

GOLDEN ABC, INC.,	}	IPC No. 14-2008-00195
Opposer,	}	Case Filed on: August 28, 2008
	}	
-versus-	}	Opposition to:
	}	App. Serial No. 4-2007-013256
G.M. STEMIKO CORPORATION,	}	Date Filed: 29 November 2007
Respondent-Applicant.	}	TM: "DENIM HUB"
	}	DECISION No. 2009-17

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DECISION

Before us is a Verified Notice of Opposition filed against the application for registration of the mark "DENIM HUB" used for all kinds of articles of outer and underwear for men, women, teenagers and children namely shirts, blouses, skirts, suits, pants, trousers, jeans, vest, dresses, ties, coats, jackets, stocking lingerie, panties, slippers, camisoles, bras, girdles, briefers, briefs, sandos, robes, socks, gloves, scarves, shoes, slippers, head wear, namely hats, caps, berets under Class 25 of the international classification of goods bearing Application Serial No. 4-2007-013256 which was published in the Intellectual Property Office Electronic Gazette on 11 July 2008.

Opposer, GOLDEN ABC, INC. is a domestic corporation, with business and postal address at 880 A.S Fortuna Street. Banilad, Mandaue City, Cebu. On the other hand, Respondent-Applicant, G.M STEMIKO CORPORATION, is also a domestic corporation with address at No. 7 Corinthian Villas, Posadas Avenue, Sucat, Muntinlupa City.

GROUND FOR OPPOSITION

The subject mark DENIM HUB is confusingly similar to and sounds almost exactly the same as the Opposer's registered marks. Moreover, the subject mark is applied for Class 25 the same class where the Opposer's DENIMLAB mark is also registered. Thus, the DENIM HUB application should be denied.

Opposer relied on the following facts to support its opposition:

1. The Opposer, since 1986, has been engaged in the retail business, selling men's and women's wearing apparel, and later, toilette/bath products (including shampoos, hair dyes, and hair gels), fashion accessories and paper products bearing the PENSHOPPE, OXYGEN, FORME, MEMO and other trademarks in various department stores, boutiques, outlets and specifically stores nationwide. The Opposer operates a total of 42 company-owned "OXYGEN" boutiques and up to 27 "OXYGEN" concessionaire outlets in major department stores nationwide
2. The Opposer, as early as February 2004, has been engaged in the retail business, selling men's and women's wearing apparel, toilette/bath products and personal care products, fashion accessories and paper products bearing the trademark DENIMLAB in various department stores, boutiques, outlets and specially stores nationwide. DENIMLAB products are found in the Opposer's 108 company-owned "Penshoppe" boutiques and up to 30 outlets in major department stores nationwide
3. As early as February 27, 2004, Opposer filed an application for registration of PENSHOPPE DENIMLAB as a trademark for Class 25 and was subsequently granted registration on 17 August 2006.

4. As early as September 30, 2004 the Opposer filed an application for registration of DENIMLAB as a trademark for Class 25 and was subsequently granted registration on 08 June 2006.

5. The Opposer has trademark registration of DENIMLAB in Class 3.

6. The Opposer has trademark registration of DENIMLAB in Class 35.

7. The Opposer has the following trademark registrations and applications for DENIMLAB together with words:

a. DENIMLAB Flirt – Trademark Certificate of Registration No. 4-2006-009393 for Class 25;

b. DENIMLAB Rebel – Trademark Certificate of Registration No. 4-1997-009394 for Class 25;

c. DENIMLAB Revolt – Trademark Certificate of Registration No. 4-2006-009395 for Class 25;

d. DENIMLAB Rock – Trademark Certificate of Registration No. 4-2006-009396 for Class 25;

e. DENIMLAB Rule – Trademark Certificate of Registration No. 4-2006-009397 for Class 25

f. DENIMLAB Flaunt – Trademark Certificate of Registration No. 4-2006-004948 for Class (deemed registered)

8. Since its adoption in February 2004 and its continued use in commerce up to the present day, the DENIMLAB trademark has been developed and has been applied for trademark registration for products relating to clothing. This same mark was extensively advertised by the Opposer in the Philippines on the following products: shirts, jackets, jeans, footwear, sandals, shoes, towels, bags, socks, handkerchiefs, as well as perfumes, eau de toilette, body sprays, bath soaps, underwear, trinkets, bracelets, and other fashion accessories and paper products.

