

GINEBRA SAN MIGUEL, INC.,
Opposer,

-versus-

TANDUAY DISTILLERS, INC.,
Respondent- Applicant.

X-----X

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Opposer,

-versus-

TANDUAY DISTILLERS, INC.,
Respondent- Applicant.

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GINEBRA SAN MIGUEL, INC.,
Opposer,

-versus-

TANDUAY DISTILLERS, INC.,
Respondent- Applicant.

X-----X

IPC No. 14-2010-00190
Opposition to:
Appln. Serial No. 4-2009-011235
Date Filed: 04 November 2009
**TM: "GINEBRA
LIME & DEVICE"**

IPC No. 14-2010-00191
Opposition to:
Appln. Serial No. 4-2009-011234
Date Filed: 25 August 2009
**TM: "GINEBRA ORANGE
& DEVICE"**

IPC No. 14-2010-00251
Opposition to:
Appln. Serial No. 4-2009-011231
Date Filed: 04 November 2009
**TM: "GINEBRA
ESPECIAL & DEVICE"**

IPC No. 14-2010-00304
Opposition to:
Appln. Serial No. 4-2010-000331
Date Filed: 11 January 2010
**TM: "GINEBRA
POMELO & DEVICE"**

NOTICE OF DECISION

POBLADOR BAUTISTA & REYES

Counsel for the Opposer
5th Floor, SEDCCO I Building
120 Rada corner Legaspi Streets
Legaspi Village, Makati City

ESCAÑO SARMIENTO AND PARTNERS

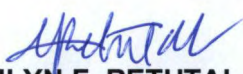
Counsel for the Respondent-Applicant
Suite 1605, The Taipan Place
F. Ortigas Jr. Road
Ortigas Center, Pasig City

GREETINGS:

Please be informed that Decision No. 2016 - 142 dated May 10, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 10, 2016.

For the Director:


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

GINEBRA SAN MIGUEL, INC.,
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IPC No. 14-2010-00190

Opposition to:
Application No. 4-2009-011235
Date Filed: 04 November 2009
Trademark: GINEBRA LIME
& DEVICE

IPC No. 14-2010-00191

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ORANGE & DEVICE

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Date Filed: 04 November 2009
Trademark: GINEBRA
ESPECIAL & DEVICE

IPC No. 14-2010-00304

Opposition to:
Application No. 4-2010-000331
Date Filed: 11 January 2010
Trademark: GINEBRA
POMELO & DEVICE

Decision 2016- 142

DECISION

GINEBRA SAN MIGUEL, INC.¹ ("Opposer") filed oppositions to the following:

- 1) Trademark Application Serial No. 4-2009-011235. The application, filed by Tanduay Distillers, Inc.² ("Respondent-Applicant"), covers the mark "GINEBRA LIME & DEVICE" for use on "spirits and liquor" under Class 33 of the International Classification of Goods and Services.³
- 2) Trademark Application Serial No. 4-2009-011234. The application, filed by Tanduay Distillers, Inc. ("Respondent-Applicant"), covers the mark "GINEBRA ORANGE & DEVICE" for use on "spirits and liquor" under Class 33 of the International Classification of Goods and Services.
- 3) Trademark Application Serial No. 4-2009-011231. The application, filed by Tanduay Distillers, Inc. ("Respondent-Applicant"), covers the mark "GINEBRA ESPECIAL & DEVICE" for use on "spirits and liquor" under Class 33 of the International Classification of Goods and Services.
- 4) Trademark Application Serial No. 4-2010-000331. The application, filed by Tanduay Distillers, Inc. ("Respondent-Applicant"), covers the mark "GINEBRA POMELO & DEVICE" for use on "spirits and liquor" under Class 33 of the International Classification of Goods and Services.

