



HOWARD FUCHI C. LU,
Opposer,

-versus-

HOO LIAN HENG,
Respondent- Applicant.

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}
} IPC No. 14-2012-00519
} Opposition to:
} Application No. 4-2012-500769
} Date filed: 27 March 2012
} TM: "COLORIS"
}
}
}
}

NOTICE OF DECISION

SIOSON SIOSON & ASSOCIATES
Counsel for Opposer
Unit 903 AIC-BURGUNDY EMPIRE TOWER
ADB Avenue corner Garnet & Sapphire Roads
Ortigas Center, Pasig City

HOOI LIAN HENG
Respondent-Applicant
No. 6 Jalan Orkid Desa
Desa Tun Razak Cheras
Kuala Lumpur 56000
Malaysia

GREETINGS:

Please be informed that Decision No. 2013 - 185 dated October 07, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 07, 2013.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



HOWARD FUCHI C. LU,
Opposer,

-versus-

HOO LIAN HENG,
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X ----- X

IPC No. 14-2012-00519

Opposition to Trademark
Application No. 4-2012-500769
Date Filed: 27 March 2012

Trademark: **COLORIS**

Decision No. 2013- 185

DECISION

Howard Fuchi C. Lu¹ (Opposer) filed on 14 November 2012 an opposition to Trademark Application Serial No. 4-2012-500769. The contested application, filed by Hoo Lian Heng² (Respondent-Applicant), covers the mark "COLORIS" for use on *"export and import agencies, marketing and sales promotional services in shops and or through worldwide communication networks, the bringing together, for the benefit of others, of a variety of goods namely, all types of footwears, bags, belts, handbags, wallets, costume jewellery, clothing and headgear, enabling customers to conveniently view and purchase those goods in a retail outlet or by means of telecommunications or from the internet; franchising consultancy services, namely, offering technical assistance in the establishment and or operation of store; organization of exhibitions and trade fairs for commercial or advertising purposes; demonstration of goods"* under Classes 35 of the International Classification of Goods³.

The facts as alleged by the Opposer are as follows:

"1. Opposer is the registered owner of the trademark 'COLOURS' and variants thereof for the use on various goods under the following registrations, namely:

1.1 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, falling under Classes 18, 24, and 25, and issued on July 26, 1989 and renewed last July 26, 2009.

A certified copy of Certificate of Registration No. 045840 is hereto attached as Exhibit 'A' and made an integral part thereof.

1.2 Registration No. 4-1990-070641 for the trademark 'COLOURS' for use on suits, coats, overcoats, topcoats, jackets, neckties, vests, handbags,

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

² With address at No. 6, Jalan Orkid Desa, Desa Tun Razak Cheras, Kuala Lumpur 56000, Malaysia..

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.

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center, 28 Upper McKinley Road, McKinley Hill Town Center
Fort Bonifacio, Taguig City 1634 Philippines

T: +632-2386300 • F: +632-5539480 • www.ipophil.gov.ph

overnight bags, travel bags and school bags falling under Classes 18 and 25, and issued on August 28, 2004.

A certified copy of Certificate of Registration No. 4-1990-070641 is hereto attached as Exhibit 'B' and made an integral part thereof.

1.3 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 falling under Class 25 and issued on May 7, 2005.

A certified copy of Certificate of Registration No. 4-1995-104450 is hereto attached as Exhibit 'C' and made an integral part thereof.

1.4 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, swimming trunks, vests, suspender, jogging suits, shoes, slippers, boots, sandals falling under Class 25 and issued on February 10, 2003.

A certified copy of Certificate of Registration No. 4-1998-08301 is hereto attached as Exhibit "D" and made an integral part thereof.

1.5 Registration No. 4-1999-003097 for the trademark 'COLOURS' for use on disposable diapers, typewriter, typewriter ribbons, stationery pads, photograph 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 falling Class 16 and issued on October 14, 2006.

A certified copy of Certificate of Registration No. 4-1999-003097 is hereto attached as Exhibit 'E' and made an integral part thereof.

1.6 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 falling under Class 25 and issued on May 12, 2005.

A certified copy of Certificate of Registration No. 4-1999-007804 is hereto attached as Exhibit 'F' and made an integral part thereof.

1.7 Registration No. 4-2009-007529 for the trademark 'COLOURS' for use on soaps, perfumes, essential oils, astringents, dentrifices, deodorants, cologne, skin whitening, toothpastes, body lotions; herb teas, asthmatic tea,

absorbent cotton, camphor oil, confectionery (medicated), contraceptives, food for babies, germicides, liniments, medicinal alcohol, 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 repellents, sanitary napkins, sanitary pads, sanitary panties, sanitary towels, serums, suppositories, adhesive tapes for medical purposes, tranquilizers falling under Classes 3 and 5, and issued on March 16, 2011.

A certified copy of Certificate of Registration No. 4-2009-007529 is hereto attached as Exhibit "G" and made an integral part thereof.

2. Opposer and his predecessor-in-interest have continued the use and have not abandoned the trademark 'COLOURS' and variants thereof. Registrations No. 045840, No. 4-1990-070641, No. 4-1995-104450, No. 4-1998-08301, No. 4-1999-003097, No. 4-1999-007804, and No. 4-2009-007529 (Exhibits 'A' to 'G') continue to be in full force and effect.

