

BODY BY JAKE, INC., BODY BY JAKE	}	IPC No. 14-2007-00316
ENTERPRISES LLC., and BODY BY	}	Opposition to:
JAKE GLOBAL LLC.,	}	Appln. Serial No. 4-2005-007886
Opposer,	}	Date Filed: 15 August 2005
	}	Trademark: "BODY BY JAKE"
-versus-	}	Class 28: "Exercise machine"
	}	
CHRIS T. SPORTS PLAZA,	}	
Respondent-Applicant.	}	
x-----x		Decision No. 2009-128

DECISION

For decision is the Notice of Opposition filed by Body By Jake, Inc., Body By Jake Enterprises LLC and Body By Jake Global LLC, (hereinafter referred to as opposers), the latter's office address at 11611 San Vicente Boulevard, Suite 515, Los Angeles, California 900, California 90049 against Application Serial No. 4-2006-007886, for the mark "BODY BY JAKE" for goods under class 28 namely "exercise machine" filed by Chris T. Sports Plaza, Inc. (hereinafter referred to as respondent-applicant) with address at Ground Floor, SM City North Edsa, Quezon City Philippines.

The grounds for the opposition are as follows:

I

"Applicant's mark BODY BY JAKE is similar to Opposer's BODY BY JAKE mark, which has been previously used in commerce and registered in the United States of America and other parts of the world and not abandoned, as to be likely, when applied or used in connection with the goods of Applicant, to cause confusion, mistake and deception on the part of the purchasing public.

II

The registration of the mark BODY BY JAKE in the name of the Applicant, violates the pertinent provisions of Republic Act 8293, the Paris Convention for the protection of Industrial Property, and the Agreement on Trade Related Aspects of Intellectual Property Rights to which the Philippines and the United States of America are parties.

III

Applicant's mark BODY BY JAKE is similar to Opposer's BODY BY JAKE mark, which has been previously used on commerce and registered in the United States of America and other parts of the world and not abandoned, as to be likely when applied t or used in connection with the goods of Applicant, to cause confusion, mistake and deception on the part of the purchasing public."

As background, opposers allege the following, to wit:

"There are four companies in the Body by Jake corporate family: (i) Body By Jake, Inc. (ii) Body By Jake Enterprises, Inc. (iii) Body by Jake Enterprises, LLC, and (iv) Body By Jake Global, LLC. These four companies are owned by the same three business partners, with Mr. Jake Steinfeld owning the controlling interest (over 80%). In each company, Body By Jake, Inc. and Body By Jake Enterprises, Inc. are both wholly owned by Body By Jake Enterprises LLC.

The fame of BODY BY JAKE mark traces its roots to Opposer’s founder, Mr. Jake Steinfeld, who has risen from a personal fitness trainer to a global icon of health fitness and physical well-being. From his humble beginnings in the personal training business, Mr. Jake Steinfeld has turned the BODY BY JAKE mark into a premiere fitness product brand. The mark has emerged as a leader in the home fitness market with some of the most successful health and fitness products all bearing the BODY BY JAKE mark. Among these famous fitness products are the AB SCISSOR, CARDIO CRUISER, AB ROCKER, HIP & THIGH SCULPTOR and GRAVITY FORCE TRAINER exercise products. These fitness products have been recognized by the Electronic Retailing Association with 17 nominations and 6 coveted awards.

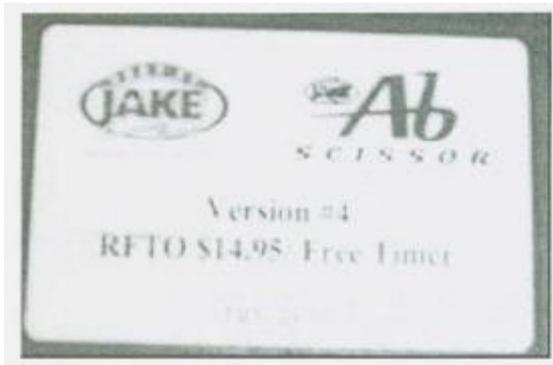
As of the present, Opposers have 3.75 million customers of BODY BY JAKE products worldwide, with \$650 million in retail sales since 1990. To promote the BODY BY JAKE mark and the products being sold under this mark, Opposers have invested over US \$250 million in television, on-line, print and other media promotion.”

Opposers submitted the following evidence, to wit:

ANNEX	DESCRIPTION
“A”	Affidavit of Mr. Kevin D. Gallagher (Annexes 1-9 photographs of promotional materials; Annexes 10-13 photographs of books; Annexes 14-16 photographs of video products; 18-31 certificates of registration in U.S.A., European Community, New Zealand, Norway, Singapore, Hong Kong, China, Canada, Korea, Mexico, Australia, Switzerland)
“B”	Certificate of Registration in the U.S.A.
“C”	Certificate of Registration (Mexico)
“D”	Certificate of Registration (European Community)
“E”	Certificate of Registration (Korea)

A Notice to Answer was received by respondent-applicant on December 4, 2007 but no Answer was filed. The issue in this case is whether respondent-applicant’s mark BODY BY JAKE can be registered and whether opposer’s mark BODY BY JAKE is a well-known mark.

