



Republic of the Philippines  
Supreme Court  
Manila

SECOND DIVISION

ABS-CBN PUBLISHING, INC.,  
Petitioner,

G.R. No. 217916

Present:

PERALTA, J.,  
Acting Chairman,  
DEL CASTILLO,\*  
PERLAS-BERNABE,  
CAGUIOA, and  
REYES, JR., JJ.

- versus -

DIRECTOR OF THE BUREAU OF  
TRADEMARKS,

Respondent.

Promulgated:

20 JUN 2018

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DECISION

REYES, JR., J.:

The Case

Challenged before the Court *via* this Petition for Review on *Certiorari* under Rule 45 of the Rules of Court is the Resolution<sup>1</sup> of the Court of Appeals promulgated on May 20, 2014, which denied ABS-CBN Publishing, Inc.'s (petitioner) "Motion for Extension of Time [To File Petition for Review]." Likewise challenged is the subsequent Resolution<sup>2</sup> of the Court of Appeals promulgated on April 15, 2015, which upheld the earlier Resolution.

\* Designated as additional Member per Raffle dated January 22, 2018.

<sup>1</sup> Penned by Associate Justice Michael P. Elbinias, and concurred in by Associate Justices Isaias P. Dicedican and Ricardo R. Rosario; *rollo*, Vol. I, pp. 58-61.

<sup>2</sup> This time penned by Associate Justice Isaias P. Dicedican, and concurred in by Associate Justices Rosmari D. Carandang and Ricardo R. Rosario; *id.* at 63-67.

Reyes

### The Antecedent Facts

In 2004,<sup>3</sup> the petitioner filed with the Intellectual Property Office of the Philippines (IPO) its application for the registration of its trademark “METRO” (applicant mark) under class 16 of the Nice classification, with specific reference to “magazines.”<sup>4</sup> The case was assigned to Examiner Arlene M. Icban (Examiner Icban), who, after a judicious examination of the application, refused the applicant mark’s registration.

According to Examiner Icban, the applicant mark is identical with three other cited marks, and is therefore unregistrable according to Section 123.1(d) of the Intellectual Property Code of the Philippines (IPC).<sup>5</sup> The cited marks were identified as (1) “Metro” (word) by applicant Metro International S.A. with Application No. 42000002584,<sup>6</sup> (2) “Metro” (logo) also by applicant Metro International S.A. with Application No. 42000002585,<sup>7</sup> and (3) “Inquirer Metro” by applicant Philippine Daily Inquirer, Inc. with Application No. 42000003811.<sup>8</sup>

On August 16, 2005, the petitioner wrote a letter<sup>9</sup> in response to Examiner Icban’s assessment, and the latter, through Official Action Paper No. 04, subsequently reiterated her earlier finding which denied the registration of the applicant mark. Eventually, in the “Final Rejection”<sup>10</sup> of the petitioner’s application, Examiner Icban “determined that the mark subject of the application cannot be registered because it is identical with the cited marks METRO with Regn. No. 42000002584 [‘Metro’ (word)] and Regn. No. 42000003811 [‘Inquirer Metro’].”<sup>11</sup>

The petitioner appealed the assessment of Examiner Icban before the Director of the Bureau of Trademarks of the IPO, who eventually affirmed Examiner Icban’s findings. The decision averred that the applicant and cited marks were indeed confusingly similar, so much so that there may not only be a confusion as to the goods but also a confusion as to the source or origin of the goods. The *fallo* of the Bureau Director’s decision reads:

**WHEREFORE**, premises considered, the instant appeal is hereby **DENIED** and the Final Rejection contained in Official Action Paper No. 04, **SUSTAINED**. Serve copies of this Decision to [petitioner] and herein

<sup>3</sup> *Rollo*, Vol. I, p. 46.

<sup>4</sup> *Id.* at 10.

<sup>5</sup> Rep. Act No. 8293 (1997), as amended.

<sup>6</sup> *Rollo*, Vol. I, p. 417.

