

YAHOO! INC.,	}	IPC No. 14-2006-00200
<i>Opposer,</i>	}	Opposition to:
	}	
- versus -	}	Serial No. : 4-2001-006334
	}	Filed : 28 August 2001
	}	Trademark : "Yaahoo"
SAM LIM CORP.,	}	
<i>Respondent-Applicant.</i>	}	
x-----x		Decision No. 08-12

DECISION

This is a VERIFIED OPPOSITION filed by Yahoo! Inc., to the application for registration of the mark "Yaahoo" bearing Application Serial No. 4-2001-006334 filed by respondent-applicant Sam Lim Corp. on 28 August 2001 for goods under Nice Classification 30, which covers biscuits and other food products. The said application was published in the Trademark Electronic Gazette of the IP Philippines (IP Phil.) that was officially released for circulation on March 9, 2007.

Opposer is a foreign organized and existing under the laws of the State of Delaware, United States of America ("USA"). Its principal office is at 701 First Avenue, Sunnyvale, California 94089, USA. Respondent-Applicant is a corporation organized and existing under Philippine laws, whose address as stated in the subject application is 1933 Felix Huertas St., Sta. Cruz, Manila.

Opposer filed its VERIFIED OPPOSITION based on the following grounds:

Yahoo! Inc. ("Opposer" or "Yahoo"), believes that as the registered owner of the well-known trademark YAHOO!, the registration in the name of the Respondent-Applicant of the subject mark: (a) will damage and prejudice the rights and interests of Opposer herein; and (b) is contrary to the express provisions of the Republic Act 8293 or the Intellectual Property Code of the Philippines ("IP Code") in regard to what trademarks may or may not be registered; therefore, Opposer objects to the registration of the subject mark upon the following legal grounds:

- a. Section 147.2 of the IP Code which pertains to the exclusive rights of the owner of a registered trademark;
- b. Section 147.2 and related Sections 123.1 (d), 123.1 (e), and 123.1 (f) of the IP Code which relates to Opposer's rights as owner of an earlier registered trademark and as owner of a well-known trademark;
- c. Section 168.1 of the IP Code.
- d. Section 165 of the IP Code.

The foregoing grounds are hereby pleaded in compliance with Section 134 of the IP Code and for the purpose of showing that registration of the subject mark is prohibited under the IP Code. Opposer reserves its rights to file separate action(s) for infringement under Section 147 and related sections and/or unfair competition under Section 168 and related sections of the IP Code, and/or intellectual property violation under Section 165 and related sections of the IP Code, it being understood that this opposition only deals with the issue of registrability of the subject mark and the proceedings will not take up the issue of injunction and recovery for damages arising from Respondent-Applicant's unauthorized use of the subject trademark.

FACTS

Opposer relies upon the following facts and circumstances to support this opposition:

1. Opposer herein is a foreign corporation duly organized and existing under the laws of the State of Delaware, United States of America ("USA") with its principal office at 701 First Avenue, Sunnyvale, California 94089, USA. Its legal existence has been recognized by the Intellectual Property Office (IPO) which has granted and/or issued in Opposer's names several trademark registrations, certified copies of which are identified, marked and submitted by under a separate Affidavit and submitted are being identified and marked as annexes in this Verified Notice of Opposition.

2. Opposer has appointed Federis & Associates Law Offices as its Attorney and resident agent for the purpose of filing and prosecuting trademark applications and also for the purpose of representing Opposer in the subject in the subject opposition proceedings. Thus, notices and processes in connection with this case and related proceedings may be served upon the Opposer through the undersigned counsel. The original legalized Power of Attorney shall be submitted by the undersigned counsel.

3. Opposer's country of origin or domicile, USA, is a member-nation of, or signatory to, the Paris Convention and the World Trade Organization and the Agreement on Trade-Related Aspects of Intellectual Property Rights, which grants to nationals of, or corporate and juristic persons of the Philippines the same right and privilege of bringing similar actions for protection of industrial property rights in Opposer's country of origin or domicile. Thus, Opposer is authorized to bring this action under Section 3 and 134 of the IP Code for the Protection of its business reputation, trademark and goodwill.

4. Respondent-Applicant is SAM LIM CORP. which represents itself as a corporation duly organized and existing under Philippine laws, whose address as stated in the subject application is Punturin Compound, Furong St., Valenzuela City and where it may be served with summons, orders and other processes of this Honorable Office.

5. Based on the records, Respondent-Applicant filed on August 28, 2001 an application for registration of the trademark YAAHOO designated as Application Serial No. 4-2001-006334 for cheese flavor biscuits and curls in International Class 30. The details of Respondent-Applicant's application were posted on the Electronic Gazette of the Intellectual Property Office which was released for circulation on September 1, 2006.

6. Opposer timely filed a Motion for Extension of Time to File a Notice of Opposition requesting that it be granted an extension of thirty (30) days from September 1, 2006 or until October 1, 2006 within which to file a notice of opposition. Subsequent Motions for Extension of Time to File a Verified Notice of Opposition were filed with payment of the corresponding fees.

Nature of Business

7. Opposer is a global Internet communications, media, and commerce company that delivers a branded network of comprehensive searching, directory, information, communication, shopping services and other online activities and features to millions of Internet users daily. The main YAHOO! Website can be accessed at <http://www.yahoo.com>. Attached and marked as *Exhibit A* hereof is a print-out of the home page of Yahoo!'s website. The YAHOO! Website is one of the leading Internet websites worldwide in terms of traffic, advertising, household and business user reach. In addition to the variety of services offered at Opposer's main website located at the domain name <yahoo.com>, it operates

many additional sites under the YAHOO! Mark and other YAHOO-formative trademarks.

8. Yahoo!'s services include both local and international web directory and search services, online games, people searches, astrology and horoscopes, greetings, corporate network software and services, online calendaring, travel reservation services, internet access, domain name registration services, photographic services, mobile messenger and SMS services, e-mail, chat and bulletin board services, instant messaging, blogging services, podcasting services, stock quotes, insurance quotes, tax information and filing services, bill payment services, electronic commerce, electronic funds transfer, small business advice and services, business and financial information and services, loan quotes, real estate and mortgage information and quotes, movie reviews, news, weather, sports, yellow pages, maps, auctions, online shopping, classified advertising, audio and video streaming, and web store hosting and management.

