



NAU S.R.L.,

Opposer,

-versus-

ANTONIO B. DEUS,

Respondent-Applicant.

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IPC No. 14-2012-00203

Opposition to:

Appln. No. 4-2011-010382

Date filed: 01 September 2011

Trademark: "NAU STYLIZED"

NOTICE OF DECISION

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ANTONIO B. DEUS

Respondent-Applicant

1025 MRR PNR Barangka Itaas

Mandaluyong City

GREETINGS:

Please be informed that Decision No. 2013 – 94 dated May 28, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 30 May 2013.

For the Director:

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

CERTIFIED TRUE COPY
Sharon S. Alcantara
SHARON S. ALCANTARA
Records Officer II
Bureau of Legal Affairs, IPO



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TM: "NAU STYLIZED"

Decision No. 2013- 94

DECISION

NAU S.R.L. ("Opposer")¹ filed on 21 June 2012 an opposition to Trademark Application Serial No. 4-2011-010382. The application, filed by ANTONIO B. DEUS ("Respondent-Applicant")², covers the mark "NAU STYLIZED" for use on "*jeans, pants, slacks, shorts, t-shirts, polo, polo shirts, blouses, dresses, skirts, sweaters, sweatshirts, jackets, jogging pants, sandos, blazers, wind breakers, overalls, briefs, panties, supporters, socks, stockings, leggings, hats, caps, visor, gloves, ties, belts of clothing, suspenders, wrist bands, head bands, swim suits, swimming trunks, shoes, sandals, slippers and boots*" under Class 25 of the International Classification of Goods and Services³. The Opposer alleges, among other things the following:

1. The registration of the NAU STYLIZED trademark is contrary to the provisions of Sections 123.1, pars. (d) to (f) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), as amended, which prohibit the registration of a mark that:

"(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;

"(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

¹ A company organized under the laws of Italy, having principal place of business at Via S.E.P. Mazzauehelli, 7 21043 Castiglione Olona (Va), Italy.

² With address at 1025 MRR PNR Barangka Itaas, Mandaluyong City.

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.

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: *Provided further*, That the interests of the owner of the registered mark are likely to be damaged by such use.”

2. Respondent’s NAU STYLIZED trademark is identical and/or confusingly similar to the Opposer’s trademark application NAU in terms of appearance, spelling, pronunciation and design as to be likely to deceive or cause confusion. In particular, both marks consist of the term “nau” in stylized and lower case font, and an exclamation point partly underneath the letter “u”.

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

1. Exh. “A” – original notarized and legalized Verified Notice of Opposition;
2. Exh. “B” – original notarized and legalized Affidavit of Fabrizio Brogi;
3. Exh. “B-1” – details of trademark registrations for various NAU marks worldwide;
4. Exh. “B-2” – representative certified copies of trademark application and registration certificates in various countries around the world such as Canada, Hong Kong, Iraq, Israel, Italy, Kuwait, Lebanon, Pakistan, Qatar, Saudi Arabia, Republic of South Africa, Argentina, Republic of Colombia, Mexico, Taiwan, Tunisia, Turkish Republic of North Cyprus, United Arab Emirates, Brazil, Chile and International Registration with the WIPO under the Madrid Agreement and Protocol;
5. Exh. “B-3” – various promotional materials used to enhance the popularity of the NAU trademark;
6. Exh. “C” – computer printouts of the trademark details of the NAU trademarks registered in the Philippines;
7. Exh. “D” – original notarized Affidavit of Marlon S. Gayamo; and
8. Exh. “E” and “E-1” – original notarized and legalized Special Power of Attorney and Officer’s Certificate signed by Fabrizio Brogi, legal representatives of the Opposer, showing his authority to sign the Verification and Certification against Forum Shopping and the authority of the counsel on record to represent the Opposer in this case.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 23 November 2012. However, no answer was filed by the Respondent-Applicant. Hence, the instant opposition is considered submitted for decision based on the evidence and the opposition submitted by the Opposer.

Should the Respondent-Applicant 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.

The records show that at the time the Respondent-Applicant filed his trademark application on 01 September 2011, the Opposer has already an existing trademark applications in the Philippines for the marks NAU & LOGO for goods under class 9 (Serial No. 4-2011-500928) and VERDE NAU for goods or services under classes 9 and 35 (Serial No. 4-2011-500936), which were filed on 30 June 2011 and 01 July 2011, respectively. The Opposer has also applied and registered its mark NAU & LOGO in various countries around the world and International Registration with the WIPO under the Madrid Agreement and Protocol⁵.

A scrutiny of the mark applied for registration by the Respondent-Applicant shows that the same is identical to the Opposer's, shown below:



"NAU" is also the defining component of the variation of the Opposer's mark - "VERDE NAU".

In this regard, the Opposer's marks are invented or coined marks, and therefore unique. The marks are considered as arbitrary marks and thus highly distinctive. Thus, while the Respondent-Applicant's trademark application covers goods under Class 25 and the NAU & LOGO mark on the other hand is used on goods under Class 9, the likelihood of confusion, or even deception, persists. Also, VERDE NAU is used for retail services of, among other things, "clothing" and "headgear".

Because the Opposer's mark is unique and highly distinctive, just by looking at the Respondent-Applicant's goods bearing the NAU mark would likely create an impression that these are owned by the Opposer. The consumers may assume that the Respondent-Applicant's goods originate from or sponsored by the Opposer or believe that there is a connection

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114509, 19 November 1999.

⁵ Opposer's Exhibit "B-2".

between them, as in a trademark licensing agreement. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:⁶

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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

In this regard, the Opposer's mark is highly distinctive and is so unique that it is incredible or highly improbable that the Respondent-Applicant came up with a mark that is identical to the Opposer's by pure chance or coincidence. Succinctly, there is nothing in the records that explains how the Respondent-Applicant arrived at using the same mark, appropriating in minutest details the features of the Opposer's mark NAU, including the font and stylized double punctuation marks.

The field from which a person may select a trademark is practically unlimited. As in all other cases of colourable imitation, the unanswered riddle is why, of the millions of terms and combination of letters and designs available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁷ The Respondent-Applicant is even likely to get "free advertisement".

Accordingly, this Bureau finds 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 fielwrapper of Trademark Application Serial No. 4-2011-010382 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 28 May 2013.


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

⁶ See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

⁷ *American Wire & Cable Company v. Dir. of Potents*, G.R. No. L-26557, 18 Feb, 1970.