<sup>7</sup> *Id.*

<sup>8</sup> *Id.*

<sup>9</sup> *Id.* at 420-423.

<sup>10</sup> *Id.* at 446.

<sup>11</sup> *Rollo*, Vol. I, p. 446.

*Meyer*

Examiner Arlene M. Icban.

**SO ORDERED.**<sup>12</sup>

Upon the denial of the petitioner's motion for reconsideration, the petitioner appealed to the Office of the Director General (ODG) of the IPO. After the submission of the memoranda from the parties, the ODG, on September 19, 2013, rendered a Decision which upheld Examiner Icban's assessment and the Bureau Director's decision.

According to the ODG, there is no merit in the petitioner's appeal because (1) the applicant and cited marks are identical and confusingly similar,<sup>13</sup> (2) the petitioner's mark was deemed abandoned under the old Trademark Law, and thus, petitioner's prior use of the same did not create a vested right<sup>14</sup> under the IPC,<sup>15</sup> and (3) the applicant mark has not acquired secondary meaning.<sup>16</sup> The *fallo* of the ODG decision reads:

Wherefore, premises considered, the appeal is hereby **DENIED** and the Decision dated 29 March 2010 and the Order denying the Appellant's Motion for Reconsideration, of the Director of the Bureau of Trademarks, are hereby **SUSTAINED**. The Appellant's Trademark Application No. 4-2004-004507 for METRO is likewise **DENIED**.

Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Trademarks. Let a copy of this Decision be furnished also the library of the Documentation, Information and Technology Transfer Bureau for its information and records purposes.

**SO ORDERED.**<sup>17</sup>

The petitioner received a copy of the ODG decision only on October 9, 2013. On the same day, the petitioner filed before the Court of Appeals its "Motion for Extension of Time (To File Petition for Review)" which requested for an extension of fifteen (15) days from October 24, 2013, or until November 8, 2013, to file its petition for review.<sup>18</sup> On October 25, 2013, the petitioner once more filed a motion for extension of time. In the second motion, the petitioner asked the appellate court for another extension of the deadline from November 8, 2013 to November 23, 2013.<sup>19</sup>

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<sup>12</sup> *Rollo*, Vol. I, p. 472.

<sup>13</sup> *Id.* at 107-108.

<sup>14</sup> *Id.* at 108-109.

<sup>15</sup> Rep. Act No. 8293 (1997), as amended.

<sup>16</sup> *Rollo*, Vol. I, pp. 109-110.

<sup>17</sup> *Id.* at 110.

<sup>18</sup> *Id.* at 122-126; *rollo*, Vol. II, pp. 624-628.

<sup>19</sup> *Id.* at 127-130, *id.* at 629-632.

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Meanwhile, on October 25, 2013, the Court of Appeals issued a Resolution which granted the petitioner's first motion praying for an extension of time to file its petition for review, subject to the "warning against further extension." Thus, the Court of Appeals extended the deadline only until November 8, 2013.<sup>20</sup>

Relying on the appellate court's favorable response to its second motion for extension (which was not acted upon by the Court of Appeals), the petitioner failed to file its petition for review on the deadline set in the Resolution dated October 25, 2013. Instead, the petitioner filed its petition for review only on November 11, 2013—three (3) days after the deadline.<sup>21</sup>

To justify this delay in filing, the petitioner stated that: (1) it received a copy of the October 25, 2013 Resolution only on November 8, 2013 at 11:30 in the morning; (2) on that same day, this Court, through its Public Information Office, suspended offices in the National Capital Judicial Region in view of Typhoon Yolanda; and (3) November 9 and 10, 2013 fell on a Saturday and Sunday, respectively.<sup>22</sup>

On May 20, 2014, the Court of Appeals rendered the assailed Resolution. It ruled that the petitioner violated its October 25, 2013 Resolution, as well as Section 4, Rule 43 of the Rules of Court, which provides for the period of appeal.<sup>23</sup>

On the basis of the foregoing, and the prevailing jurisprudence, the Court of Appeals consequently denied the petitioner's second motion for extension of time, and dismissed the petition for the petitioner's failure to file its petition for review within the deadline.<sup>24</sup>

On April 15, 2015, the appellate court denied the petitioner's motion for reconsideration.<sup>25</sup>

Hence, this petition.