On 02 June 2011, Opposer filed a Motion for Consolidation dated 31 May 2011 praying that IPC No. 14-2010-00251 be consolidated with IPC No. 14-2010-00190, IPC No. 14-2010-00191 and IPC No. 14-2010-00304. On 21 June 2011, Respondent-Applicant filed its Opposition to Motion to Consolidate. As the said cases present common questions of law and fact, this Bureau issued Order No. 2014-532 dated 25 April 2014 granting the Motion for Consolidation.

In its opposition docketed as IPC No. 14-2010-00190, the Opposer contended essentially that the dominant feature "GINEBRA" of the subject mark GINEBRA LIME & DEVICE, is identical to the dominant feature of Opposer's trade name "GINEBRA SAN MIGUEL, INC.", its duly registered trademarks and pending applications bearing the word "GINEBRA". The salient portions of the opposition substantiating are stated below, viz. :

- "i. Opposer GSMI is the owner, by prior adoption and actual use as well as by prior registration, of the mark 'GINEBRA.'

"GSMI has used the trade and business name 'Ginebra San Miguel, Inc.' since March 2003. By virtue of such prior use in commerce since March

¹A domestic corporation with principal address at 40 San Miguel Complex Building, Mandaluyong City.

²A domestic corporation with principal address at 348 J. Nepomuceno Street, San Miguel District, Manila.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

2003 - or more than 7 years - GSMI is entitled to the protection of its trade name, 'Ginebra San Miguel, Inc.'⁴

"Opposer GSMI is the owner by prior registration of the mark 'GINEBRA' and related or derivative marks. As discussed in paragraphs 17 to 17.4 above, GSMI has prior registrations and applications for registration thereof, both here and abroad.⁵

"More importantly, GSMI is the owner by prior adoption and prior actual, persistent and uninterrupted use of the mark 'GINEBRA' and related or derivative marks. As demonstrated in paragraphs 3 et seq. above, GSMI and its predecessor-companies have extensively, consistently, and continuously used the mark 'GINEBRA' as the dominant feature of its trademarks, in connection with its manufacture, distribution, marketing, and sale of gin products throughout the Philippines since 1834 (or for more than 176 years).⁶

- "ii. The mark 'GINEBRA' has become distinctive and has acquired a secondary meaning in reference to GSMI's gin products.

"GSMI's (and its predecessors') use of the 'GINEBRA' mark for over a century, in a consistent and substantially-exclusive manner, has made the same distinctive and has imbued the same with a 'secondary meaning,' i.e., the 'GINEBRA' mark has been and already is associated solely with GSMI's 'GINEBRA' gin products. The 'GINEBRA' mark already has a proprietary connotation, which means that it is GSMI which is perceived by the consuming public to own any and all 'GINEBRA' products in the market.⁷

- "iii. The registration of Respondent-Applicant's GINEBRA LIME & DEVICE mark, the dominant feature of which ('GINEBRA') is identical to GSMI's 'GINEBRA' mark, will cause confusion among the relevant consuming public.

"The registration of TDI's 'GINEBRA LIME & DEVICE' mark, as well as the use thereof in commerce, will confuse and deceive the relevant consuming public (who have come to associate the 'GINEBRA' mark with GSMI's products) that TDI's goods are those of GSMI's...⁸

"All told, GSMI's trademarks dominantly feature the word 'GINEBRA' and GSMI is entitled to protection of its property rights thereto. TDI's trademark, 'GINEBRA LIME & DEVICE,' unlawfully appropriates GSMI's 'GINEBRA' mark and will likely mislead the public into believing that the gin on which it is used is manufactured and sold by the GSMI. The registration of TDI's 'GINEBRA LIME & DEVICE' mark is therefore proscribed for being infringing of GSMI's marks and for being prohibited under Section 123.1 (d) of the IP Code.⁹

⁴ Par. 20 of the Verified Opposition.

⁵ Par. 24 of the Verified Opposition.

⁶ Par. 25 of the Verified Opposition.

⁷ Par. 35 of the Verified Opposition.

⁸ Par. 40 of the Verified Opposition.

⁹ Par. 47 of the Verified Opposition.

