JESUS ONG TIU, Opposer, -versus- YES TO LTD. (ISRAELI PRIVATE RESPONDENT) Respondent-Applicant.	} } } } } } }	IPC NO. 14-2007-00339 Opposition to: Appl'n. Serial No. 4-2006-012402 Date filed: 16 November 2006 Trademark: "YES TO CARROTS" Goods: Class 3
JESUS ONG TIU, Opposer, -versus- YES TO LTD. (ISRAELI PRIVATE RESPONDENT) Respondent-Applicant.	} } } } } } }	IPC NO. 14-2007-00346 Opposition to: Appl'n. Serial No. 4-2006-012401 Date filed: 16 November 2006 Trademark: "YES TO CARROTS & CARROT DEVICE" Goods: Class 3
		Decision No. 2009-9

DECISION

For decision are two Notices of Opposition filed by Jesus Ong Tiu, with business address at DII Building, Km. 21, 150 San Vicente Road, Brgy. San Vicente, San Pedro Laguna, Philippines, hereinafter referred to as opposer against the applications filed by Yes to Ltd. (Israeli Private Respondent), an Israeli corporation with address at Nehama Street 9 Tel Aviv Israel 68115 namely: Notice of Opposition against Application Serial No. 4-2006-012402 for the trademark YES TO CARROTS and Application Serial No. 4-2006-012401 for the trademark YES TO CARROTS & CARROT DEVICE, both filed on 16 November 2006 and covering goods under class 3 namely: soaps; perfumery; essential oils; cosmetics; hair lotions; dentifrices; skin, body, eye and hair care preparations, for cosmetic purposes; non-medicated bath preparations; creams, lotions and gels for cosmetic purposes; skin and facial cleansing preparations for personal use; cosmetic preparations containing vegetable and/or fruit extracts; cosmetic preparations containing vitamins and/or mineral extracts; cosmetic preparations containing minerals, muds and/or salts; hair lotions containing vegetable and/or fruit extracts; hair lotions containing vitamins and/or mineral extracts; hair lotions containing minerals, muds and/or salts; makeup preparations; makeup removing preparations; vegetable and/or fruit based oils for use on the skin, for cosmetic purposes; all included in class 3."

In both oppositions, opposer relied on the following grounds:

"1. The approval of the application in question is contrary to Section 123.1(d) of Republic Act No. 8293, as said mark is identical to the trademark YES duly registered in favor of Opposer under Registration No. 4-1995-100766, and subject of his Application Serial No. 4-2007-002748;

2. The use and registration by Respondent-Applicant of the mark YES TO CARROTS will violate Opposer's right to extend the use of his registered mark YES to other goods such as goods falling under Class 3;

3. The approval of the application in question has caused and will continue to cause great and irreparable damage injury to herein Opposer;

4. Respondent-Applicant is not entitled to register the trademark YES TO CARROTS in its favor."

Opposer submitted the following evidence in both oppositions:

EXHIBIT	DESCRIPTION
"A"	Certified copy of Opposer's Certificate of Registration No. 4-1995-100766 issued on March 18, 2006 for the trademark YES;
"B" to "B-3"	Certified copy of Opposer's Certificate of Copyright Registration No. O-95-685 issued on July 13, 1995 for YES Label;
"C" to "C-7"	Certified copy of the Declaration of Actual Use filed by Oppose on December 3, 2001, including the annexes thereto, for Application Serial No. 100766 for the trademark YES;
"D" to "D-8"	Representative sales invoices showing present use of the trademark YES;
"E" to "E-2"	Photographs of actual sample products of Opposer falling under Class 25 and bearing the trademark YES;
"F" to "F-2"	Duplicate copies of the Acknowledgement, Trademark Application Form, and Drawing of Application Serial No. 4-2007-002478 for the registration of the trademark YES for goods falling under Class 3;
"G" and "G-1"	Photographs of actual sample products of Opposer falling under Class and bearing the trademark YES;
"H"	Print-outs of Respondent-Applicant's marks "YES TO CARROTS" and "YES TO CARROTS AND CARROT DEVICE" as published in the e-Gazette released last September 7, 2007;
"I"	Duly notarized affidavit of opposer Jesus Ong Tiu.