9. In addition to its many online services, Yahoo! Uses the YAHOO! Mark on a wide variety of products including food, clothing, books, magazines, house wares, and computer accessories. In June 2000, Yahoo! Entered into a marketing agreement with ExpressAutoParts.com, one of the world's leading online automotive superstores. The website of ExpressAutoParts.com can be accessed on the internet at <http://www.expressautoparts.com>. The agreement called for ExpressAutoParts.com to be promoted on the Yahoo! Network, and for ExpressAutoParts.com and Yahoo! To co-sponsor a promotional 18-wheel tractor-trailer containing a 12-seat interactive race simulator, fully furnished computer rooms and VIP hospitality deck for entertaining at on-site events; to tour more than 180 key venues throughout the United States. Yahoo! Also offers a wide variety of services using the YAHOO! mark together with a descriptive name of its services, including but not limited to YAHOO! autos, YAHOO! Shopping, YAHOO! Travel, YAHOO! Small Business, YAHOO! Messenger YAHOO! Finance, YAHOO! Auctions, YAHOO! Photos, YAHOO! Address Book, YAHOO! Calendar, and YAHOO! Bill Pay. Yahoo! Also operates the YAHOO!LIGANS! Site which is specifically targeted to children aged 7-12.

History of the YAHOO! Trademark

10. "YAHOO!" is an arbitrary term as applied to the Yahoo!'s services and products. Yahoo! began as a web directory and search engine. Its web directory was developed in early 1994 by the company's founders, David Filo ("Filo") and Chihyuan "Jerry" Yang ("Yang"), while they were graduate students at Stanford University. Filo and Yang started by "surfing the Web" to find interesting sites and maintaining a list of those sites. Then they created software to categorize the websites and link them with hierarchies in a directory. They also created software to enable users to search the directory. In March 1994, the directory of websites was made available by Filo and Yang on the Internet free of charge.

11. Yahoo!'s web directory was initially called "Jerry and David's Guide to the World Wide Web," and that shortly thereafter, in June 1994, Filo and Yang changed the name of the site to YAHOO! they decided that they wanted a unique name that started with the letters "YA" that could function as an acronym beginning with the wording "Yet Another", a popular practice in the computer industry (e.g., "YACC" or "Yet Another Compiler Compiler" was used to identify a Unix software program). Filo and Yang looked at all the words starting "YA" in an online dictionary.

12. "The chose "Yahoo" because its definition – an uncivilized and crude person – was consistent with the Internet as an uncivilized terrain and them as

students. They were also able to coin an appropriate phrase using acronym "yahoo" to describe their web directory and search services - - "Yet Another Hierarchical Officious Oracle." An exclamation point was added to the mark to signify high energy and the joy of the user on discovering information on the Web using the YAHOO! web directory and search service. Yahoo! registered the domain name YAHOO.COM with Network Solutions, Inc. on January 18, 1995 and has used the domain name to identify the YAHOO! website since on or about that date.

13. The availability of Yahoo!'s directory and search services enabled Internet users to find information relevant for their purposes out of the vast amount of content on the Internet. Yahoo!'s web directory and search services allow users to quickly locate information on the Internet by typing in a word or words relating to the subject matter of interest to the user. This made the YAHOO! Website widely popular with Internet users. Shortly after the YAHOO! site was launched in June 1994, the overwhelming success of the YAHOO! site led its founders to take a leave of absence from Stanford University to concentrate on running the website and raising capital to run the business.

14. Yahoo!'s Initial Public Offering of stock was in April 1996. Since then, its revenues have grown significantly: US \$1,666,000 in 1995; US \$23,793,000 in 1996; US \$84,108,000 in 1997; US \$245,100,000 in 1998; US \$588,608,000 in 1999; US \$1,110,178,000 in 2000; US \$717,422,000 in 2001; US \$ 953,067,000 in 2002; US \$1,625,097,000 in 2003; US \$3,574,517,000 in 2004; and US \$5,257,668,000 in 2005. A statement of Opposer's revenues for the year 2005 which states an increase of 47% in revenues compared to the previous year is found in the YAHOO! 2005 ANNUAL REPORT which is posted in the Internet at the following website, <http://yahoo.client.shareholder.com/annual.cfm>. A printed version of said annual report shall be submitted by the undersigned counsel.

Fame and notoriety of YAHOO! arising from extensive use and advertising and from its overwhelming global patronage

15. Since at least as early as 1996, Opposer has advertised the YAHOO! Brand through various media such as television and radio, in publications and on signage, both in the USA and internationally. Advertising has reached hundreds of millions of people around the world.

16. Opposer provides services in more than 15 languages in over 20 countries, regions and territories, including localized versions of Yahoo! in Argentina, Australia, Brazil, Canada, Greater China Region (Mainland China, Taiwan, Hongkong), Northern Europe and Scandinavia (Denmark, Sweden, Norway), France, Germany, Greece, India, Italy, Japan, Mexico, New Zealand, Russia, Singapore, South Korea, Spain, United Kingdom & Ireland, and the United States. Opposer also provides some of its most popular and point-of-entry services through Yahoo! Asia (its portal to Southeast Asia), Yahoo! Chinese (U.S. Chinese language site), Yahoo! en Español (U.S. Hisoanic site), Yahoo! Canada en Francais (French Canadian) and Yahoo! En Catala (part of Yahoo! Spain's Catalan language offerings). Outside of Yahoo!'s English-speaking markets, it has built independent, localized-language directories, websites and other content, developed by native speakers of each language. Opposer has established offices worldwide to facilitate the local development of its international operations.

17. Most of Opposer's current Internet services are offered to the public free of charge and the majority of its income is derived from the sale of advertising, marketing and co-branding or sponsorship agreement with other companies. Yahoo! also receives revenues from certain electronic-commerce transactions

originating from its site, including YAHOO! Shopping, YAHOO! Auctions and YAHOO! Travel as well as certain premium services offered to Internet users, such as dial up and DSL Internet access, upgraded e-mail, website hosting, and more. In 2005, Opposer's email services, provided through YAHOO! Mail, have become the largest global web-based email provider, according to several leading third party sources.

