ADVANCE MAGAZINE PUBLISHERS, INC	}	INTER PARTES CASE NO. 14-2006-00021
Opposer	}	Opposition to:
-versus-	}	Serial No. : 4-1999-00897 Date Filed : 09 February 1999 Trademark : "VOGUE"
TE BI, *Respondent-Applicant*,	}	
x----------x		Decision No. 2006 – 73

DECISION

This is an Opposition to the registration of the mark "VOGUE" bearing Serial No. 4-1999-000897 being used for a retail store for men's and women's clothing filed on February 9, 1999, which application was published in the Intellectual Property Office's e-Gazette and officially released on October 28, 2005.

The Respondent-Applicant is TEBI with address at 80 Atis Road, Malabon City, Metro Manila.

The Opposer in the instant opposition is ADVANCE MAGAZINE PUBLISHERS, INC., a corporation duly organized under the laws of the State of New York, United States of America with principal address at Four Times Square, New York, United States of America.

The grounds for opposition are as follows:

> "1. Opposer is the registered owner of the trademark VOGUE in the Philippines under Registration No. 50122 issued by the Bureau of Patents, Trademarks and Technology Transfer (BPTTT) on March 31m 1991, and used on prints, publications and books. Opposer has since expanded its use of its VOGUE trademark to other goods and services worldwide. Opposer is the first user of the trademark VOGUE in the United States of America since 1892, and in the Philippines and other countries long before Respondent-Applicant appropriated the same mark VOGUE for the clothing retail store services.
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> "2. Respondent-Applicant's trademark VOGUE is identical to Opposer's trademark VOGUE as to be likely, when applied to or used in connection with the clothing retail store services of Respondent-Applicant, to cause confusion, mistake and deception on the part of the purchasing public by misleading them into thinking that Respondent-Applicant's clothing retail store services are sponsored or licensed by Opposer.
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> "3. The registration and use by Respondent-Applicant of the trademark VOGUE will diminish the distinctiveness and dilute the goodwill of Opposer's trademark VOGUE, which is an arbitrary trademark when applied to Opposer's products.
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> "4. Respondent-Applicant adopted the trademark VOGUE on the clothing retail store services with the obvious intention of misleading the public into believing that its clothing retail store services are sponsored by Opposer, which has been identified in

the trade and by consumers as the magazine bearing the trademark VOGUE, which is the preeminent authority on fashion.

"5. The approval of Respondent-Applicant's trademark VOGUE is based on the representation that it is the originator, true owner and first user of the trademark, which was merely copied/derived from Opposer's VOGUE trademark.

"6. Opposer is the first user of the trademark VOGUE in the Philippine commerce and elsewhere, having utilized extensively for over a century. Opposer's publications and books bearing the trademark VIGUE are dedicated to fashion, costume and accessories, showcasing the latest and finest trends in clothing and accessories. Respondent-Applicant's use of the same mark as the name of the retail store for its own goods is likely to cause consumer confusions as to the origin of said goods.

"7. Respondent-Applicant's appropriation and use of the trademark VOGUE infringe upon Opposer's exclusive right to use the trademark VOGUE, which is a well-known trademark protected under Section 37 of the old Trademark Law, 147 and 165 (2) (a) of the Intellectual Property Code ("IP Code"), Article 6bis of the Paris Convention and Article 16 of the Agreement on Trade Related Aspects of Intellectual Property Rights to which the Philippines and the United States of America adhere. Although Opposer's trademark VOGUE was registered under the regime of the old law, Republic Act No. 166, the protection granted by the IP Code explicitly extends to trademarks registered under Republic Act No. 166 pursuant to Section 239.2 of the IP Code, which now categorically protects well-known trademarks like VOGUE.

"8. The registration of the trademark VOGUE in the name of the Respondent-Applicant is contrary to other provisions of the IP Code, particularly in light of Section 123.1 (f) which expands the protection of well-known marks registered in the Philippines to cover goods and services which are not similar to those with respect to which the trademark has been applied for where, as in this case, the use of the mark will indicate a connection between the clothing retails store services of Respondent-Applicant, and those of the owner of the registered mark, a magazine focused on apparel and accessories.

