



NEW BARBIZON FASHION, INC.,
Opposer,

-versus-

YUP IN SHI,
Respondent-Applicant.

X-----X

}
} IPC No. 14-2011-00278
} Opposition to:
} Appln. Serial No. 4-2010-010249
} Date filed: 20 September 2010
} TM: "MONALIZA"

NOTICE OF DECISION

SAPALO VELEZ BUNDANG & BULILAN
Counsel for Opposer
11th Floor, Security Bank Centre
6776 Ayala Avenue, Makati City

YUP IN SHI
Respondent-Applicant
c/o NELSON TAN
P.O Box 2329 Manila Central Post Office (MCPO)

GREETINGS:

Please be informed that Decision No. 2012 - 100 dated June 19, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 19, 2012.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer, BLA

CERTIFIED TRUE COPY

MARILYN F. RETUTAL

IPRS IV, Bureau of Legal Affairs, IPPHL



NEW BARBIZON FASHION, INC.,	}	IPC No. 14-2011-00278
Opposer,	}	Opposition to:
	}	
	}	
- versus -	}	Appln. Ser. No. 4-2010-010249
	}	Date Filed: 20 September 2010
	}	
YUP IN SHI,	}	
Respondent-Applicant.	}	Trademark: MONALIZA
x-----x	x	Decision No. 2012 - <u>100</u>

DECISION

NEW BARBIZON FASHION, INC. ("Opposer")¹ filed on 12 September 2011 an opposition to Trademark Application Serial No. 4-2010-010249. The application, filed by YUP IN SHI ("Respondent-Applicant")², covers the mark MONALIZA for use on "*cosmetic products, namely, eye shadow, lotion, shampoo, perfume*" under Class 3 of the International Classification of Goods and Services.³

The Opposer alleges, among other things, the following:

- "1. Opposer is the first to adopt, use, apply for, and register the mark MONALIZA in the Philippines under Registration Nos. 35291 and 43864 issued on 13 February 1986 and 19 April 1989; and
- "2. Respondent-Applicant's mark MONALIZA is confusingly similar to Opposer's mark.

The Opposer's evidence consists of the following:

1. Annex "A" - Certified copy of the Identification card of IRISH HAZEL G. MANAOIS;
2. Annexes "B" and "C" - Print-out details of the Opposer's trademark registrations;
3. Annexes "D" and "E" series - Copies of the Deed of Assignment over Registration Nos. 35291 and 43864 both dated 9 March 1999;
4. Annexes "F" and "G" - Certified true copies of the Opposer's Articles of Incorporation and company profile, respectively;

1 A corporation duly organized and existing under and by virtue of the laws of the Philippines with business address at 401 VFP-MDC Bldg. 2 Veterans Road, Veterans Center, Taguig City.

2 With address on record at 490 Jaboneros St., San Nicolas, Manila.

3 The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This 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.

5. Annex "H" - Print-out details of Opposer's Registration No. 4-2010-500102 from the IPO trademark database;
6. Annex "I" series - Actual labels of Opposer's MONALIZA trademark;
7. Annex "J" - Certified true copy of the list of stores where the MONALIZA products are sold;
8. Annexes "K" series and "L" series - Certified true copies of the company's sample delivery receipts and sales order slip and detailed sales report;
9. Annex "M" series - Copies of the promotional and advertising materials including photographs; and
10. Annex "N" series - Print-outs of Opposer's website, www.monalisa.com.ph.

Should Respondent-Applicant's trademark application be allowed?

The records show that the Opposer has registered its mark MONALIZA with the Intellectual Property Philippines bearing Reg. No. 035291, date registered 13 February 1986 covering the goods lingerie's, bra, brassieres, panties, girdles, nightgowns, half slips pajama sets under Class 25 of the International Classification of Goods and Services.⁴ It was likewise registered on 19 April 1989 under Registration No. 043864 covering the goods infants wear, tie-side, t-shirt, sweater's and short, ladies and children's dresses under Class 25 of the International Classification of Goods and Services.⁵

The Respondent-Applicant's mark MONALIZA, Trademark Application No. 4-2010-010249 filed on 20 September 2010 is being used on cosmetic products, namely eye shadow, lotion, shampoo, perfume under Class 3 of the International Classification of Goods and Services.

This Bureau noticed that the competing marks when pronounced, are exactly the same or identical. However, the goods or products covered by each mark are different from each other. The Opposer's mark is under Class 25 and the Respondent-Applicant's mark is being used on goods under Class 3.

In one case, the Supreme Court ruled that:

"The Trademark "CANON" as used by Petitioner for its paints, chemical products toner and dyestuff,⁶ can be used by private respondent for its sandals⁷ because the products of these two parties are dissimilar".⁸

In *Faberge, Incorporated v. Intermediate Appellate Court*, 215 SCRA 326 (1992)

4 Annex "B".

5 Annex "C".

6 Under Class 2.

7 Class 25.

8 *Canon Kabushiki Kaisha versus Court of Appeals and NSR Rubber Corporation*, G.R. No. 120900 promulgated July 20, 2000.

the Supreme Court sustained the Director of Patents which allowed the junior user to use the Trademark of the senior user on the ground that the briefs manufactured by the junior user, the product for which the Trademark "BRUTE" was sought to be registered, was unrelated and non-competing with the products of the senior user consisting of after shave lotion, shaving cream, deodorant, talcum powder, and toilet soap.

In other case, the Supreme Court ruled that:

"The Petroleum Products on which the petitioner therein uses the Trademark ESSO, and the product of Respondent, Cigarettes are so foreign to each other as to make it unlikely that purchasers would think that petitioner is the manufacturer of Respondent's goods.⁹


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.¹⁰

Accordingly, this Bureau concludes that the competing marks are not confusingly similar; hence the Respondent-Applicant's trademark application is not proscribed by Sec. 123.1 (d) of R.A. 8293, also known as the Intellectual Property Code of the Philippines.

WHEREFORE, premises considered, the instant opposition is hereby **DENIED**. Let the filewrapper of Trademark Application Serial No. 4-2010-010249, together with a copy of this **DECISION**, be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 19 June 2012.


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

⁹ ESSO Standard Eastern, Inc. versus Court of Appeals, 116 SCRA 336.

¹⁰ Pribhdas J. Mirpuri versus Court of Appeals, G.R. No. 114508, 19 November 1999, Citing Etepha versus Director of Patents 16 SCRA 495.