

ADVANCE MAGAZINE PUBLISHERS. INC.	}	IPC No. 14-2008-00027
Opposer,	}	Opposition to:
	}	VOGUE VIGOR VALUE V3
	}	Appln. Serial No. 4-2006-008955
	}	Filing Date; August 15, 2006
-versus-	}	
	}	
MONICA CUYA,	}	
Respondent-Applicant.	}	Decision No. 09-25
x-----x		

DECISION

For decision is the Notice of Opposition filed by Advance Magazine Publishers Inc., (Opposer), a corporation organized and existing under the laws of the State of New York, U.S.A., with principal office at four Times Square, New York, U.S.A. against Application Serial No. 4-2006-008955 in the name of Monica Cuya, (Respondent-applicant) for the trademark VOGUE VIGOR VALUE V3 for goods under class 14, 18 and 25 namely : Class 14: “fancy jewelry”; Class 18: “bags and luggages”; Class 25: “shirts, jackets, jeans, pants, underwears, belts, shoes, socks, scarf” filed on 15 August 2006.

The grounds for the opposition are as follows:

- “1. Opposer is the registered owner of the trademark VOGUE under Registration No. 50122 issued by the Bureau of Patents, Trademarks and Technology Transfer on March 13, 1991, and used on prints, publications and books. Opposer has since expanded its use of its VOGUE trademark to other goods and service, including goods under 2, 3, 9,10, 14, 18, 20, 21, 23, 24, 25, 26, 27, 28, 31, 35, 36, 38, 39, 41, 42, 43, 44, 45 which are also commercially sold worldwide and for which the mark has been registered, Opposer is the first user of the trademark VOGUE in the United States of America since 1982 and in the Philippines and other countries long before Respondent-Applicant appropriated the mark VOGUE VIGOR VALUE V# for her goods and products.
2. Respondent-applicant’s trademark VOGUE VIGOR VALUE V3 makes use of Opposer’s trademark Vogue as its dominant feature, contrary to Section 155.1 of the Intellectual Property Code xxx
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.
4. Respondent-Applicant adopted the trademark VOGUE on its clothing apparel and fashion accessories with the obvious intention of misleading the public into believing that these are sponsored by the 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 VIGOR VALUE V3 is based on the representation that it s the originator, true owner and first user of the trademark, when in fact the dominant feature of such trademark, the word VOGUE, was merely copied/derived from Opposer’s VOGUE trademark.

6. Opposer is the first user of the trademark VOGUE in Philippine commerce and elsewhere, having utilized the same extensively over the century. Opposer's publication and books bearing the trademark VOGUE are dedicated to fashion, costume and accessories, showcasing the latest and finest trends in clothing and accessories. Respondent-applicant's use of the VOGUEVIGOR VALUE V3 mark, capitalizing on the word VOGUE as the dominant feature, is likely to cause consumer confusion as to the origin of said goods,

7. Respondent-Applicant's appropriation and use of the trademark VOGUE VIGOR VALUE V3 infringes upon Opposer's exclusive right to use trademark vogue, which is 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 trademark registered under R.A. 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 VIGIR VALUE V3 in the name of the Respondent-Applicant is contrary to the other provisions p of the IP Code, particularly in the light of Section 123.1 (f) which expands the protection of well-known marks in the Philippines 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 goods of the Respondent-Applicant, jewelries, bags, clothing, and those of the owner of the registered mark, magazine focused on apparel and accessories."

Opposer submitted the following evidence to support of the opposition:

ANNEX	DESCRIPTION
"A"	Notice of Opposition
"B"	Secretary's Certificate
"C"	Affidavit of John W. Bellando
EXHIBIT	DESCRIPTION
"A"	Foreign Circulation Report
"B"	Country List Report
"C"	Foreign registrations
"D"	Registration No. 50122
"E"	Copies Vogue magazines

In her Answer, respondent-applicant raised the following special and affirmative defenses:

"1. Respondent-applicant (applicant, for brevity) DENIES all allegations of the Opposer in its Notice of Opposition.

