

YAKIRA L.L.C.,	}	IPC No. 14-2008-00064
Opposer,	}	Opposition to:
	}	Application Serial No. 4-2007-001068
-versus-	}	Trademark: ECKOMART perfect
	}	buy every time at low prices
ROSANNE CO,	}	
Respondent-Applicant	}	
	}	Decision No. 2009-29
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## DECISION

For decision is the Notice of Opposition filed by Yakira L.L.C. (Opposer), a corporation organized under the law of the State of New Jersey, United States of America, with office at 40 West 23<sup>rd</sup> St., New York, NY 10010, U.S.A. against Application Serial No. 4-2007-001068, filed on February 1, 2007 for the trademark "ECKOMART perfect buy everytime at low prices" for goods under class 35 namely: "retailer, wholesaler for dry goods namely fashion accessories, clothing (TRW), kitchenware, hardwares, make-up, toy, school supplies, electrical and electronic products, hair accessories, gift items, shoes and slippers" filed by Rosanne Co, (respondent-applicant), Filipino, with address at 177 P. Sevilla St. cor 8<sup>th</sup> Ave., Caloocan City.

The grounds for the opposition are as follows:

- "a. Section 147.1 of the IP Code, which pertains to the exclusive rights of the owner of a registered trademark;
- b. Section 147.2 and related Section 123 (d), 123 (e) and 123 (f) of the IP Code which relates to Opposer's rights as owner of an earlier registered trademark as owner of a well-known trademark;
- c. Section 168.1 of the IP Code."

The facts as stated by the Opposer are as follows:

"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 juridical 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 143 of the IP Code for the protection of its business reputation, trademark and goodwill.

4. The Opposer is the original prior adopter and user of the trademarks "ECKO FUNCTION", "MARC ECKO", "RED BY MARC ECKO" and "ECKORED" abroad and in the Philippines.

4.1 In the Philippines, Opposer has obtained the following trademark registrations.

- (a) Trademark Registration No. 4-2007-004653 issued on July 30, 2007 covering the trademark "ECKO UNLTD." For use on "Retail store services" in Class 35;

(b) Trademark Registration No. 4-2000-005203 issued on October 24, 2005 covering "ECKO UNLTD." For use on goods in Class 25;

(c) Trademark Registration No. 4-2000-005204 issued on October 24, 2005 covering the trademark "MARC ECKO" filed on June 22, 2000 for use on goods in Class 25;

(d) Trademark Registration No. 4-2004-000880 issued on October 31, 2005 covering the trademark "MARC ECKO" for use on goods in Class 3; and

(e) Trademark Registration No. 4-2000-005205 issued on October 24, 2005 covering "ECKORED" for use on goods in Class 25.

Certified copies of the mentioned registrations will be identified, marked attached and presented as Exhibits in a separate Affidavit.

5. Respondent-Applicant's "ECKOMART perfect buy everytime at low prices" constitutes a colorable imitation of the Opposer's trademark "ECKO UNLTD.," "ECKO FUNCTION," "MARC ECKO," and "ECKORED," all registered and/or applied for registration in the Philippines and in many countries worldwide. Consequently, the use by Respondent-Applicant of the subject mark in connection with service in Class 35, particularly in the retail distribution of goods, including but not limited to clothing, footwear and fashion accessories (which are goods in Class 25), would likely result confusion among consumers who will be deceived into thinking that Opposer's goods are sold in Respondent-Applicant's business is related to, or sponsored by the Opposer herein, thereby clearly causing damage and prejudice to the interests and the goodwill of the Opposer.

6. While "ECKOMART" in the subject application has been presented as a unitary word, the letters "E", "C", "K" and "O" have been reflected in a shade that is different from the letters "M", "A", "R" and "T", this projects a clear intention to place an emphasis on "ECKO." Considering that the letters "M", "A", "R" and "T" or "MART" could not be exclusively appropriated by anybody with respect to services in Class 35, the Respondent-Applicant (Rosanne Co) necessarily has to claim exclusive rights only in regards to "ECKO." As a matter of fact, as clearly shown in the publication, the Respondent-Applicant has already disclaimed exclusive rights to the word "MART" and the accompanying phrase or slogan "PERFECT BUY EVERYTIME AT LOW, LOW PRICES." In short, in reality, the subject application seeks legal protection for ECKO in connection with services that are already covered by Opposer's prior trademark registration for ECKO UNLTD and by other ECKO family of registrations covering the category of goods that are precisely the subject of the services covered by the subject application.

