

KAYLA FOODS INTERNATIONAL  
(BARBADOS) INC,

Opposer,  
-versus-

Inter Partes Case No. 14-2010-00122

Opposition to:  
Appl'n. Serial No. 04-2008-014732  
(Filing Date: 05 Dec. 2008  
Trade Mark: "YOH-GURT FROZ w/  
Stylized Letters and Device"

GLACIER DAY DIVERSIFIED,  
VENTURES, INC.

Respondent-Applicant.

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Decision No. 2011- 90

## DECISION

Kayla Foods International (Barbados), Inc. ("Opposer") filed on 21 June 2010 an opposition to Trademark Application No. 4-2008-014732 filed by Glacier Bay Diversified Ventures, Inc., ("Respondent-Applicant"), covering the mark "YOH-GURT FROZ w/ Stylized Letters and Device" for use on "frozen yogurt treats" falling under Class 29 of the International Classification of goods.

The opposer alleges, among other things, that it is the lawful owner of the internationally well-known "YOGEN FRUZ" trademark for frozen yogurt, milk shakes and frozen yogurt pies falling under International Class 30, and the first to adopt, use and register it worldwide including the Philippines. The Opposer claims that it enjoys under Sec. 147 of Rep. Act No. 8293 the right to exclude others from registering or using identical or confusingly similar for use on similar or related goods. According to the Opposer, the Respondent-Applicant's mark is identical and/or confusingly similar to "YOGEN FRUZ" and thus, when applied to or used in connection with the goods of the Respondent-Applicant, will cause confusion, mistake or deception as being a trademark owned by the Opposer, or as being affiliated, connected, or associated with the Opposer, or as to origin, sponsorship, or approval of its goods and services.

To support the opposition, the Opposer submitted the following:

1. Exh. "A" : Certified true copy of Registration No. 4-2007-004411, issued on 02 May 2007 by the Intellectual Property Office for the mark YOGEN FRUZ;
2. Exh. "B": Notarized Affidavit of David Murray;
3. Exh. "B-Series": Copies of Opposer's certificates of registration worldwide covering the YOGEN FRUZ trademark issued in other countries.
4. Exh. "C": Print-out of home page of the Opposer's website showing YOGEN FRUZ;
5. Exh. "D-Series": Representative samples for the purchases of products/services bearing the mark YOGEN FRUZ;
6. Exh. "E-Series": Copies of the Opposer's annual sales reports from the year 2002 to 2008;
7. Exh. "F-Series": Copies or samples of the Opposer's promotion, advertisements, in magazine and brochures; and
8. Exh. "G-Series": Copies or surveys showing the ranking of Opposer's YOGEN FRUZ products in various years.

The respondent-Applicant filed its verified answer on 11 November 2010, alleging among other things, that its trademark is not confusingly similar to the Opposer's. The Respondent-Applicant asserts that its mark differs from the Opposer's in sound, spelling, appearance and as to their meaning. It submitted evidence consisting of the following:

1. Exh. "1" : Certified true copy of the Notice of Final Rejection;

2. Exh. "2" : Certified true copy of the Application Serial No. 4-2008-014732 for the mark YOH-GURT FROZ;
3. Exh. "3" Copy of the Notice of Final Rejection correctly mailed to Respondent-Applicant's authorized representative on 19 June 2009;
4. Exh. "4" and "5" : Copies of Notice of Appeal and the Appellants' Brief; and
5. Exh. "6": Certified true copy of the decision of the Bureau of Trademarks.

Should the trademark application of the Respondent-Applicant for the mark "YOH-GURT FROZ w/ Stylized Letters and Device" be allowed?

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; to protect the manufacturer against and sale of inferior and different articles as his products.

Thus, Sec. 123.1 (d) of Rep. Act No. 8293 states that a mark cannot be registered if it is identical with a registered mark with an earlier filing or priority date, in respect of the same goods or services, or closely related goods or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

Records and evidence show that the Opposer is the first to adopt, use and register the YOGEN FRUZ in the Philippines and worldwide for frozen yogurt, milk shakes and frozen yogurt pies. In the Philippines, YOGEN FRUZ is registered under Reg. No. 4-2007-004411, issued on 02 May 2007. On the other hand, the Respondent-Applicant filed its trademark application only on 05 December 2008, Furthermore, the Respondent-Applicant's trademark application covers goods (frozen yogurt treats), which are similar or related to the goods on which the Opposer's mark is used.

Thus, this Bureau finds the Respondent-Applicant's mark confusingly similar to the Opposer's. The Opposer's mark consists of the words "YOGEN" and "FRUZ", which are actually fanciful representations of the words "yogurt", and "froze", respectively. The Respondent-Applicant's mark on the other hand, also contains playful representations of the word "yogurt", and "frost" or "froze". Moreover, the letter "U", represented by the figure of a smiling face, appears in both marks. Thus, to the eyes, ears, and even in the minds, the Respondent-Applicant's mark could be just a variation of the Opposer's, the SUNDAE CONE DEVICE in the Respondent-Applicant's mark notwithstanding. The feature in the Respondent-Applicant's mark does not render a character sufficient to clearly distinguish it from the Opposer's. The consumers will likely assume or think the goods or services originate from the Opposer's and/or the parties are affiliated with or connected to each other. It is stressed that 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 person, or such resemblance to the original as to deceive ordinary purchasers as to cause him to purchase the one supposing it to be the other.

The determinative factor in a contest involving registration of trademark is not whether the challenged mark would actually cause 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 trademark, patent warrant a denial of an application for registration, the law does not require that the competing trademarks must be identical as to produce actual 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, moreover, the likelihood of confusion would subsist not only in the public perception of services but on the origin thereof as held by the Supreme Court.

In conclusion, this Bureau finds that Trademark Application Serial No. 4-2008-014732 therefore, is proscribed by Sec. 123.1 (d) of Rep. Act No. 8293.

WHEREFORE, premises considered, the instant opposition is hereby SUSTAINED. Let the filewrapper of the Trademark application No. 4-2008-014723 filed on 09 August 2011 by Glacier Bay Diversified Ventures, Inc., (Respondent-Applicant) for the mark "YOH-GURT FROZ w/ Stylized letters and Device" together with a copy of this DECISION, be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 17 November 2011.