2. The Verification of the Opposition was executed by opposer's alleged Vice President, without showing proof of authority from the company to file the same.
3. Applicant applied for trademark registration of "VOGUE VIGOR VALUE V3" for Garments and accessories, particularly: jackets, jeans, belts, shoes, socks, scarf, bags, luggages, and fancy jewelries under Classes Nos. 18 and 14. The words "VOGUE VIGOR VALUE" are presented on equal print size above the stylized presentation of the Letter "V" with the numeral "3" or V3.
4. Opposer filed its opposition on the basis of its claim of ownership of the trademark 'VOGUE' allegedly under Registration No. 50122 on prints, publications and books in class "16".
5. Opposer misleads this Honorable Office by proudly asserting that the word 'VOGUE' is the dominant feature of applicant's trademark registration. This is obviously false and misleading. As shown on the sample t-shirt and labels attached hereto, it is in fact the symbols "V3" that is the dominant feature in applicant's trademark. The words 'VOGUE', 'VIGOR' and 'VALUE' are printed in equal size to stress the V3 symbol and not to appropriate the single word VOGUE. The sample t-shirt hereto attached as annex "1", the plastic wrapping as Annex "2" and the labels as annexes "3", "4", "5", "6", and "7".
6. Opposer's false asseveration that the word VOGUE in applicant's trademark *"is likely to cause confusion, mistake or to deceive"* is a speculative concoction bordering on wild imagination.
7. Although it could be true "VOGUE" magazine is distributed in the Philippines and in other countries, it is NOT at all a leading magazine in the Philippines, contrary to opposer's high illusion. "Vogue" magazine might be popular to the elite but not so among the middle and lower consumers who would prefer local fashion magazines with Angel Locsin, Kris Aquino and other local artists as models. And considering that the applicant caters to the lower income groups, the claimed popularity of the opposer as magazine would not even matter. For this information of this Honorable Office, applicant's garments are being sold in Divisoria malls and tiangge, thus, *it is quite unlikely that customers of opposer who are of above average intelligence would ever make the mistake of believing that applicant's locally made products originated from, or are purportedly endorsed by VOGUE, magazine.*
8. Considering that applicant does not cater to opposer's learned readers, why would it ride on the alleged popularity of the opposer to attract her customers? This does not make sense at all.

In support of her defense, respondent-applicant submitted the following evidence:

ANNEX	DESCRIPTION
"1"	Photograph of product
"2"	Actual product (Vogue vigor value) T-shirt
"3"- "4"	Actual Labels/tags
"5"- "6"	Actual Labels

The parties were called to a Preliminary Conference on 24 July 2008 but since no amicable settlement was reached, the parties were ordered to submit their position paper.

The issues are whether the marks are confusingly similar and whether opposer's mark as is a well-known that enjoys protection under Section 123.1 (f) of the IP Code.

The opposer's mark as well as the respondent-applicant's mark are reproduced below for comparison:



Opposer's mark



Respondent-applicant's mark

In comparison the marks, it is immediately apparent that both marks contain the word VOGUE. It is opposer's contention that respondent-applicant appropriated in her trademark, its registered mark's dominant feature, VOGUE. Indeed, the likelihood of confusion is determined by the test of dominancy.

In McDonald's Corporation, et al., as L.C. Big Mak Burger, Inc., et al., G.R. No. 143993, August 18, 204, the Supreme Court held that:

"In determining the likelihood of confusion, jurisprudence has developed two tests, the dominancy test and the holistic test. The dominancy test focuses on the similarity of the prevalent features of the competing trademarks that might cause confusion. In contrast, the holistic test requires the court to consider the entirety of the marks as applied to the products including the labels and packaging, in determining confusing similarity. xxx

Under the dominancy test, courts give greater weight to the similarity of the appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding minor differences. Courts will consider more the aural and visual impressions created by the marks in the public mind, giving little weight to factors like prices, quality, sales outlets and market segments. xxx

Applying the dominancy test, the Bureau disagrees with the conclusion reached by the opposer. For as clearly seen in the evidence submitted by the respondent-applicant, consisting of labels and hang tags (Exhibit "3", "4", "5" and "6") and the actual product itself (Exhibit "2"), her 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, which is VOGUE VIGOR VALUE V3. The Supreme Court American Wire & Cable Co. vs. Director of Patents, 31 SCRA 544 explains that the most dominant part is the trademark itself, thus:

"As pointed out in the decision now on appeal, there are some differences in the mark in the front portion of the box, but they pale into insignificance in view of the close resemblance in the general appearance of the box and the trade names of the articles. Indeed, measured against the dominant feature standard, applicant's mark must be disallowed. For undeniably, the most dominant and essential feature of the article is trademark itself.

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 appropriately uses her mark for goods under classes 14, 18 and 25 which is different from opposer’s registration of the mark VOGUE for the prints, publications and under class 16.