18. Much of the advertising sold by Opposer consists of advertisements that appear on web pages within the YAHOO! website. A hypertext link is embedded in each advertisement, which allows the user to click on the advertisement and instantaneously access the advertiser's own website to obtain additional information or to purchase products or services. In addition to advertisements, Opposer also sells merchandising units, sponsorships and promotions. It also sends targeted direct e-mail advertisements to users of its e-mail services and other registered Yahoo! users who have opted to receive such advertisements.

19. Yahoo! serves advertisements for thousand of companies each year. Yahoo!'s advertising clients have included a majority of the "Fortune 100" largest advertisers. Among the companies that have advertised their products or services on the YAHOO! Site are Apple, Colgate-Palmolive, Disney, The Gap, Hilton Hotels, IBM, Lego, Microsoft, Procter & Gamble, Seagrams, Sony, Swatch, Target Stores, Toshiba, and Visa.

20. Opposer has also licensed the same of merchandise bearing the YAHOO! mark such as computer equipment, toy cars, watches, writing instruments, clothing, hats, posters, watches, writing instruments, clothing, hats, posters, watches, clocks, duffel bags, baseballs, a magazine, and much more. In 2001, Yahoo!'s worldwide licensing revenues were approximately US \$1.5 million. In April 2002, License! Magazine ranked the YAHOO! Brand among the "100 Leading Licensors."

21. The number of visits to the YAHOO! website has increased dramatically each year since Yahoo!'s inception. During September 1998, for example, the YAHOO! site averaged approximately 144 million "page views" per day, and during September 2000 traffic grew to an average of approximately 780 million page views per day. During the month of December 2004, YAHOO! site received an average of approximately 2.85 billion page views per day, during December 2005, the YAHOO! site received an average of 3.5 billion page views per day, and during June 2006, the YAHOO! site received an average of 4.2 billion page views per day. A "page view" is defined as one electronic page of information displayed in response to a user request. One visitor to the site can represent more than one page view. This translates into tens of millions of discrete visit to the YAHOO! site every month.

22. Opposer's global audience was approximately 429 million unique users in December 2005 (excluding Yahoo! Japan). Approximately 200 million active registered members (excluding Yahoo! Japan) logged onto their personalized YAHOO! accounts during December 2005 (e.g., to participate in Opposer's registered member services, including shopping, auctions, classifieds, e-mail, clubs, calendars, message boards, chat rooms, and more). In October 2006, Nielsen/Net Ratings ranked the YAHOO! network of properties number two at home with more than 90 million unique users and a reach of nearly 62% of home users in the United States and number three at work with million unique users and a reach of almost 77% of work users in the United States. In October 2006, comScore Networks ranked YAHOO! the number two web property worldwide with more than 480 unique users.

23. Since its inception, the YAHOO! website has been recognized with numerous industry awards, including the “Best of the Internet” and “Outstanding Service” awards from *Internet World* in April 1995, Global Network Navigator’s “Best of the Net” for Internet Navigation award in December 1995, the “Best of the Net ‘97” award from *Internet World Magazine*, the 1998 “Entrepreneurial Company of the Year” award from Harvard Business School, and the 1998 “ASAP – Number One Internet Services and Content” award from *Forbes Magazine*. More recent awards include the 2001 and 2002 Webby Awards in the Finance category, “Best Free E-mail Service” by *PC World Magazine* in 2000, 2001, and 2002; “Best Portal Site” by *Media Magazine* in 2001, 2002 and 2003; “Best of the Web” by *Forbes* in 2003; and “Best of the Web” by *Barron’s* in 2002 and “Best Website for Investors” by *Barron’s* in 2005. YAHOO! was also listed in *PC Magazine’s* 2004 “Top 100 Classic Sites” in eleven major categories, including search, reference, portals, games, and careers, and YAHOO! News, YAHOO! Finance, and MY YAHOO! won *Business Week’s* “Editor’s Choice Awards” and “Readers’ Choice Awards” in 2005. Most recently, Yahoo! Shopping was ranked as the number one shopping comparison website by *Consumer Reports* in December 2005; Yahoo! Desktop Search was named *PC Magazine’s* “2005 Editor’s Choice; Yahoo! won “Brand of the Year” and Yahoo! Music Unlimited won “Best Downloadable or Subscription Music Service” by the Digital Entertainment & Media Expo (DEMEXPO) Awards in December 2005; and MY YAHOO! won the “People’s Voice Award” for best home page and YAHOO! Podcasts won the “Webby Award” for best podcast site in the 2006 Webby Awards.

24. In August 2006, Interbrand, one of the world’s leading brand marketing and consulting firms, published its annual report which ranks the world’s most valuable brands. The 2006 report ranks the YAHOO! mark number 55, with a value of nearly US \$6.05 billion.

25. The YAHOO! trademark has been held by various competent authorities to be well-known in the Philippines and internationally. In the case of *Yahoo! Inc vs. Buffalo Wu, CA-00-00178A*, the United States District Court for the Eastern District of Virginia has specially held that the YAHOO! mark is famous.

26. Due to the worldwide fame of Opposer’s YAHOO! mark, among other things, the World Intellectual Property Organization (WIPO) Arbitration and Mediation Center and the National Arbitration Forum have issued 60 decisions under the Uniform Domain Name Dispute Resolution Policy (UDRP), involving hundreds of domain names using Opposer’s mark, which resulted in the transfer of more than 860 domain names to Opposer.

*The strength of Opposer’s rights to the trademark YAHOO!
Arising from its ownership of the YAHOO! family marks*

27. Opposer is the owner of the service marks and trademarks YAHOO! and YAHOO! (stylized), as well as the trade name YAHOO! and the domain name <yahoo.com>, and variations thereof. Opposer offers a wide variety of services using the YAHOO! mark together with a descriptive name of its services, including but not limited to YAHOO! Mobile, YAHOO! Shopping, YAHOO! Travel, YAHOO! Mail, YAHOO! Small Business, YAHOO! Messenger, YAHOO! Finance, YAHOO! Auctions, YAHOO! Photos, YAHOO! Address Book, YAHOO! Calendar, and YAHOO! Bill Pay.

