLANET EARTH was obtained fraudulently and contrary to law as there are many names of fish, celestial bodies, animals and other words in the dictionary where the Respondent could choose the mark for his footwear products.

6. The registration of the trademark 'PLANE EARTH' in the name of the Respondent violated Sec. 123 of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines", which provide, in part, that a mark cannot be registered if it:

x x x

7. The mark PLANET was already used in the market by the Petitioner prior to the date of filing the application that matured into the Registration subject matter of this application. Thus, the choice of the mark PLANET EARTH was conceived by Respondent to ride on the popularity if the mark PLANET owned by the Petitioner. Moreover, the Respondent has been applying for registration of marks that are identical and/or nearly resembles marks that have gained goodwill in the market. x x x."

In support of the petition, the Petitioners submitted the following:

1. affidavit of Jeffrey Tan;
2. printout of Certificate of Registration No. 4-2003-3810 from the IPOPHL website;
3. printout of Application No. 4-1996-116652 from the IPOPHL website;
4. printout of Certificate of Registration No. 4-2005-003376 from the IPOPHL website;
5. printout of alleged conflicting registrations from the IPOPHL website; and
6. copies of documents proving the use of the mark "PLANET".

For his part, the Respondent-Registrant alleges that:

"3. Respondent-Registrant is the owner of the trademark "PLANET EARTH" with Registration No. 4-2005-003376 issued February 19, 2009 for goods under Class 25 and specifically for shirts, pants, socks, underwear, jacket, footwear and headgear based on his application filed April 14, 2005. x x x

4. Prior to his trademark application filed on April 14, 2005, he had earlier filed Trademark Application No. 4-2000-03424 also for 'PLANET EARTH' last April 27, 2000. x x x

5. Respondent-Registrant had already been using the trademark "PLANET EARTH' since February 1, 1999 and had established his and the trademark's business reputation and goodwill as the manufacturer of his own various designs and brand of footwear through hard and honest work.

6. Respondent-Registrant complied with all requirements of the Intellectual Property Office for the registration of his trademark 'PLANET EARTH'.

7. During the substantive examination of the application of Respondent-Registrant, the trademark examiner issued a Registrability Report (Official Action No. 3) without the citation of any trademark as a proscription to the registration of the trademark 'PLANET EARTH' of Respondent-Registrant. x x x

8. The trademark 'Planet and Device' Registration No. 4-2003-003810 owned by the Petitioners was not cited by the trademark examiner in the Registrability Report (Official Action No. 3) as a proscription to the application of Respondent-Registrant. Hence, there is no likelihood of confusion as it is not identical nor confusingly similar with the registered mark of Petitioners.

9. There is no likelihood of confusion because the trademark registrations subject of this Petition are not identical or confusingly similar with Petitioners trademark. Petitioners' trademark registration is a composite mark for word and device and more specifically for 'the word PLANET with line written in the lower portion and a representation of a wing device' while the trademark registration of the Respondent-registrant is a word mark for 'PLANET EARTH'.

10. Determination made by the trademark examiner and the Bureau of Trademarks (BOT) regarding the registrability of marks enjoys the protective mantle of a presumption of regularity. When the law imposes certain duties and obligations it will be presumed that such duties and obligations have been performed unless it is expressly made to appear in the contrary. (Carolyn T. Lim versus Pilates, Inc. and Hon. Bureau of Trademarks)

11. Respondent filed the required Declaration of Actual Use within three (3) years from the filing date of the application and more specifically on June 22, 2005. x x x

12. The Notice of Allowance for the trademark application of Respondent-Registrant was issued December 12, 2006 and it was published in the IPO E-Gazette released last January 19, 2007. There was no Opposition by Petition by Petitioners to the application for registration. x x x

13. The Intellectual Property Philippines issued last June 25, 2007 the Notice of Issuance of Certificate of Registration for trademark 'PLANET EARTH (WORDS)' Registration No. 4-2005-003376 with Registration Date of February 19, 2007. x x x

14. Respondent-Registrant had been continuously using the trademark 'PLANET EARTH' and had complied with the filing of the 5<sup>th</sup> year Declaration of Actual

within the one year period required from the 5<sup>th</sup> year or more specifically on October 30, 2012. x x x

15. Assuming arguendo that they had any ground to oppose, petitioners had clearly slept of their right and belatedly filed this barred Petition for Cancellation AFTER SIX YEARS AND TWENTY-NINE DAYS from the registration date of Respondent-Registrant's trademark last February 19, 2007. Prescription had already barred the filing of this baseless and groundless Petition for Cancellation.

