

SHELL BRANDS INTERNATIONAL AG,

Opposers,

- versus -

ALTACROP PROTECTION CORPORATION,

Respondent-Applicant.

X-----X

IPC NO. 14-2012-00367

Appln. No. 4-2012-003897

Date Filed: 28 March 2012

TM – “MAXSHELL & DEVICE”

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 348 dated October 06, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 06, 2016.

MARILYN F. RETUTAL

IPRS IV

Bureau of Legal Affairs

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SHELL BRANDS INTERNATIONAL AG }
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-versus- }
ALTACROP PROTECTION CORPORATION }
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IPC No. 14-2012-00367

Opposition to:
Application No. 4-2012-003897
Date Filed: 28 March 2012
Trademark: "MAXSHELL &
DEVICE"

x-----x

Decision No. 2016- 348

DECISION

SHELL BRANDS INTERNATIONAL AG¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-003897. The application, filed by Altacorp Protection Corporation.² ("Respondent-Applicant"), covers the mark "MAXSHELL & DEVICE" for use on "*fertilizers, insecticides, fungicides, molluscicides*" under Class 01 and "*herbicide-pre-emergency herbice for excellent control of commonly occurring broadleaf weeds, grasses and sedges in transplanted and direct pulp seed rice; insecticides, fungicides, molluscicides*" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

X X X "GROUNDS FOR OPPOSITION"

"3. The Opposer will be damaged by the registration of the Application and respectfully submits that the Application should be denied for the reasons set forth below.

"4. The Opposer is entitled to the benefits granted to foreign nationals under Section 3 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ('IP Code'): x x x

"5. The Opposer is the registered owner of several SHELL marks and SHELL DEVICE which includes classes 1 and 5 in the Philippines, and is therefore entitled to the exclusive use of the mark. Section 138 of the IP Code states: x x x

"6. The registration of the application violates 123.1 (d), (e) and (f) of the IP Code which expressly prohibit the registration of a mark if it is: x x x

¹ A foreign corporation duly registered and existing under the laws of Switzerland, with principal address at Baarermatte, 6340 Baar, Switzerland.

² With address at Unit 3, 4F, Marcelita Bldg., 2560 National Highway, Brgy. Real, Calamba, Laguna.

³ The 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.

"7. In addition, both the Philippines and the Switzerland, where the Opposer was organized and registered, are members of the Paris Convention for the Protection of Industrial Property and the WTO TRIPS Agreement. The Paris Convention provides: x x x

"8. The WTO TRIPS Agreement widens the scope of protection of well-known marks by enjoining unauthorized use of these marks on dissimilar goods/services: x x x

"9. The Opposer is a subsidiary of Royal Dutch Shell plc and together with other Shell subsidiaries form the Shell Group of Companies ('Shell Group'). Attached hereto as Annex 'B' is the Affidavit of Georgina Evans ('Evans Affidavit'), the duly authorized attorney of Shell Brands International AG, detailing the background, history and fame of the Opposer as well as the SHELL marks. The Shell Group is a global group of energy and petrochemical companies that operates in more than 80 countries, employs about 90,000 people and operates about 44,000 service stations worldwide.

"10. It all started in 1833, when shopkeeper Marcus Samuel decided to expand his London business. Apart from antiques, he began selling oriental shells for use in interior design which was then becoming fashionable. His instinct was right - such was the demand that Samuel quickly began importing shells from the Far East, laying the foundations for his import/export business. In 1886, the Samuel business has passed to Marcus Samuel, Jr. and his brother Sam. They exported British machinery, textiles and tools. Returning from a trip to Japan, Marcus Samuel, Jr. became interested in the oil exporting business and the rest was history. In 1907, the Samuel business emerged with Royal Dutch Petroleum to form the Royal Dutch Shell Group.

"11. With a history spanning over 150 years, the Shell Group's business is so diverse that the business is organized into categories, namely, upstream, Downstream and Projects & Technology. The Upstream businesses explore for and extract crude oil and natural gas, often in joint ventures with international and national oil companies. The Downstream businesses turn crude oil into a range of refined products, which are moved and marketed around the world for domestic, industrial and transport use. The Projects and Technology business provides technical services and technology capability in upstream and downstream activities. It manages the delivery of major projects and helps to improve performance across the company.

"12. The Shell Group transports fuel to around 10 million customers each day through its 43,000 service stations worldwide. Its products and services are designed to meet the needs of businesses - from the construction industry to aviation, chemicals to shipping. Its products include fuels, oils and lubricants, chemicals and LPG. It also provides services such as business solutions and home support.