9. Among the A-list celebrity endorsers of DENIMLAB are as follows:

a. Jericho Rosales;

b. Heart Evangelista;

c. Nikki Gil;

d. Dawn Balagot

e. Victor Basa; and

f. Einar Ingebrigsten.

10. The Opposer is filing this opposition against the registration of the subject mark on the ground that it creates confusion of origin, source, and business, causing injury and damage on the original trademark DENIMLAB.

11. The Respondent is applying for the registration of DENIMHUB for Class 25. Since the Opposer's DENIMLAB was previously registered in Class 25, the likelihood of confusion is very apparent.

Attached to the Verified Opposition are the following evidences:

Exhibits	Description
"A"	Certified copy of Trademark Certificate of Registration No. 4-2004-001831 for PENSHOPPE DENIMLAB for Class 25
"B"	Certified copy of trademark Certificate of Registration No. 4-2004-009111 for DENIMLB for Class 25
"C"	Certified copy of Trademark Certificate of Registration No. 4-2006-003229 fro DENIMLAB for Class 3
"D"	Copy of Trademark Certificate of Registration No. 4-2008-005121 for DENIMLAB for Class 35
"E"	Copy of Trademark Certificate of Registration No. 4-2006-009393 for BENIMLAB Flirt for Class 25
"F"	Copy of Trademark Certificate of Registration No. 4-2006-009394 for DENIMLAB Rebel for Class 25
"G"	Copy of Trademark Certificate of Registration No. 4-2006-09395 for DENIMLAB Revolt for Class 25
"H"	Copy of Trademark Certificate of Registration No. 4-2006-009396 for DENIMLAB Rock for Class 25
"I"	Copy of Trademark Certificate of Registration No. 4-2006-009397 for DENIMLAB Rule for Class 25
"J"	Copy of Trademark Certificate of Registration No. 4-2007-004948 for DENIMLAB Flaunt for Class 25
"K" to "K-17"	Advertising materials of Opposer for DENIMLAB

On 15 September 2008, this Bureau issued a Notice to Answer, which notice was served personally to Respondent-Applicant's representative Mr. Angel Olandres, Jr. on 19 September 2008. However, despite having received the notice, Respondent-Applicant failed to file is verified Answer within the reglementary period. On 22 January 2009, this Bureau issued Order No. 2009-207 waiving Respondent's right t file the answer and its supporting documents and submitted the case fro decision.

Section 123.1 of Republic Act No. 8293, as amended, provides:

"*SEC. 123. Registrability.* – 123.1 A mark cannot be registered if it:



x 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 respect of:

- i. The same goods or service, or
- ii. Closely related goods or service, or
- iii. If it nearly resembles such a mark as to be likely to deceive or cause confusion;”

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 the mark would likely cause confusion or mistake on the part of the buying public. The law does not require that the competing marks must be so identical as to produce actual error or mistake. It would be sufficient that the similarity between the two marks is such that there is possibility of the older brand mistaking the newer brand for it. Whether or not a trademark causes confusion and likely to deceive the public is a question of fact which is to be resolved by applying the “test of dominancy.” meaning, if the competing trademark contains the main or essential or dominant features of another by reason of which confusion and deception are likely to result, then infringement takes place; and that duplication or imitation is not necessary, a similarity of the dominant features of the trademark would be sufficient. The test of dominancy is now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code, which defines infringement as the “colorable imitation of a registered mark . . . or a dominant feature thereof.”

To determine whether Respondent-Applicant’s mark is confusingly similar to Opposer’s mark, the parties’ marks are shown below for purposes of comparison:

Opposer’s Marks	Respondent-Applicant’s Mark
	

By applying the dominancy test, it is evident that the mark DENIM HUB so resembles the trademark DENIMLAB that it will likely cause confusion, mistake or deception on the part of the purchasing public. By comparing the above marks, Opposer has correctly observed glaring similarities between the contending marks, to wit: “Both DENIMLAB and DENIM HUB are composed of three syllables: The first two syllables (DENIM) are exactly the same. The last syllable is composed of the same number of letter (3) and both end with the same letter (B). LAB and HUB sound almost exactly the same. When both words are pronounced, they sound almost exactly the same. Upon hearing DENIM HUB and DENIM LAB, the aural impression created is that the two sound exactly alike.”

