

HACHETTE FILIPACHI PRESSE S.A.,
Opposer

IPC No. 14-2006-00031

-versus-

Opposition to:
Serial No. 4-2004-000802
Date Filed: 28 January 2004
Trademark: "STUDIO ELLE
WITH A DEVICE"

CP OPTICS INC.,
Respondent-Applicant.

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Decision No. 2007 – 19

DECISION

For resolution is the Opposition filed by Hachette Filipachi Presse S.A. (the "Opposer") against Application No. 4-2004-000802 filed by CP Optics Inc. (the "Respondent-Applicant") on 28 January 2004 for the registration of the mark STUDIO ELLE WITH A DEVICE CONSISTING OF BOLD LINES REPRESENTING THE WORD ELLE covering goods in Class 9, upon the ground that the mark STUDIO ELLE WITH A DEVICE is identical with and/or confusingly similar with its allegedly well-known trademark ELLE.

Opposer, HACHETTE FILIPACHI PRESSE S.A. (hereafter, the "Opposer") is a corporation duly organized and existing under the laws of France, with principal place of business address at 149 Rue Anatole France 92534 Levallois-Perret Cedex, France.

Respondent-Applicant, CP OPTICS, INC., is a corporation organized and existing under the laws of Republic of the Philippines, with business address at 26th Floor, 2609 Cityland Pasong Tamo Tower, Pasong Tamo St., Makati City.

On 13 March 2006, Opposer filed the instant Opposition against Respondent-Applicant's Application for registration of the trademark STUDIO ELLE WITH A DEVICE for goods under Class 9, specifically eyewear, optical frames, sunglasses.

On 16 March 2006, this Bureau issued a Notice to Answer, copy of which together with the Opposition was received by Respondent-applicant on 30 March 2006. The Notice to Answer required Respondent-Applicant to submit its Verified Answer within thirty (30) days from receipt thereof.

On 31 July 2006, Respondent-Applicant filed its Verified Answer to the Opposition after successive motions for extension of time to file the same were granted.

Grounds for Opposition

Opposer field the instant Opposition based on the following grounds:

1. "The registration of the mark subject of this opposition is contrary to the provisions of Sections 123.1 (d), (e) and (f) of Republic Act No. 8293, as amended;
2. "The Opposer is the owner of the ELLE MARK.
3. "The Respondent-Applicant's mark resembles the Opposer's ELLE mark as to be likely to deceive or cause confusion. Also, the Respondent-Applicant's mark is used on goods that are identical, similar or closely related to the goods on which the Opposer uses the ELLE mark, i.e., eyewear. Hence, the registration of the Respondent-Applicant's mark will be contrary to Section 123.1 (d) of Republic Act No. 8293.

4. “Opposer is entitled to the benefits granted to foreign nationals under Section 3 of Republic Act No. 8293. The Opposer is domiciled in France. Both the Philippines and France are members of the Paris Convention for the Protection of Industrial Property (the “Paris Convention”).

5. “The Opposer’s ELLE mark is a well-known and world famous mark. Hence, the registration of the Respondent-Applicant’s mark will constitute a violation of Article 6bis and 10bis of the Paris Convention in conjunction with Sections 3, 123.1 (e) and 123.1 (f) of Republic Act No. 8293.

6. “The Respondent-Applicant’s use of the ELLE mark on goods that are identical or similar to the goods of the Opposer will mislead the purchasing public into believing that the Respondent-Applicant’s goods are produced by, originate from, or are under the sponsorship of the Opposer.

7. “The Respondent-Applicant’s use of the ELLE mark will mislead the public into believing that the goods bearing the Respondent-Applicant’s mark are associated with the Opposer. Therefore, potential damage to the Opposer will be caused as a result of the Opposer’s inability to control the quality of the products put on the market by the Respondent-Applicant under the ELLE mark.

8. “The Respondent-Applicant’s use of the ELLE mark in relation to any of the goods covered by the opposed application, if these goods are considered not similar or closely related to the goods covered by the Opposer’s registration of the ELLE mark, will take unfair advantage of, dilute and diminish the distinctive character or reputation of the Opposer’s well known ELLE mark.

9. “The denial of the application subject of this opposition is authorized under other provisions of Republic Act No. 8293.

Opposer relied on the following facts to support its opposition: (1) The Opposer owns the trademark ELLE with various registrations and applications and in actual commercial use in the Philippines and abroad prior to Respondent’s application [*see pars. 1 & 4, Opposition*]; (2) Respondent-Applicant’s mark STUDIO ELLE WITH A DEVICE is visually and phonetically identical and similar to Opposer’s trademark ELLE [*see par. 2, Opposition*]; (3) Opposer did not consent to Respondent’s use and application for the registration of the mark in issue [*see 3, Opposition*]; (4) That having been in continuous use and promoted extensively, the trademark ELLE has become popular and internationally well-known [*see pars. 6-8, Opposition*].