### The Issues

The ground upon which the petitioner prays for the reversal of the

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<sup>20</sup> *Rollo*, Vol. II, p. 633.

<sup>21</sup> *Rollo*, Vol. I, p. 68.

<sup>22</sup> *Id.* at 15-16.

<sup>23</sup> *Id.* at 58-61.

<sup>24</sup> *Id.*

<sup>25</sup> *Id.* at 63-67.

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ruling of the Court of Appeals is two-fold: first is on procedural law—*whether or not the Court of Appeals erred in dismissing the petition outright for the petitioner's failure to file its petition for review within the time prescribed by the Court of Appeals*; and second is on substantive law—*whether or not the ODG was correct in refusing to register the applicant mark for being identical and confusingly similar with the cited marks already registered with the IPO*.

### The Court's Ruling

After a careful perusal of the arguments presented and the evidence submitted, the Court finds no merit in the petition.

*First, on the procedural issue:*

In *Bañez vs. Social Security System*,<sup>26</sup> the Court had occasion to reiterate that appeal is not a constitutional right, but a mere statutory privilege. Hence, parties who seek to avail themselves of it must comply with the statutes or rules allowing it.<sup>27</sup> The rule is that failure to file or perfect an appeal within the reglementary period will make the judgment final and executory by operation of law. Perfection of an appeal within the statutory or reglementary period is not only mandatory but also jurisdictional; failure to do so renders the questioned decision/resolution final and executory, and deprives the appellate court of jurisdiction to alter the decision/resolution, much less to entertain the appeal.<sup>28</sup>

In connection herewith, Section 4, Rule 43 of the Rules of Court is clear. The appeal shall be taken within fifteen (15) days from the notice of the award, judgment, final order or resolution, or from the date of its last publication, if publication is required by law for its effectivity, or of the denial of petitioner's motion for new trial or reconsideration duly filed in accordance with the governing law of the court or agency *a quo*.<sup>29</sup>

More, a litigant is allowed to file only one (1) motion for reconsideration, subject to the payment of the full amount of the docket fee prior to the expiration of the reglementary period. Beyond this, another motion for extension of time may be granted *but only for the most*

<sup>26</sup> 739 Phil. 148 (2014).

<sup>27</sup> *Id.* at 154, citing *Calipay v. NLRC*, 640 Phil. 458, 466 (2010).

<sup>28</sup> *Id.*, citing *Miel v. Malindog*, 598 Phil. 594, 606 (2009). See also *Sapitan v. JB Line Bicol Express, Inc., Lao Huan Ling/Baritua*, 562 Phil. 817, 831-832 (2007); *Sehwani Inc. and/or Benita's Frites, Inc. v. IN-N-OUT Burger, Inc.*, 562 Phil. 217, 227 (2007).

<sup>29</sup> Rules of Court (1997), Rule 43, Sec. 4.

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*compelling reasons.*<sup>30</sup>

Again, in *Bañez*, the Court ruled that filing of an appeal beyond the reglementary period may, under meritorious cases, be excused if the barring of the appeal would be inequitable and unjust in light of certain circumstances therein.<sup>31</sup> While there are instances when the Court has relaxed the governing periods of appeal in order to serve substantial justice, this was done only in exceptional cases.<sup>32</sup>

In this case, no exceptional circumstance exists.

