

KUSDIANTO SOEWARN,  
Opposer,  
  
-versus-  
  
ROBERT A. GO.,  
Respondent-Applicant.  
x-----x

}  
}  
}  
}  
}  
}  
}  
}  
}  
}

IPC NO. 14-2009-00014  
Case filed: 14 January 2009  
Opposition to:  
App. Ser. No. 4-2008-005003  
Date Filed: 28 April 2008  
TM: "J.CO and LOGO"

Decision No. 2009-63

## DECISION

This is an opposition case against the application for registration of the mark "J.CO and LOGO" for use on donuts and coffee under class 30 of the international classification of goods bearing Application Serial No. 4-2008-005003 which was published for opposition in the Intellectual Property Office Electronic Gazette officially released for circulation on 12 September 2008. Opposer filed an Unverified Opposition on 10 October 2008 and on 14 January 2009, the Verified Notice of Opposition was filed.

Opposer, KUSDIANTO SOEWARN, is a citizen of Indonesia, with address at Jl. Green Garden Blok E1 No. 49, Jakarta Barat 11520, Indonesia. On the other hand, Respondent-Applicant, ROBERTO A. GO, is a Filipino citizen with address at 57 Shaw Blvd., Mandaluyong City.

The grounds for Opposition to the registration of the mark are as follows:

1. The Opposer is the true owner, and the first to register the J.CO & Device trademark.
2. Opposer was issued Certificate of Registration No. 4-2005-003291 on 16 July 2006 by the Intellectual Property Office (IPO) for the mark J.CO & Device for cafes, cafeteria, canteens, food and drink catering, restaurants, self service restaurants, snack bar in Class 43.
3. The Applicant is not the true owner and first to file user in commerce of the said trademark when it applied for the registration of the said mark in its name.
4. Applicant's mark is identical with the registered mark of Opposer.
5. Opposer is the true owner and the first to register the mark J.CO & Device, not only in the Philippines but also in other trademark offices worldwide
6. Applicant seeks to register the mark J.CO and Logo through Trademark Application No. 4-2008-005003 filed recently on 28 April 2008
7. The mark J.CO and Logo, which Applicant seeks to register, is virtually identical to Opposer's mark.
8. Respondent-Applicant exhibited bad faith in trying to appropriate not only Opposer's J.CO mark but the peacock illustration of his Device, as well. At the time of the filing of the questioned trademark application in April 28, 2008, Respondent-Applicant was deep into negotiations with the Opposer to be its franchisee in the Philippines.

9. The Opposer has not consented to the Respondent-Applicant's use and registration of the J.CO and LOGO mark or any other mark identical or similar to the J.CO and Device trademark.

10. Approval by the Honorable Office of the trademark application in question is clearly proscribed under Sec. 123.1 (d) of the Republic Act No. 8293

11. The Respondent-Applicant's mark is virtually identical with Opposer's mark in terms of spelling, pronunciation, design and appearance as to likely deceive or cause confusion. Hence, the registration of the Respondent-Applicant's mark will be contrary to Sec. 123.1 (d) of Republic Act No. 8293.

12. The registration of the trademark J.CO and LOGO in the name of Applicant, which closely resembles the trademark J.CO and Device of the Opposer, will cause the latter incalculable damage to its reputation and general business standing.

13. The denial of the application subject of this Opposition is authorized under other provisions of the Republic Act No. 8293."

Together with the Verified Notice of Opposition (Exhibit "A"), Opposer submitted the following evidence:

Exhibits	Description of Documents
"B"	Authenticated Affidavit of Stephanus Hanan
"B-1"	Copy of Philippine Certificate of Registration No. 4-2005-003291 for the mark J.CO & Device for Class 42
"B-2"	Copy of Denmark Certificate of Registration No. VR 2008 02082 issued on 10 June 2008 for the mark J.CO & Device
"B-3"	Copy of Certificate of Registration No. 08 3 558 397 for the mark J.CO & Device dated 25 February 2008 issued in France
"B-4"	Malaysian copy of Certificate of Registration No. 05005441 for the J.CO & Device mark issued on 01 September 2008
"C"	Legalized Special Power of Attorney evidencing authority of Stephanus Hanan
"D"	Legalized Special Power of Attorney evidencing authority of law firm of Cochingyan & Peralta Law Offices to represent the Opposer

On 08 February 2009, a Notice to Answer the Verified Notice of Opposition was issued by the Bureau and personally served to Respondent-Applicant on 24 February 2009. Despite having received said notice, Respondent-Applicant failed to file his Answer within the reglementary period. As a consequence, Order No. 2009-810 was issued on 12 May 2009 waiving Respondent's right to file the answer and supporting documents and submitting the case for decision.

