



SOCIETE DES PRODUITS NESTLE, S.A.,

Opposer,

- versus -

ELDRIGE MARVIN B. ACERON,

Respondent-Applicant.

X-----X

IPC NO. 14-2015-00172

Appln. No. 4-2014-013655

Date Filed: 03 November 2014

TM – “KASAMBUHAY”

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 371 dated October 10, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 10, 2016.

MARILYN F. RETUTAL

IPRS IV

Bureau of Legal Affairs

Republic of the Philippines

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SOCIETE DES PRODUITS NESTLE, S.A.,

Opposer,

-versus-

ELDRIDGE MARVIN B. ASPERON,

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IPC No. 14-2015-00172

Opposition to Trademark

Application No. 4-2014-013655

Date Filed: 03 November 2014

Trademark: "**KASAMBUHAY**"

Decision No. 2016- 371

DECISION

Societe des Produits Nestle, S.A.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2014-013655. The contested application, filed by Eldridge Marvin B. Asperon² ("Respondent-Applicant"), covers the mark "KASAMBUHAY" for use on "*education; providing of training; entertainment; sporting and cultural activities*" under Class 41 of the International Classification of Goods³.

The Opposer objects the allowance of the Respondent-Applicant's application mainly on the ground that the mark "KASAMBUHAY" is allegedly confusingly similar to its mark "KASAMBUHAY HABANGBUHAY", which is registered under Certificate of Registration No. 4-2010-501631 issued on 07 April 2011. It contends that since the applied mark "KASAMBUHAY" will also be used for services that are covered by its registration, the same is contrary to Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code").

According to the Opposer, its company started on 25 April 1911 when it opened a sales office in Binondo, Manila. Nestle Philippines, Inc. ("NPI") is its Philippines licensee for the manufacture and distribution of its products. In 2011, NPI celebrated its "100th year of Good Food and Good Life" and decided that the event must be commemorated "in the context of the relationship Nestle has, and that it hopes to continue, with Filipino families who have trusted the Nestle brand and welcomed its products into their homes for generations". Pursuant thereto, "KASAMBUHAY HABANGBUHAY" was conceptualized which translates to "Companion in Life, For Life". The theme became the inspiration for all activities relating to the centennial celebration. In support to its Opposition, the Opposer submitted as

¹ A corporation duly organized and existing under the laws of Switzerland, with office address at CH-1800 Vevey, Switzerland.

² An individual with address at Unit 3101-B 31st Floor Atlanta Centre, 31 Anapolis St., Greenhills, San Juan, 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.

evidence the E-gazette publication for opposition of the mark "KASAMBUHAY and affidavit of Dennis Jose R. Barot, with annexes.⁴

The Respondent-Applicant filed his Answer on 19 August 2015 denying that the contending marks are confusingly similar. He claims that the would-be consumers are businesses, corporations and employers, which are not completely unwary consumers but ordinarily intelligent buyers.

The Preliminary Conference was initially set on 28 January 2016. The same was reset and eventually terminated on 03 March 2016. On the same date, the parties were directed to submit their respective position papers within ten days therefrom. After which, the case is deemed submitted for decision.

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

Prefatorily, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁵

Records reveal that the Opposer filed an application for the registration of the mark "KASAMBUHAY HABANGBUHAY" as early as 08 November 2010. Eventually, Certificate of Registration No. 4-2010-0501631 was issued covering the said mark on 07 April 2011. On the other hand, the Respondent-Applicant filed the contested application only on 03 November 2014.

To determine whether the marks of the Opposer and the Respondent-Applicant are confusingly similar, the competing marks are shown hereafter for comparison:

⁴ Marked as Exhibits "B" to "O".

⁵ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

KASAMBUHAY
HABANGBUHAY

Opposer's mark

Kasambuhay

Respondent-Applicant's mark

A perusal of the competing marks will readily show that they are almost identical and hence, confusingly similar. The Respondent-Applicant merely omitted the word "HABANGBUHAY", which is not sufficient to distinguish its mark from that of the Opposer's. Noteworthy, the Opposer explained that the word "KASAMBUHAY" is a coined word derived from combining the words "KASAMBAHAY" and "BUHAY". On the other hand, the Respondent-Applicant failed to explain how it came up with a similar mark. Aptly, the Supreme Court held in the case of **American Wire & Cable Company vs. Director of Patents**⁶ that:

"Of course, as in all other cases of colorable imitations, the unanswered riddle is why, of the millions of terms and combinations of letters and designs available, the appellee had to choose those so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark."

As the marks are visually and phonetically similar, it is impossible not to remember or associate the registered trademark "KASAMBUHAY HABANGBUHAY" when one encounters the Respondent-Applicant's mark "KASAMBUHAY". 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.⁷

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 for it.⁸ Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.⁹

⁶ G.R. No. L-26557, 18 February 1970.

⁷ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁸ American Wire & Cable Co. vs. Director of Patents, G.R. No. L-26557, 18 February 1970.

⁹ Philips Export B.V. vs. Court of Appeals, G.R. No. 96161, 21 February 1992.

Moreover, the Respondent-Applicant's mark "KASAMBUHAY" is to be used on *"education; providing of training; entertainment; sporting and cultural activities"* under Class 41. Similarly, the Opposer's mark "KASAMBUHAY HABANGBUHAY" cover services for *"corporate and corporate-sponsored training, entertainment, education, sporting and cultural activities"* also for Class 41. As the services the marks cover are closely related, if not similar, 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.


Furthermore, 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."¹⁰

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code, which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor with an earlier filing or priority date, with respect to the same or closely related goods or services, or has a near resemblance to such mark as to likely deceive or cause confusion.¹¹

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-013655 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **10 OCT 2016**


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

¹⁰ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

¹¹ Great White Shark Enterprises vs. Danilo M. Caralde, Jr., G.R. No. 192294, 21 November 2012.