In asking the Court of Appeals for a second extension to file its petition for review, the petitioner merely cited as its excuse the following: (1) heavy pressure of other professional work; and (2) attendance of the lawyers in charge in an international lawyers' conference. It said:

However, due to the heavy pressure of other equally important professional work coupled with intervening delays and the fact of the necessary attendance of the lawyers in charge of the case in an international lawyer's (sic) conference, the undersigned counsel will need more time to review and finalize petitioner ABS-CBN Publishing, Inc.'s *Petition for Review*.<sup>33</sup>

As the Court has ruled upon in a number of cases, a lawyer has the responsibility of monitoring and keeping track of the period of time left to file pleadings, and to see to it that said pleadings are filed before the lapse of the period.<sup>34</sup> Personal obligations and heavy workload do not excuse a lawyer from complying with his obligations particularly in timely filing the pleadings required by the Court.<sup>35</sup> Indeed, if the failure of the petitioner's counsel to cope with his heavy workload should be considered a valid justification to sidestep the reglementary period, there would be no end to litigations so long as counsel had not been sufficiently diligent or experienced.<sup>36</sup>

Further, the petitioner should not assume that its motion for extension of time would be granted by the appellate court. Otherwise, the Court will be setting a dangerous precedent where all litigants will assume a favorable

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<sup>30</sup> Id.

<sup>31</sup> Id., citing *Philippine National Bank v. Court of Appeals*, 316 Phil. 371, 384 (1995).

<sup>32</sup> *Boardwalk Business Ventures v. Villareal*, 708 Phil. 443, 454-456 (2013).

<sup>33</sup> *Rollo*, p. 630.

<sup>34</sup> *Hernandez v. Agoncillo*, 697 Phil. 459, 469-470 (2012), citing *LTS Philippines Corporation v. Maliwat*, 489 Phil. 230, 235 (2005).

<sup>35</sup> *Iloilo Jar Corporation v. COMGLASCO Corporation Aguila Glass*, GR. No. 219509, January 18, 2017.

<sup>36</sup> Id.

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outcome of a motion which is addressed to the discretion of the courts based on the prevailing circumstances of the case.

To be sure, there is a dearth of jurisprudence that upholds the Court of Appeals' power of discretion in disallowing a second extension of fifteen (15) days. As correctly cited by the appellate court, *Spouses Dycoco vs. Court of Appeals*<sup>37</sup> explains that the Court of Appeals could not be faulted for merely applying the rules, and that a dismissal of a petition in accordance therewith is discretion duly exercised, and not misused or abused.<sup>38</sup>

Based on the foregoing, and for the guidance of both the bench and the bar, the rule as it currently stands is that, in the absence of, or in the event of a party's failure to receive, any resolution from the courts which specifically grants a motion for extension of time to file the necessary pleading, the parties are required to abide by the reglementary period provided for in the Rules of Court. Failure to comply thereto would result to a dismissal or denial of the pleadings for being filed beyond the reglementary period.

In the case at hand, the Court of Appeals was correct in dismissing the petition. The petitioner could not assume that its motion would be granted, especially in light of its flimsy excuse for asking the second extension of time to file its petition for review.

On this ground alone, the dismissal of the current petition for review is justifiable. The Court reiterates its warning in the case of *Hernandez vs. Agoncillo*:<sup>39</sup>

Time and again, this Court has cautioned lawyers to handle only as many cases as they can efficiently handle. The zeal and fidelity demanded of a lawyer to his client's cause require that not only should he be qualified to handle a legal matter, he must also prepare adequately and give appropriate attention to his legal work. Since a client is, as a rule, bound by the acts of his counsel, a lawyer, once he agrees to take a case, should undertake the task with dedication and care. This Court frowns upon a lawyer's practice of repeatedly seeking extensions of time to file pleadings and thereafter simply letting the period lapse without submitting any pleading or even any explanation or manifestation for his omission. **Failure of a lawyer to seasonably file a pleading constitutes inexcusable negligence on his part.**<sup>40</sup> (Emphasis and underscoring supplied)

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<sup>37</sup> 715 Phil. 550 (2013).

<sup>38</sup> Id. at 563.

<sup>39</sup> Supra, note 34.

<sup>40</sup> Id. at 470-471.

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That said, however, even on the merits, the petition still fails to convince.