In the case of MARVEX COMMERCIAL CO. INC. vs. PETRA HAWPIA & CO., and THE DIRECTOR OF PATENTS, the Supreme Court held in this wise:

“Two letters of “SALONPAS” are missing in “LIONPAS”: the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of special significance (Co Tiong Sa vs. Director of Patents, 95 Phil. 1, citing Nims, The Law of Unfair Competition and Trademark, 4th ed., Vol. 2 pp. (678-679). “The importance of this rule is emphasized by the increase of radio advertising in which we are deprived of the help of our eyes and must depend entirely on the ear” (Operators Inc. vs. Director of Patents, supra).

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, Vol. 1, will reinforce our view that “SALONPAS” and “LIONPAS” are confusingly similar in sound: “Gold Dust” and “Gold Drop”; “Jantzen” and “Jass-Sea”; “Silver Flash” and “Supper Flash”; “Cascarete” and Celborite”; “Celluloid” and “Cellonite”; “Chartreuse” and “Carseurs”; “Cutex” and “Cuticlean”; “Hebe” and “Meje”; “Kotex” and “Femetex”; “Zuso” and “Ho Hoo”. Leon Amdur. In his book “Trade-Mark Law and Practice”, pp. 419-421, cites, as coming within the purview of the *idem sonans* rule, “Yusea” and “U-C-A”, “Steinway Pianos” and “Steinberg Pianos”, and “Seven-Up” and “Lemon-Up”. IN Co Tiong vs. Director of Patents, this Court unequivocally said that “Celdura” and “Cordura” are confusingly similar in sound; this Court held in Sapolin Co. vs. Balmaceda, 67 Phil. 795 that the name “Lusolin” is an infringement of the trademark “Sapolin”, as the sound of the two names is almost the same.

In the case at bar, “SALONPAS” and “LIONPAS”, when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when to merchandise of the same descriptive properties (see Celanese Corporation of America vs. E.I. Du Pont, 154 F. 2d. 146, 148).”

Expect for the font used and the fact that two letters “LA” in Opposer’s DENIMLAB, was replaced with the letters “HU” to form the mark DENIM HUB, such differences, however, pales into insignificance because of their similarity in sound and their indistinguishable appearance. In one American case, the rule applied was that, the conclusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term. Analogously, confusion cannot also be avoided by the merely changing the two letters of a registered mark, as in this case. Confusing similarity exist when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.

In addition, both trademarks cover the same goods covered by Class 25 of the International Classification of goods. As such, both products flow through the same channels of trade, therefore, confusion between the two trademarks would likely result to prospective buyers.

The protection of trademarks is the law’s recognition of the psychological function of symbols. If it true that we live by symbols, it is no less true that we purchase goods by them. A trademark is a merchandising shortcut, which induces purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, due aim is the same – to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trademark owner has something of value. If another poaches upon the commercial magnetism of the symbol he has created. The owner can obtain legal redress.

WHEREFORE, premises considered, the Notice of Verified Opposition filed by Opposer, GOLDEN ABC, INC. against Respondent-Applicant G.M. STEMIKO CORPORATION is, as it is hereby SUSTAINED. Consequently, the trademark application for the registration of the mark DENIMHUB bearing Serial No. 4-2007-013256 filed on 29 November 2007 by Respondent-Applicant

for all kinds of articles of outer and underwear for men, women, teenagers and children namely shirts, blouses, skirts, suits, pants, trousers, jeans, vests, dresses, ties, coats, jackets, stockings, lingerie, panties, slippers, camisoles, bras, girdles, briefers, briefs, sandos, robes, sock, gloves, scarves, shoes, slippers, head wear namely hats, caps, berets under Class 25 of the international classification of goods is, as it is hereby, REJECTED.

Let the filewrapper of DENIMHUB subject matter of the instant case together with a copy of this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 06 February 2009.

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