16. Section 151.1 (a) of Republic Act No. 8293 states: x x x

17. Section 231 of Republic Act No. 8293 (as amended by Section (sic) 28, Republic Act 10372) states: x x x

18. Moreover, this Petition for Cancellation was in clear disregard or (sic) contrary to the equitable principles of laches and estoppel.

19. Petitioners had desperately alleged: x x x

20. Respondent-Registrant's trademark PLANET EARTH was not obtained fraudulently and contrary to law. The trademark application went through the formal and substantive examination process, the required fees were paid and the Declaration of Actual Use were duly filed.

21. Respondent-Registrant of the trademark application PLANET EARTH may have filed trademark applications for other trademarks because such act is allowed and encouraged under the law. It is not and could (sic) never be an indicia of fraud committed by respondent-registrant. This self-serving statement is non-sequitur. Only the Bureau of Trademarks through the assigned trademark examiner can determine, decide and recommend the grant of trademark application presented to them for registration under Republic Act No. 8293.

22. Republic Act No. 8293 allows as applicant to file a trademark registration made validly in accordance with the provisions of Republic Act No. 8293 (Section 122, Republic Act 8293). Registrability is not a judicial discretion exercisable by the Respondent-Registrant. This is a judicial and substantive examination function of the Bureau of Trademarks using their expert and technical evaluation made through the assigned trademark examiner.

23. Petitioners cannot prohibit Respondent-Registrant or any other applicant or registrants from using the word 'PLANET' and/or 'PLNET' used together with a different and unique device or logo because it is not identical and confusingly similar with the 'Planet and Logo' Registration No. 4-2003-003810 of Petitioners.

24. The allowed marks listed below herein prove that the Intellectual Property Philippines in practice issue to many trademark applicants the trademark registration of the word 'PLANET' provided that it is used with another word or another device in Class 25: x x x

25. Finally, Intellectual Property Philippine already refused registration of a later filed trademark for 'PLANET EART' Application No. 4-2007-001498 filed by Earth Products, Inc. for goods under Class 25 because it was found to be clearly identical and/or confusingly similar with the registered trademark 'PLANET EARTH' of Respondent-Registrant. The trademark 'PLANET EARTH' owned by the Respondent-Registrant is very distinctive and cannot be appropriated by any person or entity much less by herein Petitioners. x x x"

The Respondent-Registrant's evidence consists of the following:

1. copy of Registration No. 4-2005-003376;
2. IPOPHL online printout pertaining to Trademark Application No. 4-2000-003424;
3. copy of the Bureau of Trademark (BOT) Registrability Report (Official Action No. 3);
4. copy of the Declaration of Actual Use (DAU);
5. copies of the Notice of Allowance and trademarks published for opposition;
6. copy of the Notice of Issuance;
7. copy of the DAU filed on 30 October 2012;
8. sales invoice and/or receipts for "PLANET EARTH" products;
9. online printout of the trademark application for "PLANET EARTH" filed by Earth Products, Inc., which was refused registration;
10. affidavit of Respondent-Registrant;
11. affidavit of Lourdes R. Makiramdam; and,
12. affidavit of Estrelita M. Lusanco.

On 27 August 2013, a Preliminary Conference was conducted where only Respondent-Registrant appeared despite due notice to Petitioners. On even date, the Preliminary Conference was terminated and the Respondent-Registrant was directed to submit his position paper within ten days therefrom. After which, the case is deemed submitted for decision.

The issue to be resolved is whether Certificate of Registration No. 4-2005-003376 should be cancelled.

Prefatorily, 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 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.<sup>4</sup>

Section 123.1 (d) of the 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:

***"(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; x x x"***

Records reveal that at the time Respondent-Applicant filed its application for registration of the contested mark on 14 April 2005, the Petitioners already have a pending application for registration of their mark "PLANET" filed on 28 April 2003. The Petitioners were eventually granted registration of their mark on 19 November 2005. Much later, on 19 February 2007, the Respondent-Registrant was also issued registration of his mark "PLANET EARTH".