28. Opposer and its subsidiaries currently own nearly three thousand (3,000) trademark applications and registrations in more than 100 countries worldwide. Opposer owns more than 800 YAHOO! formative applications and registrations in

approximately 90 countries worldwide. A list of all trademark and service mark registration and applications of owned by Opposer for the trademark YAHOO! shall be submitted in support of this opposition.

Opposer is first to register the YAHOO! trademark in the Philippines

29. In the Philippines, Opposer owns seven (7) trademark applications in connection with goods and services in Classes 9, 25, 29, 30, 35, 36, 38, 39, 41 and 42, details of which are as follows:

Mark	Appln. No.	Date Filed	Class
YAHOO!	4-2005-005746	June 22, 2005	29, 30
YAHOO	4-1997-126984	December 2, 1997	25
YAHOO!	4-1999-001053	February 15, 1999	9
MY YAHOO!	4-2005-004364	May 12, 2005	9,35,36,38,39,41, 42,43
Y! and Design	4-2006-001459	February 28, 2006	9,25,35,36,38,41 42,45
YAHOO! GO	4-2006-001458	February 8, 2006	9,25,35,36,38,39 40,41,42,42,45
Y! MUSIC and Headphones Design	4-2005-004403	May 26, 2005	9,35,38,41

Certified copies of the above-referenced trademark applications shall be submitted by the undersigned counsel.

30. In addition, Opposer has four (4) Philippine trademark registrations in connection with goods and services in Classes 16, 35, 38 and 42, as follows: Reg. No. 4-1996-110029 for YAHOO!, Reg. No. 4-1996-110030 for YAHOO!, Reg. No. 4-1996-110031 for YAHOO! and Reg. No. 4-1998-000952 for YAHOO!. Photocopies of these registrations are herewith attached and identified respectively as Exhibits B, C, D and E.

YAHOO! trademark is well known in the Philippines

31. In the Philippines, Internet users have been extensively using Yahoo!'s websites for years. Since May 2003, Yahoo! had been offering a website dedicated to the Philippines as part of its YAHOO! Asia Portal. As of October 31, 2006, Yahoo! had more than 29.5 million users who have identified the Philippines as their country of residence, and in October 2006, Yahoo! received more than 1.5 billion page views from approximately 7 million Internet users in the Philippines.

Use and registration of YAHOO! in the food category

32. Opposer owns the right to a number of YAHOO! formative trademark registrations covering certain food products and services in the USA. In 1996, Yahoo! acquired the following for YAHOO-formative U.S. trademark registrations from Miss King's Kitchens covering cakes (use for which dates back since 1981) and retail store and catalogue services in the filed of gourmet foods (use since 1980). The official registration records for these marks can be accessed in the following web pages of the U.S Patent & Trademark Office, as follows:

- <http://tarr.uspto.gov/servelet/tarr?regser=serial&entry-73725620>
- <http://tarr.uspto.gov/servelet/tarr?regser=serial&entry-73725619>
- <http://tarr.uspto.gov/servelet/tarr?regser=serial&entry-75083549>

33. Opposer licenses to Miss King's Kitchen the right to continue to use the YAHOO-formative marks for the food-related goods and services covered by these registration.

34. Opposer owns twenty eight (28) various trademarks registrations and applications in different countries for the mark "YAHOO!" and variations thereof under International Classes 29, 30, 31, and 33 to wit:

Country	Mark	Reg. No.	Reg. Date
Belize	YAHOO!	383/tm/2002	2/19/2002
Canada	YAHOO!	568690	10/8/2002
Chile	YAHOO!	663958	4/28/2003
Chile	YAHOO!	663956	4/28/2003
Costa Rica	YAHOO!	133,560	5/13/2002
Equador	YAHOO!	20185	11/22/2001
European Community	YAHOO!	693127	1/22/2001
Indonesia	YAHOO!	428378	3/31/1999
Jordan	YAHOO!	63936	3/6/2003
Jordan	YAHOO!	63937	3/6/2003
Mexico	YAHOO!	902831	9/30/2005
Panama	YAHOO!	117967	11/6/2001
Russia	Yahoo! in English and Cyrillic	211620	4/25/2002
South Korea	YAHOO!	466,946	3/21/2000
USA	THE ORIGINAL TEXAS YAHOO! CAKE CO. & DESIGN	1572204	12/19/1989
USA	YA-HOO	1536595	4/5/1989
Argentina	YAHOO!	2673163	5/24/06
Argentina	YAHOO!	2710294	10/26/06
Argentina	YAHOO!	2710295	10/26/06
Bolivia	YAHOO!	SM-4145	12/4/2001
Brazil	YAHOO!	820408255	11/28/1997
Columbia	YAHOO!	0119410	12/21/2001
India	YAHOO!	1361856	6/6/2005
Indonesia	YAHOO!	D00/4418	3/9/2000
Paraguay	YAHOO!	37186	10/31/2001
Peru	YAHOO!	137,342	10/31/2001
Uruguay	YAHOO!	332551	7/6/2001
Venezuela	YAHOO!	19966-01	11/6/2001

35. Opposer's services include YAHOO! Food, a website that provides comprehensive food information various food experts and celebrity chefs such as Martha Stewart, Wolfgang Puck and Rachel Ray. Through its website at <http://food.yahoo.com>, Opposer provides a one-stop-shop for a wide array of information and resources concerning food and cooking such as recipes, cooking ingredients, cuisine for special occasions, food stores and sources, restaurants, dining guides, culinary art and education, cookware and tableware, food festivals, parties, party preparations and decorations, and many other resources to food lovers around the world, effectively creates a food community comprised of anyone and everyone interested in learning about food.

36. The trademark YAHOO! is also used in connection with internet cafes called Yahoo! Café in countries like Japan. The trademark/service mark YAHOO!

CAFÉ is registered in Japan under certificate of Registration Number 4605459 issued on September 20, 2002 the application of which was filed on April 10, 2001.

