



NELSON CHAN,
Opposer,

-versus-

KYLIE S. UY,
Respondent-Applicant.

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IPC No. 14-2011-00334
Opposition to:
Appln. Serial No. 4-2010-011027
Date filed: 07 October 2010
TM: "GALS & GUYS"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 12 dated January 24, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 24, 2013.

For the Director:

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



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Decision No. 2013- 12

DECISION

NELSON CHAN, ("Opposer")¹ filed on 5 August 2011 an opposition to Trademark Application Serial No. 4-2010-011027. The application, filed by KYLIE S. UY ("Respondent-Applicant")², covers the mark "**GALS & GUYS**" for use on "*footwear, namely, plastic and rubber sandals, shoes and high-heeled shoes and slippers*" under Class 24 of the International Classification of goods.³

The Opposer alleges, among other things, that the approval of the application in question is contrary to Sections 123.1 (d) and 138 of Rep Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). According to the Opposer, as the registered owner of the trademarks "GAL'S" and "GAL'S & POCKET DEVICE", the approval of the application in question will violate its right to the exclusive use of his registered trademarks and cause great irreparable damage and injury to him. The Opposer's evidence consists of the following:

1. Exh. "A": certified copy of Cert. of Reg. No. 54193 issued on 01 Feb. 1993 for the mark GALS for use on "*jeans, polo, pants, shirts, jackets, shorts, jogging suits, socks*" falling under Class 25;
2. Exh. "B": certified copy of Cert. of Reg. No. 4-1999-92881 issued on 15 Aug. 2003 for the trademark "GALS & POCKET DEVICE" for use on "*jeans, polo, pants, shirts, jackets, shorts, jogging suits, socks*" falling under Class 25;
3. Exhs. "C", "D" and "E": certified copies of the Affidavits of Use/ Declaration of Actual Use submitted on 14 Jan. 1999; 11 Nov. 2003; and 22 Sept. 2008 in connection with Reg. No. 541931;
4. Exhs. "F" and "G": certified copies of the Declarations of Actual Use submitted on 29 Nov. 2001; and 13 Aug. 2009, in connection with Reg. No. 4-1994-92887;

1 Filipino, of legal age, with postal address at 1318 Francho corner Moriones Streets, Tondo, Manila

2 With address at 220 San Nicolas Street, Binondo, 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 cancelled in 1957.

5. Exhs. "H" to "H-9": certified copies of representative delivery receipts showing continued commercial use of the registered trademarks GALS & POCKET DEVICE;
6. Exhs. "I" to "I-2": photographs of the Opposer's products bearing the registered marks GALS and GALS & POCKET DEVICE;
7. Exh. "J": print out of the Respondent-Applicant's mark "GALS & GUYS" as published in the e-Gazette; and
8. Exh. "K": duly notarized affidavit of Nelson Chan.

On 08 September 2011, the Respondent-Applicant filed a "Comment (To the Verified Notice of Opposition)", which this Bureau treated as the said party's Answer to the opposition. On 16 September 2011, the Opposer filed a Manifestation stating among other things that the Respondent-Applicant should be declared in default for not verifying her answer. On 04 October 2011, this Bureau issued Order No. 2011-1437 declaring the Respondent-Applicant in default. The Respondent-Applicant, however, filed on 26 October 2011 a Motion for Reconsideration of Order No. 2011-1437 attaching therewith a copy of the Counter-Manifestation and Answer.

In this regard, the filing of a motion for reconsideration is no longer allowed under the amended Inter Partes Proceedings⁴. Moreover, this Bureau would have accepted and admitted the "Counter-Manifestation and Answer" which was verified, if the same have been filed within the 30-day reglementary period. Since the Respondent-Applicant was served a copy of the Notice to Answer on 16 September 2011, she had until 16 October 2011 to file the Answer.

Nevertheless, while the Respondent-Applicant may have been declared in default does not necessarily mean that the opposition is automatically sustained. This Bureau will still delve on the issue whether or not the mark applied for registration by the Respondent-Applicant is confusingly similar to the registered mark of the Opposer.

Thus, the question: should the Respondent-Applicant be allowed to register the mark GALS & GUYS?

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; to protect the manufacturer against and sale of inferior and different articles as his products.⁵ Thus, Sec. 123.1 (d) of the 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

4 Section 11. *Prohibited pleadings*. - No motion to dismiss shall be entertained. Instead, all grounds for dismissal shall be pleaded as affirmative defenses, the resolution of which shall be made in the decision on the merits. Neither shall a motion for bill of particulars, motion for reconsideration of interlocutory orders, and all other pleadings subsequent to the filing of an Answer, shall be allowed.

5 *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999, citing *Etepha v. Director of Patents*, 16 SCRA 485.

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 mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed her trademark application on 07 October 2010, the Opposer has existing registration for the marks "GALS" (Reg. No. 54193 issued on 01 February 1993) and "GALS & POCKET DEVICE" (Reg. No. 4-1999-92881 issued on 15 Aug. 2003), both covering "*jeans, polo, pants, shirts, jackets, shorts, jogging suits, socks*" under Class 25. Clothing, including socks are closely related to footwear, including those indicated in the Respondent-Applicant's trademark application.

But, is the mark applied for registration by the Respondent-Applicant, as shown below, sufficiently resembles the Opposer's such that confusion or deception is likely to occur?



The determinative factor in a contest involving trademark registration is not whether the use of such mark would likely cause confusion or mistake on the part of the buying public. In short, to constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it⁶.

In this regard, the Respondent-Applicant's mark is a composite mark. An obviously conspicuous feature of the mark is the word "GALS". "GALS", however, is the same word mark already covered by an earlier registration in favor of the Opposer (Reg. No. 54193). The word is also the defining component of a composite mark which is also registered under the name of the Opposer (Reg. No. 4-1999-92881).

Succinctly, because the Respondent-Applicant will use or uses the mark "GALS & GUYS" on goods that are closely related to those covered by the Opposer's registered trademarks, there is the likelihood of mistake, confusion, or even deception among the consumers. The public may assume that the Opposer has expanded or ventured into footwear with the mark "GALS &

⁶ *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

GUYS” being just a variation of said party’s already registered marks. Thus, information, assessment, perception or impression about the Respondent-Applicant’s goods bearing the mark “GALS & GUYS” may unfairly be cast upon or attributed to the Opposer, and *vice-versa*. 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:⁷

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.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application No. 4-2010-011027 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 24 January 2013.


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

⁷ *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.