

DREAMWORKS FASHION  
TRADING, INC.  
2007

Petitioner,

- versus -

NEO MARKETING CORPORATION  
Respondent-Registrant.

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IPC No. 14-2007-00276  
Case Filed: 25 September

Cancellation of:

Registration No.: 4-2006-005341  
Date Issued : 21 May 2007  
Trademark : "TATTOO"

Decision No. 2008-95

### DECISION

This is a PETITION FOR CANCELLATION filed by Petitioner Dreamworks Fashion Trading, Inc. to the Registration of the trademark "TATTOO" bearing Registration No. 4-2006-005341 issued on May 21, 2007 by Respondent-Registrant Neo Marketing Corporation covering the goods "Shoes, slippers, sandals, boots, t-shirts, pants, jeans, polo, shirts, dress" under Class 25.

The Petitioner is a corporation organized and existing under and by virtue of the laws of the Republic of the Philippines with place of business located at Lot 9-8 RDC Industrial Compound, Reparó Street, Potrero, Malabon City. Respondent-registrant is a corporation organized and existing under and by virtue of the laws of the Philippines with business address at Sto. Rosario Street, Valenzuela City.

Petitioner hereby declares that:

### PARTIES

1. Petitioner Dreamworks Fashion Trading, Inc. is a corporation organized and existing under and by virtue of the laws of the Republic of the Philippines with place of business located at Lot 98 RDC industrial Compound, Reparó St., Potrero, Malabon City, and where Petitioner may be served with notices, orders and other processes of this Honorable Office.
2. Respondent-Registrant Neo Marketing Corporation is a corporation organized and existing under and by virtue of the laws of the Philippines with business address at Sto. Rosario Street, Valenzuela City and may be served with summons and other court processes in the same address.

### GROUND S FOR CANCELLATION

3. Petitioner is the owner of the mark "TATTOO" as used in the Philippines for goods under Class 25. Opposer is also the owner of other TATTOO marks, either used as composite "SKIN ART TATTOO & DEVICE" or as device "TATTOO DEVICE".
4. Respondent-Registrant trademark "TATTOO", which adopts the exact letters in Petitioner's marks "TATTOO" and "SKIN ART TATTOO & DEVICE" is confusingly similar in spelling, sound and in general appearance, or so resembles Petitioner's above-cited marks as to be likely, when applied to or used in connection with the goods offered by Respondent-Registrant, to deceive or cause confusion.
5. Petitioner's marks "TATTOO" and "SKIN ART TATTOO & DEVICE" were used and adopted by Petitioner even prior to the filing of Respondent-Registrant's trademark

application for TATTOO in May 2006. Being the prior user, Petitioner's rights are invoked pursuant to Sec. 151.1 of R.A. 8293.

6. It is clear that Respondent-Registrant's adoption of identical marks for use on similar goods was for the purpose of taking advantage of or is designed to ride on the goodwill of Petitioner's trademarks "TATTOO", "SKIN ART TATTOO & DEVICE" and "TATTOO DEVICE" used primarily for 'shirts and other wearing apparel' in class 25.
7. The approval of the application for trademark registration of TATTOO for goods in Class 25 in Respondent-Applicant's name will cause great and irreparable damage and injury to herein petitioner.

The petitioner herein will rely on the following facts to support its petition, reserving its rights to present evidence to prove these facts and others as may appear necessary in the course of these proceedings, depending upon the evidence as may be presented by Respondent-Applicant.

8. As lawful owner of various "TATTOO" marks, Petitioner currently maintains the following trademark applications in the Philippines –

Mark	Application No.	Date Filed	Class
TATTOO	4-2007-007436	13 July 2007	25
SKIN ART TATTOO & DEVICE	4-2007-009087	06 July 2007	25
TATTOO DEVICE	4-2006-007412	07 July 2006	25

Attached as Exhibits "A" to "A-2" are certified true copy of trademark applications filed with the Intellectual Property Office for several TATTOO marks in the name of Petitioner herein.

