



SUYEN CORPORATION,  
Opposer,

-versus-

DICK SY ONG (doing business under the name  
Of SKINTEC ENTERPRISES),  
Respondent –Applicant.

x-----x

IPC No. 14-2012-00402  
Opposition to:  
Appln. Serial No. 4-2012-001201  
Date Filed: 01 February 2012  
TM: "HAIR CLAY FX"

### NOTICE OF DECISION

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#### GREETINGS:

Please be informed that Decision No. 2014 - 59 dated February 25, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 25, 2014.

For the Director:

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



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<i>Opposer,</i>	}	Opposition to:
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DICK SY ONG (doing business under the name	}	
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<i>Respondent-Applicant.</i>	}	
x-----x		Decision No. 2014- <u>59</u>

### DECISION

SUYEN CORPORATION ("Opposer")<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2012-001201. The application, filed by DICK SY ONG (doing business under the name of SKINTEC ENTERPRISES ("Respondent-Applicant"))<sup>2</sup>, covers the mark "HAIR CLAY FX" for use on "hair clay for men" under Class 3 of the International Classification of Goods and Services<sup>3</sup>.

The Opposer alleges that it will be damaged by the registration of HAIR CLAY FX in favor of the Respondent-Applicant. According to the Opposer, HAIR CLAY FX is identical to and confusingly similar to its duly registered marks and will mislead the public into believing that the products bearing the said mark are the same products marketed and sold by Opposer or that the goods originated from the same source.

To support its opposition, Opposer submitted in evidence the following:

1. Exhibit "A" – Secretary's Certificate;
2. Exhibit "B" – affidavit direct testimony of Kristine Anne C. Lim;
3. Exhibit "C" – certified true copy of Reg. No. 4-2000-002133 for the mark FIX;
4. Exhibit "D" – certified true copy of Reg. No. 4-2001-004439 for the mark FIX BENCH SALON;
5. Exhibit "E" – certified true copy of Reg. No. 4-2002-008629 for the mark I-FIX & DEVICE of LETTER I;
6. Exhibit "F" – certified true copy of Reg. No. 4-2002-008636 for the mark BENCH/FIX PROFESSIONAL;
7. Exhibit "G" – certified true copy of Reg. No. 4-2010-001719 for the mark CLAY DOH;

<sup>1</sup> A domestic corporation with office at 2214 Tolentino Street, Pasay City.

<sup>2</sup> Filipino with business address at No. 1530 Chicago Street, Industrial Subdivision, Iba Road, Pantoc, Meycauayan, Bulacan.

<sup>3</sup> 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.



8. Exhibit "H" – certified true copy of Reg. No. 4-2010-013772 for the mark CLAY DOH LITE;
9. Exhibit "I" – list of Suyen's products bearing the FIX Trademark and CLAY DOH trademarks, attached to Kristine Anne C. Lim's affidavit;
10. Exhibit "J" with sub-markings" – photographs of Suyen's products;
11. Exhibit "K" with sub-markings of the Lim Affidavit" – these refers to FIX Salons nationwide;
12. Exhibit "L" with sub-markings" – promotional campaigns using TM FIX and CLAY DOH;
13. Exhibits "M", "N", "O" and "O-1" – advertising campaign and substantial amount spent for advertising its FIX products including CLAY DOH products;
14. Exhibit "P" – advertisement in local news paper and popular lifestyle magazines for the products bearing FIX and CLAY DOH;
15. Exhibits "L", "L-1" to "L-12", "O", "O-1", "P-1", "P-3", "P-5", "P-6", "P-16", "P-29" and "P-31" – advertising media such as cable and television commercials and engaged the services of costly celebrity endorsers; and
16. Exhibit "Q" – Suyen website, [www.bench.com.ph/bench-fx-salon](http://www.bench.com.ph/bench-fx-salon) and social networking sites such as facebook and twitter.

The Respondent-Applicant filed his answer on 15 January 2013 admitting some of the allegations of the Opposition while denying all the material allegations thereof. The Respondent-Applicant argues that HAIR CLAY FIX is not confusingly similar with the Opposer's trademarks.