Respondent through Counsel, filed its Answer and interposed the following defenses, to wit:

1. “The alleged grounds for the Opposition are pars. (d), (e) and (f) of Section 123.1 of Republic Act No. 8293, as amended.
2. “In relation to par. (d), respondent-applicant most respectfully states that its trademark STUDIO ELLE WITH A DEVICE is not identical with the trademark ELLE. Moreover, its application is for goods entirely different goods and services from that of goods of Oppositor and the trademark of the former does not nearly resemble the trademark ELLE, thus, the trademark of applicant will not likely deceive nor cause confusion to consumers wanting to buy goods with trademark ELLE.
3. “First and foremost, respondent-applicant is applying for registration of the trademark STUDIO ELLE WITH A DEVICE and not just ELLE. Thus, the trademark of the respondent-applicant is clearly and obviously neither identical nor likely to deceive or cause confusion to the consumers. Even

the presentations of the two trademarks clearly show the difference from each other.

4. “Moreover, respondent-applicant will be using its trademark STUDIO ELLE WITH A DEVICE only for eyewear, optical frames and sunglasses, that is, goods which are under Class 9, while opposer is using the trademark ELLE for goods under Classes 38, 35, 16, 3, 14, 18, 21, 25, 28, 12 and 7, as alleged in par. 2 of the NOTICE OF OPPOSITION. Clearly then, the opposition is without factual and legal basis and should be dismissed.
5. “In relation to par. (e) of Section 123.1 R.A. No. 8293, the provision proscribes the registration of a trademark which “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 of identical or similar goods or services...” Granting for the sake of argument, but without admitting that indeed ELLE is well-known, still what is proscribed or prohibited is the registration for identical or similar goods or services and not for all goods. Meaning, registration shall be allowed for goods, which are not identical or similar goods and services. In the instant case, in addition to the substantial difference between the trademarks, the goods of the respondent-applicant are also different and not even closely related to the goods of Opposer.
6. “Contrary to the allegation of Opposer in par. 6, respondent-applicant will not and never use the trademark ELLE because the latter is applying for the trademark STUDIO ELLE WITH A DEVICE and not ELLE only. Thus, there is no chance the purchasing public patronizing goods bearing the trademark ELLE shall be misled into buying goods bearing the respondent-applicant trademark of STUDIO ELLE WITH A DEVICE.
7. “It would be very unfair and untrue for Opposer to state (see par. 7 of NOTICE OF OPPOSITION) that the use by Respondent-Applicant of the trademark STUDIO ELLE WITH A DEVICE will mislead that public into believing that the products are associated with the Opposer and that potential damage to the Opposer will be cause as a result of the Opposer’s inability to control the quality of the products put on the market by the Respondent-Applicant under the ELLE mark because, again, the trademark used by the latter is very entirely different from that trademark used by the latter is very entirely different from that of the Opposer and the goods are not closely related.
8. “Moreover, respondent-applicant already proposed to Opposer that it will just drop the word ELLE from its STUDIO ELLE WITH A DEVICE and just use the trademark STUDIO WITH A DEVICE in order to remove any chance of misleading the purchasing public that STUDIO ELLE WITH A DEVICE is one and the same as ELLE and that products bearing the two different trademarks were produced by the same corporation.
9. “Sec. 147 of the Intellectual Property Code is also very clear on what right are conferred during the registration by stating that the owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade identical and similar signs or containers for goods or services which are identical

or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion shall be presumed.

10. “In view of the fact that Respondent-Applicant’s trademark STUDIO ELLE WITH A DEVICE for goods under international class No. 9 is substantially different from trademark ELLE for goods under international classes 38, 35, 16, 3, 14, 18, 21, 25, 28, 12 and 7, respondent-applicant most respectfully prays for the denial of the Opposition filed by Opposer.

Issues

The issues to be resolved in the instant Opposition case are:

- (a) Whether or not Respondent-Applicant’s trademark STUDIO ELLE WITH A DEVICE is confusingly similar to Opposer’s ELLE trademark such that Opposer will be damaged by registration of STUDIO ELLE WITH A DEVICE mark in the name of Respondent-Applicant; and
- (b) Whether or not Respondent-Applicant’s trademark application for STUDIO ELLE WITH A DEVICE should be granted registration.

From receipt of the Answer, this Bureau required the parties to attend the Preliminary Conference which finally took place on 08 November 2006 after several resetting and on said date, the parties agreed to terminate the conference and then submitted the case for decision.

