PHELPS DODGE PHILIPPINE ENERGY PRODUCTS CORPORATION,	}	**IPC No. 14-2014-00090**
Opposer,	}	Opposition to:
	}	Appln. Serial No. 4-2013-00011362
	}	Date Filed: 20 September 2013
-versus-	}	**TM: "PDX"**
	}	
	}	
	}	
ADVANCE BRANDS, INC.,	}	
Respondent- Applicant.	}	
x----------x		

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 243 dated July 12, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 12, 2016.

For the Director:

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

PHELPS DODGE PHILIPPINE ENERGY PRODUCTS CORPORATION,
Opposer,

-versus-

ADVANCE BRANDS, INC.,
Respondent-Applicant.
x ---------- x

IPC No. 14-2014-00090

Opposition to Trademark
Appln. No. 4-2013-00011362
Date Filed: 20 September 2013

Trademark: "**PDX**"

Decision No. 2016-243

DECISION

Phelps Dodge Philippine Energy Products Corporation[1] ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-011362. The contested application, filed by Advance Brands, Inc.[2] ("Respondent-Applicant"), covers the mark "PDX" for use on *"non-electric wires and cables"* and *"electric wires and cables"* under Classes 06 and 09, respectively, of the International Classification of Goods[3].

According to the Opposer, Phelps Dodge Philippines, Inc. ("PDPI") applied for registration of "PERMALITE NMPDX", which was eventually allowed registration on 31 December 2005 under Certificate of Registration No. 4-1999-005249. The said certificate was, however, removed from the register for the failure to submit a Declaration of Actual Use ("DAU") within three years from registration. On 10 January 20012, General Cable Technologies Corporation ("General Cable"), an affiliate of PDPI, again filed an application for the same mark, which was issued registration on 31 May 2012 under Certificate of Registration No. 4-2012-00395. Then on 24 June 2013, the Opposer, an affiliate of both PDPI and General Cable, filed an application for the mark NMPDX" after securing authorization from General Cable, which is the registered owner of "PERMALITE NMPDX".

The Opposer thus contends that the Respondent-Applicants mark "PDX" is confusingly similar to its applied mark "NMPDX". It asserts likelihood of confusion is heightened since the applied mark is being registered under Class 09, which is exactly the same class it applied for its mark "NMPDX". As to the Respondent-Applicant's goods under Class 06, the Opposer contends that the same are also related to its products. It explains that the goods, whether under Class 06 or 09,

[1]A domestic corporation with address at 2nd Floor BCS Buiding, 2297, Pasong Tamo Extension, Makati City.
[2]A domestic corporation with address at P.O. Box 3985, 1097, Metro Manila.
[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.

both involve wires and cables. In support of its Opposition, the Opposer submitted the following:[4]

1. copy of Certificate of Registration No. 4-1999-005249;
2. copy of Certificate of Registration No. 4-2012-000395;
3. copy of the trademark application for NMPDX; and
4. copy of the letter of General Cable authorizing the Opposer to register the mark "NMPDX"

A Notice to Answer was issued and served upon the Respondent-Applicant on 14 May 2014. The latter, however, did not file its Answer. Thus, the Hearing Officer issued Order No. 2014-1265 declaring the Respondent-Applicant in default. It filed an Urgent Motion to Lift Order of Default but the same was denied. Hence, the case is now deemed submitted for resolution.

The issue to be resolved is whether the Respondent-Applicant's mark "PDX" should be allowed.

Perusing the Opposer's tradename and the Respondent-Applicant's mark "PD", it appears that the applied mark is merely an abbreviation of "PHELPS DODGE". Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. 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 purchased as to cause him to purchase the one supposing it to be the other.[5] Thus, it is likely that consumers will be confused or have the wrong impression that the contending marks and/or the parties are connected or associated with one another. This is especially because the contending parties are engaged in the business of wires and cables.

The issue to be resolved is whether the Respondent-Applicant's mark "PDX" should be allowed registration.

Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that:

"123.1. 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

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[4] Marked as Exhibits "A" to "D".
[5] Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

(iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

Records reveal that the Opposer filed an application for the mark "NMPDX' on 24 June 2013. The Respondent-Applicant filed the questioned application for the mark "PDX" on 20 September 2013.

But, are the marks, as reproduced hereafter, confusingly similar?

NMPDX **PDX**

Opposer's mark *Respondent-Applicant's mark*

A perusal of the marks will readily show that they are almost identical and hence, confusingly similar. The Respondent-Applicant merely omitted the first two letters of the Opposer's mark. Just the same, the marks are visually and phonetically similar such that it is impossible not to remember or associate the trademark "NMPDX" when one encounters the Respondent-Applicant's mark "PDX". After all, confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. 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.[6]

Moreover, it is noteworthy that Respondent-Applicant's mark "PDX" are also being sought to be registered for electric wires and cables, which are the same goods which the Opposer uses or intends to use its mark "NMPDX". Thus, it is highly likely that the consumers will be lead to believe that Respondent-Applicant's services is allied to or sponsored by the Opposer. Time and again, it has been held in our jurisdiction that the law does not require that the competing trademarks must be so identical as to produce actual error or mistake. It would be sufficient, for the purposes of the law that similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the new brand

[6] Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

for it.[7] Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.[8]

Succinctly, 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."[9]

Finally, 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.[10] Based on the above discussion, Respondent-Applicant's trademark fell short in meeting this function. The latter was given ample opportunity to defend its trademark application but Respondent-Applicant failed to do so.

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-011362 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 12 JUL 2016

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

[7] American Wire & Cable Co. vs. Director of Patents, G.R. No. L-26557, 18 February 1970.
[8] Philips Export B.V. vs. Court of Appeals, G.R. No. 96161, 21 February 1992.
[9] Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.
[10] Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.