Respondent-applicant in its Answers made the following admissions and denials:

"6. Respondent admits that it is the applicant for the mark "YES TO CARROTS" under Application Serial No. 42006012402 filed on November 16, 2006 for goods under Class 3, as specifically set forth in the publication of the said application in the IPO e-Gazette released on 9/7/2007, a copy of which was attached as Exh. "H" to the Verified Notice of Opposition;

7. Respondent has no knowledge or information sufficient to form a belief as to the truth of opposer's allegations in pars. 1, 2, 3, 4, 5, and 6 of his Verified Notice of Opposition under the heading "FACTS" and therefore DENIES the same.

8. Except for opposer's Exh. "H" (Publication of Respondent's Trademark Application No. 42006012402 in the IPO e-gazette) which is admitted, respondent has no knowledge or information sufficient to form a belief as to the genuineness, truthfulness and authenticity of all the other documents attached to the Verified Notice of Opposition and therefore it reserves all objections to their admission.

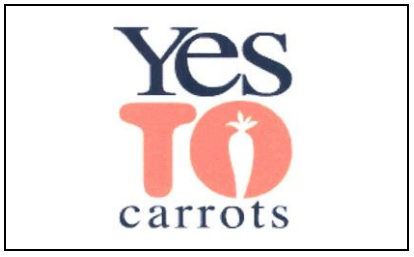
9. Respondent denies opposer's allegations under pars. 7, 8, 9, 10, and 11 of his Verified Notice of Opposition for being conclusions rather than statements of ultimate facts and for lack of knowledge or information sufficient to form a belief as to the truth thereof."

The issue is whether the respondent-applicant's YES TO CARROTS and YES TO CARROTS & DEVICE can be registered for goods under class 3 in view of opposer's earlier registration of the mark YES.

The marks of the contending parties are reproduced below for reference.

Opposer's mark

Respondent-Applicant's mark



The marks as shown give different commercial visual impressions. Records also show that the respondent-applicant disclaimed the exclusive right to use the words "CARROTS" apart from the mark as shown. Still, the respondent-applicant's mark consisting of three (3) words, YES TO CARROTS and the CARROT & DEVICE mark which is described as "YES" printed in black, with letter "Y" capitalized and "E" and "S" in small letters; below the word yes is the word "to" printed in orange stylized letters with the center of the letter "O" containing a silhouette of an upright carrot printed in white and the word "carrots" printed in small black letters" is distinct in appearance from opposer's plain YES mark. In view of their differences, this Bureau finds both marks are not confusingly similar.

The Intellectual Property Code states:

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

(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"

Evidence show that the opposer is the registered owner of the mark YES as evidenced by Certificate of Registration No. 4-1995-100766 (Exhibit "A") issued in 18 March 2006 covering

goods under class 25 namely: “T-shirts, jeans, slacks, shorts, polo shirts, skirts, jackets, pants, briefs, jogging pants, sweatshirts, blouses, swimsuits, shoes, sandals and boots”. He secured a Certificate of Copyright Registration (Exhibit “B”) in 26 June 1995 of a depiction of a YES label. Opposer submitted sales invoices showing it has sold clothing apparel with the YES mark. (Exhibit “C” and “D”). Some of the receipts dated in 2006 and 2007 show that the opposer sold perfume and cologne with YES mark (Exhibit “D”). Exhibit “G” is a pictorial representation of a cologne bottle with the mark YES. However, opposer registration of its mark for goods under class 3.