The mere fact that mark has been adopted by one person does not prevent the adoption of the same mark for dissimilar goods. In *Philippine Refining Co., Inc. v. Ng Sam G.R. No. L-26676*, 3 July 1982, the Supreme Court explained:

“A rudimentary precept in trademark protection is that “the right to a trademark is a limited one, in the sense that others may use the same mark on unrelated goods (Sec. 221, Nims, *Unfair Competition and Trade Mark*, Vol. 1, p. 657). Thus, as pronounced by the United States Supreme Court in the case of *American Foundries v. Robertson* (269 US 372, 381, 70 L ed 317, 46 Sct. 160), “the mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description.” Such restricted right over a trademark is likewise reflected in our Trademark Law. Under Section 4(d) of the Law, registration of a trademark which so resembles another already registered or in use should be denied, where to allow such registration could likely result in confusion, mistake or deception to the consumers. Conversely, where no confusion is likely to arise, registration of a similar or even identical mark may be allowed.”

Opposer argues that VOGUE is a well known mark registered in the Philippines and is protected under Section 123 (f) of the IP Code. As such, it opines that since its mark is well-known in the clothing and fashion industry and the use by respondent-applicant of its mark would cause confusion, mistake and deception as to sponsorship or origin. The law states:

#### SEC. 123. Registrability

##### 123.1 A mark cannot be registered if it: xxx

“(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 service: 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 services 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 service would indicate a connection between those goods or service, 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;

Rule 102 of the Rules and Regulations on Trademarks contains the criteria to be taken into account in determining whether a mark is well-known. These are the following:

- a. The duration, extent and geographical area of use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including

advertising or publicity and the presentation at fairs or exhibitions, of the goods and/or services to which the mark applies;

- b. The market share in the Philippines and in other countries of the goods and/or services to which the mark applies;
- c. The degree of the inherent or acquired distinction of the mark;
- d. The quality image or reputation of the acquired mark;
- e. The extent to which the mark has been used in the world;
- f. The exclusivity of the use attained by the mark in the world;
- g. The commercial value attributed to the mark in the world;
- h. The record of successful protection of the rights in the mark;
- i. The outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- j. The presence or absence of identical or similar goods or services owned by persons other than the person claiming that his mark is well-known mark.

Opposer submitted the affidavit of John W. Bellando (Annex "A") who testified on the circulation of the magazine (Exhibit "A") and a country of its registrations. (Exhibit "B") Opposer likewise submitted photocopies of cover of its fashion magazines (Exhibit "E"). A review of the evidence submitted will show that the mark has not gained status of being well-known. Assuming that the mark VOGUE which is registered in the Philippines is well-known, the registered owner still has to prove that the respondent's use indicates a connection with the opposer and the interest of the opposer is likely to be damaged by such use. The use of VOGUE VIGOR VALUE V3 on fancy jewelry; bags and luggages, shirts, jackets, jeans, pants, underwears, belts, shoes, socks, scarf does not indicate a connection with a magazine. Besides, it well to point out that opposer inspite of its registration of the VOGUE mark as early as March 13, 1991 under Certificate of Registration No. 50122 (Exhibit "D"), for publication on fashion, it has not since then attempted to register on clothes. The Supreme Court has ruled that no deception arises from the use of an identical mark contemporaneously on a department store and t-shirts, pants and articles of wear even if the same articles can be sold in a department store. In the case of Ang Si Heng and Dee vs. Wellington Dept. Store, Inc. (92 Phil. Reports 448, 1953), the Supreme Court ruled:

"While there is a similarity between the trademark or tradename "Wellington Company" and that of "Wellington Department Store" no confusion or deception can possibly result or arise from such similarity because the latter is a "department store" while dormer does not purport to be so. The "Wellington" is admittedly the name of the trademark on shirts, pants, drawers, and other articles of wear for men, women, children, whereas the name used by the defendant indicates not these manufactured articles or any similar merchandise, but a department store."

WHEREFORE, premises considered the OPPOSITION filed by Advance Magazine Publishers, Inc. is, as it is herby, DENIED. Accordingly, Application Serial No. 4-2006-008955 for the mar VOGUE VIGOR VALUE V3 covering goods under For classes 14, 18 and 25, namely: Class 14: "fancy jewelry"; Class 18: "bags and luggages"; Class 25: "shirts, jackets, jeans, pants, underwears, belts, shoes, socks, scarf" filed by Monica Cua, is as it is, hereby given DUE COURSE.

Let the filewrapper of “VOGUE VALUE VIGOR V3”, subject matter of this case, together with a copy of this Decision be forwarded to the Bureau of Trademark (BOT) for appropriate action.

SO ORDERED.

Makati City, 13, February 2009.

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