*Second, on the substantive issue:*

According to Section 123.1(d) of the Intellectual Property Code of the Philippines (IPC),<sup>41</sup> a mark cannot be registered if it is “identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date,” in respect of the following: (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.<sup>42</sup>

To determine whether a mark is to be considered as “identical” or that which is confusingly similar with that of another, the Court has developed two (2) tests: the dominancy and holistic tests. While the Court has time and again ruled that the application of the tests is on a case to case basis, upon the passage of the IPC, the trend has been to veer away from the usage of the holistic test and to focus more on the usage of the dominancy test. As stated by the Court in the case of *McDonald's Corporation vs. L.C. Big Mak Burger, Inc.*,<sup>43</sup> the “test of dominancy 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 xxx or a dominant feature thereof.’”<sup>44</sup> This is rightly so because Sec. 155.1 provides that:

SECTION 155. Remedies; Infringement. — Any person who shall, without the consent of the owner of the registered mark:

155.1. Use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark or the same container **or a dominant feature thereof** in connection with the sale, offering for sale, distribution, advertising of any goods or services including other preparatory steps necessary to carry out the sale of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or x x x. (Emphasis and underscoring supplied)

In using this test, focus is to be given to the dominant features of the marks in question. In the 1954 case of *Co Tiong Sa vs. Director of Patents*,<sup>45</sup> the Court, in using the dominancy test, taught that:

But differences of variations in the details of one trademark and of another

<sup>41</sup> Rep. Act No. 8293 (1997), as amended.

<sup>42</sup> Id., Sec. 123.1(d).

<sup>43</sup> 480 Phil. 402 (2004).

<sup>44</sup> Id. at 435.

<sup>45</sup> 95 Phil. 1 (1954).

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are not the legally accepted tests of similarity in trademarks. It has been consistently held that the question of infringement of a trademark is to be determined by the test of dominancy. **Similarity in size, form, and color, while relevant, is not conclusive. If the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place.**<sup>46</sup> (Emphasis and underscoring supplied)

The Court, in *Skechers, U.S.A., Inc. vs. Inter Pacific Industrial Trading Corp.*,<sup>47</sup> and in once again using the dominancy test, reiterated *Del Monte Corporation vs. Court of Appeals*<sup>48</sup> in saying that “the defendants in cases of infringement do not normally copy but only make colorable changes.”<sup>49</sup> The Court emphasized that “the most successful form of copying is to employ enough points of similarity to confuse the public, with enough points of difference to confuse the courts.”<sup>50</sup>

In other words, in committing the infringing act, the infringer merely introduces negligible changes in an already registered mark, and then banks on these slight differences to state that there was no identity or confusing similarity, which would result in no infringement. This kind of act, which leads to confusion in the eyes of the public, is exactly the evil that the dominancy test refuses to accept. The small deviations from a registered mark are insufficient to remove the applicant mark from the ambit of infringement.

In the present case, the dominant feature of the applicant mark is the word “METRO” which is identical, *both visually and aurally*, to the cited marks already registered with the IPO. As held by the ODG—and correctly at that—

x x x **there is no dispute that the subject and cited marks share the same dominant word, “Metro”.** (sic) Even if, as the Appellant (petitioner herein) points out, the second cited mark owned by Metro International contains an accompanying device, and the third cited mark contains the terms “Philippine Daily Inquirer”, (sic) **the dominant feature of the subject and cited marks is still clearly the word “Metro”, (sic) spelled and pronounced in exactly the same way.** The identity between the marks would indubitably result in confusion of origin as well as goods.<sup>51</sup> (Emphasis and underscoring supplied, citations omitted)

Also, greater relevance is to be accorded to the finding of Examiner

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<sup>46</sup> Id. at 4.

<sup>47</sup> 662 Phil. 11 (2011).

<sup>48</sup> 260 Phil. 435 (1990).

<sup>49</sup> Id. at 443.

<sup>50</sup> Id.

<sup>51</sup> *Rollo*, Vol. I, p. 108.

