



ESPRIT INTERNATIONAL,
Opposer,

-versus-

LEILA T. CRISTOBAL,
Respondent-Applicant.

IPC No. 14-2012-00005
Opposition to:
Appln. Serial No. 4-2011-009972
Date Filed: 19 Aug. 2011
Trademark: "EUROSTEP"

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NOTICE OF DECISION

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LEILA T. CRISTOBAL
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GREETINGS:

Please be informed that Decision No. 2012 - 171 dated September 12, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 12, 2012.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs

/CERTIFIED TRUE COPY

MARILYN F. RETUTAL



ESPRIT INTERNATIONAL,
Opposer,

IPC No. 14-2012-00005

-versus-

LEILA T. CRISTOBAL,
Respondent.

Opposition to:
Appln. No. : 4-2011-009972
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TM : "EUROSTEP"

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Decision No. 2012-171

DECISION

ESPRIT INTERNATIONAL, ("Opposer")¹, on 15 August 2011, filed an opposition to Trademark Application Serial No. 4-2011-009972. The application filed by LEILA T. CRISTOBAL, ("Respondent-Applicant")², which covers the mark "EUROSTEP (stylized) for goods under Classes 3, 18 and 25 of the International Classification of Goods.³

The Opposer alleges among other things, that it is the prior user and first registrant of the ESPRIT trademark in the Philippines. According to the Opposer the Respondent's EUROSTEP mark is confusingly similar, if not identical, to Opposer's ESPRIT trademarks, particularly as the former likewise utilizes Opposer's triple-bar "E" device, and thus runs contrary to the provisions of the IP Code.

The Opposer's evidence consists of the following:

1. Exhibit "A" - Original Verified Notice of Opposition;
2. Exhibit "B" - Copy of the Certificate and Special Power of Attorney dated 05 March 2012 executed by Michael Ching Chow Man, confirming his authority and authority of Opposer's counsel to verify the Notice of Opposition and execute the certificate of non-forum shopping as well as the authority of Opposer's counsel to represent Opposer;
3. Exhibit "C – Series" - Attachments to the Verified Notice of Oppositions;
4. Exhibit "D" - Affidavit of Angela Pia B. Alvendia dated 05 March 2012;

¹ A corporation organized and existing under the laws of the United States of America, with address at 1370 Broadway, New York, New York 10018, United States of America.

² With address at 15 Alliance Street, Village East, Cainta Rizal.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

5. Exhibit "E – Series" - Representative sample of various trademark registrations secured in the name of Opposer for ESPRIT and derivative marks.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 27 March 2012. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant's trademark application be allowed and/or is the Respondent-Applicant's mark confusingly similar with the Opposer's mark?

It is emphasized that the essence of trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; to secure to him who has been instrumental in bringing into the market a superior article of merchandise; the fruit of his industry and skill; to assure to the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his products.⁴

Thus Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or it nearly resembles such, mark as to be likely or cause confusion.

Jurisprudence says that a practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of the prospective buyer. The trademark complained should be compared and contrasted with purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some factors such as sound; color; idea connoted by the mark; the meaning; spelling and pronunciation of the words used; and the setting in which the words appear may be considered for indeed, trademark infringement is a form of unfair competition.⁵

The competing marks are reproduced for comparison and scrutiny:

ESPRIT

Opposer's Mark

EUROstep

Respondent-Applicant's Mark

Comparison of the marks reveals that no confusing similarity exists. They are entirely distinct and different from each other both in terms of composition, spelling and pronunciation as well as in appearance. The Opposer's mark consists of two (2) syllables of

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 115508, 19 November 1999.

⁵ Clarke v. Manila Candy Co., Phil. 100, Co Tiong S.A. v. Director of Patents, 95 Phil., 1, 4.

six (6) letters, while the Respondent-Applicant's mark consists of four (4) syllables with eight (8) letters. The only similarity between the competing marks is the first letter "E" which is not considered to be a dominant feature of either of the two competing marks. The difference in the remaining letters and syllables of the competing marks makes a fine distinction between them such that confusion or deception is unlikely to occur. There is a remote possibility for a consumer to assume or conclude that there is a connection between the parties solely because both marks start with the stylized letter "E" of the alphabet. As a matter of fact, there are some registered marks bearing the same stylized "E" such as the following below:



Further, trademark search on the IPO Website, reveals that the EUROstep mark subject of the instant opposition was previously registered with the Intellectual Property Office of the Philippines on 15 September 2008 in the name of the herein Respondent-Applicant, for goods falling under Classes 3, 18 and 25 of the International Classification of Goods. The present trademark application subject of the instant opposition is a re-registration of the mark EUROstep previously registered as above-mentioned which was cancelled for failure to file the Declaration of Actual Use as required by law. However, the use of the mark has not been abandoned and still continuously being in used by the Respondent-Applicant.

In conclusion, therefore, this Bureau finds that the Respondent-Applicant's trademark application is not proscribed by Sec. 123.1 (d) of R.A. No 8293, also known as the Intellectual Property Code of the Philippines ("IP Code").

WHEREFORE, premises considered, the opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-009972 be returned, together with a copy of this DECISION, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 12 September 2012.


ATTY. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs

/Joanne/