To support the opposition, Opposer relied on the following facts:

"1. Opposer adopted and has been using the trademark VOGUE for its goods since 1989, decades before Respondent-Applicant's unauthorized appropriation of the trademark VOGUE. Opposer has been commercially using the trademark VOGUE for more than a century before the appropriation and the filing of the application for the registration of the trademark VOGUE by Respondent-Applicant.

"2. Opposer is the first user of the trademark VOGUE. Opposer has also used and registered or applied for the registration of the trademark VOGUE in many countries worldwide.

"3. Opposer's trademark VOGUE is an arbitrary and well-known trademark and is entitled to broad legal protection against unauthorized users like Respondent-Applicant who has appropriated the identical trademark VOGUE for its own clothing retail store services.

"4. Opposer is the first user of the trademark VOGUE for the above-mentioned goods. Respondent-Applicant has appropriated the trademark VOGUE for the obvious purpose of capitalizing upon the renown of Opposer's self-promoting trademark by misleading the public into believing that its clothing retail store services are sponsored by Opposer.

"5. The registration and use of a confusingly similar trademark by the Respondent-Applicant will tend to deceive and/or confuse purchasers into believing that Respondent-Applicant's clothing retail store services emanate from or under the sponsorship of Opposer and damage Opposer's interest for the following reasons:

i) The trademarks are identical.

ii) Since both trademark are used to promote and sell clothing and other personal accessories through a magazine in the case of Opposer and a retail store in the case of Respondent-Applicant, this opposition is covered by Section 147.1, which provides that "in case of the use of an identical sign of identical goods or services, a likelihood of confusion shall be presumed."

iii) Respondent-Applicant's unauthorized appropriation and use of VOGUE will dilute its reputation and goodwill among consumers.

iv) Respondent-Applicant used VOGUE on its clothing retail store services as a self-promoting trademark to gain public acceptability for its products through its association with Opposer's popular VOGUE trademark, which is used on books and publication devoted principally to fashion, clothing and accessories.

v) The services of which the Respondent-Applicant uses the VOGUE trademark is in the same field of industry as that of the goods on which Opposer's mark is used, i.e., the clothing and fashion industry, and consequently advertised to consumer through the same channels of trade.

Respondent-Applicant intends to trade, and is trading on, Opposer's goodwill.

"6. The registration and use of an identical trademark by Respondent-Applicant will diminish the distinctiveness and dilute the goodwill of Opposer's trademark.

On March 6, 2006, a Notice to Answer was sent to the Respondent-Applicant through registered mail with Return Card bearing NO. C-1654-A, which was duly received by the Respondent-Applicant on March 20, 2006.

The Respondent-Applicant, despite having received the Notice to Answer did not file the required answer within the period to do so and in the form required under Section 8 and Subsection 8.1 of Office Order No. 79, Series of 2005. Hence, for failure of Respondent-Applicant to file his answer within the reglementary period allowed, he is *considered* as having *waived* his right to file his affidavit and the documents he intended to submit. Consequently, this case is considered submitted for decision on the basis of the documents/evidences submitted.

The only issue to be resolved in this case is:

> WHETHER OR NOT RESPONDENT-APPLICANT IS ENTITLED TO THE REGISTRATION OF THE TRADEMARK "VOGUE".

The applicable provision of law is Section 123.1 (d) of Republic Act No. 8293 of the Intellectual Property Code of the Philippines which provides:

> "Section 123. *Registrability* –
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> 123.1 – A mark cannot be registered if it:
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> (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:
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> (i) The same goods or services; or
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> (ii) Closely related goods or services; or
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> (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion.