9. Sometime in July 2007, Petitioner learned of Respondent-Registrant's registration of the mark TATTOO.
10. Respondent's Registration Number 42006005341 was filed on 19 May 2006 and covers goods under Class 25, particularly for the following: "shoes, slippers, sandals, boots, t-shirts, pants, jeans, polo, shorts, dress."
11. Petitioner's marks "TATTOO", "SKIN ART TATTOO & DEVICE" and "TATTOO DEVICE" was first adopted on February 2006 specifically when we dealt with SM Mart Inc. Attached as Exhibits "B" to "B 50" are duplicate original copies of sales invoices starting from the period Feb. 06, 2006 to June 29, 2007.
12. Petitioner's TATTOO marks are also promoted locally through extensive sales and advertisement. Attached as Exhibits C to "C 5" are original magazines showing several promotional activities of petitioner to advertise its TATTOO marks.
13. The appropriation, therefore, by Respondent of identical mark "TATTOO" with the same spelling and pronunciation for use on similar goods is a manifest act of bad faith. Petitioner will be damaged and prejudiced by Respondent's unlawful appropriation of an identical and/or confusingly similar "TATTOO" mark.
14. In support of this Petition, attached is the Affidavit-Testimony of Petitioner's President, MARILENE GO.

On 23 October 2007, this Bureau mailed a copy of the Notice to Answer dated 02 October 2007 to respondent-applicant, however the same was returned back because the place cannot be located.

On 27 February 2008, this Bureau issued Order No. 2008-339, the dispositive portion reads to wit:

“WHEREFORE, in view thereof, petitioner is directed to exert diligent efforts to locate and secure respondent-registrant’s exact and complete address, and to inform this Bureau through a written manifestation within twenty (20) days from receipt of its copy of this Order the exact and complete address of respondent-registrant. If the same could not be secured within the said period, petitioner is directed likewise within the same period to file a written manifestation to this effect, upon which notice to answer shall be effected by publication pursuant to Section 14 and 17, Rule 14 of the Rules of Court at petitioner’s expense. Failure to abide by these directives shall be cause for the dismissal of the instant case.”

On 16 April 2008, petitioner filed a MANIFESTATION dated 14 April 2008 requesting that the petition for cancellation be effected by publication which eventually was granted by this Bureau through Order No. 2008-769.

On 10 September 2008, petitioner filed a COMPLIANCE showing that the same has affected the publication of the Petition for Cancellation and Notice to Answer on July 21, 28, and August 4, 2008 at VIEWLINER WEEKLY NEWS.

Despite the publication, no Answer was filed by respondent. On 25 September 2008 Order No. 2008-1445 was issued declaring respondent-registrant to have waived its right to file an Answer and at the same time directed petitioner to file its position papers within a non-extendible period of ten days from receipt of the Order.

The evidences presented by petitioner to support its cancellation case comprises of Exhibits “A” to “C” inclusive of sub-markings.

WHETHER OR NOT RESPONDENT’S REGISTRATION No. 4-2006-005341 SHOULD BE CANCELLED IN ACCORDANCE WITH THE PROVISION OF THE INTELLECTUAL PROPERTY CODE OF THE PHILIPPINES.

The marks of opposer as well as respondent-applicant are reproduced below for comparison:



Petitioner’s Marks



#### Respondent-Registrant's Mark

There is no question that the mark of both parties are confusingly similar to each other, most striking is the word mark TATTOO, which can be found in petitioner's SKIN ART TATTOO mark with application ser. nos. 4-2007-007087 and TATTOO mark with Appln. Ser. Nos. 4-2007-007436. Nowhere in petitioner's application ser. No. 4-2006- 007412 can the "TATTOO" mark be found except for the device which is also present in petitioner's skin art TATTOO and device.

Respondent-registrant's mark "TATTOO" is spelled exactly the same as petitioner's two marks mentioned above which is printed with the first letter capitalized and the rest with small letters. All of the letters were printed slightly on a slant position. While in petitioner's SKIN ART TATTOO WITH DEVICE, there appears a tattoo device on the upper most portion then below it is the skin art words printed in fancy letters and again bellow it is the word tattoo and printed in a straight manner with all letters capitalized. In petitioner's Application Ser. No. 4-2007-007087, only the TATTOO mark is present and printed in a straight, bold and capitalized letter with the font slightly different from the Skin Art Tattoo.

Though the manner of presentation of petitioner's and respondent-registrant's respective marks differ, the word: "TATTOO" appearing on both marks are one and the same such that they have identical denotations and pronunciation. This Bureau holds, thus, that respondent-registrant's mark is confusingly similar to opposer's mark in this sense and, further, in the sense that the ordinary purchaser might likely be induced to believe that the goods of one party are those of the other party and/or that, at the least, there is some connection between opposer and respondent-applicant which, in fact, does not exist. There is likelihood not only of confusion as to goods but also confusion of business especially as the dominant feature of the competing marks- the word "TATTOO"- are one and the same. Similarity in size, form and color, while relevant, is not conclusive. Neither duplication/imitation, nor the fact that the infringing label suggests an effort to emulate, is necessary. The competing marks need only contain the main, essential or dominant features of another; and that confusion and deception are likely (*Sterling Products International, Inc. v. Farbenfabriken Bayer Aktiengesellschaft*, G.R. No. L-19906, April 30, 1969; *Urn Ho. v. Director of Patents*, G. R. No. L-8072, October 31, 1956; *Co Tiong Sa v. Director of Patents, et al.*, G. R. No. L-5378, May 24, 1954).