"13. Because of the Shell Group's products and innovation for the past 150 years, the Shell Group, through its parent company Royal Dutch Shell plc, is consistently ranked among the World's Biggest Public Companies by Forbes. In 2012, Royal Dutch Shell plc is ranked no. 4 among the World's Biggest Public Companies by Forbes.

"14. Shell group strives to be the top performer in oil industry. Shell Group's chemicals division is a world leader in the petrochemical industry. With a collective multi-billion dollar turnover and major manufacturing facilities around the world, the

companies that make up Shell Chemicals number among the world's largest petrochemical operations.

"15. In the Philippines, the Shell Group operates through Shell Chemical Philippines. Founded in the 1960's, Shell Chemicals Philippines is a world class petrochemicals supplier because of its extensive links with modern oil refineries, state-of-the art petrochemical complexes and trading networks.

"16. There are about 1000 SHELL retail service stations in the Philippines selling SHELL products. Apart from the SHELL service stations, there are also SHELL SELECT convenience stores operating 24 hours a day and selling the full range of SHELL world-class lubricants.

"17. Another subsidiary in the Philippines which is also a part of the Shell Group is Shell Philippines Exploration B.V. It is the operator of the joint venture, which developed the Malampaya Deepwater Gas-to-Power Project. The Malampaya Project promises the birth of the gas industry in the Philippines and aims to reduce the country's reliance on imported coal or low sulphur oil to generate electricity. The project will also provide the country with very substantial revenues that can be invested in additional infrastructure and other government projects designed to stimulate economic growth and improve the living conditions of Filipinos.

"18. For more than 150 years, the Opposer's trade mark SHELL and the SHELL DEVICE have identified the Shell Group's brand and promoted its reputation. These symbols have stood not only for the quality of the Shell Group's products and services, but also as very visible representations of its professionalism and values in all of its business activities.

"19. The mark SHELL first appeared in 1891, as the trade mark for kerosene being shipped to the Far East by Marcus Samuel and Company. The mark was elevated to corporate status in 1897, when Samuel formed the The 'Shell' Transport and Trading Company. When the Royal Dutch Petroleum Company and 'Shell' Transport and Trading merged in 1907 it was the latter's brand name SHELL and symbol (PECTEN) which then became the short form name and the visible emblem of the new Royal Dutch/Shell Group.

"20. The mark SHELL and the PECTEN LOGO have been consistently named as one of the top 100 Global Brands in annual brand recognition studies conducted by Interbrand and released in conjunction with Business Week. Rankings over the last 10 years show that the SHELL trade mark is consistently ranked among the top 100 trade marks worldwide.

"21. The mark SHELL and the PECTEN LOGO have gained goodwill and reputation worldwide through advertisements and promotions as well as its connections with the innovative products of the Shell Group.

"22. SHELL products are advertised and used worldwide. The Shell Group maintains a global website which can be accessed at www.shell.com by users around the world. There are also country-specific websites for the following countries: x x x

"23. In the Philippines, the local website can be accessed at www.shell.com.ph.

"24. The mark SHELL is one of the most recognized and reputable brands in the Philippines because of advertisements, promotion and extensive use of SHELL branded products. These products are popular among Philippines consumers because of the presence of about 1000 SHELL service stations nationwide.

"25. The Shell Group is also involved in several philanthropic and charitable activities in the Philippines through Pilipinas Shell Foundation, Inc. (PSFI), a non-stock, non-profit organization engaged in social development projects aimed to improve the quality of life in rural communities in the Philippines. Since 1982, PSFI has been assisting out-of-school youth (OSY), farmers, fisherfolks, unemployed women, young scientists, teachers, soldiers, military dependents and former communist rebels through various training programs all over the country. PSFI recently celebrated its 30th anniversary. In the three decades that it existed, PSFI has touched over six million lives. PSFI is actively involved in community affairs and has assisted other Shell companies in the Philippines in fostering relationships with various communities that they directly affect nationwide.

"26. The Shell Group also sponsors the National Students Arts Competition, the longest running art competition in the Philippines. It is part of Shell's commitment to help the Filipino youth develop their full potential. Since its inception in 1951, it has launched the careers of many of today's established and rising Filipino artists.

"27. The Shell Group holds about 8,000 registrations and applications for its SHELL marks in different jurisdictions worldwide. Details of registrations of SHELL printed form the online websites of the respective Intellectual Property Offices in the United States, Singapore, Europe, Australia and Hong Kong are attached as x x x

"28. The earliest registration for the MUSSELL SHELL DEVICE which includes the text mark SHELL was in the United Kingdom with the following details:

x x x

"29. In the Philippines, the Opposer owns the following registrations for SHELL marks:

x x x

"30. The Opposer has successfully opposed the following trademark applications in the Philippines:

x x x

"31. In a decision in Greece for Case No. 6925/2007, Zois Efstathiou Shipping Items Trading Co Et Al applied to register the trademark SHELLBACKS for pleasure craft products and was opposed by Shell. The court stated that the Opposer's SHELL mark is well-known and enjoined the applicant from using the trademark SHELLBACKS.