- "iv. The registration of Respondent-Applicant's GINEBRA LIME & DEVICE mark will cause damage to the goodwill built by GSMI upon its 'GINEBRA' mark.

"Through its prior and extensive use and promotion of the 'GINEBRA' mark, GSMI has already generated tremendous goodwill for the same. Through the efforts of GSMI and its predecessors, the 'GINEBRA' mark has come to be distinctive of GSMI in the class of spirits and liquor. The mark 'GINEBRA' has already attained the status of an iconic brand...¹⁰

"GSMI's goodwill over the 'GINEBRA' mark is tremendous and undeniable. Goodwill of this quality is surely not built overnight. Its destruction, however, stems from the tiniest crack: a competitor's unauthorized use of the mark upon which the goodwill is founded. This Honorable Office should not let this happen and should reject the subject application.¹¹

The Opposer's evidence consists of a copy of GSMI's Articles of Incorporation; the Affidavit of Josephine A. Caldo, Product Manager of GSMI; photographs of GSMI's gin products and merchandising goods; a compact disc compilation of GSMI's radio and television advertisements and jingles written and performed by Gary Granada in 2007; reports and photographs of GSMI's sponsored contests; copy of the Project Ocelot Nationwide Liquor Retail Trade Audit summary; the Affidavit of Ramon M. Cruz, Senior Product Manager of GSMI from 1997 until 2000; evidence/s showing use of GINEBRA product labels and trademarks; the Affidavit of Avelino "Samboy" Lim, Jr., then Team Manager of "Barangay Ginebra Kings" in the Philippine Basketball Association; pictures and samples of team merchandise like replica game jerseys, practice jerseys and championship shirts, etc; copies of sample newspaper, magazines and PBA annual write-ups; the Affidavit of Mercedes R. Abad, then Managing Director of TNS TRENDS; copy of Ms. Abad's resume; copies of the questionnaires given in tested areas; copy of the final report analyzing the data tabulated from all the accomplished questionnaires; a copy of the final report for Project Georgia; the Affidavit of Ma. Elizabeth Gustilo, President and Chief Executive Officer of Lowe, Inc.; CD and DVD compilations of GSMI's advertisements; the Affidavit of Mary Joy L. Dicen, Docket Assistant at the Office of the General Counsel of GSMI; copy of Certificate of Registration No. R-1388-A for the trademark "GINEBRA SAN MIGUEL BOTTLE" first issued on 13 October 1973; copy of Certificate of Registration No. C-143 for the trademark "GINEBRA SAN MIGUEL (gin) 250 ml. Container" issued on 23 February 1996; copy of Certificate of Registration No. 4-199-00968 for the trademark "BARANGAY GINEBRA (LABEL)" issued on 30 May 2003; copy of Certificate of Registration No. 001389 for the trademark "GINEBRA SAN MIGUEL" bottle issued on 13 October 1993; copy of Certificate of Registration No. C-114 for the trademark "GINEBRA SAN MIGUEL CONTAINER" issued on 20 May 1988; copy of Certificate of Registration No. 4-1981-000115 for the trademark "GINEBRA SAN MIGUEL" issued on

¹⁰Paragraph 49 of the Verified Opposition.

¹¹Paragraph 55 of the Verified Opposition.

16 April 2004; copy of Certificate of Registration No. 4-1995-127907 for the trademark "BOTTLE DESIGN OF GINEBRA SAN MIGUEL FRASCO" issued on 18 February 2006; copies of pending Philippine applications in the name of GSMI; copies of foreign trademark registrations in the name of GSMI; copies of pending foreign applications in the name of LTDI; copies of foreign applications in the name of GSMI; the Affidavit of Mr. Joaquin "Chito" Loyzaga, Assistant Team Manager of the "GINEBRA SAN MIGUEL" team and Manager of the said team, 1997-1998.¹²

The contents of the opposition and the pieces of evidence presented by the Opposer in IPC No. 14-2010-00190 are substantially the same as in IPC No. 14-2010-00191, IPC No. 14-2010-00251 and IPC No. 14-2010-00304.