37. In Japan, Yahoo! Café is located in Hibiya, Narita Airport, Haneda Airport and one in Shingawa Prince Hotel. In a Yahoo! Café, aside from internet services wherein computer units are made available to patrons or customers, food such as sandwiches, pasta, pancakes, coffee and tea are also sold and served to customers. Yahoo! Cafes are advertised worldwide through its main website <http://cafes.yahoo.co.jp/>.

38. Yahoo!'s local website in Hongkong also has a specific section that focuses on the restaurant industry, food and diet namely, YAHOO! Life. This website features various restaurants and their food specialties. In addition, discussion boards and/or forums are available and open to the public. The topics in these forums range from diet, new restaurants in town and food. YAHOO! Hongkong's YAHOO! Life page can be accessed worldwide through <http://hk.lifestyle.yahoo.com/dining/>.

Legal protection for YAHOO! as a corporate name

39. Opposer has been using YAHOO! not only as a trademark but also as a trade name and company name from the inception of its business and to this day, continues to use the same as its business and trade name in most countries around the world where it has business dealings or transactions. As a trade name, "YAHOO!" is protected under Section 165 of the IP Code, whether or not the same is registered as trademark in the Philippines.

40. The trademark subject of this opposition, "YAAHOO!" is confusingly similar to Opposer's trademark YAHOO! and is used in connection with goods in the same category for which Opposer uses and licenses its trademark such that if allowed to register, YAAHOO! will likely deceive or cause confusion, in contravention of Section 123.1 (d) of the IP Code. The subject marks can be considered as visually identical to Opposer's trademark and company name. The marks are identical in pronunciation.

41. Opposer's YAHOO! trademark is well-known internationally and in the Philippines and the registration and use of YAAHOO by Respondent-Applicant will falsely indicate a connection between the Opposer's and Respondent-Applicant's goods which will result in damage to Opposer in terms of, among others, the whittling away of Opposer's goodwill and the dilution of the rights of Opposer to its YAHOO! trademark -- all in contravention of Section 123.1 (e) and 123.1 (f) of the IP Code.

42. As YAHOO! also constitutes Opposer's company or trade name which is protected under Section 165 of the IP Code, even without registration, the registration and use of YAAHOO in the name of Respondent-Applicant violate Opposer's legal rights to its trade name which consists, among others, in Respondent-Applicant unfairly profiting from the high reputation and goodwill generated by the overwhelming popularity of Opposer's trademark.

43. Confusion and deception upon the consuming public with respect to, among others, the source of goods and services or the sponsorship of goods and services will likely result if YAAHOO is allowed to be used and registered in the name of Respondent-Applicant.

44. Supporting Affidavit are concurrently submitted herewith pursuant to the Rules.

The Notice to Answer dated 04 January 2007 was sent to Respondent Sam Lim Corp. by registered mail directing it to file its Verified Answer within a prescribed period from receipt. Respondent filed its Verified Answer on 18 May 2007.

Respondent, through the undersigned counsel, by way of Answer, most respectfully states that:

1. Respondent specifically denies the allegations in paragraph 1 of the *Opposition* for lack of knowledge or information sufficient to form a belief as to the truth thereof.
2. Respondent specifically denies the allegations in paragraph 2 of the *Opposition* for lack of knowledge or information sufficient to form a belief as to the truth thereof.
3. Respondent specifically denies the allegations in paragraph 3 of the *Opposition* for lack of knowledge or information sufficient to form a belief as to the truth thereof.
4. Respondent admits the allegations in paragraph 4 of the *Opposition* only in so fact as it alleges that SAM LIM CORP. is a corporation duly organized and existing under Philippine law, and Sam Lim Corporation's principal office address stated therein.
5. Respondent admits the allegations in paragraph 5 of the *Opposition*.
6. Respondent specifically denies the allegations in paragraphs 6, 7 and 8 of the *Opposition* for lack of knowledge or information sufficient to form a belief as to the truth thereof.
7. Respondent specifically denies the allegations in paragraph 9 of the *Opposition*, the truth being those stated in the special and affirmative defenses.
8. Respondent specifically denies the allegations in paragraphs 10 to 17 of the *Opposition* for lack of knowledge or information sufficient to form a belief as to the truth thereof.
9. Respondent admits the allegations in paragraph 18 of the *Opposition* only in so far as it alleges that much of the advertising sold by opposer consists of advertisements that appear on the web pages within the Yahoo! website
10. Respondent specifically denies the allegations in paragraphs 19 to 26 of the *Opposition* for lack of knowledge or information sufficient to form a belief as to the truth thereof.
11. Respondent specifically denies the allegations in paragraphs 27 to 28 of the *Opposition* for lack of knowledge or information sufficient to form a belief as to the truth thereof.
12. Respondent specifically denies the allegations in paragraphs 29 to 31 of the *Opposition* for lack of knowledge or information sufficient to form a belief as to the truth thereof.

A junior user of a well-known mark on goods or services which are not similar to the goods or services, and are therefore unrelated, to those specified in the certificate of registration of the well-known mark is precluded from using the same on the entirely unrelated goods or services, subject to the following requisites, to wit:

1. The mark is well-known internationally and in the Philippines. Under Rule 102 of the Rules and regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers, in determining whether a mark is well known, the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of the registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.

(2) The use of the well-known mark on the entirely unrelated goods or services would indicate a connection between such unrelated goods or services and those goods or services specified in the certificate of registration in the well known mark. This requirement refers to the likelihood of confusion or origin or

business or some business connection or relationship between the registrant and the user of the mark.

(3) The interests of the owner of the well-known mark are likely to be damaged. For instance, if the registrant will be precluded from expanding its business to those unrelated goods or services, or if the interests of the registrant of the well-known mark will be damaged because of the inferior quality of the goods or services of the user.

18. The descriptions of the goods and services covered by the applications for the "YAHOO!" trademark (Reg. No. 4-1996-110519 for YAHOO!, Reg. No. 4-1996-110520 for YAHOO!, Reg. No. 4-1996-110029 for YAHOO!, Reg. No. 4-1996-110030 for YAHOO!, Reg. No. 4-1996-110031 for YAHOO!, Reg. No. 4-1998-000952 for YAHOO!) which the respondent has obtained from the Intellectual Property Office only cover computer services, magazines, communication services, promotional displays and the like. FOOD PRODUCTS ARE NOT COVERED BY THE TRADEMARK APPLICATIONS OF "YAHOO".