"32. In Taiwan, in case no. 479110, Lui Ying Min applied to register the mark SHELL AND DEVICE for spectacles and spectacles for short-sightedness and was opposed by Shell International Petroleum Group Limited. The Taiwanese registry held that the SHELL marks are generally recognized by consumers as belonging to Shell. The applicant's mark was deemed similar to the SHELL marks and use of the applicant's mark was deemed likely to cause confusion to the public.

"33. In a similar case in Taiwan (case no. 502921), Lui Ying Min applied to register the mark SHELL AND DEVICE for refrigerators, air-conditioners and washing machines and was opposed by Shell International Petroleum Group Limited. Again, the Taiwanese registry held that the SHELL marks are generally recognized by consumers as belonging to Shell. The applicant's mark was deemed similar to the SHELL marks and use of the applicant's mark was deemed likely to cause confusion to the public.

"34. Also in Taiwan, in Application No. 01090255, the applicant, QB Internet Group Limited, applied to register the mark QB SHELL LOGO for beauty services and hairdressing services and was opposed by herein Opposer. The Registry held that the SHELL mark is generally recognized by consumers as belonging to Shell and is a well-known mark. The applicant's mark was deemed similar to the SHELL marks and use of the applicant's mark was deemed likely to cause confusion to the public or likely to dilute the distinctiveness or reputation of the SHELL mark.

"35. Further, in Application No. 01077839 in Taiwan, the applicant, Shang Wei Jia Food Industries, Limited, applied to register the mark SHELL DEVICE for sago and desserts and was opposed by herein Opposer. The Registry held that the SHELL mark is generally recognized by consumers as belonging to Shell and is a well-known mark. The applicant's mark was deemed similar to the SHELL mark and use of the applicant's mark was deemed likely to cause confusion to the public or likely to dilute the distinctiveness or reputation of the SHELL mark.

"ARGUMENTS

"36. The dominant portion of the Respondent-Applicant's mark is the word SHELL which is identical to the Opposer's SHELL mark.

x x x


"37. In determining confusing similarity between trademarks, jurisprudence has developed two tests: the Dominancy Test and the Holistic or Totality Test -

x x x

"38. Recent cases, however, have tended to rely on the Dominancy Test and in McDonald's Corporation vs. L.C. Big Mak Burger, Inc., the Supreme Court recognized that the Dominancy Test 'is now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code which defines infringement as the 'colorable imitation of a registered mark... or a dominant feature thereof.'

"39. What is evident from the foregoing is that the Opposer's SHELL marks are highly distinctive and have established fame and reputation and consumers would automatically attribute a relation between the Opposer and any product or service bearing a word that is identical to SHELL.

"40. The dominant portion of the Respondent-Applicant's mark is SHELL which is identical to the Opposer's SHELL mark. Consumers will make a connection between the Opposer's SHELL mark and Respondent-Applicant's MAXSHELL & DEVICE, considering that the Opposer's mark has been used worldwide for more than 150 years and the goods covered by the Opposer's mark and the Respondent-Applicant's mark are similar.



"41. The public will most likely assume a connection between such goods and allow Respondent-Applicant to unfairly take advantage of the substantial goodwill attached to the Opposer's SHELL mark and SHELL DEVICE. Confusion and/or association is likely given the similarity between the trademarks, the related goods covered and, most importantly, the considerable reputation attached to the Opposer's SHELL marks and SHELL DEVICE.

"42. The goods covered by the Application are identical or related to the goods covered by the Opposer's registered marks which include classes 1 and 5 as follows:

x x x

"43. The goods covered by the Respondent-Applicant's mark are identical to the goods covered by the Opposer's SHELL DEVICE in classes 1 and 5. These goods and those covered by the Opposer's SHELL mark flow in the same channels of trade as that of the Opposer's marks as both relate to chemicals. The risk of confusion is aggravated by the fact that Opposer's SHELL marks, products and services have been in the market for many years and have established a strong reputation in the chemicals and oil industry. As the registered owner of SHELL marks and SHELL DEVICE, Opposer has the right to be protected against similar marks used on the same or related goods and services.