In its Answer in IPC No. 14-2010-00190, the Respondent-Applicant avers the following:

x x x

"DISCUSSION

"5.1 Section 121.3 of Republic Act NO. 8293, or the Intellectual Property Code of the Philippines ('IP Code'), defines a trade name as 'the name or designation identifying or distinguishing an enterprise.'

"5.2 It appears from the Opposition's Annex 'A' that the name 'Ginebra San Miguel, Inc.' is the Opposer's corporate name. The Securities and Exchange Commission approved the use of the name 'Ginebra San Miguel, Inc.' in order to identify the Opposer's distinct corporate entity.

"5.2.1 As stated in the Verified Opposition, it appears that Opposer changed its corporate name only in 2003, roughly during the same time Opposer started to initiate various actions against TDI for using the term 'Ginebra' in its mark 'Ginebra Kapitan.'

"5.3 The American Heritage Dictionary of the English Language defines the term 'Ginebra' as:

"A strong colorless alcoholic beverage made by distilling or redistilling rye or other grain spirits and adding juniper berries or aromatics such as anise, caraway, seeds, or angelica root as flavoring.'

"5.4 The term 'Ginebra' is designated to represent all strong colorless alcoholic beverages made from distilling or redistilling rye or other grain spirits and by adding juniper berries or other aromatics. The term is applicable and can be used on all products that fall under its general description. The usage of the term, 'Ginebra' is generic in nature, as it does not exclude any product falling under its definition from using the term to refer to it.

¹²Marked as Exhibits "A" and "HH", inclusive.

"5.5 A generic term cannot be considered as a dominant feature of a trademark or trade name, as a generic term is available for use by any party in referring to their goods, products and line of business. In a composite mark bearing the generic terms, the dominant portions are the distinct composite components thereof. In the case of Asia Brewery, Inc. vs. Court of Appeals, the Supreme Court held that the generic portion of a trademark is not its dominant part, to wit:

"What are the dominant features of the competing trademarks between Us?

"There is hardly any dispute that the dominant feature of SMC's trademark is the name of the product: SAN MIGUEL PALE PILSEN, written in white Gothic letters with elaborate serifs at the beginning and end of the letters 'S' and 'M' on an amber background across the upper portion of the rectangular design.

"On the other hand, the dominant feature of ABI's trademark is the name: BEER PALE PILSEN, with the word 'Beer' written in large number letters, larger than any of the letters found in the SMC label.

"The trial court perceptively observed that the word 'BEER' does not appear in SMC's trademark, just as the words 'SAN MIGUEL' do not appear in ABI's trademark. Hence, there is absolutely no similarity in the dominant feature of both trademarks.

"5.6 In the above-cited case, the Supreme Court compared the dominant portions of the trademarks and the Court excluded in the comparison that portion which refers to the goods. The dominant feature of trademarks is that portion of the composite mark which is not the generic name of the item.

x x x

"6.1 Section 123.1 of the IP Code provides that signs and symbols that are generic for the goods and services it represents cannot be the subject of a trademark:

x x x

"6.2 The cited Section limits the use of generic mark in the law on trademarks, as a generic mark cannot be exclusively used by one party to represent particular goods as the said mark is used to refer to the entire class of the particular goods. International jurisprudence confirms that 'The name of a product itself - what it is - is the very antithesis of a mark.'

"6.3 In a long line of cases, the Supreme Court has constantly affirmed the rule that generic words cannot be exclusively appropriated.

"6.3.1 In *Masso Hermanos v. Director of Patents*, the Supreme Court ruled that shoe dealer cannot register the generic words 'leather shoes' as 'it would be unjust to deprive other dealers in leather shoes of the right to use the same words with reference to their merchandise.'

"6.3.2 In *Ong Ai Gui v. Director of Patents*, the Supreme Court explicitly held that the use of a generic term as part of a trademark is always conditional and subject to the limitation that the registrant does not acquire the exclusive right to the generic term. Generic words like 'nylon' is a generic term that cannot be appropriated for exclusive use by anyone and because of its nature, such words can never acquire secondary meaning. The Court further added that no length of use and no amount of advertising will make a generic word distinctive.

