

EMERALD GARMENT MANUFACTURING CORPORATION,

Opposer,  
-versus-

WANG CHUI SHI,  
Respondent-Applicant.

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IPC NO. 14-2010-00225

Opposition to:  
Appln. Ser. No. 4-2009-010206  
Date Filed: 08 October 2009  
TM: "JRR"

Decision No. 2011-34

## DECISION

EMERALD GARMENT MANUFACTURING CORPORATION ("Opposer"), a corporation organized and existing under the laws of the Philippines, with business and postal address at 52 Santiago Street, San Francisco Del Monte, Quezon City, filed on 05 October 2010 an opposition to Trademark Application No. 4-2009-010206. The trademark application, filed by WANG CHUI SHI ("Respondent-Applicant"), with address at 119 Seafront Garden, Roxas Boulevard, Pasay City covers the mark "JRR" for use on "bag, leather bag, wallet" under Class 18 and "pants, shorts, T-shirt, cup, underwear, sock, blouse sando for men and women, shoes, sandals, rubber shoes" under Class 25 of the International Classification of Goods.

The Opposer alleges that the approval of Trademark Application Serial No. 4-2009-010206 is contrary to Sections 123.1 (d) and 138 of the Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") and has caused and will continue to cause great and irreparable damage and injury to the Opposer. The Opposer's evidence consists of the following:

- "1. Exh. "A" – Certified copy of Amended Articles of Incorporation;
- "2. Exh. "B" – Certified copy of Certificate of Reg. No. 4-2002-000626;
- "3. Exh. "C" – Certified copy of Certificate of Reg. No. 4-2003-006094;
- "4. Exh. "D" – Certified copy of declaration of Actual Use;
- "5. Exh. "E" – duplicate original of the Declaration of Use filed on 03 September 2010;
- "6. Exh. "F" to "F-20" - certified copies of representative cash invoices and listing of Opposer's various stock numbers;
- "7. Exh. "G" to "G-3" - copies of newspaper advertisements depicting Opposer's products bearing the RRJ INSIDE AN OBLONG DEVICE mark;
- "8. Exh. "H" - print out of Respondent-Applicant's mark; and
- "9. Exh. "I" – Affidavit of Johnson R. Gumba, General Manager of the Opposer.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 09 November 2010. However, the Respondent-Applicant did not file its answer. Hence, pursuant to Rule 2, Sec. 11 of the Regulations on Inter Partes Proceedings, as amended, the case was deemed submitted for decision on the basis of the opposition and the evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark JRR?

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 and sale of an inferior and different articles of his products.

In this regard, Sec. 123.1 (d) of the IP Code provides that 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 same goods or services or closely related goods and services, if its nearly resembles such mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application on 08 October 2009, the Opposer already has existing trademark registrations, to wit:

1. Reg. No. 4-2002-000626, issued on 17 January 2005, for use on various goods:

Class 03-“COSMETICS, FRAGRANCE, TOILETRIES, COLOGNE, POWDER, LIPSTICK SHAMPOO”;  
Class 14-“WATCHES”;  
Class 18-“BELTS, BAGS”;  
Class 25-“SHOES, POLO, POLO SHIRTS, BRASSIERES, UNDERSHIRTS, NIGHTIES, JUMPER, ROBES, WAISTBAND, OVERALLS, AND UTILITY TROUSERS FOR MEN, LADIES, GIRLS AND BOYS, CAPS, NECKTIES, TANK TOPS, CYCLING SHORTS”;  
Class 09-“EYEGLASSES, SUNGLASSES, CONTACT LENSES”; and  
Class 24-“HANDKERCHIEFS, FACE TOWELS, HAND TOWELS AND BATH TOWELS”; and

2. Reg. No. 4-2003-006094, issued on 17 August 2006, for use on various goods:

Class 14-“KEY CHAINS, SILVER NECKLACE, SILVER RING”;  
Class 21-“COMBS, HAIR BRUSH”;  
Class 20-“COMPACT MIRROR”;  
Class 16-“PAPER BAGS”;  
Class 18-“BELT, BAGS, WALLETS, COIN PURSE, TOTE BAGS”;  
Class 25-“PANTS, JEANS, SLACKS, SHORT PANTS, BOXER SHORTS, T-SHIRTS, SHIRTS WITH COLLAR, JACKETS, CAMISOLE, BLOUSES, PANTIES, SOCKS AND SANDALS”;  
Class 26-“BUTTON PINS.”

Obviously, the goods indicated in the Respondent-Applicant’s application are similar or closely related to the goods covered by the Opposer’s trademark registrations.

But, are the competing marks, as shown below, identical or resemble each other that confusion, mistake or deception is likely to occur?



Opposer’s mark



Respondent-Applicant’s mark

This Bureau finds that notwithstanding the differences between the competing marks, the Respondent-Applicant’s mark is a colorable imitation of the Opposer’s. Used on goods or products covered by the Opposer’s trademark registration, the Opposer’s mark is unique, highly distinctive, and thus, leaves an impression in the minds of consumers. In this respect, it is obvious that the Respondent’s mark is only a play on the Opposer’s, involving only a change in the position of the letter J with respect to the two (2) letter Rs.

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. Corollarily, colorable imitation does not mean such similitude to such similarity in form, content, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or In their essential, substantive and distinctive parts as would like to mislead or confuse persons in the ordinary course of purchasing the genuine article. The determinative-factor in a contest involving trademark registration is not whether the challenge mark actually causes confusion or deception of the purchasers but whether the use of such mark would likely cause confusion or mistake on the part of the buying public. In short, to constitute an infringement of an existing trademarks, patent, and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.

A consumer, therefore, that is familiar or has previously encountered the Opposer's mark, would likely be reminded thereof when he or she sees or hears the Respondent-Applicant's mark. Likewise, a consumer who sees or hears for the first time the competing marks is likely to assume that one is just a variation of the other, or the products to which the marks are attached came from just one source or manufacturer, or the sources or manufacturers are connected or associated with one another.

Moreover, the likelihood of confusion would subsist not only on the public's perception of services but on the origin thereof as held by the Supreme Court.

"Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary prudent purchaser would be included to purchase one product in the belief that he was purchasing the other. In which case, the defendant's goods are then bought as the plaintiffs 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 that there is some connection between the plaintiff and the defendant which, in fact does not exist."

The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitations, the unanswered riddle is why, of the millions of terms and combination of letters and designs available, such person had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark. In this instance, the parties being in the same line of business, it is fair inference that the Respondent-Applicant is aware of the Opposer's brand or trademark. Yet the Respondent-Application chose to use and apply for registration a mark that also consists of two adjoining letter "Rs" and one letter "J". On this, the Respondent-Applicant was given opportunity to explain its side and defend its trademark application. However, it failed or chose not to do so.

Accordingly, it is stressed that the law on trademarks and trade names is based on the principles of business integrity and common justice. This law, both in letter and spirit is laid upon the premise that, while it encourages fair trade in every way and aims to foster, and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing others business by fraud, deceit, trickery or unfair methods of any sort. This necessary precludes the trading by one dealer upon the good name and reputation built by another.

WHEREFORE, premises considered, the opposition is hereby SUSTAINED. Let the filewrapper of the Trademark Application Serial No. 4-2009-010206 be returned, together with a copy of this decision, to the Bureau of Trademark (BOT) for information and appropriate action.

SO ORDERED.

Makati City, 31 March 2011

NATHANIEL S. AREVALO  
Director, Bureau of Legal Affairs  
Intellectual Property Office