For comparison, the contending marks are reproduced below:



*Petitioners' mark*



*Respondent-Registrant's mark*

Upon perusal of the depicted illustrations above, it can be observed that both marks appropriate the word "PLANET". Be as it may, the Respondent-Registrant's mark is readily distinguishable from the mark "PLANET" in view of the addition of the word "EARTH". The Petitioners' mark, on the other hand, has a wing device above the word "planet". Visually and aurally, the subject marks are individualized by their second word and/or device that the similar word "PLANET" pale in significance. They vary substantially in the composition and integration of other

<sup>4</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

main and essential features, in the general design and overall appearance. Hence, there is no confusing similarity.

Succinctly, the Supreme Court arrived at a similar decision in the case of **Great White Shark Enterprise, Inc. vs. Danilo M. Caralde, Jr.**<sup>5</sup>, where it allowed the registration of marks which both contain a "SHARK". Noteworthy, the goods covered in this case also fall under Class 25. Aptly, the Supreme Court held:

*"A trademark device is susceptible to registration if it is crafted fancifully or arbitrarily and is capable of identifying and distinguishing the goods of one manufacturer or seller from those of another. Apart from its commercial utility, the benchmark of trademark registrability is distinctiveness. Thus, a generic figure, as that of a shark in this case, if employed and designed in a distinctive manner, can be a registrable trademark device, subject to the provisions of the IP Code."*

Corollarily, Section 151.1 of the IP Code provides in part that:

*"Section 151. Cancellation. - 151.1. A petition to cancel a registration of a mark under this Act may be filed with the Bureau of Legal Affairs by any person who believes that he is or will be damaged by the registration of a mark under this Act as follows:*

*xxx*

*(b) At any time, if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of this Act, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used."*

Against this legal backdrop is a clear picture, that is, the Petitioners cannot now cause the cancellation of the Respondent-Registrant's registered mark on the ground that the same contains the word "PLANET". This is a common word which may be used in conjunction with another word or device. The Petitioners cannot

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<sup>5</sup> G.R. No. 192294, 21 November 2012.



claim exclusive use thereof as in fact, "PLANET" is a weak mark. A search on the Trademark Registry of this Office, which this Bureau takes judicial notice, would reveal that many other entities have registered marks that include the word "PLANET" likewise for Class 25. As cited in Respondent-Registrant's Answer<sup>6</sup>, the following marks are registered with the Office:


- " 24.1 Animal Planet, Registration No. 4-2002-2798  
Registration Date: April 16 2004 x x x
- 24.2 Planet Infinity and Logo, Registration No. 4-2004-009342  
Registration Date: April 28, 2006 x x x
- 24.3 Simple Shoes For A Happy Planet, Registration no. 4-2008-3151  
Registration Date: November 1, 2009 x x x
- 24.4 Planet First, Registration No. 4-2007-007386  
Registration Date: March 11, 2010 x x x
- 24.5 Planet Hollywood Globe Logo, Registration No. 4-2009-009923  
Registration Date: September 2, 2010 x x x
- 24.6 Nickolodeon Planet Sheen, Registration No. 4-2010-009246  
Registration Date: March 10, 2011 x x x
- 24.7 Animal Planet, Registration No. 4-2010-011722  
Registration Date: September 1, 2011
- 24.8 Save The Planet, Registration No. 4-2011-005434  
Registration Date: September 15, 2011 x x x
- 24.9 Planet Fitness, Registration No. 4-2012-500907  
Registration Date: November 1, 2012 x x x"

Thus, to allow the cancellation of Respondent-Registrant's mark will only create a dangerous precedent as it will pave way to future cancellation cases of long registered marks that uses the term "PLANET". In effect, it will give undue favour to Petitioners over the use of the word. As to Petitioners' allegation of fraud, the same is unsubstantiated and hence, self-serving. This Bureau cannot give weight on premises based merely on surmises and baseless assumptions.

**WHEREFORE**, premises considered, the instant petition is hereby **DISMISSED**. Let the filewrapper of Trademark Registration No. 4-2005-003376 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 11 MAY 2016

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

<sup>6</sup> See Verified Answer, p. 4.