



JESUS ONG TIU,
Opposer,

-versus-

NEW LOOK LIMITED,
Respondent – Applicant.

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}
} IPC No. 14-2012-00087
} Opposition to:
} Appln. Serial No. 4-2010-500550
} Date filed: 23 April 2010
} TM: "STYLIZED YES YES
} (VERTICAL)"
}

NOTICE OF DECISION

SIOSON SIOSON & ASSOCIATES

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

NEW LOOK LIMITED

Respondent-Applicant
New Look House, Mercery Road
Weymouth, Corset DT3 5HJ
United Kingdom N/A

GREETINGS:

Please be informed that Decision No. 2014 - 29 dated February 06, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 06, 2014.

For the Director:


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



JESUS ONG TIU,

Opposer,

-versus-

NEW LOOK LIMITED,

Respondent-Applicant.

X ----- X

IPC No. 14-2012-00087

Opposition to Trademark

Application No. 4-2010-500550

Date Filed: 23 April 2010

Trademark: "**STYLIZED YES YES (VERTICAL)**"

Decision No. 2014- 29

DECISION

Jesus Ong Tiu.¹ ("Opposer") filed on 23 March 2012 an opposition to Trademark Application Serial No. 4-2010-5000550. The contested application, filed by New Look Limited² (Respondent-Applicant), covers the mark "STYLIZED YES YES (VERTICAL)" for use on "*Headgear for wear; jackets (clothing); jackets (stuff-)(clothing); shirt fonts, shirt yokes, shirts, skirts, suits, trouser straps, trousers; underwear and leggings*" under Class 25 of the International Classification of Goods³.

The Opposer alleges that trademark "YES" is duly registered in its favor under Registration Nos. 4-1995-100766 and 4-2007-002748 for use on goods falling under Classes 25 and 3, respectively. It likewise asserts that "YES Label" is copyrighted in its favor under Certificate of Copyright Registration No. O-95-685 issued on 13 July 1995. It also claims adoption and use of the trademarks "YES" and "YES Label" since 03 January 1994 on t-shirts, jeans, slacks, shorts, polo shirts, skirts, jackets, pants, briefs, pants, sweatshirts, blouses, swimsuits, shoes, sandals and boots. Furthermore, the Opposer avers that on 16 March 2007, it extended the use of its mark on personal and skin care products.

Thus, the Opposer argues that the mark "STYLIZED YES YES (VERTICAL)" is confusingly similar to its "YES" mark. The registration of the mark "STYLIZED YES YES (VERTICAL)" in favor of Respondent-Applicant will violate of Section 123.1 (d) of

¹ With business and office address at DII Building, Km. 21, 150 San Vicente Road, Brgy. San Vicente, San Pedro, Laguna, Philippines.

² With address at New Look House, Mercery Road, Weymouth, Dorset DT3 5HJ.

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 Act No. 8293, also known as the Intellectual Property Code ("IP Code"), and cause it great and irreparable injury.

To support its Opposition, the Opposer submitted the following as evidence:

1. certified copy of the Certificate of Registration No. 4-1995-100766⁴;
2. certified copy of Certificate of Registration No. 4-2007-002784⁵;
3. certified copy of the Certificate of Copyright Registration No. O-095-685⁶;
4. certified copy of the Declaration of Actual Use (DAU) filed on 3 December 2001, including the annexes, in connection with Application Serial No. 100766⁷;
5. certified copies of representative sales invoices showing the present use of the trademark "YES"⁸;
6. photographs of Opposer's actual sample products⁹;
7. certified copy of the DAU filed on 15 March 2010, including the annexes, in connection with Application Serial No. 4-2007-002748¹⁰;
8. printout of the e-Gazette showing the publication of Respondent-Applicant's Application Serial No. 4-2010-500550¹¹; and,
9. affidavit of Jesus Ong Tiu¹².

This Bureau issued and served a Notice to Answer upon the Respondent-Applicant on 02 April 2012. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued on 30 July 2013 Order No. 2013-1071 declaring the Respondent-Applicant in default and submitting the case for decision.

Should the mark "STYLIZED YES YES (VERTICAL)" be registered in favor of Respondent-Applicant?

Section 123.1 (d) of the IP Code provides that:

"123.1. A mark cannot be registered if it:

⁴ Marked as Exhibit "A".

⁵ Marked as Exhibit "B".

⁶ Marked as Exhibit "C".

⁷ Marked as Exhibits "D" to "D-7".

⁸ Marked as Exhibits "E" to "E-11".

⁹ Marked as Exhibits "F" to "F-2".

¹⁰ Marked as Exhibits "G" to "G-2".

¹¹ Marked as Exhibit "H".

¹² Marked as Exhibit "I".

(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;*

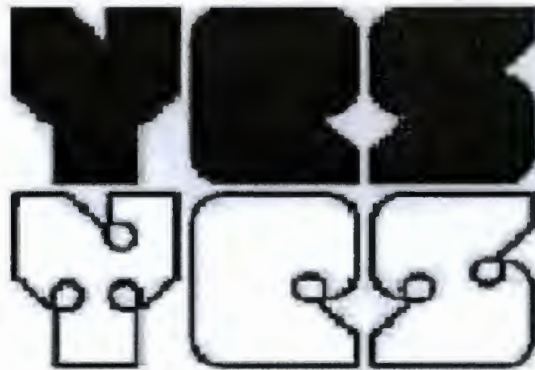
xxx."

The records reveal that at the time Respondent-Applicant filed for an application of registration of its mark "STYLIZED YES YES (VERTICAL)" on 23 April 2010, Opposer has already an existing and valid registration of its trademark "YES" under Registration Nos. 4-1995-100766 issued on 18 March 2006.

Now, to determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the two are shown below for comparison:

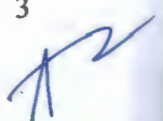


Opposer's Mark



Respondent-Applicant's Mark

When one looks at Respondent-Applicant's mark, what is impressed upon the eyes and mind is the word "yes". The word "yes" turns out to be the Opposer's registered mark. The duplication of the word "yes" and its bold design in Respondent-Applicant's mark are not sufficient to eradicate the possibility of confusion to the purchasing public. 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.¹³ The Supreme Court in **Del Monte Corporation vs. Court of Appeals**¹⁴ held:

"The question is not whether the two articles are distinguishable by their label when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods is the touchstone."

Succinctly, since the Respondent-Applicant will use or uses the mark "STYLIZED YES YES (VERTICAL)" to goods that are similar and/or closely related to that of Opposer's registered mark "YES", the minor dissimilarities will not diminish the likelihood of the occurrence of confusion, mistake and/or deception. Noteworthy, both marks cover apparel under Class 25. Thus, it is highly probable that the purchasers will be led to believe that Respondent-Applicant's mark is a mere variation of Opposer's mark. Withal, the protection of trademarks as intellectual property is intended not only to preserve the goodwill and reputation of the business established on the goods bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods.¹⁵

Moreover, it is settled 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."¹⁶

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

¹³ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

¹⁴ G.R. No. L-78325, 25 January 1990.

¹⁵ Skechers, USA, Inc. vs. Inter Pacific Industrial Trading Corp., G.R. No. 164321, 23 March 2011.

¹⁶ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.


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.¹⁷ Based on the above discussion, Respondent-Applicant's trademark fell short in meeting this function. The latter was given ample opportunity to defend its trademark application but Respondent-Applicant did not bother to do so.

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. 4-2010-500550 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 06 February 2014.



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

¹⁷ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.