The original of the aforesaid applications for the "YAHOO!" trademark are attached as Exhibits – "1" to "6" and made an integral part hereof.

19. The Highest Magistrate declared in *Faberge, Inc. vs. Intermediate Appellate Court* that an owner of a trademark cannot prevent the adoption and use of the same trademark by others for products which are of a different description, thus:

"Having thus received the laws applicable to the case before us, it is not difficult to discern from the foregoing statutory enactments that private respondent may be permitted to register the trademark "BRUTE" for briefs produced by it notwithstanding petitioner's vehement protestations of unfair dealings in marketing its own set of items which are limited to: after-shave lotion, shaving cream, deodorant, talcum powder and toilet soap. Inasmuch as petitioner has not ventured in the production of briefs, an item which is not listed in its certificate of registration, petitioner can not and should not be allowed to feign that private respondent had invaded petitioner's exclusive domain. To be sure, it is significant that petitioner indeed intended to expand its mark "BRUT" to other goods" (Page 27, Brief for the Petitioner; Page 202, Roilo). Even then, a mere vest an exclusive right in its favor that can ordinarily be protected by the Trademark Law. In short, paraphrasing Section 20 of the Trade-mark Law as applied to the documentary evidence adduced by petitioner, the certificate of registration issued by the Director of Patents can confer upon petitioner the exclusive right to use its own symbol only to those goods specified in the certificate, subject to any conditions and limitations stated therein. This basic point is perhaps the unwritten rationale of Justice Escolin in *Philippine Refining Co., Inc. vs. Ng Lam* (115 SCRA 472 1982)}, when he stressed the principle enunciated by the United States Supreme Court in *American Foundries vs. Robertson* (269 U.S. 372, 381, 70 L. ed 317, 46 Sct. 160) that ONE WHO HAS ADOPTED AND USED A TRADEMARK ON HIS GOODS DOES NOT PREVENT THE ADOPTION AND USE OF THE SAME TRADEMARKS BY OTHERS FROM PRODUCTS WHICH ARE OF A DIFFERENT DESCRIPTION.

XXX

The protective mantle of the Trademark Law extends only to the goods used by the first user as specified in the certificate of registration following the clear message conveyed by Section 20.

Judging from the physical attributes of petitioner's and private respondent's products, there can be no doubt that confusion or the likelihood of deception to the average purchaser is unlikely since the goods are NON-COMPETING AND UNRELATED." (Emphasis supplied)

(20) The same ruling was reiterated by the Supreme Court in the recent case of *Pearl Dean (Phils), Inc. vs. Shoemart, Inc.* to wit:

"Under the circumstances, the Court of Appeals correctly cited *Faberge Inc. vs. Intermediate Appellate Court*, where we, invoking Section 20 of the Old Trademark Law, ruled that "the certificate of registration issued by the Director of Patents can confer (upon petitioner) the exclusive right to use its own symbol only to those goods specified in the certificate, subject to any conditions and limitations specified in the certificate x x x. One who has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others for products which are of a different description." *Faberge, Inc. was correct and was in fact recently reiterated in Canon Kabushiki Kaisha vs. Court of Appeals.*" (Emphasis supplied)

(21) To reiterate, the descriptions of the goods and services of "YAHOO!" in its trademark applications are limited to computer services, magazines, communication services, promotional displays and the like. It is crucial to emphasize herein that as to the promotions of goods and services of others, what is covered by the opposer's trademark applications are only the advertisements and promotional displays bearing the "YAHOO!" mark and not the food products advertised/promoted therein.

(22) The goods and services of "YAHOO!" in its trademark applications are non-competing and unrelated to "YAAHOO!" biscuits. In addition, "YAAHOO" is for a food product which is of a different description from the said goods and services of "YAHOO!". Moreover, the font, spelling and design of "YAHOO!" / "YAHOO!IGANS!", as shown in its trademark applications, are different from the "YAAHOO" mark.

The aforesaid YAAHOO food product trademark is attached as Exhibit – "7" and made an integral part hereof.

(23) It is clear, therefore, based on the above-cited Supreme Court decisions, that "YAHOO!" CANNOT prevent the adoption and use by W.L. Foods of "YAAHOO" trademark on the labels of its biscuits.

(24) Furthermore, an essential element of "infringement" in Section 155 of the Intellectual Property Law (RA 8293) is colorable imitation which may likely to cause confusion, mistake or deception.

(25) The Supreme Court defined “colorable imitation” in *Emerald Garment Manufacturing Corporation vs. Court of Appeals*, thus:

“Proceeding to the task at hand, the essential element of infringement is colorable imitation. This term has been defined as “such a close or ingenious imitation as to be calculated to deceive ordinary purchasers, or such resemblance of the infringing mark to the original as to deceive an ordinary purchaser giving such attention as a purchaser usually gives, and to cause him to purchase the one supposing it to be the other.” (Emphasis supplied)

(26) The goods and services covered by the “YAHOO!” trademark cannot be confused with the respondent’s “YAAHOO” biscuits. A *holistic comparison* between the “YAAHOO” mark on the labels of W.L. Foods’ biscuits and the “YAHOO!” mark on the goods and services being offered by the respondent, without dissecting each feature thereof, reveals glaring discrepancies that one cannot be mistaken for the other. Moreover, there is not much similarity of the *prevalent features* of the competing trademarks which might cause or deception and thus constitute infringement. A purchaser who is out in the market for the purpose of buying a “YAHOO!” magazine, for example, would definitely be not mistaken or misled into buying YAAHOO biscuits. It is likewise important to point out that most, if not all, of the goods and services covered by the “YAHOO!” trademark applications cannot be purchased/availed of in the grocery or *sari-sari* stores where “YAAHOO” biscuits are being sold. Hence, confusion or deception on the buyers cannot possibly occur.