7. The continued use by Respondent-Applicant of its "ECKOMART perfect buy everytime at low prices," on services falling under Class 35 will constitute a clear case of criminal piracy. Accordingly, if allowed to proceed to registration, the Trademark Application Serial No. 4-2007-001068 will violate not only the provisions of the Intellectual Property (IP) Code, particularly paragraphs (d), (e) and (f) and (g) of Section 123.1 therefore, but also the commitment of the Philippines to the International community through its accession with the Paris Convention and membership with the World Trade Organization (WTO) and as signatory to the Trade Related Aspects of Intellectual Property Rights Agreement (TRIPS).

8. As matter of fact, the adoption and use of Respondent-Applicant's "ECKOMART perfect buy everytime at low prices." On services falling under Class 35 constitutes infringement or Opposer's Trademark Registration Nos. 4-

2007-004653 ("ECKO UNLTD." In Class 35), 4-2000-005203 ("ECKO UNLTD." In Class 25), No. – 2000-005204 ("MARC ECKO" in Class 25), 4-2004-000880 ("MARC ECKO" in Class 3) and 4-2000-005205 ("ECKORED" in Class 25).

9. Opposer has been extensively and continuously using and promoting through aggressive worldwide registrations, sales and advertising of the trademarks "ECKORED" thereby incurring much expenses. Hence, Opposer's Business and goodwill will clearly be damaged, tarnished and diluted and Opposer will suffer irreparable injury by the registration and use a confusingly similar and infringing mark by Respondent-Applicant.

10. Respondent-Applicant has fraudulently applied for the registration of "ECKOMART perfect buy everytime at low prices" since it is merely taking a free ride on the popularity and fame of Opposer's well-known marks "ECKO UNLTD.," "ECKO FUNCTION," "MARC ECKO," and "ECKORED".

11. Even before the filing on February 1, 2007 of Respondent-Applicant's Trademark Application Serial No. 4-2007-001068, the aforementioned Opposer's trademarks are already well-known abroad and in the Philippines. Opposer has started the actual commercial use of said marks in the Philippines Trademark Registration Nos. 4-2000-005203 ("ECKO UNLTD." In Class 25), No. 4-2000-005204 ("MARC ECKO" in Class 25), 4-2004-000880 ("MARC ECKO" in Class 3) and 4-2000-005205 ("ECKORED" in Class 25).

Proof of local commercial use said marks will be identified, marked attached and presented as Exhibits of the Opposer in a separate Affidavit that will be attached to this Notice of Opposition.

12. Opposer owns and has registered in several countries of the world the trademarks "ECKO UNLTD.," "ECKO FUNCTION," "MARC ECKO" and "ECKORED". Among the foreign countries where Opposer has registered the trademark "ECKO UNLTD." In International Class 25 and in other International Classes are as follows: Algeria, Argentina, Armenia, Aruba, Australia, Austria, Bahrain, Belize, Benelux, Bolivia, BULGARIA, Chile, China, Colombia Costa Rica, Croatia, Czech Republic, Dominican Republic Ecuador, El Salvador, European Community, France, Georgia, Germany, Guatemala, Honduras, Hongkong, Iceland, Iran, Israel, Jamaica, Japan, Jordan, Republic of Korea, Lebanon, Liechtenstein, Mexico, Monaco, Morocco, Netherlands Antilles, New Zealand, Nicaragua, Norway, Panama, Paraguay, Peru, Romania, Russian Federation, Saudi Arabia, Singapore, Slovakia, Switzerland, Taiwan, Thailand, Ukraine, United Arab Emirates, United States of America, Uruguay and Venezuela.

Certified true copies of the copies of Certificate of Registration issued in the name of Opposer in Australia, Chile, Croatia, European Community and the United States of America covering the trademark "ECKO UNLTD." That were previously marked as Exhibit "A", "B", "C", "D" and "E", respectively, of the Verified Notice of Opposition and presented as evidence in connection with Inter Partes Case No. 14-2003-00053, entitled: "YAKIRA L.L.C. VS. RAMON ONG" will be identified marked, attached and presented as Exhibits in a separate Affidavit.

