

ICI BERLIN BRILLEN GMBH,
Opposer,

-versus-

MA. VICTORIA LAKHMANI
Respondent-Applicant.
X-----X

IPC No. 14-2008-000126
Case Filed: 10 June 2009
Opposition to:
Appln. Serial No. 4-2007-009110
Date Filed: 22 August 2007
Trademark: "EYE SEE"

Decision No. 2011-09

DECISION

ICI Berlin Brellin GMBH ("Opposer"), a corporation organized and existing under the laws of Germany, with principal address at Saarbrucker, Str. 37, 10405 Berlin, Germany, filed an opposition to Trademark Application Serial No. 4-2007-009110. The application, filed by the Ma. Victoria Lakhmani ("Respondent-Applicant"), a Filipino citizen with address at No. 100 TECC Center, Sierra Madre St., Mandaluyong City, covers the mark "EYE SEE" for use on "reading glasses, optical frames, sunglasses and optical accessories namely eyewear holder nose pads, temple and temple tips" under Class 09 of the International Classification of goods.

The Opposer alleges, among others, the following:

9. Opposer was formed in Berlin, Germany some twenty years ago. It started in February of 1999 when Ralph Anderl, Harald Gottsschling and Philipp Haffmans, Corinna Harfouch and Peter Lohmeyer form the partnership ad started making eyeglasses. Shortly after its foundation, the IC! Berlin, popularly known simply as IC! Glasses, became an instant hit. Adding to the already rising popularity of the brand, famous actor and actresses started wearing glasses made by IC! Berlin. IC! Berlin's quick rise to fame and notoriety was owed to its excellent design and high level of craftsmanship. Its glasses are all handmade in Germany using a unique hand procedure, thus, ensuring the quality of all of IC! Berlin products. It is this craftsmanship that has earned it a significant global recognition, the same craftsmanship that IC! Berlin continues to maintain and nurture all through this year. The same craftsmanship that propelled the IC! Berlin brand into a international refute has also earned the company numerous international awards and prizes, namely:

1998	'Einfach Genial' (Simply genius) TV award, MDR, Germany
1998	'Golden Silmo' Eye wear Award, Silmo, Paris
1999	'2 nd prize at the 'Eye Wear Awards' Mido, Milan
1999	'Glasses of the Year 2000' loft, Tokyo
2000	'Glasses of the Year 2001' loft, Tokyo
2002	'Read Dot Award Product Design 2002', Germany
2004	'Glasses of the Year 2005' loft, Tokyo
2005	'Glasses of the Year 2006' loft, Tokyo
2007	'Germany-Land of Ideas'

10. Opposer is the owner of the Trademark IC! Berlin also popularly known simply as IC!.

11. In each home country, Germany, the Trademark IC! Berlin is registered under Trademarks Registration No. 30338931, issued on September 16, 2003 covering goods under Class 09 of the Nice Classification, registered in the name of Ralph Anderl, Harald Gottsschling and Philipp Hafmans, and Peter Lohmeyer xxx

12. The trademark IC! is likewise registered under Trademark Registration No. 39967632 issued on December 9, 1999 covering goods under Class 09 of the Nice Classification registered under Ralph Anderl, Harald Gottschling and Philipp Hafmans, and Peter Lohmeyer xxx

13. Opposer has obtained and continues to obtain registration for each well-known trademark IC! Berlin from the Intellectual Property Offices of various countries around the world. China, Germany, Taiwan, Japan, Singapore, South Korea, Hongkong, US, Canada. Spain, Australia are just of the countries were Opposer IC! Berlin holds trademark for 'IC! Berlin' and 'IC!'.xxx

14. In the Philippines, Opposers well-known mark IC! Berlin is registered with Intellectual Property Office (IPO) of the Philippines with details as follows:

Trademark:	IC! Berlin
Registration No.:	4-2006-500258
Goods:	SPECTACLES, SPECTACLE FRAMES, SPECTACLE LENSES, SUNGLASSES, SPECTACLE GLASSES, SPECTACLA CASES, OPTICAL APPARATUS AND INSTRUMENTS, CONTACT LENSES,
Application Date:	August 29, 2006
Registration Date:	17 September 2007

x x x As a registered Trademark "IC! Berlin" or "IC!" is entitled to such protection in the Philippines against an unauthorized use or appropriation of identical or confusingly similar marks by third parties

15. It should be noted that the Opposer upon request by the IPO examiner dropped exclusive claim of the mark 'Berlin' the same being a name of a place and hence, incapable of exclusive appropriation. Clearly, the term IC! is the distinctive element of Opposer's mark.