"44. It must be emphasized that Opposer's SHELL and SHELL DEVICE traces its history as far back as 1833 and has enjoyed continuous goodwill throughout the years. In contrast, Respondent-Applicant only filed the application for the MAXSHELL & DEVICE mark on 28 March 2012. As the prior user and registered owner of the marks, the Opposer is entitled to protection against registration and use by third parties of confusingly similar marks such as Respondent-Applicant's MAXSHELL & DEVICE mark.

"45. Laws on trademarks and trade names are meant to protect its owners from unfair business practices of third parties who, by adopting a mark that is similar to the trademark owner's, take advantage of and unfairly benefit from the prior mark's goodwill. In *La Chemiste Lacoste, S.A. vs. Fernandez*, the Supreme Court stated:

x x x

"45. The criteria for determining whether a mark is well-known are enumerated in Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Tradenames and Marked or Stamped Containers. The Rule provides that:

x x x

"47. The Opposer has satisfied a combination of the requirements set forth above.

"47.1. The Opposer has been using the SHELL and SHELL DEVICE marks for over 150 years.

"47.2. SHELL products and services are available in more than 80 countries through its 44,000 service stations worldwide.

"47.3. The SHELL and SHELL DEVICE hold about 8,000 registrations and applications worldwide.



"47.4. The SHELL and SHELL DEVICE marks are promoted and advertised worldwide through websites, advertisements, sponsorships and other civic activities.

"47.5. The SHELL marks have been consistently ranked as one of the top brands worldwide for the last 10 years.


"47.6. The Opposer has successfully protected and enforced its rights as the worldwide owner of SHELL and SHELL DEVICE marks such as in the Philippines, Greece and Taiwan and was even declared a well-known mark in Greece and Taiwan.

"48. As Opposer's SHELL and SHELL DEVICE marks are registered and well-known trademarks, they are protected against goods/services that are similar or dissimilar to those specified in the registration.

"49. One of the incorporators and directors of the Respondent-Applicant and now its current president, Wendell T. Garcia is a former employee of Opposer's subsidiary Shell Chemicals Company in the Philippines. Mr. Garcia was hired by Shell Chemicals Company of the Philippines in 23 November 1982 and his last payroll date was 19 September 1994. Mr. Garcia is therefore aware of the Opposer's SHELL trademarks and goods. The incorporation of the Opposer's mark SHELL in the Respondent-Applicant's mark MAXSHELL & DEVICE is not a mere coincidence but is a blatant attempt to ride on the goodwill of the Opposer and its SHELL marks.

"50. Ultimately, therefore, the Application should be denied for being confusingly similar to the Opposer's registered trademarks, because the SHELL and SHELL DEVICE marks are well-known marks and Respondent-Applicant is in bad faith.

The Opposer's evidence consists of the Notice of Opposition; the Special Power of Attorney confirming appointment of Baranda & Associates as counsel of Opposer; the Affidavit of Opposer's authorized Attorney, Georgina Evans; overview and fast facts about Shell Group from http://www.shell.com/home/content/aboutshell/at_a_glance; The Shell Group's history printed from <http://www.shell.com/home/content/aboutshell/affidavit> signed by Thomas Senderovitz and Marcus Heppner; a copy of the Certwho_we_are/our_history; website printout from http://www.shell.com/home/content/aboutshell/our_business showing Shell Group's business; Shell Group's list of products and services printed from http://www.shell.com/home/content/products_services; website printout from <http://www.forbes.com/global2000/list> showing that the Opposer's parent company Royal Dutch Shell plc is consistently ranked among the World's Biggest Public Companies by Forbes; website printout from http://www.shell.com/home/content/aboutshell/who_we_are/our_history/history of pecten showing the history of SHELL LOGO; website printouts from <http://www.interbrand.com/en/best-global-brands/best-global-brands-2008/best-global-brands-2002.aspx> showing the SHELL trade mark in Interbrand rankings for the year 2002; website printouts from <http://www.interbrand.com/en/best-global>.