Considering that the case was mandatorily covered by the Summary Rules under Office Order No. 79, this Bureau required the parties through their counsels to submit their respective position papers. Opposer filed its Memorandum and draft decision on 26 January 2006 while Respondent-Applicant filed their Position Paper on 06 February 2007.

From the evidence on record, Opposer is the registered owner in the Philippines of the trademark ELLE (*Annex “A-A-3”, Opposer*), as follows:

Trademark	Registration Number	Nice Classification
ELLE	55241	38
ELLE	54796	35
ELLE	46299	16
ELLE	54778	3, 9, 14, 18, 21, 25 and 28

Opposer is also the owner the following pending trademark applications (*Annex “B-B-2”, Opposer*):

Trademark	Application Number	Nice Classification
ELLE	4-2005-005577	12
ELLE	4-2004-002846	25
ELLE	4-2002-010885	07

Opposer’s trademark, ELLE, was registered with the then Bureau of Patents, Trademarks and Technology Transfer as 11 September 1989 for goods under Class 16 as shown by its Certificate of Registration No. 46299 (*Annex “A-2”, Opposer*) with date of first use in the Philippines on 01 September 1984 and for goods under Classes 3, 14, 18, 21, 25, 28 including Class 9 with Certificate of Registration No. 54778 issued on 16 April 1993.

Opposer has also registered or applied for the registration of the trademark ELLE for various goods principally for Class 9 in the following countries:

Country	Trademark	Registration Number
Japan	ELLE Class 9	1948158-1 February 1, 1972
	ELLE Former Japanese Class 23 (Horological instruments, Glasses, their parts and accessories)	2721283 May 9, 1997
Hongkong	ELLE Class 9	1993B01080 June 30, 1988
	ELLE Classes 9, 38, 41, 42	1999B13484AA September 18, 1996
	ELLE Class 9	300341207 December 21, 2004
U.S.A.	ELLE Classes 8, 9, 20, 21, 24 and 25	2,708,222 April 22, 2003

Opposer's products using the trademark ELLE are promoted, advertised and sold through Opposer's website www.elle.com, among other channels of trade.

The applicable provision of the Trademark Law particularly, Section 123.1 of R.A. 8293 provides:

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

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(d) *Is identical with a registered mark belonging to a different proprietor or 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;"*

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A comparison of Opposer's and Respondent-Applicant's marks will show that Respondent-Applicant's STUDIO ELLE WITH A DEVICE is confusingly similar to Opposer's trademark ELLE. The mark STUDIO ELLE WITH A DEVICE of Respondent-Applicant, is visually and phonetically similar, in fact obviously identical to the trademark ELLE used and not abandoned by Opposer. The subject mark applied for, STUDIO ELLE WITH A DEVICE and Opposer's ELLE trademark as they appear on the goods of the contending parties readily manifest the glaring similarities. In its overall appearance, the mark STUDIO ELLE WITH A DEVICE of Respondent-Applicant can easily be mistaken as Opposer's ELLE trademark since they are the same in spelling, both containing the word ELLE in the word mark which Opposer has been using since September 1984 in the Philippines initially for its allegedly famous ELLE magazine. To create some variations which is not significantly distinctive, Respondent-Applicant's mark bears a device CONSISTING OF BOLD LINES REPRESENTING THE WORD ELLE, as described by Respondent when the latter was required to give a specific description of

eh subject mark. However, other than the word ELLE written in small letters after the word studio, the logo or device altogether can still be read and viewed as Opposer's ELLE trademark, the final outcome and/or general appearance fell short of the requirement to be distinctive in that Respondent-Applicant's mark is for most part likely to be mistaken or confused as Opposer's mark with the adoption by Respondent of the word ELLE not just in the word mark as well as in the device used.

The word ELLE still dominates the whole appearance of Applicant's mark notwithstanding the combination of another word "studio", thus, similarities in the dominant feature of both marks are not lost. It is noteworthy to cite at this juncture the ruling of the Supreme Court in the cases of *Co Tiong Sa v. The Director of Patents* (95 Phil 1 (1954); *Sapolin Corp. vs. Balmaceda* (67 Phil. 705); and *Fornes Nurma & Co. vs. Ang San To* (40 Phil 272) which applied the dominancy test in determining the existence of confusing similarity between trademarks, that "if there is similarity with the essential or dominant feature of the trademark, despite some differences or variations in detail, *there is infringement.*"

This Bureau reproduced Opposer's as well as Respondent-Applicant's marks for purposes of comparison:

Opposer's Mark
for Class 9
Registration No. 54778

Respondent's Mark
for Class 9
Application No. 4-2004-000802

The word ELLE remains the prominent and distinctive feature in the new mark, the combination or addition of the word STUDIO printed in small letters below the device representing the word ELLE is insignificant as to yield a distinct appearance not only because it is printed in small letters and is placed just below the device or logo but the word or device ELLE standing alone has continued to create confusion between the competing marks.