16. Opposer IC! Berlin has likewise established considerable local notoriety and a strong foothold in the Philippine market, Opposer IC! Berlin products are sold all over the country thru some of the most reputable eyewear dealers in the Philippines, such as Sarabia Optical at the Concourse Level Rockwell, Makati, Perez Optical at Eastwood City, Almeda Optical in Glorietta 4, Ayala Center Makati City, Unique Optical at the SM Mall of Asia, Pasay City, J. Vinas Optical at the Shangrila Mall, Ortigas and at Optical Works in Shoppesville, Greenhills, San Juan. x x x

17. In view of the foregoing facts, the registration of the trademark 'EYE SEE' in the name of Respondent-Applicant will violate Section 123.1 (d) of R.A. 8293 which provides:

x x x

18. The mark EYE SEE used or applied in the goods of Respondent-Applicant is confusingly similar to Opposer's mark IC! Berlin or IC!, as it is popularly known. The confusing similarity between the Respondent-Applicant's EYE SEE with the well-known trademark 'IC! Berlin' popularly known simply as 'IC!' of Opposer is likely to deceive the purchases of goods on which the marks are being used, not only as to the origin of sponsorship of said goods, but also as to the nature, quality, characteristics of the goods to which the mark is affixed, especially considering that the contending marks cover the same goods.

IC! Berlins Mark

Trademark: IC! Berlin
Registration : 4-2006-500258
Goods: Class 9 (SPECTACLES,
SPECTACLE FRAMES, SPECTACLE
LENSES, SUNGLASSES, OPTICAL
APPARATUS AND INSTRUMENTS,
CONTACT LENSES)
Registration Date: September 17, 2007

Ma. Victoria Lakhmani

Trademark : EYE SEE and Device
Application : 4-2007-009110
Goods: Class 9 (READING GLASSES,
OPTICAL FRAMES, SUNGLASSES, AND
OPTICAL ACCESSORIES NAMELY;
EYEWEAR HOLDER, NOSEPAD,
TEMPLE AND TEMPLE TIPS)
Application Date: August 22, 2007

19. A comparison between Respondent-Applicant's mark 'EYE SEE' and Opposer's well-known mark 'IC! Berlin' popularly known simply as 'IC!' would readily show that Respondent merely misappropriated Opposer's 'IC!' mark and the dominant element of Opposer's mark 'IC!' from 'IC!' Berlin. Although Respondent changed the spelling from 'IC!' to EYE SEE it is beyond doubt that the contending marks are phonetically identical. In fact, when the marks are spoken, the visual difference becomes insignificant.

20. The IDEM SONANS RULE, providing that the two trademarks used on identical or related products will result in confusion if they have similar sounds, applies. In the case at bar, IC! and 'EYE SEE' not only sound similar, but in fact, sound identical. And since both marks pertain to eye wears, eye glasses, and related products, confusion will most definitely result.

21. The identity and confusingly similarity between the contending marks, results to confusion among the consumers to the prejudice and damage of the Opposer. There is a possibility that a customer who asks for an IC! product would be given "EYE SEE" products and the customer would be misled into thinking that they are one and the same when in fact they are not. Hence, it would be unjust to allow the Respondent to have its applied mark 'EYE SEE' registered in the Philippines. Otherwise, Respondent use of the 'EYE SEE' mark is fraught with the danger of being confused with the Opposer's mark, again to the latter's damage and prejudice.