brands/best-global-brands-2008/best-global-brands-2003.aspx showing the SHELL trade mark in Interbrand rankings for the year 2003; website printouts from <http://www.interbrand.com/en/best-global-brands/best-global-brands-2008/best-global-brands-2004.aspx> showing the SHELL trade mark in Interbrand rankings for the year 2004; website printouts from <http://www.interbrand.com/en/best-global-brands/best-global-brands-2008/best-global-brands-2005.aspx> showing the SHELL trade mark in Interbrand rankings for the year 2005; website printouts from <http://www.interbrand.com/en/best-global-brands/best-global-brands-2008/best-global-brands-2006.aspx> showing the SHELL trade mark in Interbrand rankings for the year 2006; website printouts from <http://www.interbrand.com/en/best-global-brands/best-global-brands-2008/best-global-brands-2007.aspx> showing the SHELL trade mark in Interbrand rankings for the year 2007; website printouts from <http://www.interbrand.com/en/best-global-brands/best-global-brands-2008/best-global-brands-2008.aspx> showing the SHELL trade mark in Interbrand rankings for the year 2008; website printouts from <http://www.interbrand.com/en/best-global-brands/best-global-brands-2008/best-global-brands-2009.aspx> showing the SHELL trade mark in Interbrand rankings for the year 2009; website printouts from <http://www.interbrand.com/en/best-global-brands/best-global-brands-2008/best-global-brands-2010.aspx> showing the SHELL trade mark in Interbrand rankings for the year 2010; website printouts from <http://www.interbrand.com/en/best-global-brands/best-global-brands-2008/best-global-brands-2011.aspx> showing the SHELL trade mark in Interbrand rankings for the year 2011; list of SHELL applications and registrations worldwide; a copy of US Registration No. 1663096 for the SHELL issued on 5 November 1991; a copy of US Registration No. 0852113 for SHELL issued on 9 July 1968; a copy of Singapore Registration NO. T4911225G for SHELL issued on 7 May 1949; a copy of Singapore Registration No. T49112241 for SHELL issued on 7 May 1949; a copy of CTM Registration No. 001118801 for SHELL issued on 11 July 2001; a copy of Australia Registration No. 223079 for SHELL issued on 9 October 1968; a copy of Australia Registration No. 116492 for SHELL issued on 30 November 1953; a copy of Hong Kong Registration No. 19520119 for SHELL issued on 3 September 1951; a copy of Hong Kong Registration No. 200313106 for SHELL issued on 26 March 2001; a copy of the commemorative certificate issued by the UK Patent Office in recognition of the trade mark registration no. 233532 becoming 100 years old; a copy of Philippine Registration No. 4-2002-000984 for SHELL issued on 31 October 2005; a copy of Philippine Registration No. 037525 for SHELL (DEVICE) issued on 25 June 1987; a copy of the Decision on Inter Partes Case No. 200; a copy of the Decision bearing Inter Partes Case No. 14-2005-00037; a copy of the decision in Greece for Case No. 6925/2007, Zois Efstathiou Shipping Items Trading Co Et Al; English Translation of the decision in Greece for Case No. 6925/2007, Zois Efstathiou Shipping Items Trading Co Et Al; a copy of the decision in Taiwan for case no. 479110; English translation of the decision in Taiwan for case no. 479110; a copy of the decision in Taiwan case no. 502921; English translation of the decision in Taiwan case no. 502921; a copy of the Registry's decision in Taiwan case no. 502921; a copy of the Registry's decision in Taiwan Application NO. 

01090255; English translation of the Registry's decision in Taiwan Application No. 01090255; a copy of the Registry's Taiwan Application No. 01077839; a copy of the registration certificate of registration no. 4-2002-00984 for SHELL; and a copy of the registration certificate of registration no. 37525 for SHELL PECTEN.⁴

This Bureau issued a Notice to Answer and sent a copy thereof upon Respondent-Applicant on 10 December 2012. The Respondent-Applicant filed its Answer on 27 February 2013 and avers the following:

x x x

"III

"AFFIRMATIVE ALLEGATIONS AND DEFENSES

"6. The subject application-MAXSHELL & DEVICE - is derived and is a 'derivative and composite mark' from Respondent's various trademark registrations, to wit:

"6.a 4-Leaf Device under Certificate of Registration No. 2-2007-000274 x x x

"6.b Cyanamid Leaf & Device under Certificate of Registration No. 4-2009-006447 x x x

"6.c McShell EC under Certificate of Registration No. 4-2010-007337 x x x

"7. A representation of the actual product label of the mark McShell EC (herbicide product) is shown below, x x x

"8. A simple examination of the above trademarks and devices owned and registered under the name of the Respondent would readily show that the subject trademark application - MAXSHELL & DEVICE - is but a derivation, a reiteration or replication and/or combination of the three trademarks, thus, a derivative and composite mark, adopted from the said previously registered trademarks, which to repeat, are already registered under Respondent's name, in line with current branding and marketing practices of any commercial venture expanding its business.

"9. The trademark McShell EC is registered for Class 05 (herbicides) and has been in actual commercial use since 2009. The two other marks - 4-Leaf Device (registered for Classes 01 (fertilizers) and 05 (herbicides and insecticides) and Cyanamid Leaf & Device (registered for Class 05 [herbicide]) have been used and are in current actual commercial use for various trademarks of the respondent covering numerous fertilizers, herbicides and insecticides products of the Respondent which product labels are representatively shown below.

x x x



⁴ Marked as Exhibits "A" to "SS".