Certified copies of the Declaration of Actual Use filed following the 5th, 10th and 15th anniversaries of opposer's various existing registrations are marked as Exhibits 'H' to 'H-12' and made integral parts hereof.

3. Likewise marked as Exhibits 'I' to 'I-2' are photographs of the stores where opposer's products using his registered mark 'COLOURS' and variants thereof are displayed and being sold, which are made integral parts hereof.

4. The approval of respondent's Application SN 4-2012-500769 is contrary to Section 123.1 (d), 138 and 147 of the IP Code.

A printout of Application Serial No. 4-2012-500769 as published in the e-Gazette is marked as Exhibit 'J' and made an integral part hereof.

5. The trademark 'COLORIS' being applied for registration by respondent, is identical and/or confusingly similar to opposer's registered trademark 'COLOURS' and variants thereof.

6. The approval of respondent's application is violative of the right of opposer to the exclusive use of his registered trademark 'COLOURS' and variants thereof, as provided by Sections 138 and 147 of the IP Code.

The approval of respondent's application will cause irreparable damage and injury to opposer and the consuming public as the latter will likely think and assume that respondent is an affiliate and/or business associate authorized by opposer to file the instant application.

7. Through the nationwide and continuous use by opposer and his predecessor-in-interest since January 1, 1982, the trademark 'COLOURS' and variants thereof have acquired goodwill and valuable business reputation which respondent must be fully aware of. Opposer has not given respondent the right and/or authority to register his identical mark 'COLORIS'.

8. Respondent having acted fraudulently and in bad faith in filing the instant application to take advantage of opposer's goodwill and business reputation as registered owner and prior user of the trademark 'COLOURS' and variants thereof, respondent is not entitles to have its instant application approved."

In support of its contentions, the Opposer submitted the following as evidence:

1. certified copy of Certificate of Registration No. 045840;
2. certified copy of Certificate of Registration No, 4-1990-070641;
3. certified copy of Certificate of Registration No. 4-1995-104450;
4. certified copy of Certificate of Registration No. 4-1998-08301;
5. certified copy of Certificate if Registration No. 4-1999-003097;
6. certified copy of Certificate of Registration No. 4-1999-007804;
7. certified copy of Certificate of Registration No. 4-2009-007529;
8. certified copies of the Declaration of Actual Use filed following the 5th, 10th and 15th anniversaries of Opposer's various existing registrations;
9. photographs of the stores where Opposer's products using his registered mark 'COLOURS' and variants thereof are displayed and being sold;
10. print-out of Respondent-Applicant's mark 'COLORIS' as published in the e-Gazette; and,
11. duly notarized affidavit of Opposer Howard Fuchi C. Lu.

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 22 January 2013. However, the Respondent-Applicant failed to comply prompting the Hearing Officer to issue on 19 July 2013 Order No. 2013-1011 declaring it in default and directing the Opposer to submit or present within ten days from the receipt of the Order, the original and/or certified copy of the affidavits and other documents or evidence attached to the Opposition. On 06 August 2013, the Opposer presented to the Hearing Officer the originals and/or certified copies of the documents and evidence supporting the Opposition. Thereafter, the case was deemed submitted for decision.

Ultimately, the issue to be resolved is whether Application No. 4-2012-500769 should be allowed registration.

In this regard, Section 123.1 (d) of the IP Code provides that:

"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 to deceive or cause confusion; xxx"

Records reveal that at the time Respondent-Applicant filed an application for registration of its mark "COLORIS" on 27 March 2012, the Opposer has valid registrations of the mark "COLOURS" and its variants for as early as 26 July 1989 and the same are existing until the present. Unquestionably, the Opposer is the prior registrant.

Now to determine if there is likelihood of confusion, the marks of the parties are reproduced herein for comparison:

Opposer's marks:

COLOURS

COLOURS

COLOURS

FASHION COLOURS



Colours



Respondent-Applicant's mark:

COLORIS

The mark applied for registration by Respondent-Applicant is almost or practically identical to Opposer's registered marks. The slight difference in the spelling does not diminish the likelihood of confusion, even deception. 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 ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchased as to cause him to purchase the one supposing it to be the other.⁴

The next question that arises is whether the goods and/or services covered by the competing marks are closely related. Opposer's certificates of registration pertains to goods under Classes 03, 05, 16, 18, 24 and 25 while the services of Respondent-Applicant fall under Class 35. However, even if the goods and/or services of the parties differ in classification, it does not automatically obliterate the likelihood of confusion. Although the mark "COLORIS" covers export and import agencies, marketing and sales promotional services in shops and/or through worldwide communication networks, franchising consultancy services and organization of exhibitions and trade fairs, the fact remains that these agencies deal with products which are covered by Opposer's certificates. As stated in Respondent-Applicant's application, the coverage of its mark includes "the bringing together, for the benefit of others, of a variety of goods namely, all type of footwears, bags, belts, handbags, wallets, costume jewellery, clothing and headgear". These aforementioned products are among the goods protected under the Opposer's registrations.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether such mark will likely cause confusion or deception on the buying public. Moreover settled is that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. Callman notes two types of confusion. The first is the *confusion of goods* "in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other." In which case, "defendant's goods are then bought as the plaintiff's, and the poorer quality of the former reflects adversely on the plaintiff's reputation." The other is the *confusion of business*: "Here though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff, and the public would then be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."⁵

⁴ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁵ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 1772276, 08 August 2010.

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of 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 product.

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-500769 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 07 October 2013.



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