22. It should be noted that as a direct result of Opposer's long international presence, excellent quality and workmanship, extensive advertisement and excellent product design, its mark IC! has achieved such fame as to become a byword amongst consumers of eyeglasses and eye related products. One way this fame and popularity spreads is by word of mouth. A satisfied buyer would recommend IC! products to his friends and give praise for its excellent design and quality. It is this fame and popularity of IC! that the applicant wished to take advantage of. By trying to sell her eye wears and related products under the mark "EYE SEE", she hopes to pass them off as possessing the same quality and workmanship as that of the Opposer's as both sounds the same and hence consumers who only heard the fame and repute associated with 'IC!' will be misled into thinking that said repute pertains to 'EYE SEE' products. Indeed, Ms. Lakhmani's deliberate selection of 'EYE SEE' reveals a deliberate and calculated effort to infringe the opposer's well-known mark 'IC! Berlin' commonly known as 'IC!' and ride upon its popularity and goodwill, taking immoral, illegal and undue advantage of opposer's popularity and repute which took extensive sums of money and effort to establish and develop. Certainly, Lakhmani's illegal act must not be countenanced.

23. Furthermore in the case of Marvex Commercial Co., Inc. vs. Petra Hawpia and Co., and the Director of Patents (GR No. L-19297 December 22, 1966) the Supreme Court said that 'Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties' xxx. In the case at bar, the 'EYE SEE and Device' not only sound similar but in fact sounds identical and is nothing but a transliteration of opposer's well-known mark

'IC! Berlin' popularly known as 'IC!' and therefore cannot be registered in the name of applicant Lakhmani.

24. There is no doubt that Opposer's mark 'IC! Berlin' is well-known in accordance with the criteria set forth in RA 8293. i.e., taking into account the knowledge of the relevant sectors of society rather than the public at large which has been obtained by extensive promotion. IC! Berlin has maintained a website at www.ic-berlin.de xxx. IC Berlin has also spent considerable sums of money to promote 'IC! Berlin' products locally xxx. Hence, pursuant to RA 8293, relevant Philippine jurisprudence, The Paris Convention, and the TRIPS Agreement, the Government of the Republic of the Philippines, through the Intellectual Property Office is mandated to protect Opposer's trademarks by rejecting all applications for the registration of identical or confusingly similar marks.

25. Opposer will be damaged in its proprietary rights/interest and business reputation by the registration of the mark 'EYE SEE' in the name of Respondent-Applicant considering that the Opposer's well-known mark has long been established and obtained goodwill and consumer recognition. The distinctiveness of said well-known mark will be diluted, and will allow Respondent-Applicant to unfairly benefit from and get a free ride on the goodwill of Opposer's well-known mark, thereby causing irreparable injury to the Opposer.

26. By reason of the goodwill and popularity of Opposer's 'IC! Berlin' 'IC!' mark, the registration of Respondent-Applicant's 'EYE SEE' mark will create confusion in the minds of purchasers and consumers, who will be deceived into mistaking that 'IC! Berlin' products are the same as 'EYE SEE', to the latter's great prejudice.

27. In view of the foregoing, Respondent-Applicant's trademark application for 'EYE SEE' under Application No. 4-2007-009110 on August 22, 2007 covering goods in Class 09 specifically 'READING GLASSES, OPTICAL FRAMES, SUNGLASSES AND OPTICAL ACCESSORIES, NAMELY, EYEWEAR HOLDER, NOSE PADS, TEMPLE AND TEMPLE TIPS' in the name of MA. Victoria Lakhmani should be denied, in accordance with Section 123.1 (d) (e) (f) (g) of RA 8293.

x x x

The Opposer presented the following pieces of evidence:

1. Exhibit "A" – Authenticated Special Power of Attorney executed by Joelle Sanit Hugot in favor of Cesar C. Cruz & Partners Law Offices;
2. Exhibit "B" – Photocopy of certificate of registration for the mark "IC! Berlin" issued in Germany;
3. Exhibit "C" – Photocopy of Registration No. 39967632 for the mark "IC! for goods under Class 9;
4. Exhibit "D" to "D-22" – Photocopy of the list of countries where the mark "IC! Berlin" is registered as well as the corresponding photocopy of such registrations;
5. Exhibit "E" – Photocopy of Philippine Registration No. 4-2006-500258 for the mark "IC! Berlin";
6. Exhibit "F" to "F-3" – Affidavit of Allan V. Mucho and photocopies of the photographs of store selling eye wears bearing the mark "IC! Berlin" and the IC! Berlin eye wears sold in the stores;

7. Exhibit "G" to "G-3" – Photocopy of the printouts from the www.ic-berlin.com;
8. Exhibit "H" to "H-3" – picture of IC! Berlin product and promotional material in the Philippines, and
9. Exhibit "I" – Affidavit of Mr. Ramesh Dargant;
10. Exhibit "I-1" – pictures of IC! Berlin glasses;
11. Exhibit "1-2" – Catalogue of IC! Berlin Germany;
12. Exhibit "I-3" – Copies of sample invoices of IC! Berlin pertaining to the sales in the Philippines;
13. Exhibit "L" – Special Power of Attorney.