(27) The use by respondent of “YAAHOO” mark on the labels of W.L. Foods’ biscuits, which are entirely unrelated to the goods and services being offered by the respondent, would not indicate a connection between such unrelated goods or services and those goods or services specified in the certificate of registration of “YAHOO!” trademark. There can be no likelihood of confusion of origin or business or some business connection or relationship between the respondent and the opposer for the same reasons aforementioned. Furthermore, there can be no damage that may be caused to the interests of the opposer. As mentioned, a purchaser of a “YAHOO!” product, or even an advertiser, for instance, would definitely be not mistaken or misled into buying YAAHOO biscuits nor will such purchaser or advertiser be precluded from buying YAHOO! products for the sole reason that they also availed of YAAHOO biscuits or food products. Equally important is the fact that most, if not all, of the goods and services covered by the “YAHOO!” trademark applications cannot be purchased/available of in the grocery or *sari-sari* stores where “YAAHOO” biscuits are being sold.

(28) On the other hand “unfair competition” under Section 168.2 and 168.3 of the Intellectual Property and 168.3 of the Intellectual Property Law (RA 8293) is committed only when there is a conduct tending to “pass off one man’s goods or business as that of another. Actual or probable deception and confusion on the part of the customers by reason of defendant’s practices MUST ALWAYS appear.”

(29) As above-stated, there is no conduct by W.L. Foods to pass off “YAHOO!” biscuits as the goods and services covered by the “YAHOO!” trademark applications. There is no proof whatsoever that there was actual or even probable deception of the consumers because of the use of W.L. Foods of “YAHOO!” on the labels of its biscuits.

(30) The general appearance of respondent's trademark would not evidently create a likelihood of confusion to that of the opposer among the purchasing public. Considering further that the trademark sought to be registered by respondent is distinctively dissimilar from those of the petitioner, the likelihood of confusion would not subsist, either on the purchaser's perception of the goods or on the origins thereof. By using the word "YAAHOO," respondent's biscuits and food products are not likely to be mistaken as having been produced by petitioner. It is noteworthy that the risk of damage is not limited to a possible confusion of goods but also includes confusion of reputation if the public could reasonably assume that the goods of the parties originated from the same source. That could not be possible in the present case.

(31) Evidently, as shown above, the respondent has not committed any facts which can be construed as an infringement on the trademark of "YAHOO!" nor as an unfair competition for which the penalties under the Intellectual Property Law (RA 8293) can be imposed.

(32) Hence, the respondent's demand that W.L. Foods cease and desist from using "YAAHOO" on the labels of its food product is contrary to law and established jurisprudence.

COMPULSORY COUNTERCLAIM

(33) Respondent repleads and reiterates the allegations in the Special Affirmative Defenses.

(34) As respondent was constrained to engage the services of its counsel by reason of the instant case, opposer must be made liable to pay the respondent the amount of FIFTY THOUSAND PESOS (Php50, 000.00) incurred for attorney's fees and litigation expenses in the instant case.

On May 28, 2007 opposer filed its Reply alleging that the goods under the contending marks are in truth related and/or similar due to the fact that opposer's YAHOO! is also being used on food products and the food industry; and that under the present law, similarity of marks used on unrelated goods is expressly provided as a ground for denying registration; and lastly, that YAHOO! is a well-known mark and as such will be a ground for the denial of respondent-applicant's registration. On June 8, 2007, respondent-applicant filed a Rejoinder basically contradicting all of the allegations made by the opposer in its Reply and made a compulsory counterclaim amounting to fifty thousand pesos.

The Preliminary Conference was initially set on July 2, 2007 and after a few re-settings the same was officially terminated on August 30, 2007.

To prove that it would be damaged by the registration of respondent's mark, opposer adduced in evidence Exhibit "A to G" inclusive of submarkings while the respondent-applicant for its defense offered in evidence Exhibits "1 to 7" inclusive of submarkings.

The issues to be resolved are as follows:

1. Whether respondent-applicant's "Yaahoo" is confusingly similar to opposer's mark "YAHOO!"
2. Whether opposer's "YAHOO!" trademark is a well-known mark; and
3. Whether respondent-applicant is entitled to the registration of the mark "Yaahoo"

As to the first issue, this Bureau rules in the affirmative.

Notwithstanding the additional letter “a” found in the respondent-applicant’s trademark and the exclamation point found in the opposer’s mark, the trademark of both parties bears almost the same spelling and if read has exactly the same pronunciation. Visually and aurally then, opposer’s and respondent-applicant’s respective marks are confusingly similar.

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 such mark would likely cause confusion or mistake on the part of the buying public. X X X The law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it. (*American Wire and Cable Company v. Director of Patents*, 31 SCRA 544)

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 *Asia Brewery, Inc. v. Court of Appeals*, 224 SCRA 437; *Co Tiong v. Director of Patents*, 95 Phil. 1; *Lim Hoa v. Director of Patents*, 31 SCRA 544; *Philippine Nut Industry, Inc. v. Standards Brands, Inc.*, 65 SCRA 575; *Converse Rubber Corp. v. Universal Rubber Products, Inc.*, 147 SCRA 154; and the Holistic Test developed in *Del Monte Corporation v. Court of Appeals*, 1818 SCRA 410; *Mead Johnson & Co. v. Director of Patents*, 17 SCRA 128; *Fruit of the Loom, Inc. v. Court of Appeals*, 133 SCRA 405.

As its title implies, the test of dominancy focuses on the similarity of 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.

In the case of *McDonald’s Corporation v. L.C. Big Mak Burger, Inc.*, 47 SCRA 10, the Supreme Court has relied on the dominancy test resolving the issue of likelihood of confusion. It was ruled that:

“This Court, however, has relied on the dominancy test rather than the holistic test. The dominancy test considers the dominant features in the competing marks in determining whether they are confusingly similar under the dominancy test courts give greater weight to the similarity of the appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding minor differences. Courts will consider more the aural and visual impressions created by the marks in the public mind, giving little weight to factors like prices, quality, sales outlets and market segments”.

Thus, in the 1954 case of *Co Tiong Sa v. Director of Patents*, 95 Phil. 1, the Supreme Court held that:

“x x x It has been consistently held that the question of infringement of a trademark is to be determined by the test of dominancy. Similarity in size, form, and color, while relevant, is not conclusive. If the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place. Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate. The question at issue in cases of infringement of trademarks is whether the use of the marks involved would likely to cause confusion or mistakes in the mind of the public or deceive purchasers.”