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Icban on the confusing similarity between, if not the total identity of, the applicant and cited marks. Examiner Icban, in reiterating with finality her earlier findings, said that the applicant and cited marks are “*the same in sound, spelling, meaning, overall commercial impression, covers substantially the same goods and flows through the same channel of trade,*” which leads to no other conclusion than that “confusion as to the source of origin is likely to occur.”<sup>52</sup> This is also the tenor of Examiner Icban’s “Final Rejection” of the application, which stated that:

After an examination of the application, the undersigned IPRS has determined that the mark subject of the application cannot be registered because it is identical with the cited marks METRO with Regn. No. 42000002584 and Regn. No. 42000003811. METRO being dominant word (sic) among the marks causes remarkable similarity in sound, spelling, meaning, connotation, overall commercial impression, covers identical goods and flows through the same channel of trade. **The concurrent use by the parties of the word METRO is likely to cause confusion among purchasers as well as confusion of business or origin hence, registration of this subject application is proscribed under R.A. 8293, Sec. 123.1(d).**<sup>53</sup> (Emphasis and underscoring supplied)

The findings of Examiner Icban, reviewed first by the Director of the Bureau of Trademarks, and again by the Director General of the IPO, are the result of a judicious study of the case by no less than the government agency duly empowered to examine applications for the registration of marks.<sup>54</sup> These findings deserve great respect from the Court. Absent any strong justification for the reversal thereof—as in this case—the Court shall not reverse and set aside the same. As such, the prior findings remain: the applicant mark, “METRO,” is identical to and confusingly similar with the other cited marks already registered. By authority of the Sec. 123.1(d) of the IPC, the applicant mark cannot be registered. The ODG is correct in upholding the Decision of both the Director of the Bureau of Trademarks and Examiner Icban.

This ruling stands despite the specious arguments presented by the petitioner in the current petition.

The petitioner asserts that it has a vested right over the applicant mark because Metro Media Publishers, Inc. (Metro Media), the corporation from which the petitioner acquired the applicant mark, first applied for the registration of the same under the old Trademark Law,<sup>55</sup> and since then, actually used the applicant mark in commerce. The petitioner belabors the

<sup>52</sup> *Rollo*, Vol. I, p. 31.

<sup>53</sup> *Rollo*, Vol. I, p. 446.

<sup>54</sup> Rep. Act No. 8293 (1997), as amended, Sec. 5(b).

<sup>55</sup> Rep. Act No. 166 (1947), as amended.



point that under the old Trademark law, actual use in commerce is a pre-requisite to the acquisition of ownership over a trademark and a trade name.<sup>56</sup> The petitioner even went on further in asserting that its actual use of the applicant mark enabled it to automatically acquire trademark rights, which should have extended even upon the promulgation of the IPC in 1998.

Two things must be said of this argument.

First, there is no question that the petitioner's predecessor already applied for the registration of the applicant mark "METRO" on November 3, 1994 under Class 16 of the Nice classification. It was docketed as Application No. 4-1994-096162.<sup>57</sup> There is likewise no question that as early as 1989, Metro Media has already used the applicant mark "METRO" in its magazine publication. At that point, Metro Media exercised all the rights conferred by law to a trademark applicant.

Second, however, the petitioner itself admitted in its petition that its application/registration with the IPO under Application No. 4-1994-096162 was already "*deemed abandoned*."<sup>58</sup>

While it is quite noticeable that the petitioner failed to discuss the implications of this abandonment, it remains a fact that once a trademark is considered abandoned, the protection accorded by the IPC, or in this case the old Trademark Law, is also withdrawn. The petitioner, in allowing this abandonment, cannot now come before the Court to cry foul if another entity has, in the time that it has abandoned its trademark and in full cognizance of the IPC and the IPO rules, registered its own.