On the other hand, respondent-applicant filed an application for registration of its mark YES TO CARROTS and YES TO CARROTS & DEVICE on 16 November 2006 for goods under class 3. This application ante date the application lodged by the opposer for the mark YES in 15 March 2007.

In this regard, the law provides that the right to a mark is acquired through registration. Section 122 provides: “Sec. 122. How marks are acquired. The rights in a mark shall be acquired through registration made validly in accordance with law.” Thus, respondent-applicant can validly acquire the right to its mark for goods under class 3 as enumerated in its application.

Opposer argues that the use of the mark YES TO CARROTS & CARROT DEVICE will cause confusion, mistake or deception as to the source or origin of the respondent-applicant’s goods. It asserts that goods clothing under class 25 and class 23 namely perfume etc. are related. We disagree. The goods do are not competing and the same do not flow through the same channel of trade. Neither do they possess the same physical attributes.

The Supreme Court defined related goods in Esso Standard Eastern v. CA (116 SCRA 336) It held:

> “Goods are related when they belong to the same class or have the same descriptive properties: when they possess the same physical attributes or essential characteristics with reference to their form composition, texture, or quality. They may also be related because they serve the same purpose xxx”

The High Court further explains in Mighty Corporation and La Campana Fabrica de Tabaco, Inc. v. E. & J. Gallo Winery and the Andersons Group, Inc. (G.R. No. 154342. July 14, 2004.) It ruled:

> “In resolving whether goods are related, several factors come into play:
> (a) the business (and its location) to which the goods belong
> (b) the class of product to which the goods belong
> (c) the product’s quality, quantity, or size, including the nature of the package, wrapper or container
> (d) the nature and cost of the articles
> (e) the descriptive properties, physical attributes or essential characteristics with reference to their form, composition, texture or quality
> (f) the purpose of the goods
> (g) whether the article is bought for immediate consumption, 100 that is, day-to-day household items
> (h) the fields of manufacture
> (i) the conditions under which the article is usually purchased and
> (j) the channels of trade through which the goods flow, how they are distributed, marketed, displayed and sold.”

In Philip Morris, Inc. Benson & Hedges (Canada), Inc., and Fabriques de Tabas Reunies, S.A. v. Fortune Tobacco Corporation, GR No. 15859, 27 June 2006, the Supreme Court held:

> For one, as rightly concluded by the CA after comparing the trademarks involved in their entirety as they appear on the products, the striking dissimilarities are significant enough to warn any purchaser that one is different from the other. “Indeed, although the perceived offending word “MARK” is itself prominent in petitioner’s trademarks “MARK VII” and “MARK TEN,” the entire marking system should be considered as a whole and not dissected, because a discerning eye would focus not only on the predominant word but also on the other features appearing in the labels. Only then would such discerning observer draw his conclusion whether one mark would be confusingly similar to the other and whether or not sufficient differences existed between the marks. xxx
>
> But, even if the dominancy test were to be used, as argued by the petitioners, but bearing in mind that a trademark serves as a tool to point out distinctly the origin or ownership of the goods to which it is affixed, the likelihood of confusion tantamount to infringement appears to be farfetched. The reason for the origin and/or ownership angle is that unless the words or devices do so point out the origin or ownership, the person who first adopted them cannot be injured by any appropriation or imitation of them by others, not can the public be deceived.”

There being no confusion similarity between the marks, both marks may co-exist.

WHEREFORE, premises considered the OPPOSITION filed by Jesus Ong Tiu is, as it is hereby, DISMISSED. Accordingly, Application Serial No. 4-2006-012401 for the mark YES TO CARROTS & CARROT DEVICE and Application Serial No. 4-2006-012402 for the mark YES TO CARROTS filed by Respondent-Applicant, Yes to Ltd. (Israeli Private Company) are, as they are, hereby given DUE COURSE.

Let the filewrapper of “YES TO CARROTS & CARROT DEVICE” and “YES TO CARROTS”, 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, 21 January 2009.

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