13. Moreover, Opposer owns and has registered the trademark "MARC ECKO," with respect to goods in International Class 25 and in other International Classes, in the Principal Registers of the following countries: Algeria, Argentina, Armenia, Aruba, Australia, Bahrain, Barbados, Belize, Bolivia, Bulgaria, Chile, China, Guatemala, Honduras, Iceland, Indonesia, Iran, Israel, Jamaica, Japan, Jordan, Republic of Korea, Lebanon, Liechtenstein, Malaysia, Mexico, Monaco,

Morocco, Netherlands Antilles, New Zealand, Nicaragua, Norway, Panama, Peru, Romania, Russian Federation, Saudi Arabia, Singapore, Slovakia, Switzerland, Taiwan, Thailand, Trinidad & Tobago and Turkey.

Certified true copies of the copies of certificates of registration under Opposer's name issued in Australia, Bulgaria, Czech Republic, Japan and the Russian Federation for the Trademark "MARCO ECKO" that were previously marked as Exhibits "F", "G," "H," "I" and "J", respectively, of the Verified Notice of Opposition and presented as evidence in connection with Inter Partes Case No. 14-2003-00053, will be identified, marked, attached and presented as Exhibits of the Opposer in separate Affidavit.

14. The use of "ECKOMART perfect buy everytime a low prices" in connection with providing services as a "Retailer, wholesaler for dry goods namely fashion accessories, clothing (RTW), kitchenware, hardwares, make-up, school supplies, electrical and electronic products, hair accessories, gift items, shoes and slippers" will likely mislead or confuse the public as to the nature, quality, characteristics and origin of the services and goods involved especially since the services employing the Opposer's mark "ECKO UNLTD." Registered under Trademark Registration No. 4-2007-004653 fall under Class 35 and considering that the products or goods on which Opposer's registered mark "ECKO UNLTD." [Please see Trademark Registration No. 4-2000-005203] is being used, which are "Men's sports bags and non-leather travels accessory bags; sweatbands; men's clothing, namely jerseys, jumpsuits, uniforms, sport pants, knit shirts, shirts, t-shirt, polo shirt, tank tops, slacks, jeans, shorts, underwear, nightwear, coats, jackets, parkas, overcoats, pullovers, sweatshirts, and sweater; women's leather clothing and legging; men's headwear of all types, namely, hats, sports caps and visor; women baseball hats, visors, and bucket style hats," are identical with the Respondent-Applicant's services and goods in connection with which Respondent-Applicant uses it trademark/services mark;

15. Of equal importance is the fact that the Respondent-Applicant's use of "ECKOMART perfect buy everytime at low prices" on the mentioned services and the goods involved will likely mislead or confuse the public as to the nature, quality, characteristics and origin of such services and goods, considering that the goods on which Opposer's registered "ARC ECKO" [Please see Trademark Registration No. 4-2000-05204] is being use which are "Clothing, namely, jerseys, sweatbands, jump suits, uniforms, sport pants, knit shirts, shirts, polo shirts, tank tops, blouses, slacks, jeans, shorts, underwear, stockings, nightwear, leotards, leggings, coats, jackets, parkas, overcoats, pullovers, sweatshirts, and sweater; footwear; and headwear of all types, namely hast, sports caps and visors," are also identical with the goods in connection with which Respondent-Applicant uses its trademark/service mark;

16. Confusion and/or deception on the part of the consumers as to the nature, quality, characteristics and origin of the services and goods involved in the services is also likely to happen by the use of the Respondent-Applicant's "ECKOMART perfect buy everytime at low prices" since the Opposer registered trademark "ECKORED" [Please see Trademark Registration No. 4-2000-005205] is being used on "Clothing, namely, jerseys, sweatbands, jumpsuit, uniforms, sport pants, knit shirts, shirts, t-shirts, polo shirts, tank tops, blouses, slacks, jeans, shorts, underwear, stockings, nightwear, leotards, leggings, coats, jackets, parkas, overcoats, pullovers, sweatshirts and sweaters; men's headwear of all types, namely, hats, sport caps, and visors; women's baseball hats, visors, and bucket style hats;"

17. Opposer sells its products affixed with the above trademarks worldwide in specialty clothing stores which are also use “ECKO”, “ECKO UNLTD.” and/or “ECKO UNLIMITED” on its signages. The goods sold in these independent specialty stores sell primarily “ECKO” branded goods, particularly clothing articles. Opposer’s products are sold and distributed through the Internet at which is the main retail website of the OPPOSER;

18. Opposer, or an affiliate of Opposer, has also registered the following domain names, which contain ECKO formatives” ecko.com, eckofunction.com, eckocomplex.com, eckoutlet.com, eckored.com, eckounlimited.net, eckounltd.com, eckounltd.net, wckowomen.com, marcecko.com, marcecko.nte, marceckoenterprises.com, ecko-footwear.com, eckounltdkids.com, eckoasia.com and marceckofootwear.com All of these websites are accessible to Internet in the Philippines.