This Bureau issued on 24 June 2008 a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 30 June 2008. The Respondent-Applicant filed a Motion for Extension to File Answer which was granted by this Bureau. On 29 August 2008 the Respondent-Applicant filed its Answer alleging, among others, the following:

The Opposition was filed beyond the 120 days prescription period. Hence, should have been dismissed outright.

12. In the Order dated 14 July 2008, the Honorable Director correctly ruled that the opposer has until 07 June 2008 within which to file his opposition together with the supporting documents/evidence. As provided under the Regulations on Inter Partes Proceedings (Sec. 4 Rule 7 of the Rules and Regulations on Inter Parties Proceedings.

13. On the other hand, and as admitted by the opposer, in particular its Manifestation dated 12 June 2008 and 13 June 2008 it was only on 10 June 2008 when it filed its Notice of Opposition against the subject trademarks application. This is supported as well by the stamp of filing on the Notice of Opposition itself which bears the date 10 June 2008. In other words, the instant Opposition was filed out of time, hence dismissible.

14. Ergo, considering that the filing of the notice of Opposition itself was well beyond the 120 day period provided by the Rules, it follows to law and reason that the instant opposition should have been DISMISSED outright.

14.1.1. Moreover, as a consequence of the Issuance of the Order dated 14 July 2008, the opposer even filed a Motion for Reconsideration dated 06 August 2008.

14.1.2. A cursory as a consequence of the said Motion for Reconsideration would disclose that it was intended to set aside as interlocutory order. Under the rules however, in particular Sec. 10 as amended, entitled Prohibited Pleadings a motion for reconsideration of an interlocutory order is verbose. As such, Opposer's motion for reconsideration should therefore be DENIED as well for being a prohibited pleading.

"The Notice of Opposition was not properly verified and certified, i.e. if the pleadings was not verified and certified at all. Hence, another ground for the outright dismissal of the Opposition.

15. The Notice of Opposition was purportedly verified and certified by a certain Jacquilene A. Guzman who claimed in par. 1 of her Verification and Certification Against

Non-Forum Shopping xxx that she was duly empowered by a Special Power of Attorney issued by the Opposer IC! Berlin Brillen GMBH.

16. A meticulously perusal however, of Opposer's Notice of Opposition and the attached exhibit would readily disclose that no such power of attorney exists in favor Jacqueline A. Guzman; In other words. Aside from Ms. Guzman's say-so, there is no documentary evidence proving such authority alluded to by Guzman.

17. Even the Special of Attorney, subsequently submitted by the oppose and attached its Manifestation dated 13 June 2008 xxx was in reality issued in favor of the law firm of Del Rosario Bagamasbad and Raboca. There is no mention Jacqueline Guzman.

18. More to the point, Sec. 2 (d) Rule 7 Supra. Categorically provides that the Opposition must be verified by a person who knows the facts. Otherwise, the opposition shall be dismissed. In the case at the bar, there is no showing that Jacqueline Guzman is an officer and/or an employee of IC! Berlin Brillen GMBH who personally knows the incidents alleged in the Opposition. Outright dismissal is again warranted.

x x x

"The trademark application of herein Respondent-Applicant is law compliant and is not confusingly Similar with the alleged mark of the opposer.

21. Juxtaposing the trademark applied for by herein respondent-applicant with that of the opposer's [IC! Berlin], and on visual vantage point, one could readily conclude, and rightly so, that the two are very much different. There is no similarity that would tend to confuse consumers;

21.1. While the mark of the respondent-applicant is a square with the words EYE SEE and Reading Glasses with a drawing of an eye in the middle, the mark of the oppose IC! Berlin bears no such words or graphics. xxx

22. Furthermore, since the I and C in IC! Berlin do not bear periods at the end of which letter, the same should be read and pronounced together, rather than read separately, thereby producing the sound IK, as in the word BIC [the ballpen]. Verily, even from an aural angle the same conclusion would be reached, i.e. the two marks are distinct and different from each other and would cause no confusion to the consumer;

22.1. Note that a consumer buying products would use his God given five senses, i.e. sight, hearing, touch, smell and taste. And in this particular case, the senses of sight and hearing would be pertinent;

22.2. Applying our sense of sight and hearing to the case-at-bar, we shall arrive at the obvious conclusion that the trademarks in question are not similar and would not create the imagined confusion alluded to by the opposer.