"10. The common denominator-device of the above trademarks and product labels of the Respondent is the 4-Leaf Device and Cyanamid Leaf & Device trademark under Certificate of Registration Nos. 4-2007-000274 and 4-2009-006447, respectively; which Devices (to repeat) has been duplicated, replicated and/or simulated and in the subject mark - MAXSHELL & DEVICE.

"11. On the other hand, the sound and pronunciation of the MAXSHELL & DEVICE trademark is derived, simulated, replicated and/or taken from the McShell EC trademark of the Respondent already registered with the Bureau of Trademarks-IPO (BOT-IPO) since 31 March 2011.

"12. Respondent's actual product labels using the 4-Leaf Device and Cyanamid Leaf & Device are herein attached x x x

"13. The MAXSHELL & DEVICE trademark and the products covered by the same -fertilizers, insecticides, fungicides, molluscides and herbicides - is therefore but a natural and normal consequence of an expanding product line and, consequently, increasing trademark portfolio of a thriving business.

"14. Respondent having already owned and registered under its name the 4-Leaf Device trademark (Reg. No. 4-2007-000274), the Cyanamid Leaf & Device trademark (Reg. No. 4-2009-006447) and the McShell EC trademark (Reg. No. 4-2010-007337) is well-within its trademark and business rights to adopt, apply, prosecute and procure the MAXSHELL & DEVICE trademark which is legal parlance 'within the normal and natural business expansion of the trademark and business owner to pursue and rightfully have' as rightfully declared by no less than the BOT-IPO.

"15. The MAXSHELL word mark is clearly different in sound, pronunciation, spelling even in definition or connotation as against Opposer's Shell mark. By definition or connotation, Shell and MAXSHELL have different meanings or reference. 'Shell' is commonly defined by dictionaries as 'a hard outer covering, i.e. a nutshell, the shell of the tortoise seashell.' On the other hand, 'MAXSHELL' (as previously stated) is a derivative and composite mark derived/duplicated, replicated and/or simulated from Respondent's previously registered McShell EC trademark (Reg. No. 4-2010-007337).

"16. Opposer's 'Shell' mark is represented by a Pecten Device similar to sea shells one finds on beach sand. Arguably, the Shell Mark and its Pecten/Shell Device is generally recognized by consumers or the public as belonging to Opposer, with that consumers or public having in mind oil, gas, diesel, fuel and its derivative products NOT to fertilizers, insecticides, fungicides, molluscicides and herbicide products for which the Respondent's MAXSHELL & DEVICE is applied for.

"17. There is no concrete evidence on record that the Filipino consumers or the public identify the Shell mark of the Opposer to fertilizers, insecticides, fungicides, molluscicides and herbicide products, much more, to every goods, products or even any and all service/s offered in the market.

"18. In fact, most of not all, of the documentary evidence of the Opposer in this Opposition relates and/or deals with oil (also natural gas) and oil derivative

products (fuel and lubricants), service stations and hyped global stature and repute.

"19. The Supreme Court has in a long line of cases found the following marks NOT confusingly similar. 'Pertussin' and 'Atussin' (Etepha vs. Director of Patents, 16 SCRA 495 [1966]) both for the treatment of cough, 'Bioferin' and 'Bufferin' (Bristol Meyers Co. vs. Director of Patents, 17 SCRA 128 [1966]) both for medicine; 'Alaska' and 'Alacta' (Mead Johnson & Co., vs. NVJ Van Dorp. Ltd., 7 SCRA 768 [1963]) for powdered half-skim milk; 'Sulmetine' and 'Sulmet' (American Cyanamid Co., vs. Director of Patents, 76 SCRA 568 [1977]) both for veterinary medicine used for the same purpose; 'Victorias' and diamond design and 'Valentine' and diamond design (Victories Milling Co., Inc. vs. Ong Su, 79 SCRA 207 [1977]) both for sugar; and 'Fruit of the Loom' and 'Fruit for Eve' (Fruit of the Loom, Inc. vs. Court of Appeals, 133 SCRA 405 [1984]) both for lingerie and evening wear.

"20. Based on the above jurisprudence laid down time and again by the Supreme Court, Shell and MAXSHELL are words and/or marks that are NOT similar and/or confusingly similar.

"21. Consequently, Shell and MAXSHELL should be allowed to co-exist as trademarks, the former for oil and oil products and the latter for fertilizers, insecticides, fungicides, molluscides and herbicide products.