"6.3.3 *Asia Brewery, Inc. vs. Court of Appeals* reiterated that words that form part of the public domain are incapable of being exclusively appropriated:

x x x

"6.3.4 The Supreme Court held, in the case of *Societe Des Produits Nestle SA v. Court of Appeals*, citing *Federal Unfair Competition: Lanham Act S. 43 (a)*, that:

x x x

"6.4 Considering that the term 'Ginebra' is a generic term, no party may use the term to the exclusion of others.

"6.5 While generic words may form part of a composite mark, the law prescribes that the generic component of a composite mark must be disclaimed pursuant to Rule 608 of the Trademark Regulations:

x x x

"6.6 It must be noted that Opposer disclaimed the exclusive use of the term 'Ginebra' in the following trademarks, to wit:

"a. The mark 'Ginebra San Miguel, Inc.' under Trademark Regulation No. 7484, whose disclaimer reads, 'The word 'Ginebra' is disclaimed apart from the mark as shown.'

"b. The mark 'Ginebra San Miguel' under Trademark Registration No. 42568, whose disclaimer reads, 'Applicant disclaimed the word 'Ginebra' apart from the mark as shown.'

"c. The mark 'Ginebra S. Miguel 65' under Trademark Registration No. 113597, whose disclaimer reads 'The word 'Ginebra 65' is disclaimed.'

"d. The mark 'La Tondena Cliq! Ginebra Mix & Stylized Letters Ltd. with Crown Device' under Trademark Registration No. 4-1996-113597" whose registration disclaims the terms 'Ginebra Mix.'

"6.7 While the Opposition states that Opposer claims the term 'Ginebra' as its own mark, Opposer recognizes that its composite marks have a component that is not capable of exclusive appropriation.

x x x

"6.8 Opposer tried to seek exclusive use of the term 'Ginebra' when it filed Trademark Application No. 4-2003-001682 for the mark 'Ginebra.' The attempts of the Opposer failed when the Bureau of Trademarks denied the registration of the mentioned trademark application.

"6.9 Opposer appealed the denial of the Bureau of Trademarks to the Office of the Director General. On 07 December 2009, the Office of the Director General issued a Decision in Appeal No. 04-09-01, dismissing the appeal filed by Opposer. The said Decision holds:

x x x

"6.10 Opposer again appealed this denial to the Court of Appeals. On 13 August 2010, the Court of Appeals promulgated a Decision, in C.A. G.R. SP No. 112005, dismissing the Petition for Review. The Court of Appeals held:

x x x

"6.11 While Opposer is still pursuing its appellate remedies for its trademark application, there seems to be no question that the Intellectual Property Office and the appellate courts recognize the doctrine that generic terms are not capable of exclusive appropriation. The proposition that prior adoption and prior actual, persistent use of a generic term ripens to ownership over the same does not have any merit or legal support and basis.

x x x

"6.13 A generic term cannot be exclusively appropriated merely because Opposer advances the argument that the public currently associates the term with its products. A limitation of the right to use a name available to all merely because of a current circumstance of prevalent use severely places undue restrictions on the public. Following the Opposer's argument, the public shall not be allowed to recognize and assimilate the use of foreign words to refer to their products of services merely because of a business entity's prior use and huge advertising budget. The internationally applied doctrine of foreign equivalents allows the public the freedom to call their products by its name, albeit a different language.

"7.1 In *Ang v. Teodoro*, the doctrine of secondary meaning is explained as 'a word or phrase originally incapable of exclusive appropriation with reference to an article on the market, because of geographically or otherwise descriptive, might nevertheless have been so long and so exclusively used by one producer with reference to his article that, in trade and to that branch of the'

"7.2 Succinctly put, a generic term is not susceptible of secondary meaning.