19. Opposer has also prominently advertised the trademark “ECKO UNLTD.,” “ECKO FUNCTION,” MARC ECKO” and “ECKORED” in various magazines which included, but are not limited to, Complex, Cosmo, Cosmo Girl, Dirt Rider, DNR, Dub, EGM, Elle Girl, Expert Gamer, The Fader, FEDS, Flaunt, Frank 151, Import Tuner, Jane, Mass Appeal, Mari Claire, Marvel, Maxim, Mixer, MX Racer, Nylon, Official Playstation Magazine, Paper, Playboy, Racer X, Ride, Slam, Slap, Snap, The Tokion, Toyfare, Trace, Trasworld Surf, Transworld Stance, URB, Vibe, XLR8R, XXL, Vice and YM.

20. Opposer’s goods, particularly clothing articles and the “ECKO UNLTD.,” “ECKO FUNCTION,” “MARC ECKO,” RED BY MARC ECKO” and “ECKORED” trademark, have been advertised and featured in numerous movies and television shows shown all over the world including the Philippines. The titles of theses movies and television shows include, but are not limited to “Step-up,” “8 mile,” “Fast and Furious,” “The Wire,” “Entourage,” “Scrubs,” “King of QUEENS’ and “American Idol”.

21. By reason of Opposer’s worldwide registrations, use and advertising the trademarks “ECKO UNLTD., “ECKO FUNCTION,” “MARC ECKO,” “RED BY MARC ECKO” and “ECKORED” have unquestionably attained worldwide fame and notoriety.

22. Opposer and its trademarks “ECKO UNLTD.,” “ECKO FUNCTION,” MARK ECKO,” RED BY MARK ECKO” and “ECKORED” are intentionally well-known by reason of the long use of the said trademarks by Opposer, and the worldwide trademark registrations and applications of the said trademarks.

23. The registration of the Respondent-Applicant’s “ECKOMART perfect buy everytime at low prices” will impinge upon and damage the Intellectual Property rights and interest, business reputation and goodwill of the Opposer over its trademarks since the distinctiveness of Opposer’s trademark will be diluted and considering that Respondent-Applicant will unfairly benefit from, and get a free ride on, the goodwill of Opposer’s trademarks and business reputation, thereby causing irreparable injury to the Oppose.”

Opposer submitted the following evidence. Exhibit “A” to “I” with sub-markings, to support the opposition:

EXHIBITS	DESCRIPTION
“A”	Specimen of opposer’s trademarks

“B”	Affidavit of Gregg Donnenfield
“C”	Affidavit of Jan Abigail L. Ponce
“D”	Legalized Special Power of Attorney
“E”	Print-out of Ecko unlimited website
“F”	Print-out of IPO website CTC of Registration No. 4-2000-005203 CTC of Registration No. 4-2000-005204 CTC of Registration No. 4-2004-000880 CTC of Registration No. 4-2000-005205
“G”	CTC of Records of IPC No. 14-2003-0053
“H”	CTC of Declaration of Actual Use
“I”	Affidavit of MARC Ivan Ong
“J”	CTC of Registration No. 4-2007-004653

Respondent-applicant filed her Answer on 18 August 2008 denying the material allegations of the opposition and raised the following special and affirmative defenses, namely:

- “1. Most of the exhibits submitted by the Opposer in support of its notice of Opposition do not comply with Section 7.1 of Office Order No. 79, Series of 2005 and therefore, pursuant to Section 12.1 of the same Office Order, they should not be admitted as evidence, namely:
- a) Exhibit “A”, “A-1” to “A-5”; “H”, “H-1” and “H-2”, Annexes A,B,C,D, D-1, to D-8, E, E-1, and E-2, F, G, to G-3, OF Exhibit “I” are neither originals nor certified true copies, but are mere Xerox copies;
  - b) Exhibit “E” is a mere computer print out without any signature to authenticate/identify it;
  - c) Exhibit “B” and “D” are not notarized;
  - d) Exhibit “G” and the copies attached thereto were taken from Inter Case No. 14-2003-00053 to which Respondent-Applicant was not a party.

