

ADVANCE MAGAZINE
PUBLISHERS, INC.,
Opposer-Appellant,

-versus-

MONICA CUYA,
Respondent-Appellee.

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Appeal No. 14-09-30

Inter Partes Case No. 14-2008-00027
Opposition to:
Application No. 4-2006-008955
Date Filed: 15 August 2006
Trademark: VOGUE VIGOR VALUE

DECISION

Advance Magazine Publishers, Inc. ("Appellant") appeals the decision of the Director of the Bureau of Legal Affairs ("Director") denying the Appellant's opposition to the registration of the mark "VOGUE VALUE VIGOR V3" in favor of Monica Cuya ("Appellee").

Records show that on 15 August 2006, the Appellee filed Trademark Application No. 4-2006-008955 for VOGUE VALUE VIGOR V3 for use on goods falling under Classes 14, 18 and 25 of the Nice Classification,¹ namely: Class 14: fancy jewelry, Class 18: bags and luggages, and Class 25: shirts, jackets, jeans, pants, underwears, belts, shoes, socks and scarf. The application was published in the Intellectual Property Office Electronics Gazette for Trademarks on 11 October 2007. On 07 February 2008, die Appellant filed a "NOTICE OF OPPOSITION" alleging the following:

1. It is the registered owner of the mark "VOGUE" in the Philippines under Reg. No. 50122 issued on 13 March 1991 and used on prints, publications and books;
2. It has expanded the use of VOGUE to other goods and services including those in Classes 2, 3, 9, 10, 14, 18, 20, 21, 22, 23, 24, 25, 26, 27, 28, 31, 35, 36, 38, 39, 41, 42, 43, 44, and 45 which are commercially sold worldwide and for which the mark has been registered;
3. It is the first user of VOGUE in the United States of America ("U.S.A.") in 1892 and in the Philippines and other countries long before the Appellee appropriated VOGUE VIGOR VALUE V3 for her goods and products; it has also registered and/or applied for the registration of VOGUE in man), countries worldwide;
4. VOGUE VIGOR VALUE V3 makes use of the Appellant's mark VOGUE as its dominant feature, contrary to Sec. 155.1 of the Intellectual Property Code of the Philippines ("IP Code"); the IP Code incorporates the dominant feature test that has been defined and used by the Supreme Court of the Philippines in many intellectual property rights cases;
5. Despite the addition of the other words "Vigor", "Value" and "V3", the focal point of the Appellee's mark is still the word VOGUE, especially since it is the first word appearing in the trademark;
6. The use of the Appellant's mark which is well-known in clothing and fashion industry, when applied to or used in connection with die clothing and fashion apparel of the Appellee is likely to cause confusion, mistake and deception on the part of the purchasing public by misleading them into thinking that the Appellee's goods are sponsored or licensed by the Appellant;
7. The Appellee intends to trade and is trading on the Appellant's goodwill and the registration and use by the Appellee of VOGUE VIGOR VALUE V3 will diminish the distinctiveness and dilute the goodwill of VOGUE which is an arbitrary and well-known

mark that is entitled to broad legal protection against unauthorized users like the Appellee;