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademarks said to be infringed (87 C.J.S., pp.288-291). Some such factors as sound, appearance form, style, shape, size, format, color, ideas connoted by the marks; the meaning, spelling and pronunciation of the word used; and the setting in which the words appear may be considered (87 C.J.S. pp. 291-292). For indeed, trademark infringement is a form of unfair competition (Clarke vs. Manila Candy Co., 36 Phil. 100, 106; Co Tiong Sa vs. Director of Patents, 95 Phils., 1, 4)

The trademark of the Respondent-Applicant is "VOGUE" and the Opposer's mark is likewise "VOGUE". The competing marks are practically the same in all aspect. The *spelling, pronunciation,* as well as *appearance* are the same. In other words, *identical* to each other.

One important point to be emphasized is the fact that the Opposer in the instant opposition is the registered owner of the trademark "VOGUE" in the Philippines under Registration No. 50122, issued by the Bureau of Patents, Trademarks and Technology Transfer (BPTTT) on *March 13, 1991.* Opposer is the *first user* of the mark in the United States of America since 1892. It obtained certificate of registrations of the mark "VOGUE" in many countries of the world. The VOGUE magazines are published circulated worldwide.

The Opposer's publications and books bearing the trademark "VOGUE" are dedicated to *fashion, costume* and *accessories, showcasing* the latest and finest trends in clothing and accessories.

In this particular case, although the Respondent-Applicant's mark is being used on his clothing retail store services still it would mislead the public into believing that his clothing retail store services is sponsored by the Opposer because the goods and services for which VOGUE is being user are related/connected to each other.

The Opposer's mark VOGUE has been used for so many years in many countries of the world, including the Philippines. The publications and books, magazines and other printed materials bearing the mark "VOGUE" are dedicated to fashions, costumes and accessories, showcasing the finest trends in clothing and accessories.

It is truly difficult and unthinkable to understand why, of the millions of terms and combinations of letters and designs available, the herein Respondent-Applicant had to choose exactly the mark "VOGUE" of the Opposer, if there was no intent to take advantage of the goodwill of the Opposer's mark.

In connection with the use of a confusingly similar or identical mark, it has been ruled thus:

> "Those who desire to distinguish their goods from the goods of another have a broad field from which to select a trademark for their wares and there is no such poverty in the English language or paucity of signs, symbols, numerals, etc., as to justify one who really wishes to distinguish his products from those of all others entering the twilight zone of a filed already appropriated by another." (Weco Products Co., vs. Milton Ray Co., 143 F. 2d, 985, 32 C.C.P.A. Patents 1214)
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> "Why of the million of terms and combinations of letters and designs available, the appellee had to choose those closely similar to another trademark if there was no intent to take advantage of the goodwill generated by the other mark." (American Wire & Cable Co., vs. Director of Patents, 31 SCRA 544)
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> "Why with all the birds on the air, and all the fishes in the sea, and all the animals on the face of the earth to choose from, the defendant company (Manila Candy Co.) elected two roosters as its trademark, although its directors must have been well aware of the long and continued use of a rooster by plaintiff with the sale and achievement of its goods? x x x a cat, a dog, a carabao, a shark or an eagle stamped upon the container in which candies are sold would serve as well as a rooster for the product of defendant's factory. Why did defendant select two roosters as its trademark?" (Clarke vs. Manila candy Co., 36 Phil. 100)

From the evidences presented, this Bureau finds that the Respondent-Applicant's trademark VOGUE is confusingly similar to Opposer's VOGUE trademark and that the Opposer is the prior user of said trademark in the Philippines.

On the other hand, Respondent-Applicant failed to substantiate his claim over the mark "VOGUE" as he did not submit any evidence nor file his answer to the Verified Notice of Opposition.

Therefore, considering the evidence presented, it is safe to conclude that Opposer has validly proven its ownership of the trademark "VOGUE".

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Consequently, application bearing Serial No. 4-1999-000897 for the mark "VOGUE" filed on February 9, 1999 by TE BI is hereby REJECTED.

Let the filewrapper of the trademark “VOGUE” subject matter of this case be forwarded to the Bureau of Trademarks for appropriate action in accordance with this DECISION.

SO ORDERED.

Makati City, 31 July 2006.

ESTRELLITA BELTRAN ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office