In addition, there is no showing that the originals and/or certified copies of the documents attached to Exhibit “G” were duly submitted in IPC No. 14-2003-00053.

By entering into a settlement agreement with Ramon Ong with assignment of his application for the registration of the mark ECHO, oppose impliedly accepted the right of Ramon Ong to use and register the mark in the Philippines.

2. Section 7.1 Office Order No. 79 requires that the opposition, together with the affidavits of witnesses and originals of the documents and other

requirements, shall be filed with the Bureau of Legal Affairs, provided, that in case of public documents, certified copies shall be allowed in lieu of originals. Since Officer Order No. 79 does not how copies of public documents should be certified, then Section 5 of Rule 130 of the Rules of Court which provides as follows, shall apply:

xxx

In cases where the original of the documents are kept abroad, then Section 24 and 25 of Rule 132 of the Rules of Court shall apply. Said sections of Rule 132 of the Rules of Court provide:

xxx

When documents are in unofficial languages, Section 33 of RULE 132 OF THE Rules of Court requires that such documents must be accompanied by English or Filipino translations in order to be admissible.

3. Respondent-applicant's mark "ECKOMART perfect buy every time at low prices" is neither identical nor confusingly similar to any of Opposer's trademark.

4. Opposer claims that its marks are internationally well-known and in the Philippines. Unfortunately, Opposer failed to submit substantial and admissible evidence to show that indeed, its marks are intentionally well-known and in the Philippines.

- a) None of Opposer's marks are among the marks considered internationally well-known in the Memorandum issued by then Minister Luis R. Villafuerte of the Ministry of Trade and Industry on November 20, 1980;
- b) Opposer failed to submit duly authenticated and certified copies of its registration certificates for its marks issued in other countries;
- c) Opposer also failed to submit originals and/or certified copies of its sales invoices to show commercial use of its marks in any country, including the Philippines.
- d) Opposer even failed to submit substantial evidence to show that it has advertised and promoted its marks worldwide and in the Philippines.
- e) In fine, aside from its gratuitous and unsubstantiated claim, Opposer failed to present substantial and admissible evidence to show that its mark is well-known as provided by Rule 102 of the implementing Rules and Regulations for Trademarks, etc.

5. In approving Application Serial NO. 4-2007-001068, THE Bureau of Trademark did not see any violation of any provision of the IP Code, including Section 123.1 (d), (e), (f), (g); 138, 147.1, 147.2 and 168.1 thereof.

6. The approval of subject application will not likely cause mistake, confusion and/or deception upon the consuming public and will not damage nor prejudice the Opposer.

In support of its defense, the respondent-applicant submitted the following evidence, to wit:

EXHIBIT	DESCRIPTION
"1"	Copy of trademark application form
"2"	Copy of Examiner's action and responses by respondent-applicant
"3"	Copy of Recommendation for allowance
"4"	Copy of Notice of Allowance
"5"	Copy of Declaration of Actual Use
"6", "7", "8"	Copies of DTI Registration, BIR Registration, Mayors Permit and Barangay Clearance
"9"	Affidavit of Rosanne Co

The preliminary conference was scheduled on 23 September 2008 but since no amicable settlement was obtained, the parties were required to submit their position papers. The issues are whether respondent-applicant's mark is confusingly similar to the opposer's registered mark and whether "ECKOMART perfect buy everytime at low prices" can be allowed registration. Corollary is whether opposer's marks are well-known.

The marks of the parties are reproduced below for comparison:

Respondent-applicant's mark

Opposer's mark



**ECKO UNLTD.**

At the outset, we shall resolve respondent-applicant's assertion that the exhibits submitted do not comply with Section 7.1 of Office Order No. 79, Series of 2005. Exhibit "A", the verified Notice of Opposition is notarized and authenticated. Concededly, Exhibits "A" submarkings are mere photocopies. However, Exhibit "B" is likewise notarized and authenticated and "C" is a notarized document. Exhibit "E" is a computer print-out from the internet and Exhibit "F" is a computer print-out from the internet and Exhibit "F" is a computer print-out from the IPO website which we shall take cognizance of under the Rules on Electronic Evidence. The annexes of Exhibit "G" are mere photocopies. EXHIBIT "G" was certified by the Office as records of Inter Partes Case No. 14-2003-00053 which Bureau shall take cognizance of.