8. The Appellee adopted VOGUE on its clothing apparel and fashion accessories with the obvious intention of misleading the public into believing that these are sponsored by the Appellant, which has been identified in the trade and by consumers as the magazine bearing the mark VOGUE which is the preeminent authority on fashion;
9. The approval of VOGUE VIGOR VALUE V3 is based on the representation that the Appellee is the originator, true owner and first user of this mark when in fact the dominant feature of such mark, the word VOGUE, was merely copied/derived from the Appellant's mark;
10. It is the first user of VOGUE in Philippine commerce and elsewhere, having utilized the same extensively for over a century, the Appellant's publications and books bearing the mark VOGUE are dedicated to fashion, costume and accessories, showcasing the latest and finest trends in clothing and accessories; the Appellee's use of VOGUE VIGOR VALUE V3, capitalizing on the word VOGUE as the dominant feature, is likely to cause consumer confusion as to the origin of said goods;
11. The Appellee used VOGUE VIGOR VALUE V3 on its clothing apparel and fashion accessories as a self-promoting trademark to gain public acceptability for its products through its association with the Appellant's VOGUE which is used on books and publications devoted principally to fashion, clothing and accessories;
12. The services for which the Appellee use the VOGUE VIGOR VALUE V3 is in the same field or industry as that of the goods on which the Appellant's mark is used, i.e., the clothing and fashion industry and consequently is advertised to consumers through the same channels of trade;
13. The Appellee's appropriation and use of VOGUE VIGOR VALUE V3 infringes upon the Appellant's exclusive right to use VOGUE, which is a well-known mark protected under Sec. 37 of the old Trademark Law, Sections 147 and 165(2)(a) of the IP Code, Article 6bis of the Paris Convention for the Protection of Industrial Property, and Article 16 of the Agreement on Trade-Related Aspects of Intellectual Property Rights to which the Philippines and the U.S. adhere; although VOGUE was registered under the regime of the old law, Rep. Act No. 166, ("RA 166") the protection granted by the IP Code explicitly extends to trademarks registered under RA 166 pursuant to Sec. 239.2 of the IP Code; and
14. The registration of VOGUE VIGOR VALUE V3 in the name of the Appellee is contrary to the other provisions of the IP Code, particularly in Sec. 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 mark has been applied for where, as in this case, the use of the mark will indicate a connection between the goods of the Appellee, jewelries, bags and clothing, and those of the owner of the registered mark, magazine focused on apparel and accessories.

The Appellant submitted the following evidence to support its opposition:

1. Notice of Opposition, dated 04 January 2008;²
2. Special Power of Attorney, executed on 24 January 2008;³
3. Affidavit of John W. Bellando, executed on 28 January 2008;⁴
4. Foreign Circulation Reports for VOGUE;⁵
5. Copy of Country List Report for VOGUE;⁶
6. Certificate of registrations (foreign) for VOGUE;⁷
7. Cert. of Reg. No. 50122 for VOGUE;⁸

8. Copies of the Appellant's magazines;⁹
9. Decision No. 2006-73, dated 31 July 2006;¹⁰ and
10. Audit Bureau of Circulation for VOGUE.¹¹

The Appellee filed its "VERIFIED ANSWER" on 27 June 2008 alleging the following:

1. The opposition was executed by the Appellant's alleged Vice President without showing proof of authority from the Appellant;
2. It applied for registration of VOGUE VIGOR VALUE V3 for garments and accessories, particularly, jackets, jeans, belts, shoes, socks, scarf, bags, luggages, and fancy jewelries under Class Nos. 18 and 14 and that the words "VOGUE VIGOR VALUE" are presented on equal prints size above die stylized presentation of the Letter "V" and the numeral "3" or "V3";
3. The Appellant filed its opposition on the basis of its claim of ownership of VOGUE under Reg. No. 50122 on prints, publications and books 111 Class 16;
4. The Appellant misleads this Office by proudly asserting that the word "VOGUE" is the dominant feature of the Appellee's trademark application; this is false and misleading as the sample t-shirt and labels show "V3" that is the dominant feature and the words "VOGUE", "VIGOR" and "VALUE" are printed in equal size to stress the V3 symbol and not to appropriate the single word "VOGUE";
5. The Appellant's false asseveration that the word "VOGUE" is likely to cause confusion, mistake or to deceive is a speculative concoction bordering on wild imagination;
6. VOGUE is not at all a leading magazine in the Philippines and that VOGUE magazine might be popular to the elite but not so among the middle and lower consumers who would prefer local fashion magazines; the Appellee caters to the lower income groups, thus, the claimed popularity of the Appellant's magazine would not even matter; the Appellee's garments are being sold in *Divisoria* malls and "tiangge", thus, it is quite unlikely that customers of the Appellant who are of above average intelligence would ever make the mistake of believing that the Appellee's locally made products originated from, or are purportedly endorsed by VOGUE magazine;
7. Jurisprudence has developed two (2) tests in determining the similarity and likelihood of confusion of a trademark, the "Dominancy Test" and the "Holistic Test"; contrary to the Appellant's claim, it is in fact the combination of both tests that is applied in almost all cases in this jurisdiction;
8. The cases cited by the Appellant are not in accord with the facts and circumstances in this case as the Appellee's and Appellant's marks do not belong to the same class and that jurisprudence in fact favors the intellectual property rights of the Appellee; and
9. The word "VOGUE" is a generic term derived from the dictionary and was not coined by the Appellant; Webster defined it as "1. the prevailing fashion at a particular time; 2. popular favor; popularity".