In the case of *Emerald Garment Mfg. Corp. vs. Court of Appeals*, 251 SCRA 600, the court ruled, thus:

"While it is true that there are other words such as "STYLISTIC", printed in the appellant's label, such word is printed in such small letters over the word "LEE" that it is not conspicuous enough to draw the attention of ordinary buyers whereas the word "LEE" is printed across the label in big, bold letters and of the same color, style, type and size of lettering as that of the trademark of the appellee. The alleged difference is too insubstantial to be noticeable."

Respondent-Applicant's use of the confusingly similar mark STUDIO ELLE WITH A DEVICE, for goods under Class 9, is likely to mislead the public that its goods are affiliated with or sponsored by the Opposer. It will impress upon the buying public that they are the same or related as to source not only because these marks are used on the same goods contrary to the allegation in Respondent's Answer (*par. 4, Answer*) that the same are used on entirely different goods in the Philippines, Opposer already obtained registration for goods under Class 9 with a term of twenty (20) years reckoning from April 16, 1993. The classes of merchandise covered by registrations obtained by Opposer were those goods and/or services related and unrelated, but we cannot discount the fact that in the Philippines alone, there is registration for the same goods as Respondent's: eyewear. Looking at the list of registrations in other countries like in Japan, USA, Hongkong, and France, to name a few, Opposer has long ventured in the production of

eyewear dating as far back as in the 70s. Respondent-Applicant's word mark and device representing the word ELLE constitutes not only the dominant but the entire word mark of Opposer's trademark ELLE, thus making Respondent's mark STUDIO ELLE WITH A DEVICE CONSISTING OF BOLD LINES REPRESENTING THE WORD ELLE indubitably confusingly similar to the trademark ELLE of Opposer which the latter owns and has not abandoned.

Given the international reputation for Opposer's world famous magazine bearing the trademark, ELLE, with worldwide distribution including the Philippines dating back to the early 80s (*Annex A-2, Opposer*), the trademark owner, the Opposer in this instant suit, is entitled to protection when the use of the junior user, a Philippine applicant, "forestalls the normal expansion of their business". In fact, Opposer has already embarked in the production of eyewear in the Philippines alone (*Annex "C", Opposer*), upon a registration obtained in 1993, which is more than a decade before Respondent applied for registration of the same mark to be used on the same article or merchandise.

This Bureau quotes the pronouncement of the Court in the case of *Sta. Ana vs Maliwat, et.al.* (G.R. No. L-2302318), which states:

"Modern law recognized that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trade mark or trade-name is likely to lead to a confusion of source, as where prospective purchasers would be misled into the field or is in any way connected with the activities of the infringer; or when it forestalls the normal potential expansion of his business."

Having shown and proven resemblance of the two marks at issue, we now delve on the matter of priority in use which certainly has decisive effect in the adjudication of the case. From the evidence on record, Opposer established prior use of the trademark ELLE in commerce and his continuous adoption and use thereof consisting of sale and promotional works. Opposer has prior registration for ELLE mark and was using the ELLE trademark on goods under class 16 in the 80s for the Philippines alone. As held in the case on *Unno Commercial Enterprises, Inc. vs. General Milling Corporation* "prior use by one will controvert a claim of legal appropriation by subsequent users". Hence, it may be concluded inevitably that Respondent-Applicant's use of identical mark on the same or related goods will result in an unlawful appropriation of mark previously used by Opposer and not abandoned.

The right to register trademarks, trade names and service marks is based on ownership. Only the owner of the mark may apply for its registration (*Bert R. Bagano v. Director of Patents, et.al.*, G.R. No. L-20170, August 10, 1965). And where a trademark application is opposed, the Respondent-Applicant has the burden of proving ownership (*Marvex Commercial Co., Inc. v. Peter Hawpia and Co.*, 18 SCRA 1178). In the instant case, Opposer has shown prior use of the ELLE trademark with date of its first use on September 1984 for goods under Class 16 (*Annex "A-2", Opposer*) and registered for goods belonging to Class 9 since April 16, 1993. Several registrations and applications in the Philippines and abroad for the ELLE trademark have been presented. Being the prior user and registrant of the trademark ELLE in the Philippines, Opposer is the actual owner thereof.

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby SUSTAINED. Consequently, Application bearing Serial No. 4-2004-000802 filed by CP Optics, Inc. on January 28, 2004 for the registration of the mark "STUDIO ELLE WITH A DEVICE" used on goods under Class 9 particularly eyewear, optical frames, sunglasses is, as it is hereby, REJECTED.

Let the filewrapper of STUDIO ELLE WITH A DEVICE, subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks for appropriate action.

SO ORDERED.

27 February 2007, Makati City.

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