Turning to the main issues, the law provides that a mark cannot be registered if it is identical to a registered mark or if it resembles a mark with an earlier filing date or priority date so as to cause confusion and deception. The law provides:

"Section 123.1 of Republic Act No. 8293, otherwise known as The Intellectual Property Code of the Philippines, provides:



“Section 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 early resembles such a mark as to be likely to deceive or cause confusion;”

Respondent-applicant contends that in approving Application Serial No. 4-2007-001068, the Bureau of Trademarks did not see any violation of any provision of the IP Code as to the registrability of the mark “ECKOMART Perfect buy every time at low low prices”. This argument deserves scant consideration.

The Supreme Court in *Ong Ai Gui v. Director of Patents* (GG.R. No. L-6253. March 28, 1955) clarified that:

“It is the decision of the Director, given after this hearing, or opportunity to very interested party to be heard, that finally terminates the proceedings ad in which the registration is finally approved or disapproved. Thereafter, notice of the issuance of the certificate of registration is published. xxx  
It is evident that the decision of the Director after the first step, ordering publication, can not have any finality. Of what use is the second step in the proceedings, if the Director is bound by his first decision, giving course to the publication? His first decision is merely provisional, in the sense that the application appears to be meritorious and is entitled to be given course leading to the more formal and important second step of hearing and trial, where the public and interested parties are allowed to take part.”

Evidence show that opposer’s registered mark which is for class 35 is in block style consisting of two words, “ECKO” and “UNLTD” (Exhibit “J”). Notably, opposer has three registered marks in Philippines. These are Certificate of Registration No. 4-2007-004653 for the trademark ECKO UNLTD dated July 30, 2007 for goods under Class 35 namely retail store services with a filing date of May 9, 2007. (Exhibit “J”); Certificate of Registration No. 4-2000-005203 for the trademark ECKO UNLTD DATED October 24, 2005, FOR GOODS UNDER Class 25 namely: “men’s sports bags and non-leather travel accessory bags, sweatbands, men’s clothing, namely: jersey, jump suits, uniforms, sport pants, knit shirts, t-shirts, polo shirts, tank tops, slacks, jeans, shorts, underwear, nightwear, coats, jackets, parkas, overcoats, pullovers, headwear of all types, namely hast, sports caps and visors, women’s baseball hats, visors and bucket style hats.” (Exhibit “F-1”); and Certificate of Registration No. 4-2000-005204 for the trademark MARK ECKO dated October 24, 2005 for goods under class 25 namely: clothing, namely jerseys, sweatbands, jump suits, uniforms, sport pants, knit shirts, shirts, polo shirts, tank tops, blouses, slacks, jeans, shorts, underwear, stockings, nightwear, leotards, leggings, coats, jackets, parkas, overcoats, pullovers, sweatshirts, and sweater, footwear and headwear of all types, namely hast, sports caps and visors. (Exhibit “F-2”). And Certificate of Registration No. 4-200-005205 for the mark ECKORED dated October 24, 2005 for goods under class 25 namely: jerseys, sweatbands, jump suits, uniforms, sport pants, knit shirts, shirts, polo shirts, tank tops, blouses, slacks, jeans, shorts, underwear, stockings, nightwear, leotards, leggings, coats, jackets, parkas, overcoats, pullovers, sweatshirts, and sweater; footwear; and headwear of all types, namely hast, sports caps and visors, women’s baseball hats, visors and bucket style hats. (Exhibit “F-4”).

Certificate of Registration No. 4-2004-000880 for MARC ECKO dated October 31, 2005 for goods under class 3 is subject for removal from register for non-filing of DAU (Exhibit “F-3”)

In summary, opposer’s registered marks in the Philippines are ECKO UNLTD. For classes 35 and 25, MARK ECKO for goods under class 25 and ECKORED for goods under class

25. Two of its mark consists of two words and one is a coined word. On the other hand, respondent-applicant's "ECKO MART perfect buy every time at low low prices" is a coined word with a slogan and is applied for class 35, namely: "retailer, wholesaler for dry goods namely fashion accessories, clothing (RTW), kitchenwares, hardwares, make-up, toy, school supplies. Electrical and electronic products, hair accessories, gift items, shoes and slippers".