"7.3 The IP Code allows the application of the doctrine of secondary meaning pertains only to words disclaimed for being descriptive and not generic terms. McCarthy notes:

x x x

"7.4 Professor Rudolph Callman opines that, 'only descriptive marks can be made registrable or protectable by secondary meaning, generic marks cannot.' McCarthy adds, 'A rule of thumb sometimes forwarded as distinguishing a generic name from a descriptive term is that generic names are nouns and descriptive terms are adjectives.'

"7.5 The term 'Ginebra' is a noun as it is a 'word that is the name of a person, place, thing, quality, idea or action.' It is used to identify the genus of the product or service. It cannot be used to identify the qualities of the product itself. Any product coming from another supplier still falls under the generic term. The generic term cannot be a descriptive term as the generic term refers to the thing itself, and not to the specific qualities of the thing.

"7.6 The Office of the Director General, in its previously cited Decision in Appeal No. 04-09-01, shares the view that the term 'Ginebra' is incapable of secondary meaning:

x x x

"7.7 A finding that the term 'Ginebra' is generic in nature renders irrelevant and immaterial all arguments pertinent to the doctrine of secondary meaning:

x x x

"7.9 Opposer seems to have focused its advertising and marketing campaigns on the term, 'Ginebra.' While it seems that Opposer has invested a substantial amount in advertising its products, the offered evidence as contained in the Opposition is not a showing that the term 'Ginebra' points to and is exclusively identified with GSKI's product:

x x x

"7.12 Lastly, an examination of the Opposer's offered surveys is not indicative of any conclusion to the effect that the term 'Ginebra' is exclusively associated with the Opposer and that its products are well-known. 'Surveys Project Bookman' and 'Project Georgia' were conducted in the years 2003 and 2005 respectively and were only composed of three hundred (300) survey participants. Such sample size is too inconsequential for Opposer to draw its offered conclusions.

"8.1 An examination of the Subject Mark reveals that there is no possibility that the use of the mark shall cause confusion to the relevant consuming public. The Subject Mark consists of a device of a knight's helmet and a coat of arms under it, placed inside an oblong flourished with four (4) swirly lines on its left and right sides. The device is placed above word 'GINEBRA' followed by the word 'POMELO' below it. The products bearing the Subject Mark and other similar marks from TDI are also shown in different colors in order to distinguish one flavor from another. There is no mark that enjoys a prior application or registration date that resembles the Subject Mark.

"8.2 Opposer's marks consist mainly of a label that features an angel with a sword about to strike another angel on the ground. The image occupies most of the label, while the mark 'Ginebra San Miguel' is placed on top of the image using a smaller font.

"8.3 As previously discussed, the dominant terms of the Subject Mark and that of the Opposer's is not the term 'Ginebra' as the said term is generic in nature. The dominant feature of trademarks is that portion of the composite mark, which is not the generic name of the item. The distinct composite terms of both the

Subject Mark and that of the Opposer's marks share no common, identical or similar element.

"8.4 Considering that the dominant terms are distinct in every way, there can no issue in the incorporation of the term 'Ginebra' in the Subject Mark. No party may monopolize the use of a generic term. Any producer of gin alcoholic beverages has the right to refer to their products as gin. Callman added:

x x x

"8.5 In a similar case brought on by makers of the drink 'Coca-Cola' for infringement against the manufacturers of the product 'Pepsi Cola.' The Canadian Court, in holding that there was no ground for the charge of infringement, wrote:

x x x

"9.1 Opposer does not stand to suffer any damage in TDI's registration of the Subject Mark as the dominant portion of the Subject Mark is distinct from any of the Opposer's marks.

"9.2 There can be no damage, as envisioned by the IP Code, when there is no source of confusion. The distinctiveness of the Subject Mark to that of the Opposer's belies any claim that the public would not be placed in a situation where they would be duped into buying a product they do not want.