23. Analogously, the Supreme Court in the case of Asia Brewery vs. Court of Appeals and San Miguel Corporation, G.R. No. 103543, 05 July 1993, had occasion to rule that inn order to determine if there was indeed infringement of a Trademark, the similarity and the dominant features of the Trademark's test should be employed. And we quote:

x x x

24. Verily, applying the foregoing test to the case-at-bar. It would be readily evident that the dominant features of the Trademark applied for by herein Respondent-Applicant DO NOT appear in the purported of the Opposer. Per force, no similarity exists between the two trademarks and no infringement.

25. Anent the contention that the Respondent-Applicant trademark would be confusingly with that of the Opposer, the same is more imaginary than real.

x x x

27. Again, using the foregoing test as parameter, one could safely conclude that the trademark applied for by herein Respondent-Applicant when juxtapose with that of the Opposer, would not create any confusingly similarity and/or resemblance.

28. The long and short of this is that:

- a. The opposition was filed way beyond the 120 days prescriptive period. Hence, should have been dismissed outright;
- b. The notice of opposition was not properly verified and certified, i.e. as if the pleading was not verified and certified at all, considering that the one who supposedly verified is not an officer and/or Director of the opposed company. Besides, the purported special power of attorney was actually issued in favor of the law firm Del Rosario, BAGAMASBAD and RABOCA. Hence, another ground for the outright dismissal of the opposition:
- c. The trademark application of the herein Respondent-Applicant is low compliant and is not confusingly similar with the alleged mark of the Oppose: and,
- d. There is no similarity in the dominant features of the trademark applied for by herein respondent-applicant and the trademark of the opposer.

The respondent-applicant's evidence consists of the following:

1. Exh. "1" – Copy of the drawing of respondent-applicant's trademark applied for;
2. Exh. "2" – Affidavit of Ma. Victoria Lakhmani;

The Opposer filed a reply on 08 September 2008. After the termination of the preliminary conference, this Bureau issued Order No. 2009-206 directing the Parties to submit the respective position papers. The Opposer filed its position paper on 14 November 2008 the Respondent-Applicant did so on 16 February 2009.

The issues to be resolve in this case are:

1. Whether the opposition complies with the requirement under the Regulations on the Inter Parties Proceedings:
2. Whether the Opposer's mark "IC! Berlin" and IC! are well-known marks; and
3. Whether the Respondent's mark EYE SEE is confusingly similar to the Opposers.

On the issue of the timeliness of the filing of the verified notice of Opposition, the Opposer's deadline was on 07 June 2008 which was a Saturday. The Opposer therefore, had

until 09 June 2008, the following Monday to file the opposition. 09 June 2008 however, was declared a holiday. Accordingly, the filing of the verified notice of the opposition on 10 June 2008 was still within the reglementary period under Section 4 (a), Rules 7 of the Rules and Regulations on Inter-Parties Proceedings, to wit:

“Section 4. (a) Extension of period for filing the verified opposition. – For good cause shown and upon payment of the required surcharge the time for filing the verified opposition maybe extended for an addition one month by the Director upon the written request of the Opposer. Whenever, an extension is granted the Director shall cause the applicant to be notified thereof. The petition for extension shall be filed in triplicate. However, in no case shall the period within which to file the verified opposition exceed four months from the date of release of the IPO Gazette publishing the mark being opposed. The last day for filing of the notice of opposition of the verified opposition falls on a Saturday, Sunday. Holiday, non working holiday as maybe declared by the President of the Philippines of on a day of the Office or the Bureau is close for business as may be declared by the Director General. The same shall be move to the immediately following working day.”

