

LE COMITE INTERPROFESSIONEL DU
VIN DE CHAMPAGNE,
Opposer,

-versus-

LOUIS MARIE JOSEPH THEVENIN,
Respondent- Applicant.

X-----X

IPC No.14-2013-00350

Opposition to:

Appln. Serial No. 4-2012-008187

Date Filed: 06 July 2012

TM: "SHANPELINO"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 273 dated August 03, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 03, 2016.


ATTY. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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Trademark: **"SHANPELINO"**

Decision No. 2016- 273

DECISION

Le Comité Interprofessionel Du Vin De Champagne¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-008187. The contested application, filed by Louis Marie Joseph Thevenin², ("Respondent-Applicant") covers the mark "SHANPELINO" for the use on "*cider, wine, spirit*" all under Class 33 of the International Classification of Goods.³

The Opposer anchors its opposition on Sections 123.1 (a) and (g) and 165.2 (a) and (b) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") and Articles 22 and 23 of the World Trade Organization Trade-Related Aspects of Intellectual Property Rights Agreement ("TRIPS Agreement"). It is a public service body with legal personality having various public authority prerogatives. It was established by the 12 April 1941 Act of the French Parliament. It alleges, among others, that membership is compulsory to all parties engaged in the production, process and trade of products sold as "CHAMPAGNE". One of its main objectives is the protection and development of "CHAMPAGNE" market in general. Pursuant to this, it is entitled to investigate and verify that products sold as "CHAMPAGNE" worldwide have been wholly produced in Champagne in accordance with relevant legislations. "CHAMPAGNE" is produced within the strictly defined territory and conforms to the strict methods prescribed by the French Law and Community Regulations. The "CHAMPAGNE" production zone is defined and delimited by the law of 22nd of July 1927.

According to the Opposer, "CHAMPAGNE" is protected as a controlled appellation of origin worldwide. The use of the name "CHAMPAGNE" is strictly regulated by national laws and international conventions and is registered and/or

¹ A trade organization and public service body established by an Act of the French Parliament (Act of 12 April 1941), with principal address at 5, rue Henry Martin, 51204, Epernay Cedex, France.

² A Filipino with address at 371 Gorordo Ave., Cebu City 6000.

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.

applied as a geographical indication in some jurisdictions. It asserts that the mark "SHANPELINO" is confusingly similar to "CHAMPAGNE" as the former imitates the distinctive and valuable name of the latter for the same goods, which are sold in bottle shape configuration which is characteristic of products sold as "CHAMPAGNE". It thus contends that the registration and use of "SHANPELINO" by the Respondent-Applicant falsely suggests a connection to its company and misleads the public as to the quality, characteristics and geographic origin of the goods. Also, it asserts that "SHANPELINO" is confusingly similar with its tradename "CHAMPAGNE". In support of its opposition, the Opposer submitted the affidavit of its authorized attorney, Jean-Luc Barbier, with annexes, and copies of its registration certificate issued in India, Indonesia, Malaysia, African countries, Panama, Dominican Republic and Thailand.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 13 January 2014. The latter, however, did not file an Answer. Thus, the Hearing Officer issued Order No. 2014-505 on 22 April 2014 declaring the Respondent-Applicant in default and the case submitted for decision. On 30 May 2014, the Respondent-Applicant filed a Motion for Reconsideration/Motion to Lift Declaration of Default and to Admit Answer Already in the Case Records (Under Oath). However, the said motion was denied.

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

Records show that the Respondent-Applicant filed an application for the mark "SHANPELINO" on 06 July 2012. The Opposer, on the other hand, has no pending application and/or registration of the mark "CHAMPAGNE" in this Office. Regardless of this fact, the Opposer is still a proper party of the opposition proceedings in view of the provisions of Section 165.2 of the IP Code, which provides:

"165.2.(a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful."(Emphasis supplied.)

The Opposer, therefore, has interest that may be damaged by the filing of the contested mark, if found confusingly similar, as the public may likely be confused or mislead that the Respondent-Registrant's goods is in any way connected to it. Prior registration of the trade name is not a prerequisite for its protection. This is further

⁴ Marked as Exhibits "C" to "X".

explained by the Supreme Court, in the case of **Coffee Partners, Inc. vs. San Francisco Coffee and Roastery, Inc.**⁵, as follows:

"In Philips Export B.V. v. Court of Appeals, this Court held that a corporation has an exclusive right to the use of its name. The right proceeds from the theory that it is a fraud on the corporation which has acquired a right to that name and perhaps carried on its business thereunder, that another should attempt to use the same name, or the same name with a slight variation in such a way as to induce persons to deal with it in the belief that they are dealing with the corporation which has given a reputation to the name."

But is the Opposer's tradename "CHAMPAGNE" confusingly similar with the Respondent-Applicant's mark "SHANPELINO"? It is manifest that the two marks are distinct and distinguishable from each other. They obviously differ in spelling, pronunciation and connotation. The Respondent-Applicant's mark does not appropriate the word "CHAMPAGNE" or even a syllable thereof. Hence, there is no basis for the Opposer's claim of confusing similarity of its tradename and the Respondent-Applicant's mark.

For the same reason, registration of the Respondent-Applicant's mark is not a violation of Section 123.1 (a) and (g), which provides that a mark cannot be registered if it:

"(a) Consists of immoral, deceptive or scandalous matter, or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute;

x x x

(g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services; x x x"

In view of the glaring differences of "CHAMPAGNE" and "SHANPELINO", it is unlikely that the purchasing public will be misled that the Respondent-Applicant's goods as re sponsored by, affiliated with or connected to the Opposer. Nowhere in the mark "SHANPELINO" does it appear that the Respondent-Applicant attempts to pass off its products as connected to the Opposer. Moreover, the contested application merely states that the mark "SHANPELINO" is used or to be used on cider, wine and spirits. Noteworthy, the Trademark Registry shows many other registered trademarks covering the same goods including "BARON DE LUZE", "KALINKA" and "XIJIU". Certainly, the Opposer cannot claim monopoly over the said goods.

⁵ G.R. No. 169504, 03 March 2010.


Furthermore, a very important circumstance is whether there exists a likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the source of the goods in question. The "purchaser" is not the "completely unwary consumer" but is the "ordinarily intelligent buyer" considering the type of product involved. He is "accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The simulation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."⁶ With the products involved in this case, the target market is presumed to be discerning consumers knowledgeable and conscious of their preferences of liquors thus making confusion, much more deception, improbable.

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.⁷ The Respondent-Applicant's mark substantially met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application No. 4-2012-008187 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 03 August 2016.


ATTY. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

⁶ Mighty Corporation vs. E. & J. Gallo Winery, G.R. No. 154342, 14 July 2004.

⁷ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.