Sec. 123.1 (d) of R.A. 8293 (I.P. Code of the Philippines) provides that:

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 deceive or cause confusion;

We have noted likewise that the Supreme Court has observed and upheld confusing similarity the following trademarks with similar and dominant suffixes: DURAFLEX and DYNAFLEX (American Wire and Cable Co. vs. Director of Patents, 31 SCRA 244); LIONPAS and SALONPAS (Marvex Commercial Co. Inc., vs. Petro Hawpia & Co., 18 SCRA 1178); AMBISCO and NABISCO (Operator, Inc. vs. Director of Patents, 15 SCRA 149); and SUNVIS and UNVIS (Esso Standard Oil Company vs. SUN Oil Company, et al, 46 TMR 444).

As to the second issue of whether Opposer's YAHOO! trademark is internationally well-known, this Bureau likewise rules in the affirmative.

Sections (c), (e) and (l) of Rule 102 of the Rules On Trademarks, Service Marks, Trade Names and Marked or Stamped Containers provide, to wit:

“Rule 102. Criteria for determining whether a mark is well-known. – In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

x x x

(c) the degree of the inherent or acquired distinction of the mark:

(d) the extent to which the mark has been registered in the Philippines;

x x x

In the case at bench, the trademark registrations secured from practically all countries around the world from the continents of North and South America, Europe, Asia, Australia-New Zealand and the Middle East (Annexes “A-1” to “A-52”) shows proof that opposer's trademark is registered and used worldwide as a website to an immensely broad scope of information. It appears, too, that the subject mark has acquired that degree of distinction in the minds of the public worldwide as a major website: Opposer's evidence shows that opposer's website is used by virtually all persons from the relevant sector of the public-office workers, students, people in the academe, people whose jobs require the use of computers, families, computer hobbyist and enthusiasts- internationally and locally including the Philippines such that the subject mark has become synonymous with opposer. Hence, the use even on dissimilar and/or unrelated goods vis-à-vis respondent-applicant's goods would indicate a connection between respondent-applicant's goods and opposer when in fact, there is none. Consequently, it is likely that opposer's interest in its mark shall be likely damaged by use of an identical mark.

As to the third issue, this Bureau rules in the negative.

It is true that with respect to the goods and services of respondent-applicant when compared to opposer's certificates of trademark registrations secured from this Office do not belong to the same class. Respondent's application covers mark on cheese flavor biscuit curls

falling under class 30 while the opposer has several subsisting registrations in the Philippines, namely Registration No. 4-1996-110029 (Exhibit B) issued on February 24, 2005 falling under class 16 for books, regarding computer networks and searching and retrieving information, sites and other resources on computer networks; Registration No. 4-1996-110030 (Exhibit C) issued on February 24, 2005 under class 35 for promoting the goods and services of others by placing advertisements and promotional displays in an electronic site accessed through computer networks; Registration No. 4-1996-110031 (Exhibit D) falling under class 42 for computer services, namely, creating indexes of information, sites and other resources available on computer networks, searching and retrieving information sites, and other resources available on computer networks, providing online access to news, weather, sports, current events, and reference materials; and lastly Registration No. 4-1998-000952 (Exhibit E) falling under class 38 for communications services; telecommunications services; electronic mail services; telephony services' providing multiple-user access to computer networks for the transfer and dissemination of a wide range of information; electronic transmission of data, images and document; and providing online facilities for real-time interaction with other computer users in international class 38. However, record shows that the YAHOO! trademark has been used by Opposer for food products and services as early as in the 1980's when Miss King's Kitchen, Inc. assigned the trademark YA-HOO to herein opposer YAHOO! Inc., (Annex B-16 of the Affidavit of Ms. Laura Covington). In fact, YAHOO! has been registered for food products in Belize, Canada, Chile, Costa Rica, Ecuador, The European Community, Indonesia, Jordan, Mexico, Panama, Russia, South Korea, and the USA (Annex B-16 of the Affidavit of Ms. Laura Covington). Moreover, opposer has filed here in the Philippines on June 22, 2005 application No. 4-2005-005749 for the mark YAHOO! under classes 29 and 30 indicating its intention to expand their business here which cover's the same class with that of the respondent. Clearly, the application of respondent-applicant's trademark if allowed will deny the opposer's right and/or interest to expand here in the Philippines its business, particularly in the food industry. Paragraph (f), Section 123.1 of the Intellectual Property Code provides:

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

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark; Provided further, That the interest of the owner of the registered mark are likely to be damaged by such use.

In the case of Levi Strauss v. Clinton Apparel, GR No. 138900, 20 September 2005, the Supreme Court made a definition on "Trademark Dilution" which we find relevant to the instant case to wit:

"Trademark dilution" is the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of:

1. competition between the owner of the famous mark and other parties; or
2. likelihood of confusion, mistake or deception. Subject to the principles of equity, the owner of a famous mark is entitled to injunction "against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark." this is intended to protect famous marks from subsequent uses

that blur distinctiveness of the mark or tarnish or disparage it.

In order to be protected from dilution, it must be proved that:

1. the trademark sought to be protected is famous and distinctive;
2. the use by the respondent of the mark began after petitioner's mark became famous;
3. such subsequent use defames petitioner's mark"

Furthermore, the Intellectual Property Code of the Philippines has specific provision protecting the rights of a well known mark to wit:

Sec. 147.2. The exclusive right of the owner of a well-known mark defined in Subsection 123.1 (e) which is registered in the Philippines, shall extend to goods and services which are not similar to those in respect of which the mark is registered: Provided, that use of that mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered mark: Provided further, That the interest of the owner of the registered mark are likely to be damaged by such use.

WHEREFORE, the VERIFIED OPPOSITION is, as it is, hereby SUSTAINED. Consequently, Application Serial No. 4-2001-006334 for the mark "Yaahoo" for biscuits and other food products under Class 30 filed on August 28, 2001 by Cam Lim Corp., Inc. is, as it is, hereby REJECTED.

Let the filewrapper of "Yaahoo" together with this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, January 16, 2008.

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