In fact, in *Birkenstock Orthopaedie GMBH and Co. KG. vs. Philippine Shoe Expo Marketing Corporation*,<sup>59</sup> the Court accorded no right at all to a trademark owner whose trademark was abandoned for failure to file the declaration of actual use as required by Sec. 12 of the old Trademark Law.<sup>60</sup> In *Mattel, Inc. vs. Francisco*,<sup>61</sup> the Court rendered a petition as moot and academic because the cited mark has effectively been abandoned for the

<sup>56</sup> *Rollo*, Vol. I, p. 27.

<sup>57</sup> *Rollo*, Vol. I, p. 10.

<sup>58</sup> *Id.*

<sup>59</sup> 721 Phil. 867 (2013).

<sup>60</sup> Section 12. Duration. – Each certificate of registration shall remain in force for twenty years: Provided, That registrations under the provisions of this Act shall be cancelled by the Director, unless within one year following the fifth, tenth and fifteenth anniversaries of the date of issue of the certificate of registration, the registrant shall file in the Patent Office an affidavit showing that the mark or trade-name is still in use or showing that its non-use is due to special circumstance which excuse such non-use and is not due to any intention to abandon the same, and pay the required fee.

The Director shall notify the registrant who files the above- prescribed affidavits of his acceptance or refusal thereof and, if a refusal, the reasons therefor.

<sup>61</sup> 582 Phil. 492, 499 (2008).

*Meyer*

non-filing of a declaration of actual use, and thus presents no hindrance to the registration of the applicant mark.

Also, as correctly pointed out by the ODG, this abandonment is the very reason why the petitioner lost its rights over its trademark, and that it is also the reason why, after twenty years (20) from the initial application and after actual use of the applicant mark, the petitioner once again came before the IPO to apply for registration. The ODG said:

Records show that this is the very situation the [petitioner] finds itself in. **It has acquired no right under the old trademark law since its original application way back 1994 has been deemed abandoned, which is the reason why it filed the current application in 2004 under the new law.** Clearly, then, if [petitioner] has acquired no right under R.A. 166, it possesses no existing right that ought to be preserved by virtue of Section 236 of the IP Code.<sup>62</sup> (Emphasis and underscoring supplied)

Anent the petitioner's argument that "confusion between the marks is highly unlikely,"<sup>63</sup> the petitioner asserts that the applicant mark "METRO" (word) is covered by class 16 of the Nice classification under "magazines," the copies of which are sold in "numerous retail outlets in the Philippines,"<sup>64</sup> whereas the cited mark "METRO" (word) is used in the Philippines only in the internet through its website and does not have any printed circulation.<sup>65</sup>

But like the petitioner's earlier argument, this does not hold water.

Section 3, Rule 18 of the Rules of Procedure for Intellectual Property Cases<sup>66</sup> provides for the legal presumption that there is likelihood of confusion if an identical mark is used for identical goods. The provision states:

**SEC. 3. *Presumption of likelihood of confusion.*** – Likelihood of confusion shall be presumed in case an identical sign or mark is used for identical goods or services.

In the present case, the applicant mark is classified under "magazines," which is found in class 16 of the Nice classification. A perusal of the records would reveal, however, that the cited marks "METRO" (word) and "METRO" (logo) are also both classified under magazines. In fact, Examiner Icban found that the cited marks were used on the following

<sup>62</sup> *Rollo*, Vol. I, p. 109.

<sup>63</sup> *Id.* at 37.

<sup>64</sup> *Id.* at 40.

<sup>65</sup> *Id.*

<sup>66</sup> A.M. No. 10-3-10-SC (2011).



classification of goods:

Paper, cardboard and goods made from these materials, not included in other classes; newspapers, magazines, printed matter and other printed publications; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastics materials for packaging (not included in other classes); playing cards; printers types; printing blocks.<sup>67</sup> (Emphasis and underscoring supplied)

Thus, the presumption arises.

