



HOWARD FUCHI C. LU,

-versus-

DIMENSION 10, INC.,
Respondent-Applicant.

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}
} IPC No. 14-2012-00106
} Opposition to:
} Appln. Serial No. 4-2011-006063
} Date filed: 26 May 2011
} TM: "THE COLOURS
} COLLECTION BY: EMY"

NOTICE OF DECISION

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Ortigas Center, Pasig City

GREETINGS:

Please be informed that Decision No. 2013 - 37 dated February 19, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 19, 2013.

For the Director:

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



HOWARD FUCHI C. LU,
Opposer,

IPC No. 14-2012-00106
Case Filed: 02 March 2012

-versus-

Opposition to:
Appln. Serial No. : 4-2011-006063
Date Filed: 26 May 2011

DIMENSION 10, INC.,
Respondent-Applicant.

TM: "THE COLOURS
COLLECTION BY: EMY"

x-----x

Decision No. 2013- 37

DECISION

HOWARD FUCHI C. LU ("Opposer")¹ filed on 02 March 2012 a Verified Opposition to Trademark Application Serial No. 4-2011-006063. The application, filed by DIMENSION 10, INC., ("Respondent-Applicant")², covers the mark "THE COLOURS COLLECTION BY EMY" for use on "textiles and textile goods, clothing, namely: gowns, cocktail dress, corporate dress, party dress, swim wear, advertising and education and training purposes" under Classes 24, 25, 35 and 41 of the International Classification of Goods and Services³.

The Opposer alleges among other things that the approval of the application in question is contrary to Sections 123.1 (d) and 147 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). According to the Opposer, the approval of the application in question will violate his right to the exclusive use of his registered trademark "COLOURS" and variants thereof and cause him irreparable damage and injury. To support his opposition, the Opposer submitted the following:

1. Exhibit "A" – Certified copy of Certificate of Registration No. 045840 for the trademark "COLOURS" for use on belts; handkerchiefs; shoes, sandals, slippers, boots, jeans, pants, t-shirts, shirts, briefs, shorts, socks, jogging pants, sweatshirts and issued on July 26, 1989 in favor of Opposer's predecessor-in-interest, renewed last July 26, 2009, and assigned to Opposer;
2. Exhibit "B" – Certified copy of Certificate of Registration No. 4-1990-070641 for the trademark "COLOURS" for use on suits, coats, overcoats, topcoats, jackets, neckties, vests, handbags, overnight bags, travel bags and school bags and issued on August 28, 2004 in favor of Opposer's predecessor-in-interest and assigned to Opposer;

¹ Filipino citizen, with postal and business address at 1620 Zamora Street, Paco, Manila.

² With address at # 80 E. Rodriguez Jr. Avenue, (C5) Bagumbayan, Libis, Quezon City, Metro Manila.

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.

3. Exhibit "C" – Certified copy of Certificate of Registration No. 4-1995-104450 for the trademark "**COLOURS & DEVICE**" for use on shoes, sandals, slippers, boots, jeans, pants, t-shirts, shirts, briefs, shorts, socks, jogging suits, sweatshirts and issued on May 07, 2005 in favor of Opposer's predecessor-in-interest and assigned to Opposer;
4. Exhibit "D" – Certified copy of Certificate of Registration No. 4-1998-08301 for the trademark "**COLOURS AND EAGLE DEVICE**" for use on t-shirts, polo shirts, pants, jeans, slacks, polo jackets, sweatshirts, briefs, sandos, belts, socks, blouses, skirts, shorts, panties, bras, caps, swim suits, swimming trunks, vests, suspender, jogging suits, shoes, slippers, boots, in favor of Opposer's predecessor-in-interest and assigned to Opposer;
5. Exhibit "E" – Certified copy of Certificate of Registration No. 4-1999-003097 for the trademark "**COLOURS**" for use on disposable diapers, typewriter, typewriter ribbons, stationery pads, photographs albums, ballpens, pencils, markers, sign pens, cutter, cashbox, clearbook, expanding file, folders, scissors, binders, clips, stick on post-it-note, glue stick, glue, stapler, tape dispenser, puncher, stamp pad, stamp pad ink refill, packaging tape, stationery tape, paper clips, thumbtacks, push pins, staple wire, notebook, correction tape, correction fluid, eraser, envelopes, boards, copier paper, thermal paper, bond paper and pads, time cards, envelopes, diskettes, cash register tapes, add machine tapes, fasteners, rubberbands, specialty papers, bookpaper, multi-purpose paper, newsprint, mimeo paper, staple wire remover, correction pen, carbon paper, laser paper, index cards, water color saucers and issued on October 14, 2006 in favor of Opposer's predecessor-in-interest and assigned to Opposer;
6. Exhibit "F" – Certified copy of Certificate of Registration No. 4-1999-007804 for the trademark "**FASHION COLOURS**" for use on shoes, slippers, sandals, boots, t-shirts, polo shirts, polo, pants, jeans, slacks, jackets, sweatshirts, shorts, skirts, sandos, briefs, panties, socks, stockings, belts, caps, suspender, swim suits, swimming trunks, jogging suits, coats, vests and issued on May 12, 2005 in favor of Opposer's predecessor-in-interest and assigned to Opposer;
7. Exhibit "G" – Certified copy of Application SN 4-2009-007529 for the trademark "**COLOURS**" for use on soaps, perfumes, essential oils, astringents, dentifrices, deodorants, cologne, skin whitening, toothpastes, body lotions; herb teas, asthmatic tea, absorbent cotton, camphor oil, confectionery (medicated), contraceptives, food for babies, germicides, liniments, medicinal oils, medicinal roots, medicinal herbs, menthol, medicated candies, capsules for medicines, disinfectants (hygienic purposes), drugs for medical purposes, eyewash, fly paper, fungicides, hygienic bandages, petroleum jelly, milk sugar (lactose), panty liners, ointment (pharmaceutical purposes), insect repellants, sanitary napkins, sanitary pads, sanitary panties, sanitary towels, serums, suppositories,