"22. The marks Shell and MAXSHELL being different under the above jurisprudence should also be taken along with their respective Devices and/or Symbols/Logos which are principally and necessarily dominant in word marks with Devices such as that of Opposer's.

"23. Opposer's Pecton/Shell Device is shown below: x x x

"24. In contrast, Respondent's Device in MAXSHELL & DEVICE is represented below: x x x

"25. Examining the above Devices, it is clear as daylight that the above Logos/Devices, to wit: Opposer's Pecton/Shell Device and Respondent's 4-Leaf Device are NOT the same, NOT similar or even confusingly similar. In other words, they are different Devices and/or Device/Marks which by current jurisprudence can be applied for and registered for similar, identical or even on the same goods and products.

"26. Being different marks, specifically the parties' Device/Marks, there can be no public confusion and/or deception since the consuming public would know Opposer's fertilizers, insecticides, fungicides, molluscicides and herbicides symbolized by the Pecton/Shell Device as against Respondent's fertilizers, insecticides, fungicides, molluscicides and herbicides represented by the 4-Leaf Device.

"27. It is highly far-fetched that the consuming public, even farmers, who actually are more drawn into symbols and logos (Devices) than words in patronizing agri-products would mistake Respondent's fertilizers and herbicides

as originating from the Opposer by the mere 'shell' in MAXSHELL, where the same is represented by the 4-Leaf Device and NOT by the Pecten/Shell Device.

"28. If such confusion be true and common, then the Shell word mark and even the Pecten/Shell Device mark of the Opposer would only be proven as NOT so famous, distinctive or well-known after all, as alleged by the Opposer repeatedly in this Opposition.

"29. What is dominant in trademarks coupled with Devices/Symbols/Logos are such Devices/Symbols and Logos, the same being universal in character that transcends language limitation, thus, the swoosh of Nike- x x x the 'apple fruit' of Apple Inc.- x x x or the twin-tailed mermaid (siren) in the Starbucks logo- x x x is what makes these famous marks 'famous' and internationally well-known, anywhere in the world; the word mark (Nike, Apple, Starbucks) taking the supporting role of trademark function.

"30. There being no similarity/confusing similarity between the word marks SHELL and MAXSHELL and no similarity/confusing similarity of the subject marks' respective Devices/Symbols, Opposer's alleged damage to be caused by the registration of the MAXSHELL & DEVICE mark is NOT real and apparent especially so when the parties stature in business is a classic David against Goliath case.

"31. Opposer or Goliath is a hundred-year plus multinational company with billions of dollars in net earnings every year. It operates hundreds of offices worldwide employing tens of thousands. Respondent (or David) is a small-to-medium size corporation operating on a one-floor rented office in Laguna with around ten individuals as employees. Suffice it to say that the latter's earnings pale in comparison with the Opposer. Armed with a mission (and vision) to help local farmers attain a bountiful produce each harvest season through an array of affordable and quality fertilizers and pesticides, Respondent has just quite recently started allocating its meager resources to build and protect its own trademark line for its fertilizer/pesticide products. Thus, the filing and prosecution of herein MAXSHELL & DEVICE, among other trademark applications.

"32. Such is the reality of every small-to-medium size local company (David) dreaming to be a Goliath someday. However, Respondent's dream is more often indicted as bad faith, malice even by multinational corporations whose objective and goal of lording it over local and small companies maybe the only damage caused or maybe caused Opposer. Such damage is not the damage prevented by the Intellectual Property Code.

"33. In view of the foregoing, SUBJECT OPPOSITION against MAXSHELL & DEVICE trademark must be, as it should be DISMISSED.

The Respondent-Applicant's evidence consists of the Affidavit of Ms. Grace E. Mogar, Company Controller of the Respondent-Applicant Altacrop Protection Corporation; a copy of Certificate of Registration No. 4-2007-000274 for the trademark 4-Leaf Device; a copy of Certificate of Registration No. 4-2009-006447 for the trademark Cyanamid Leaf & Device; a copy of Certificate of Registration No. 4-2010-007337 for the

trademark McShell EC; a representation of the actual product label of the mark McShell EC (herbicide product); and sample actual product labels of the trademarks SHELTER 2, 4-D amine, Swipe 70 WP, Sparrow 50SP, Evict 31.5EC, Torch 2.5 EC, Switch 70EC, Mango Boom, Canopy 80WP, all with or using the 4-Leaf Device and Cyanamid Leaf & Device.⁵

On 15 May 2014, the Preliminary Conference was conducted and terminated. Parties were directed to file their respective position papers. Thereafter, the case was deemed submitted for resolution.