Even then, it must be emphasized that absolute certainty of confusion or even actual confusion is not required to refuse registration. Indeed, it is the mere likelihood of confusion that provides the impetus to accord protection to trademarks already registered with the IPO. The Court cannot emphasize enough that the cited marks “METRO” (word) and “METRO” (logo) are identical with the registrant mark “METRO” both in spelling and in sound. In fact, it is the same exact word. Considering that both marks are used in goods which are classified as magazines, it requires no stretch of imagination that a likelihood of confusion may occur. Again, the Court points to the finding of Examiner Icban which was reviewed and upheld twice: one by the Director of the Bureau of Trademarks and another by the Director General of the IPO.

As a final point, the petitioner, in the pleadings submitted, manifested that the cited marks are no longer valid. It said that: (1) the cited mark “METRO” (logo) was removed from the IPO register for non-use, citing the IPO online database,<sup>68</sup> (2) the cited mark “INQUIRER METRO,” while valid according to the IPO online database, was cancelled according to a certain certification from the Bureau of Trademarks of the IPO; and (3) the cited mark “METRO” (word) already expired on June 26, 2016 according to yet another certification from the IPO.

A perusal of the records, however, would reveal that these alleged de-registration and cancellation all allegedly occurred after the ODG has already ruled on the instant case. Considering that the Court is not a trier of facts, the Court could therefore not make a determination of the validity and accuracy of the statements made in the petitioner’s manifestation. As such, the Court, through the limited facts extant in the records, could not give weight and credence thereto.

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<sup>67</sup> *Rollo*, Vol. I, p. 417.

<sup>68</sup> *Id.* at 38, citing Annex “R” of the petition.

*Meyer*

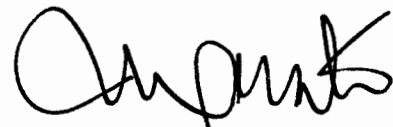
Nonetheless, not all is lost for the petitioner. Should it be true that the cited marks, which were the basis of the IPO in refusing to register the applicant mark, were already de-registered and cancelled, nothing prevents the petitioner from once again applying for the registration of the applicant mark before the IPO.

**WHEREFORE**, premises considered, the Resolutions of the Court of Appeals dated May 20, 2014 and April 15, 2015, are hereby **AFFIRMED** without prejudice to the petitioner's refiling of its application for the registration of the trademark "METRO" before the Intellectual Property Office.

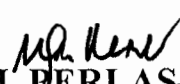
**SO ORDERED.**

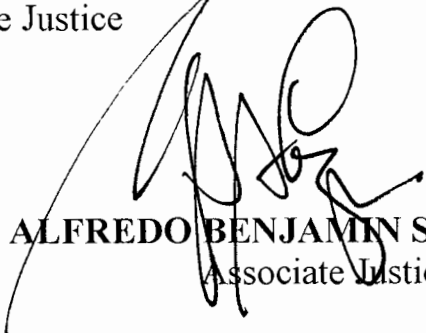
  
**ANDRES B. REYES, JR.**  
Associate Justice

**WE CONCUR:**

  
**DIOSDADO M. PERALTA**  
Associate Justice  
Acting Chairperson

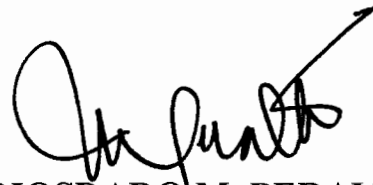
  
**MARIANO C. DEL CASTILLO**  
Associate Justice

  
**ESTELA M. PERLAS-BERNABE**  
Associate Justice

  
**ALFREDO BENJAMIN S. CAGUIOA**  
Associate Justice

## ATTESTATION

I attest that the conclusions in the above Decision had been reached in consultation before the case was assigned to the writer of the opinion of the Court's Division.



**DIOSDADO M. PERALTA**  
Associate Justice, Acting Chairperson

## CERTIFICATION

Pursuant to Section 13, Article VIII of the Constitution, and the Division Chairperson's Attestation, I hereby certify that the conclusions in the above Decision had been reached in consultation before the case was assigned to the writer of the opinion of the Court's Division.



**ANTONIO T. CARPIO**  
Senior Associate Justice  
(Per Section 12, R.A. No. 296 The  
Judiciary Act of 1948, as amended)