adhesive tapes for medical purposes, tranquilizers and approved for issuance of Certificate of registration on March 16, 2011 and assigned to Opposer last January 31, 2012 (Note: a certified copy of Certificate of Registration No. 4-2009-007529 will be submitted upon release thereof);

8. Exhibit "H" to "H-10" – Certified copies of the Declaration of Actual use filed following the 5th, 10th and 15th anniversaries of Opposer's various existing registrations;
9. Exhibit "I" to "I-2" – Photographs of the stores where Opposer's products using his registered mark "**COLOURS**" and variants thereof are displayed and sold;
10. Exhibit "J" – Print-out of Respondent-Applicant's mark "**THE COLOURS COLLECTION BY : EMY**" as published in the e-Gazette; and
11. Exhibit "K" – Duly notarized affidavit of Opposer Howard Fuchi C. Lu.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 27 March 2012. However, the Respondent-Applicant did not file its Verified Answer. Hence, the instant opposition is considered submitted for Decision based on the opposition and evidence submitted by the Opposer.

Should the Respondent-Applicant's trademark application be allowed?

It is emphasized that the essence of trademark registration is to give protection to the owner of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; 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 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 products⁴.

In this regard, Section 123.1 (d) of R.A. 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 closely related goods or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its' trademark application on 26 May 2011, the Opposer already has existing trademark registrations for the mark COLOURS bearing Reg. No. 045840 issued on 26 July 1989 for goods under Classes 18, 24 and 25 of the International Classification of Goods. The goods covered by the said registrations are similar and/or closely related to the goods and services indicated by the Respondent-Applicant in its trademark application. It is also obvious from the composition of the

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 November 1999.

Respondent-Applicant's mark that the use thereof in advertising, education and training relate to the promotion of the goods.

The competing marks are reproduced for comparison and scrutiny:

COLOURS

THE
COLOURS
COLLECTION
by Emy

Opposer's Mark

Respondent-Applicant's Mark

The competing marks are practically identical. The feature or part of the mark applied for registration by the Respondent-Applicant which immediately draws the eyes and ears is the word COLOURS. The prominence of this word renders inconsequential the difference with respect to the other features of the Respondent-Applicant's mark more specifically the terms and/or phrases "THE", "COLLECTION" and "by EMY" which are written in a very small font scattered around the word COLOURS written in big letters and considered the dominant features of the competing marks. The conclusion created by the use of the same word as the primary element in a trademark is not counteracted by the addition of another term⁵.

In this regard, confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenious imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other⁶.

Thus, because the Respondent-Applicant will use or uses its' mark on goods and services that are similar and/or closely related to those covered by the Opposer's registered trademark, the likelihood of the occurrence of mistake, confusion, or even deception cannot be avoided. Consumers will likely assume that the Respondent-Applicant's mark is just a variation of the Opposer's and/or the goods and services originate or provided by one party alone, or the parties are connected or associated with one another.

WHEREFORE, premises considered the instant opposition is hereby **SUSTAINED**. Let the filer wrapper of Trademark Application Serial No. 4-2011-006063 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 19 February 2013.


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

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⁵ Ref: Continental Connector Corp., v. Continental Specialties Corp. 207 USPQ 60.

⁶ Societe Des Produits Nestle, S.A. v. Court of Appeals G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.