An assessment of the contending marks reveal that both include the word ECKO. Respondent-applicant coined a word ECKOMART and appended the slogan "perfect buy every time at low low prices". Respondent-applicant claimed the color red and yellow as background for her mark. The word ECKOMART is written in capital letters with style, the phrase "perfect buy every time at low prices" in small letters are written shows that the words "mart" and perfect buy every time at low, low prices" have been disclaimed.

The marks ECKO UNLTD and ECKOMART buy every time at low prices are not confusingly similar even if applied on the same class 35. The Supreme Court 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, 24. ) explained:

In determining the likelihood of confusion, the Court must consider: [a] the resemblances the trademarks; [b] the similarity of the goods to which the trademarks are attached; [c] the likely effect on the purchaser and [d] the registrant's express or implied consent and other fair and equitable considerations.

The Dominancy Test focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception xxx

The Holistic Test requires that the entirety of the marks in question be considered in resolving confusing similarity. Comparison of words is not the only determining factor. The trademarks in their entirety as they appear in their respective labels or hang tags must also be considered in relation to the goods to which they are attached. The discerning eye of the observer must focus not only on the predominant words but also on the other features appearing in both labels in order that he may draw hid conclusion whether one is confusingly similar to the other."

There are glaring differences in the way the marks are presented. Respondent-applicant's mark in addition to the word MART has eight (8) more words which although disclaimed still form part of the ECKO word. There is also a claim of color and the presentations of the letters are in stylized form. Although some components it have its own unique commercial impression in order to make the mark distinct and to prevent deception. In *Ong Al Gui v. Director of Patents* [G.R. No. L-6235. March 28, 1955.] the Supreme Court held:

" . . . Other use the same or similar descriptive word in connection with their own wares, provided they take proper steps to prevent the public being deceived." . . . (Richmond Remedies Co. vs. Dr. Miles Medical Co., 16 E. (2d) 598.)

" . . . A combination of marks or words may constitute a valid trademark or (in the case of words) a tradename even though some of the constituent portions thereof would not be subject, separately, to exclusive appropriation as such. Thus, although a word may be descriptive and not subject to exclusive use of a trademark, it may properly \become the subject of a trademark by combination with another word or term which is nondescriptive, although no exclusive right to the descriptive word or term is created". . . (52 Am. Jur. 553.)

Applying the test of dominancy, to the instant case, the word ECKO does not necessarily point to the opposer as the source or sponsor of goods or services. In Philip Morris, Inc. Benson & Hedges (Canada), Inc., and Fabriques ded Tablac Reunies, S.A. v. Fortune Tobacco Corporation, GR NAO. 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 urged 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, nor can the public be deceived."

Anent the issue of ECKO mark of the opposer as being well-known, the law provides a criteria for its determination. The law states:

"SEC 123. Registrability

123.1. A mark cannot be registered if it: xxx

"(e) 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 for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark.

"(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 are likely to be damaged by such use;

Rule 102 of the Rules and Regulations on Trademarks contain the criteria to be taken into account in determining whether a mark is well-known. These are the following:

- a. The duration, extent and geographical area of use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the 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 of the acquired mark;
- e. The extent to which the mark has been used in the world;
- f. The exclusivity of the use attained by the mark in world;
- g. The commercial value attributed to the in the world;
- h. The record of successful protection of the right in the mark;
- i. The outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- j. The presence or absence of identical or similar goods or services owned by persons other than the person claiming that his mark is a well known mark.

The evidence presented is insufficient to show that opposer's marks have attained the reputation and goodwill in the Philippines or abroad. Photocopies of registrations, pictures of items, tags, etc. attached to the certified true copies of documents attached to Inter partes case no. 14-2003-00053 (Exhibit "G") not its registrations here (Exhibit "F") are insufficient to show the well-known status of opposer's ECKO marks.

WHEREFORE, premises considered the OPPOSITION filed by Yakira L.L.C. is as it is hereby, DENIED. Accordingly, Application Serial No. 4-2007-001068 for registration of the mark "ECKOMART perfect buy every time at low prices" covering goods under Class 35, namely "retailer, wholesaler for dry goods namely fashion accessories, clothing (RTW), kitchenwares, hardwares, make-up, toy, school supplies, electrical and electronic products, hair accessories, gift items, shoes and slippers", filed by Rosanne Co is, as it is, hereby given DUE COURSE.

Let the filewrapper of the ECKOMART perfect buy every time at low prices", 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. 27, February 2009.

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