"9.3 The presence in the market of TDI's products, including those bearing the Subject Mark, provides more options to the average consumer. The buying public is given the power of choice. Opposer's position that it owns something that is available to all has the chilling effect of creating a monopoly on something the public has access to. This is not what the IP Code envisions, as trademark laws were never intended to create and abet monopolies. McCarthy wrote:

x x x

"9.4 The damage Opposer refers is, ultimately, a decrease in its market share, not because of public confusion, but because of market competition:

x x x

"9.5 TDI strongly objects and disagrees with any claim that it is seeking a 'free ride.' TDI does not seek to ride on the coattails of the Opposer. TDI has a long and impressive history and the company is known for presenting high quality products to the Philippine market. In all its years of existence, TDI never sought nor does it seek to present its products as that of Opposer's as TDI has its own distinct reputation to protect.

The Respondent-Applicant's evidence consists of a Decision promulgated on 07 December 2009 by the Office of the Director General in Appeal No. 04-09-01; and a copy of the Decision promulgated on 13 August 2010 by the Court of Appeals in C.A. G.R. SP No. 112005.¹³

¹³Marked as Annexes "1" and "2".

This Bureau noted that the facts cited and the arguments posed in the Answer and the pieces of evidence presented by the Respondent-Applicant in IPC No. 14-2010-00190 are substantially the same in IPC No. 14-2010-00191, IPC No. 14-2010-00251 and IPC No. 14-2010-00304.

Should the Respondent-Applicant be allowed to register the trademarks GINEBRA LIME & DEVICE, GINEBRA ORANGE & DEVICE, GINEBRA ESPECIAL & DEVICE and GINEBRA POMELO & DEVICE?

The Opposer anchors its opposition on Sections 123.1, paragraph (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

Sec. 123. Registrability. – 123.1. 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;"

Records show that at the time the Respondent-Applicant filed trademark applications for GINEBRA LIME & DEVICE, GINEBRA ORANGE & DEVICE, GINEBRA ESPECIAL & DEVICE and GINEBRA POMELO & DEVICE in 2009 and 2010, the Opposer already has existing trademark registrations and pending applications for GINEBRA in the name of GSMI and LDTI. The registration covers "gin" under Class 33. This Bureau noticed that the products indicated in the Respondent-Applicant's trademark applications, i.e. spirits and liquor under Class 33, are similar to the Opposer's.

A comparison of the competing marks reproduced below:



Opposer's trademarks

A handwritten signature in blue ink, located in the bottom right corner of the page.



Respondent-Applicant's marks

shows that both Opposer's and Respondent-Applicants marks contain the word GINEBRA. Ginebra, as word, however, is generic or descriptive as it refers to a gin, a colorless alcoholic beverage made from distilled or redistilled neutral grain spirits flavored with juniper berries and aromatics (as anise and caraway seeds).¹⁴ If generic or descriptive, no one has exclusive right over the word GINEBRA. In an appeal filed by La Tondena Distillers, Inc. against the Director of Bureau of Trademarks where the Director sustained the final rejection of the Appellant's Trademark Application No. 4-2003-0001682 for the registration of the mark "GINEBRA" for use on gin products, the Director General resolved, to wit:

"There is no principle more firmly settled in the law of trademarks, than that words or phrases which have been in common use and which indicate the character, kind, quality and composition of the thing, may not be appropriated by anyone to his exclusive use. In the exclusive use of them the law will not protect. The reason for this is because generic words are considered to be in the public domain and free for all to use. To allow an individual or an entity to register a generic term would give the registrant the exclusive right to use the generic term to the prejudice of others who are engaged in producing or manufacturing a similar class of products and who are using the same generic words in their similar trade or services."¹⁵

La Tondena Distillers, Inc. then filed a petition for review of this Decision of the Director General dated December 7, 2009 docketed as CA-G.R. SP No. 112005. The Court of Appeals affirmed the said assailed Decision rendered by the IPO Director General and explained, to wit:

"Corollary thereto, petitioner's claim that the 'GINEBRA' mark is not solely generic but also descriptive which may acquire secondary meaning in accordance with the provisions of Section 123.1(j) in relation to Section 123.1 of R.A. No. 8293 since it designates the kind of goods manufactured is untenable. Its contention that 'GINEBRA' is not a direct Spanish counterpart of the English

¹⁴Merriam-Webster definition of gin.