This Bureau also finds the Respondent-Applicant’s contention that the opposition was not properly verified untenable. The records show that Del Rosario Bagamasbad & Rebecca Law Office or any of its, partners, senior associates, agents and representatives was authorized by the Opposer to execute and sing the required verification and certification against non forum shopping.

With respect to the second issue, Sec. 123.1 (e) Rep. Act. No. 8293 also known as the Intellectual Property Code of the Philippines (“IP Code”), provides.

SEC. 123 Registrability – 123. A mark cannot be registered if it:

xxx

(e) is identical with or confusingly similar to or constitute 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 that the applicant for registration and used for identical or similar goods or services. Provided, that determining whether a mark is well known, account shall betaken of the knowledge of the relevant section 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.

Corollarily thereto, Rule 102 of the Trademark Regulation sets forth the criteria on determining whether a mark is a well known mark. To:

- (a) the duration, extent and geographical area of any use of the mark in particularly, 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 supplies;
- (b) the market share in the Philippines and in other countries, of the goods and/or services to which the mark applied;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;

- (f) the exclusivity or registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the right in the mark;
- (k) the outcome of litigation dealing with the issue of whether the mark is a well known mark; and
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well known

While the Opposer submitted copies or certificates or registration of the marks IC! Berlin and IC! in Germany, Taiwan, Japan, Canada, China, Singapore, United States of America, Australia, Hong Kong, Korea and in the Philippines, this Bureau finds the other pieces of evidence, i.e., printouts from website www.ic-berlin.de, picture of the IC! Berlin product and promotion materials in the Philippines, a Catalogue of IC! Berlin and sample invoices of IC! Berlin and sample of IC Berlin pertaining to the sales in the Philippines limited in extent and scope and thus, not sufficient to declare the mark well known under the abovementioned rule.

Going to the third issue, it must be emphasize that the essence of trademark registration is to give protection to the owner of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the article to which it is affixed, to secure to him, who has been instrumental in bringing into a 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 substitution and sale of an inferior and different articles as his products.

Thus, Section 123.1 (d) of Rep. Act. No. 8293 also known as the Intellectual Property Code of the Philippines (IP Code) states that a mark can not 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 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. As the likelihood of confusion of goods or business is a relative concept, to be determined only according to the particular, and sometimes peculiar, circumstances of each case, 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.

It is undisputed that the Opposer's mark IC! Berlin is registered here in the Philippines under Registration No. 4-2006-500258 for goods under Class 09. On the other hand, the Respondent-Applicant's mark EYE SEE for use on goods under the same class was applied for registration on 22 August 2007. Clearly, the Opposer already had an existing registration even before the Respondent-Applicant filed its application for registration of her mark EYE SEE. Thus,

the question now is: Does the competing marks resemble each other that confusion or deception or mistake is likely to occur?

The competing marks are shown below for comparison:

ic! berlin

Opposer's mark



Respondent-Applicant's Mark

Visually, the Opposer's mark is entirely different from that of the Respondent-Applicant's mark. The Opposer's mark IC! Berlin is a word mark while the Respondent-Applicant's mark consists of a "square with the words EYE SEE and Reading Glasses with a drawing of an eye in the middle". The use of a different word and the presence of a graphic or device in the Respondent-Applicant's mark makes it distinguishable from that of the Opposer's.

Also, the Opposer's argument that the "EYE SEE and Device" not only sound similar but in fact sounds identical is untenable. Under the Philippine setting, a person who will come across the Opposer's mark "IC!" for the first time will read and pronounce it together as "IK" rather than read it separately as "I-C" considering that the mark of the Opposer is not well-known or popular here in the Philippines. The Opposer did not present any evidence of radio or television advertisement of its IC! Berlin products to show that the purchasing public is aware or knows of its mark as to likely create confusion or mistake that the Respondent-Applicant's mark "EYE SEE" and the Opposer's mark "IC!" are one and the same.

Thus, considering therefore that the Respondent-Applicant's mark is neither identical or confusingly similar to that of the Opposer's mark, the same can be registered.

WHEREFORE, premises considered, the instant opposition to Trademark Application Serial No. 4-2007-009110 is hereby DENIED. Let the file wrapper of Trademark Application Serial No. 4-2007-009110 be returned, together with a copy of this Decision to the Bureau of Trademark (BOT) for appropriate action.

SO ORDERED.

Makati City, 15 February, 2011.

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