The marks of the contending parties are reproduced below for comparison:



Evidence show that opposers' foreign registrations (Exhibit "A" – Annexes 2-16; Exhibit "B", Exhibit "C", Exhibit "D", Exhibit "E") of the word mark BODY BY JAKE is identical with the word component of respondent-applicant's logo with the words BODY BY JAKE in an eclipse as shown from the filewrapper. Curiously, respondent-applicant's mark it describes, this way, to wit: "Logo with the words "BODY BY JAKE" are inside an ellipse. The words "BODY BY" is located in the upper portion of the ellipse and is enclosed by a small band. The word JAKE is written in capital bold letters beneath the band of "BODY BY". Letter "A" in the word "JAKE" has a star in its center. A swoosh written as a horizontal line is located under the word "JAKE". The swoosh line exactly design as the depiction of opposers mark when contained in all its promotional items and videos. (Exhibit "A" – Annexes 1-16). It is surprising that respondent-applicant has conceptualized exactly the same word mark and logo in all aspects as that of opposers.

In *Shangri-la International Hotel Management, Ltd. v. Developers Group of Companies, Inc.* (G.R. No. 159938, March 31, 2006), the Court held:

"By itself, registration is not a mode of acquiring ownership. When the applicant is not the owner of the trademark being applied for, he has no right to apply for registration of the same. xxx

As correctly observed by the petitioners, to which we are in full accord:

. . . When a trademark copycat adopts the word portion of another's trademark as his own, there may still be some doubt that the adoption is intentional. But if he copies not only the word but also the word's exact font and lettering style and in addition, he copies also the logo portion of the trademark, the slightest doubt vanishes. It is then replaced by the certainty that the adoption was deliberate, malicious and in bad faith.

It is truly difficulty to understand why, of the millions of terms and combination of letters and designs available, the respondent had to choose exactly the same mark and logo as that of the petitioners, if there was no intent to take advantage of the goodwill of petitioner's mark and logo.

As it is incredible that respondent-applicant could have conceptualize the same mark and apply the same on same goods under class 28 namely exercise machine equipment, gymnastic and sporting goods, hence, the same should not be allowed registration. Moreover, records show that BODY BY JAKE is the dominant portion of opposer's corporate names under which they filed this instant opposition. Thus, the word BODY BY JAKE cannot be lawfully appropriated as a mark as the same may cause confusion and deception. The IP Code states, in respect of the protection to trade names:

"Section 165. *Trade Names or Business Names.* 165.1 A name or designation may not be used as a trade name if by its nature or the use to which such name or designation may be put, it is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name."

The Supreme Court in *Converse Rubber Corporation vs. Universal Rubber products* [G.R. No. L-27906. January 8, 1987.], the High Court held:

"Knowing, therefore, that the word "CONVERSE" belongs to and is being used by petitioner, and is in fact the dominant word in petitioner's corporate name, respondent has no right to appropriate the same for use on its products which are similar to those being produced by petitioner.

“A corporation is entitled to the cancellation of a mark that is confusingly similar to its corporate name”. “Appropriation by another of the dominant part of a corporate name is an infringement.”

Opposers witness Kevin D. Gallagher (Exhibit “A”) also testifies that opposers maintain a webpage at www.bodybyjake.com. Thus, it can be said that opposers have promoted their mark.

The Supreme Court in *Pribhdas J. Mirpuri v. Court of Appeals* [G.R. No. 114508. November 19, 1999.] held:

“Today, the trademark is not merely a symbol of origin and goodwill; it is often the most effective agent for the actual creation and protection of goodwill. It imprints upon the public mind an anonymous and impersonal guaranty of satisfaction, creating a desire for further satisfaction. In other words, the mark actually sells the goods. The mark has become the “silent salesman,” the conduit through which direct contact between the trademark owner and the consumer is assured. It has invaded popular culture in ways never anticipated that it has become a more convincing selling point than even the quality of the article to which it refers. In the last half century, the unparalleled growth of industry and the rapid development of communications technology have enabled trademarks, tradenames and other distinctive signs of a product to penetrate regions where the owner does not actually manufacture or sell the product itself. Goodwill is no longer confined to the territory of actual market penetration; it extends to zones where the marked article has been fixed in the public mind through advertising.”

As regards the issue of whether BODY BY JAKE is well-known, Section 123 of the Intellectual Property Code of the Philippines (Republic Act No. 8293, hereafter “IP Code”) provides:

“Sec. 123. *Registrability.* – 123.1 A mark cannot be registered if it:

x x x

(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 services: *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; x x x”

In this regard, evidence is not sufficient to sustain a finding that the mark BODY BY JAKE has acquired distinction, fame, has been promoted and sold on in the Philippines or abroad, thus it cannot be considered well-known.

WHEREFORE, premises considered the OPPOSITION filed by Body By Jake, Inc., Body By Jake Enterprises LLC., and Body By Jake Global LLC., Opposers is, as it is, hereby SUSTAINED. Accordingly, Application Serial No. 4-2005-007886 filed by Respondent-Applicant Chris T. Sports Plaza, Inc. on 15 August 2005 for the mark BODY BY JAKE used on goods under classes 28: namely “exercise machines,” is as it is hereby REJECTED.

Let the file wrapper of “BODY BY JAKE”, subject matter of this case be forwarded to the Bureau of Trademarks (BOT) for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, 13 October 2009.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs