

GILMAR S.P.A and  
SEMINVEST INVESTMENTS B.V.,  
Opposer,  
- versus -

IPC 14-2007-00006

Opposition to:  
TM Application No. 4-2004-007508  
(Filing Date: 17 August 2004)

RAMON ONG,  
Respondent-Applicant.  
x-----x

TM: "ICE JEANS"  
Decision No. 2007 – 85

## DECISION

This is an opposition to the registration of the mark "ICE JEANS" under Application No. 4-2004-007508 filed on August 17, 2004 covering the goods "t-shirts, polo shirts, pants, jeans, slacks, jackets, briefs, panties, belts, caps, blouses, skirts, socks, suspenders, coats, vests, sweaters, jogging suits, swimming trunks, swimsuits, shorts, shoes, slippers, sandals and boots" falling under Class 18 and 25 of the International Classification of goods which application was published on Intellectual Property Philippines (IPP) Official Gazette on September 1, 2006.

The Opposers in the instant opposition are "Gilmar S.P.A." a company duly organized and existing under the laws of Italy with principal office located at Via Malpaso 723/725 S. Giovanni Marignano RN., Italy and "Seminvest Investments B.V." a company duly organized under the laws of The Netherlands, with principal office at 61 Max Ewuelaan, Rotterdam, The Netherlands.

On the other hand, the Respondent-Applicant is "Ramon Ong" a Filipino citizen with address at 33 Panalturan Street, Del Monte 1, Quezon City.

The grounds for the opposition are as follows:

- "1. The allowance of registration of the mark "ICE JEANS" contravenes Section 123.1 (d) and (e) of the Republic Act No. 8293 ("R.A. No. 8293" or the IP Code)
- "2. The mark "ICE JEANS" is identical to and so resembles the Opposers' well-known marks "ICE" and "ICE JEANS", for goods falling under, among others International Class 25, and also Opposers' well-known mark "ICEBERG" bearing Application No. 4-1998-0054, filed on January 27, 1998 for goods falling under, among others, International Class 25, when applied to or used in connection with the Respondent-Applicant's sought-to-be covered goods, as to likely deceive or caused confusion with Opposers' goods.
- "3. The use by Respondent-Applicant of the words "ICE JEANS" on goods that are similar, identical or closely related to the goods that are produced by, originate from, or are under the sponsorship of Opposers, will greatly mislead the purchasing public into believing that Respondent-Applicant's goods are produced by, originated from, or are under sponsorship of herein Opposers.
- "4. Opposers have not abandoned the use in many countries around the world of their "ICE" and "ICE JEANS" and "ICEBERG" mark.
- "5. Opposers' marks are well-known marks which are entitled to broad protection under Article 6bis of the Paris Convention for the Protection of Industrial Property ("Paris Convention") and Article 16 of the Trade-Related Aspects of Intellectual Property (TRIPS Agreement") to which the Philippines, Italy and the Netherlands are signatories.

“6 The registration of Respondent-Applicant’s “ICE JEANS” mark contravenes the provisions of Republic Act No. 8293, the Paris Convention and the TRIPS Agreement, hence is subject to non-allowance for registration under the pertinent provisions of Republic Act No.8293 the Paris Convention, and the TRIPS Agreement.

Opposers relied on the following to support their opposition:

“1. Opposers are the true owners of the marks “ICE”, “ICE JEANS” AND “ICEBERG” which have been registered in the Opposers’ name elsewhere around the world to wit:

Country of Registration	Registration No.	Date of Registration	Classes/ Goods Covered
Japan	2288662	Dec. 26, 1990	25
U.S.A	1,850,0734	Aug. 23, 1994	8, 15
Singapore	T87/02878J	June 17, 1987	25
Germany	397 49 450	Oct. 16, 1997	25
Australia	A564045	June 3,1987	25
Hong Kong	199711714	Nov. 18, 1996	18
China	396388	April 16, 2006	40
OPMI	513595	July 13, 1987	3, 18, 25

The Registration Certificates are attached and marked hereto as Annexes “A” to “H” respectively to from integral parts hereto.

- “2. Opposers have been commercially using the “ICE” mark internationally on January 19, 1999, which use antedates the use by Respondent-Applicant of his “ICE JEANS” mark.
- “3. Opposer have been commercially using the “ICE JEANS” mark internationally and in the Philippines respectively on January 19, 1999 and February 11, 2002, which use antedates the use by Respondent-Applicant of his “ICE JEANS” mark.
- “4. Opposers have been commercially using the “ICEBERG” mark internationally since 1974 and in the Philippines on April 3, 1996, which use antedates the use by Respondent-Applicant of his “ICE JEANS” mark.
- “5. In support of Opposers’ claim that they have made extensive commercial use in the Philippines and worldwide of their “ICE, “ICE JEANS” and “ICEBERG” marks, marked and attached hereto as Annexes “I” to “O” are sales summaries through the years made of products bearing said marks. Likewise the Philippines invoices, as well as invoices from Korea, Taiwan and Singapore are marked and attached as Annexes “P” to “P-26” to “Q-26” and “S” to “S-7”.
- “6 In further support of Opposers’ claim that their aforementioned marks have gained international notoriety, via extensive publicity and promotions of said mark, marked and attached hereto, as Annexes “T” to “T-65”. Are advertisements/catalog, pictures featuring Opposer’s marks. Furthermore, Opposer’s worldwide advertising investments summary is marked and attached herewith as Annex “U”, to from an integral part hereof.
- “7. By spelling, pronunciation and appearance, the words “ICE JEANS” are identical to add/or confusingly similar to the Opposer’s marks “ICE”, “ICE JEANS” and “ICEBERG”.

- “8. Opposers continue to use the marks “ICE”, “ICE JEANS” and “ICEBURG” worldwide.
- “9. By virtue of the prior registration of the marks “ICE”, “ICE JEANS” and “ICEBURG” in various countries around the world, as well as the prior and continued use of said marks in said other countries around the globe by herein Opposers, said marks have become popular and internationally well-known and have established valuable goodwill for the Opposers with the general purchasing public, which have identified Opposers as the owner and the sources of goods bearing the said marks.

After the Respondent-Applicant filed his Answer and compliance, a Notice to a Preliminary Conference was issued by the Bureau of Legal Affairs setting the hearing on May 23, 2007 at 2:00 in the afternoon.

On May 23, 2007, only the counsel for the Opposers appeared. There was no appearance on the part of the Respondent-Applicant.

Order no. 2007-933 dated 28 May 2007 was issued ordering the Opposers to file their position paper and declaring Respondent-Applicant right to submit his position paper deemed WAIVED.

The ultimate issue to be resolved in the instant opposition is:

WHETHER OR NOT RESPONDENT-APPLICANT IS ENTITLED TO THE REGISTRATION OF THE MARK “ICE JEANS”.

The appliance provisions the law is Section 123.1 (d) of Republic Act No.8293, otherwise known as the Intellectual Property Code of the Philippines which provides:

Sec.123. Registrability- 123.1. A mark cannot be registered if it.

x                      x                      x

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in a 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 likely to deceive or cause confusion;

The Opposer submitted the following as their evidences

Annex	Description
Annexes “A” to “H”	List of Country Registration Certificates of the marks “ICE”, “ICE JEANS” and “ICEBERG” in the name of the Opposers
Annexes “I” to “O”	Sales summaries through the years made of products bearing the marks “ICE”, “ICE JEANS” and “ICEBERG” in the Philippines and worldwide.
Annexes “P” to “P-26”, “Q” to “Q-26”, “R” to “R-22” and “S” to “S-7”	Invoice for the Philippines, Korea, Taiwan and Singapore
Annexes “T” to “T-65”	Advertisements, catalog pictures featuring Opposer’s marks.

Annex "U"	Opposer's worldwide advertising investments summary
-----------	---

On the other hand, Respondent-Applicant submitted the following as his evidence in support of his trademark application subject of the instant opposition.

Exhibit	Description
Exhibit "1"	The Verified Answer
Exhibit "2"	The Verification of Silvano Gerani (Annex "A" of the verified Answer and the Affidavit of Ramon Ong)
Exhibit "2-a"	The Verification of Walter Hoogstraate/Teun de Bruin (Annex "A" of the verified Answer and the Affidavit of Ramon Ong)
Exhibit "3"	The Affidavit of Respondent-Applicant Ramon Ong.

Records will show that the trademark of the Respondent-Applicant consist of the words "ICE JEANS". However, the exclusive right to use the word "JEANS" has been disclaimed apart from the mark sought for registration by the Respondent-Applicant. Relative thereof what is actually sought to be registered is only the word "ICE".