¹⁵Appeal No. 04-09-91.

word 'gin' but rather, the Spanish equivalent of 'genever' or 'jenever,' the juniper berry-flavored grain spirit which originated in the Netherlands in the 17th century, hence, considered a 'kind of gin,' compared to 'gin' which may refer to any kind of alcoholic spirits, does not change the fact that 'ginebra' and 'gin' refer to the same object. Hence, being exclusively generic, the doctrine of secondary meaning which states that 'a word or phrase originally incapable of exclusive appropriation with reference to an article in the market (because it is geographically or otherwise descriptive) might nevertheless have been used for so long and so exclusively by one producer with reference to his article that, in the trade and to that branch of the purchasing public, the word or phrase has come to mean that the article was his property,' finds no applicability. Besides, for the doctrine to apply, the use of the mark must have been exclusive which is not the case here. Records reveal that other manufacturers of gin and other alcoholic beverages like Tanduay Distillers, Inc., Twin Ace Holding Corporation, Consolidated Distillers of the Far East, Inc. and Webengton Distillery (Philippines) Inc. had similarly used the mark 'GINEBRA' as part of the composite marks for their products. Hence, even assuming that the word 'GINEBRA' is not exclusively generic, its lack of exclusivity in use has prevented it from becoming distinctive or acquiring a secondary meaning to bar others from using the same mark in their gin or alcoholic beverage products..."

In Opposer's mark, the word GINEBRA accompanies the words SAN MIGUEL. Likewise, Respondent-Applicant's marks POMELO & DEVICE, ORANGE & DEVICE, ESPECIAL & DEVICE and LIME & DEVICE for use on its spirits and liquor contain the word GINEBRA. The distinctive feature of the Opposer's mark and of Respondent-Applicant's is not the word GINEBRA but the words accompanying GINEBRA such as SAN MIGUEL, POMELO & DEVICE, ORANGE & DEVICE, ESPECIAL & DEVICE and LIME & DEVICE. Also, Respondent-Applicant's mark used a device described as "a knight's helmet and a coat of arms under it, placed inside an oblong flourished with four (4) swirly lines on its left and right sides" above the word "Ginebra" followed by the word "lime" to distinguish itself from others using the word GINEBRA on their gin products.

The Office of the Director General is consistent when in Appeal No. 14-09-28 entitled "Ginebra San Miguel, Inc. vs. Tanduay Distillers, Inc.", it affirmed the Decision of the Director of Legal Affairs in IPC No. 14-2007-00196 and held that "GINEBRA" being generic is not subject to exclusive appropriation. As discussed by the Director General:

"Thus, even if the Appellant has been using GINEBRA for a long period of time in its business activities, this will not amount to the Appellant's exclusive right to use GINEBRA. Otherwise, this would prejudice other persons who are also engaged in producing or manufacturing a similar class of gin products and who are using the same generic term in their trade or services. GINEBRA is a generic term that cannot be exclusively used by anyone. Generic terms are those which

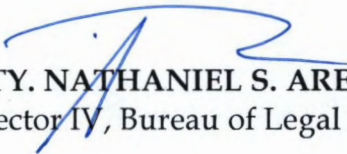
constitute the common descriptive name of an article or substance, or compromise the genus of which the particular product is a specie or are commonly used as the name or description of a kind of goods, or imply inference to every member of a genus and the exclusion of individuating characters, and are not legally protectable."

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.¹⁶ This Bureau finds that the Respondent-Applicant's marks sufficiently serve this function.

WHEREFORE, premises considered, the instant Oppositions are hereby DISMISSED. Let the filewrappers of Trademark Application Nos. 4-2009-011235, 4-2009-011234, 4-2009-011231 and 4-2010-000331 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 10 MAY 2016



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

¹⁶Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.