The records of the case will show however, that respondent-registrant filed its application for the registration of its mark "TATTOO" on 19 May 2006 with Application No. 4-2006-005341 under class 25 which eventually was registered on 21 May 2007, as compared to petitioner who has three (3) applications which are still pending to wit:

Mark	Application No.	Date Filed	Class
TATTOO	4-2007-007436	13 July 2007	25
SKIN ART TATTOO & DEVICE	4-2007-009087	06 July 2007	25
TATTOO DEVICE	4-2006-007412	07 July 2006	25

It is important to emphasize at this point that respondent-registrant filed its application earlier than the three applications of petitioner by more than a year and the fact that respondent-registrant was able to secure the registration of its mark on May 21, 2007 or before the filing of petitioner of its three application, the earliest of which is only on July 6, 2007, giving the same a far better right to the mark in contention.

Considering that the application date of respondent-registrant was made on the year 2006, it is only just and appropriate that R.A. 8293 otherwise known as the Intellectual Property Code of the Philippines be applied, particularly Sec. 123, paragraph d which gives a better right to a registered mark or a mark with an earlier filing or priority date, to wit:

Sec. 123. Registrability. – 123.1 A mark cannot 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;

The principle of “prior use” is material only when use of a trademark is during the effectivity of the (old) Trademarks Law which is prior to January 1, 1998. Meanwhile, the First-To-File Principle, the basis of which is Section 123.1 (d) of the IP Code, is the controlling principle under said IP Code which became effective on January 1, 1998. Section 123.1 (d) in conjunction with Section 124.2 of the IP Code supports the First-To-File Principle. A reading of Section 124.2 which provides that “The applicant shall file a declaration of actual use of the mark with evidence to that effect within three (3) years from the filing date of the application”, the failure of which shall be cause for the application to be refused or the mark removed from the Trademarks Register all the more shows that prior use is not a requirement for registration: An applicant need not prove at the time of the application that there is actual use of the mark prior or even during the application but he has to prove only that there is actual use of the mark through a declaration of actual use with the evidence attached thereto, which declaration may be filed after the filing of the application but should be within 3 years from such filing. If these conditions are not met, the application shall be refused or the mark removed from the Trademarks Register. Meanwhile, Section 2 of the (old) Trademarks Law supports the “prior use” principle, to wit:

“Trade-marks, trade names, and service marks owned by persons, corporations, partnerships or associations domiciled in the Philippines and by persons, corporations, partnerships or associations domiciled in any foreign country may be registered in accordance with the provisions of this Act: Provided, That said trade-marks, trade names, or service marks are actually in use in commerce and services not less than two months in the Philippines before the time the applications for registration are filed: And provided, further, That the country of which the applicant for registration is a citizen grants by law substantially similar privileges to citizens of the Philippines, and such fact is officially certified, with a certified true copy of the foreign law translated into the English language, by the government of the foreign country to the Government of the Republic of the Philippines.” (Underscoring supplied.)

In the instant case, there is no evidence submitted by petitioner to show its use of the mark “TATTOO” in the Philippines during the effectivity of the (old) Trademarks Law notwithstanding its allegation that it has prior use.

Since respondent-registrant’s mark is duly registered with this Office, Sec. 138 of the R.A. 8293 further states, a viz;

“Sec 138. Certificate of Registration. - A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.”

Hence, this Bureau finds no cogent reason to cancel Registration No.: 4-2006-005341 for the trademark “TATTOO” with respect to and in accordance with the provisions of applicable laws particularly the Intellectual Property Code of the Philippines.

WHEREFORE, premises considered, the PETITION FOR CANCELLATION is, as it is, hereby DENIED for lack of merit. Consequently, Registration No. 4-2006-005341 for the registration of the mark "TATTOO" issued on May 21, 2007 by Respondent-Registrant Neo Marketing Corporation for goods under Class 25, namely, "shoes, slippers, sandals, boots, t-shirts, pants, jeans, polo, shorts, dress" remains valid.

Let the filewrapper of the trademark "TATTOO" subject matter under consideration be forwarded to the Bureau of Trademark (BOT) for appropriate action in accordance with this Decision

SO ORDERED.

Makati City, 30 July 2009.

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