The Appellee's evidence consist of a sample t-shirt,¹² plastic wrapping,¹³ and labels.¹⁴

In deciding in favor of the Appellee, the Director ruled that applying the Dominancy Test, there is no likelihood of confusion as the Appellee's mark does not only include the word "VOGUE" but two distinct and arbitrary words, "VIGOR" and "VALUE" with the addition of the letter "V" and a number "3". According to the Director, in the Appellee's file wrapper there is a disclaimer that no claim is made to the exclusive right to use the words "vogue" and "value" apart from die mark as shown which implies that the Appellee's mark when used will contain all these

elements, namely VOGUE VIGOR VALUE V3. The Director also held that the Appellee uses her mark oil goods different from the Appellant and that the Appellant's mark has not gained the status of being well-known. Furthermore, she held that assuming that VOGUE is well-known, the Appellant has to prove that the Appellee's use indicates a connection with the Appellant and the interest of the Appellant is likely to be damaged by such use.

Dissatisfied with the Director's decision, the Appellant filed a "MEMORANDUM OF APPEAL" on 14 April 2009 asserting that VOGUE is the dominant feature in the Appellee's mark, that VOGUE is well-known, and that the Appellee's use of VOGUE VIGOR VALUE V3 would indicate a connection between the Appellant's and Appellee's products so as to damage or prejudice the Appellant's interests.

The Appellee filed a "COMMENT TO APPEAL" on 01 June 2009 contending that the Appellant misstated that VOGUE is the dominant feature of VOGUE VIGOR VALUE V3 when VOGUE can hardly be considered as the dominant feature since the three words are printed in equal font size. The Appellee maintains that not only were the marks different and distinct from each other but their goods belong to different classes. The Appellee also claims that the Appellant's mark is not well-known.

Pursuant to Office Order No. 197, Series of 2010, Mechanics for IPO-Mediation and Settlement Period, this case was referred to mediation. The parties were ordered to appear in the IPOPHL Mediation Office on 22 February 2011 to consider the possibility of settling the dispute.¹⁵ On 09 August July 2011, this Office received from the IPOPHL Arbitration and Mediation Center a copy of the "MEDIATOR'S REPORT" stating the unsuccessful mediation of this case.

The issue in this appeal is whether the Director was correct in denying the Appellant's opposition to the registration of VOGUE VALUE VIGOR V3 in favor of the Appellee.

Sec. 123.1 (d) of the IP Code provides that a mark cannot be registered if it:

(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;

In this regard, the Appellant is the owner and the registrant of VOGUE for prints, publications and books -which fall under Class 16 of the Nice Classification. On the other hand, the Appellee seeks to register VOGUE VIGOR VALUE V3 for goods under Classes 14, 18 and 25 covering jewelry, bags, luggages and articles of clothing such as shirts, jackets, jeans, pants, underwear, belts, shoes, socks and scarf.

Thus, the goods covered by die Appellee's trademark application are not the same or closely related to the goods covered by VOGUE registered ill the name of the Appellant. The relevant question, therefore, is whether VOGUE VIGOR VALUE V3 resembles VOGUE as to likely deceive or cause confusion.

In trademark cases, particularly in ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, no set of rules can be deduced. Each case is decided on its own merits.¹⁶ As the likelihood of confusion of goods or business is a relative concept, to be determined only according to die particular, and sometimes peculiar, circumstances of each case,¹⁷ the complexities attendant to an accurate assessment of likelihood of such confusion requires that the entire panoply of elements constituting the relevant factual landscape be comprehensively examined.¹⁸

Below are the reproductions of the Appellant's and Appellee's marks:

VOGUE

Vogue Vigor Value



Appellant's mark

Appellee's mark

While the word "VOGUE" is present in these marks, there are marked differences between them. The Appellant's mark is composed solely of the word "VOGUE" while the Appellee's mark is composed of the three words, "Vogue", "Vigor", and "Value", and the letter-number combination of "V3" written in bold font and stylized form. Moreover, the dominant feature of the Appellee's mark is not the word "VOGUE" but "V3".

In this regard, it is unlikely that the consumer will mistake or confuse the Appellee's mark or the goods to which the mark is used, as belonging to or originating from the Appellant. Moreover, the Appellee's products are different and not closely related to the Appellant's products or goods.

Thus, the mere fact that the Appellant and the Appellee are both using the word "Vogue" is not sufficient to conclude the likelihood of deception or confusion. Significantly, the Appellee's use of "Vogue" in its mark is not a hindrance to the registration of d-ds mark. The obvious differences in the features of the aforementioned marks and the parties' use of their respective marks on different and unrelated goods and services, bar any confusion, mistake or deception.

In addition, the Appellee is not chaining the exclusive right to the use of the word "VOGUE". As pointed out by the Director:

Moreover, it is worthy to point out that in the file wrapper, a disclaimer that "No claim is made to the exclusive right to use the words "vogue", "value" apart from the mark as shown" which implies that the respondent-applicant's mark when used will contain all these elements, namely: VOGUE VIGOR VALUE V3. Furthermore, not only are the marks different and distinct from each other, the respondent-applicant appropriated [uses] her mark for goods wider Classes 14, 18 and 25 which is different from opposer's registration of the mark VOGUE for the prints, publications and books under class 16.

The mere fact that a mark has been adopted by one person does not prevent the adoption of the same mark for dissimilar goods.¹⁹

A person who would buy the Appellee's products would do so not on the basis of the mistaken belief that the product is that of the Appellants' but because that is the product the person intends to buy. In one case decided by the Supreme Court of the Philippines, it was held that the ordinary purchaser must be thought of, as having, and credited with, at least a modicum of 'intelligence'.²⁰

A certificate of trademark registration confers upon the trademark owner the exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.²¹ The protection given to the registered mark VOGUE is limited to the goods and services and those related thereto as specified in the certificate of registration. Hence, the Appellant's certificate of registration covers only the protection for prints, publications and books which are not related to the Appellee's fancy jewelry, bags and luggages, shirts, jackets, jeans, pants, underwears, belts, shoes, socks and scarf. The protection given to the Appellant's VOGUE cannot extend to the entirely different goods of the Appellee covered by VOGUE VIGOR VALUE V3.

With respect to the Appellant's claim that its mark is well-known, this is now immaterial to this case. The protection accorded to a well-known mark applies only if there is a finding of

confusing similarity between competing marks. In this case, VOGUE VIGOR VALUE V3 is not confusingly similar to VOGUE. Neither was there any proof of connection or damage to the Appellant's mark arising from the Appellee's use of its mark. Accordingly, the Appellee's trademark application can be given due course.

WHEREFORE, premises considered, the instant appeal is hereby DISMISSED. 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 Legal Affairs for appropriate action. Further, let also the Director of the Bureau of Trademarks and the library of the Documentation, Information and Technology Transfer Bureau be furnished a copy of this decision for information, guidance, and records purposes.

SO ORDERED.

November 16, 2011, Taguig City

RICARDO R. BLANCAFLOR
Director General

FOOTNOTES:

1 The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral treaty, administered by the World Intellectual Property Organization. This 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-

2 Annex "A" of the Appellant's Manifestation and Motion, dated 01 February, 2008.

3 Annex "B" of the Appellant's Manifestation and -Motion, dated 01 February 2008.

4 Annex "C" of the Appellant's Manifestation and Motion, dated 01 February 2008.

5 Exhibits "A", "H" and "I".

6 Exhibit "B".

7 Exhibits "C" to "C-8".

8 Exhibit "D".

9 Exhibits "E" to "E-6".

10 Exhibit "f".

11 Exhibit "G".

12 Annex "1" of the Verified Answer

13 Annex "2".

14 Annexes "3" to "7".

15 Order dated 01 February 2011.

16 *Emerald Garment Manufacturing Corporation vs. Court of Appeals*, 251 SCRA 600 (1995).

17 *Esso Standard Eastern, Inc. vs. CA*, 116 SCRA 336 (1982).

18 *Societe Des Produits Nestle, S.A., et.al vs. CA, et. al.*, G.R. No. 112012, 04 April 2001.

19 Decision No. 09-25, dated 13 February 2009, page 6.

20 *Fruit of the Loom, Inc. vs. Court of Appeals and General Garments Corporation*, G.R. No. L-32747, 29 November 1984.

21 See Sec. 138 of the IP Code.