On the other hand, the Opposers trademarks are the following:

1. ICE
2. ICE JEANS
3. ICEBERG

In ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, two kinds of test have been developed. The dominancy test applied in the following cases:

1. Asia Brewery, Inc. vs. Court of Appeals, 224 SCRA 437
2. Co Tiong vs. Director of Patents, 95 Philippines 1
3. Lim Hoa vs. Director of Patents, 100 Philippines 214
4. American Wire & Cable Company vs. Director of Patents, 31 SCRA 544
5. Philippine Nut Industry, Inc., vs. Standard Brands, Inc., 65 SCRA 575
6. Converse Rubber Corporation vs. Universal Rubber Products, Inc., 147 SCRA 154

And the *holistic test* applied in the following cases:

1. Del Monte Corporation vs. Court of Appeals, 181 SCRA 410
2. Mead Johnson & Co., vs. N.V.J. Van Dorp, Ltd., 7 SCRA 771
3. Bristol Myers Co., vs. Director of Patents, 17 SCRA 128
4. Fruit of the Loom, Inc., vs. Court of Appeals, 133 SCRA 405

As its title implies the test of dominancy focuses on the similarity of the prevalent, essential or dominant features of the competing trademarks which might cause confusion or deception. On the other side of the spectrum, the holistic test mandates that the entirety of the marks in question must be considered in determining confusing similarity.

An examination of the conflicting marks "ICE", "ICE JEANS" and "ICEBERG" of the Opposer and "ICE JEANS" of Respondent-Applicant as shown and presented in their respective

labels show that dominant feature of the marks is the word "ICE". It is very clear and there is no doubt that they are identical or similar in spelling, composition of letters, pronunciation as well as in meaning.

The remaining issue to be resolved is who between the parties has a better right over the trademark involved in the instant opposition?

The Opposers marks were registered in the following countries (exhibits "A" to "H"):

Country of Registration	Registration No.	Date of Registration	Classes / Goods Covered
Japan	2288662	Dec. 26, 1990	25
U.S.A.	1,850,0734	Aug. 23, 1994	8,15
Singapore	T87/02878J	June. 17, 1987	25
Germany	397 49 450	Oct. 16, 1997	25
Australia	A564045	June 3, 1987	25
Hong Kong	199711714	Nov. 18, 1996	18
China	396388	April 16, 2006	40
OMPI	513595	July 13, 1987	3, 18, 25

It appearing that the Opposers mark having been registered in Singapore on June 17, 1987 and Australia on the same year and in 1994 in Japan, periods were more than ten (10) years before the Respondent-Applicant's trademark application was filed on its registration with the Intellectual Property Office of the Philippines which was on August 17, 2004.

Likewise Opposers mark commercially used in the Philippines as early as 1996 (paragraph 4 of the affidavit of Silvano Gerani, the Legal Officer of Gilmar S.P.A. marked as Exhibit "V" as requested)

It must also be noted that the Respondent-Applicant admitted the Opposers used of the mark in the Philippines but claimed that said commercial use was abandoned. (Paragraph 2.1 of the verified Answer).

On the other hand, Respondent-Applicant failed to submit proof to use his mark in commerce in the Philippines, except for his claim for his affidavit, paragraph 2.2 being the first party to file an application for the registration of the mark "ICE JEANS" in the Philippines, Respondent-Applicant owns the said mark.

In paragraph 5.0 of the affidavit of the Respondent-Applicant, he claimed that he is using the mark "ICE JEANS" in the Philippines through his related companies, however, the allegations has not been substantiated by any Proof of evidence.

Moreover, Opposer 's mark "ICEBERG" for use in goods under Class 25 bearing Serial No. 4-1998-0084 has been filed as early as January 27, 1998 and use since 1998. It shows therefore, Opposer is the prior adopter and user of the mark "ICE", "ICEBERG" and therefore has a better right over the same.

It is a fundamental principle in the Philippines Trademarks law that actual use in commerce in the Philippines is a pre-requisite to the acquisition of ownership over a trademark or trade name (Kabushiki Kaisha Isetan vs. Intermediate Appellate Court, et al., G.R. No. 75420, November 15, 1991).

Likewise, the use required as a foundation of the trademark rights refer to local use at home ad not abroad (2 Callman Unfair Competition and Trademarks, par. 76, p. 1006).

Therefore, considering the evidences presented, it is safe to conclude that Opposers have validly proven its prior use of the mark "ICE JEANS".

"A rule widely accepted and firmly entrenched because it has come down through the years is that actual use in commerce or business is a pr-requisite to the acquisition of the right ownership of a trademark."

As claim by Opposers, their trademark, specifically the mark "ICE" is well-known internationally is of no moment.

It is worthy to note that Memorandum issued by the then Ministry of Trade, Honorable Luis B. Villafuerte dated 20 November 1980, specifically made mention what are those internationally known marks, but the "ICE" is not one of them.

WHEREFORE, premises considered, the instant opposition is, as it is hereby SUSTAINED. Consequently, application bearing No.4-2004-007508, for the mark "ICE JEANS" filed on August 17, 2004 by herein Respondent-Applicant Ramon Ong is hereby REJECTED.

Let the filewraper of the trademark "ICE JEANS" subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 26 June 2007.

ESTRELITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affair  
Intellectual Property Office