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

The Opposer anchors its opposition on Sections 123.1, paragraphs (d), (e) and (f) and 138 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;
- (e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;
- (f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or service which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use;

⁵ Marked as Exhibits "1" to "13", inclusive.

Sec. 138. *Certificates of Registration.* – A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.

Records show that at the time the Respondent-Applicant filed its trademark application on 28 March 2012, the Opposer already owns SHELL trademark registrations in different countries including the Philippines. These registrations cover generally oil and oil products in Class 04. On the other hand, Respondent-Applicant's trademark application for the mark MAXSHELL & DEVICE covers fertilizers, insecticides, fungicides, mollusides and herbicide products in Classes 1 and 5.

Hence, the question, does MAXSHELL & DEVICE of Respondent-Applicant resemble Opposer's trademark registrations for SHELL and the PECTEN LOGO such that confusion or deception is likely to occur? The marks are shown below:



SHELL

Opposer's trademarks



Respondent-Applicant's mark

This Bureau finds that confusion or deception is unlikely to occur at this instance. Anent the Opposer's argument that the dominant portion of the Respondent-Applicant's mark is SHELL which is identical to the Opposer's SHELL and PECTEN LOGO trademarks, this Bureau finds that it is not SHELL but the 4-Leaf Device which is dominant in terms of creating commercial impression. Corollarily, an opposition cannot be sustained solely for the reason that the contending marks both contain the word SHELL. The determination whether there is confusing similarity would depend on the evaluation of the other words, letters, device or features that are added to the word SHELL. Except for the word SHELL in combination with the word MAX, the 4-Leaf Device and not the PECTEN logo can be found in Respondent-Applicant's mark MAXSHELL & DEVICE. In this regard, what draws the eyes with respect to the Respondent-Applicant's mark is the 4-Leaf Device or Cyanamid Leaf logo. Hence, it is the 4-Leaf Device and not the word MAXSHELL which is the defining and distinctive feature in Respondent-Applicant's composite mark MAXSHELL & DEVICE. Also, the use of the 4-Leaf Device or Cyanamid Leaf to the word mark MAXSHELL has rendered Respondent-Applicant's mark a character that is distinct from the Opposer's trademarks SHELL and PECTEN LOGO. Respondent-Applicant's mark consisting of the word MAXSHELL has 4-Leaf Device while Opposer's trademarks consist of the PECTEN logo alone or the wordmark SHELL in combination with another word or

words, such as, SHELL SELECT, SHELL HELIX, SHELL DIESOLINE, SHELL GLOBAL SOLUTIONS, SHELL RIMULA EXPRESS, etc.

Moreover, the goods/services covered by the marks are different. MAXSHELL & DEVICE mark is used for fertilizers, insecticides, fungicides, mollusides and herbicide products in Classes 1 and 5 while SHELL and PECTEN LOGO is generally oil, fuel and oil products in Class 4. Thus, confusion, mistake and deception is unlikely among the purchasing public.

Furthermore, Respondent-Applicant's mark MAXSHELL & DEVICE is derived from a combination of its previous trademark applications and registrations namely:



1) **4 LEAF DESIGN** under Application Serial No. 4-2005-005492 filed on 15 June 2005; 2) **DEVICE (4-Leaf Design)** under Trademark Reg. No. 4-2007-000274 issued on 09 January 2007; **CYANAMID LEAF & DEVICE (A REPRESENTATION OF A LEAF DEVICE ABOVE THE WORD "CYANAMID LEAF** under Trademark Reg. No. 4-2009-006447 issued on 30 June 2009; and 3) **McSHELL EC** under Trademark Reg. No. 4-2010-007337 issued on 07 July 2010. The Certificate of Registration, when presented in evidence, affords a prima facie presumption of its correctness and validity, specifically, of the registrant's ownership of the mark. Section 138 of R.A. 8293 states:

SEC. 138. Certificates of Registration. – A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.

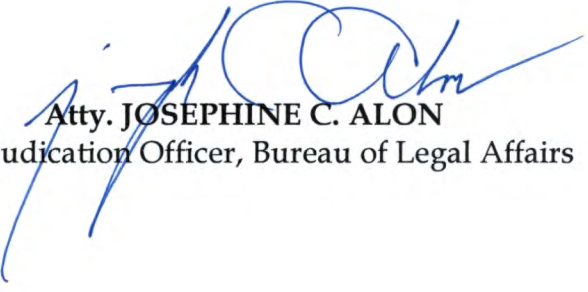
The essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, 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.⁶ This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

⁶Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-003897 is hereby DISMISSED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 06 OCT 2016.


Atty. JOSEPHINE C. ALON
Adjudication Officer, Bureau of Legal Affairs