The sole issue to be resolved in this case is: WHETHER OR NOT RESPONDENT-APPLICANT'S MARK "J.CO and LOGO" IS CONFUSINGLY SIMILAR TO OPPOSER'S MARK "J.CO & Device".



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

"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 above-cited provision of the IP Code is explicit and leaves no room for interpretation that whenever a mark applied for registration is similar or identical to a registered mark, its registration is proscribed. For that purpose, the subject mark is hereunder illustrated together with Opposer's mark for comparison:

Opposer's Mark	Respondent-Applicant's Mark
	

As can be observed from the above illustration, the competing marks are almost identical. Both marks use the word "J.CO" and both marks contain a circular device with the J.CO word in it. Also, both marks have an image of a peacock inside a small circular device. Undisputably, the mark of Respondent-Applicant is a mere copycat of Opposer's mark. Why, with all the birds in the air, and all the fishes in the sea, and all the animals on the face of the earth to choose from, the Respondent-applicant chose to use the image of a peacock just like Opposer's not to mention the fact that it used also the same "J.CO" word and the circular device.

Furthermore, as borne by the records of this case, Opposer is the registered owner of the J.CO & Device mark having obtained Certificate of Registration No. 4-2005-003291 on July 16, 2006. As such, pursuant to Section 138 of the IP Code, it has the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto. However, when a trademark is used by a party on a product in which the other party does not deal, the use of a same trademark on the latter's product cannot be validly objected to.

In the instant case, a perusal Opposer's certificate of registration vis-à-vis the filewrapper of this case would show that Opposer's mark was registered under Class 43 for cafes, cafeteria,

canteen, food and drink catering, restaurants, self service restaurants, snack bar while that of Respondent-Applicant's is under Class 30 for donuts and coffee.

Seemingly, since the goods or services upon which the competing marks are used belong to different class, there would be no confusion of goods. However, because the marks are identical it may also lead to a confusion of source, as when prospective customers would be misled into thinking that the Opposer has extended its business into the field, otherwise stated, prospective buyer would be likely misled into believing that the goods of Respondent-Applicant is sourced, originate or manufactured by Opposer.

"There are two types of confusion, the first is the confusion of goods, "in which event the ordinary prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other." . . . The other is the confusion of business: "Here though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff, and the public would then be deceived into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist. In cases of confusion of business or origin, the question that usually arises is whether the respective goods or services of the senior user and the junior user are so related as to likely cause confusion of business or origin, and thereby render the trademark or trade names confusing similarity.

In the case at bar, it is evidence that the goods of the parties are related and competing. Respondent-Applicant's mark is used in donut and coffees which goods are normally offered in cafes, cafeterias, restaurants and snack bars on which Opposer's registered mark is being used. Hence, it cannot be denied that confusion of origin or source is inevitable. Thus under this premise, the registration of the herein subject mark in favor of the Respondent-Applicant cannot be allowed.

It must be always emphasized that the protection of trademarks is the law's recognition of the psychological function of symbols. If it is 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 a 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, KUSDIANTO SOEWARNO against Respondent-Applicant ROBERT A. GO's application for registration of the mark J.CO and LOGO is, as it is hereby SUSTAINED. Consequently, the trademark "J.CO and LOGO" bearing Serial No. 4-2008-005003 filed on 28 April 2008 by Respondent-Applicant for donuts and coffees belonging to Class 30 of the international classification of goods is, as it is hereby, REJECTED.

Let the filewrapper of "J.CO and LOGO" 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, 14 May 2009.

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