In support of his trademark application, Respondent-Applicant submitted in evidence the following:

1. Exhibit "1" – affidavit direct testimony of DICK SY ONG;
2. Exhibit "2" – copy of the trademark application form consisting of two pages contained therein that the Respondent-Applicant disclaimed the exclusive right to use "HAIR CLAY FX";
3. Exhibits "3" to "8" – sample of promotional materials; and
4. Exhibit "9 series" – tv commercial and advertisement campaigns in media hub youtube.com and in facebook and twitter.

Should the Respondent-Applicant's 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 products.<sup>4</sup>

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<sup>4</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999

Thus, Sec. 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("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 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 a mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed his trademark application on 01 February 2012, the Opposer already has existing registrations issued by the Intellectual Property Office of the Philippines, as follows:

1. Reg. No. 4-2000-002133, issued on 01 July 2014, for the mark FIX for use on "hair lotion, hair gel, hair crème, hair polish, hair shampoo, hair conditioner" under Class 3;
2. Reg. No. 4-2001-004439, issued on 02 July 2004, for the mark FIX BENCH SALON for use on "hairstyle, makeup, grooming and other related services" under Class 44;
3. Reg. No. 4-2002-008636, issued on 18 September 2006, for the mark I-FIX & DEVICE of LETTER I for use on "hair refresher, hair gel, hair lotion, hair treatment, hair shampoo and hair conditioner" under Class 3;
4. Reg. No. 4-2002-008629, issued on 16 July 2006, for the mark BENCH FIX PROFESSIONAL for use on "hair refresher, hair gel, hair lotion, hair treatment, hair shampoo and hair conditioner" under Class 3;
5. Reg. No. 4-2010-001717, issued on 02 June 2010, for the mark CLAY DOH for use on "hair refresher, hair gel, hair lotion, hair treatment, hair shampoo and hair conditioner" under Class 3; and
6. Reg. No. 4-2010-013772, issued on 07 July 2010, for the mark CLAY DOH LITE for use on "hair molding clay" under Class 3.

The question is: Is HAIR CLAY FX resembling the Opposer's marks such that confusion or even deception, is likely to occur?

Jurisprudence says that a practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of the prospective buyer. The trademark complained should be compared and contrasted with the purchaser's memory of the trademark said to be infringed. Some factors such as sound; appearance; form, style, shape, size or format; color, idea connoted by the mark; the meaning, spelling and pronunciation of the words used; and the setting in which the words used, may be considered for indeed, trademark infringement is a form of unfair competition<sup>5</sup>.

This Bureau finds that there is likelihood that HAIR CLAY FX could be confused, with the Opposer's marks, as shown below:

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<sup>5</sup> Clarke v. Manila Candy Co. 36 Phil 100, 106, Co Tiong SA v. Director of Patents as Phil. 1, 4.



Reg. No. 4-2000-002133

**HAIR CLAY FX**

*Respondent-Applicant's Mark*

Reg. No. 4-2001-004439

Reg. No. 4-2002-008629



*Opposer's Marks*

The distinctive feature of the mark applied for registration by the Respondent-Applicant are the letters "FX". In fact, the Respondent-Applicant disclaimed the words "HAIR" & "CLAY" for being generic or descriptive. The "FX", in the Respondent-Applicant's mark, even without the letter "I", looks like the Opposer's "FIX" mark. 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 purchaser as to cause him to purchase the one supposing it to be the other.<sup>6</sup>

Because Respondent-Applicant will use or uses the HAIR CLAY FX on goods that are similar and/or closely related to those covered by the Opposer's registered marks, consumers are likely to assume, that the Respondent-Applicant's mark is just a variation of or related to the Opposer's and/or the goods or services originated or provided by one party alone or the parties themselves are connected or associated with one another while in fact there is none. The

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<sup>6</sup> Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

likelihood of confusion would subsist not only on the purchaser's perception of the goods but on the origins thereof as held by the Supreme Court.<sup>7</sup>

The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why? Of the millions of terms and combination of letters are available, the Respondent-Applicant had come up with a mark identical or so closely similar to the Opposer's if it has no intention to take advantage of the goodwill generated by the other mark.<sup>8</sup>


It is stressed that the law on trademarks and tradenames is based on the principle of business integrity and common justice. This law, both in letter and spirit is laid upon the premise that, while it encourages fair trade in energy way and aims to foster, and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing others business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another<sup>9</sup>.

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

**WHEREFORE**, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-001201 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 25 February 2014.

  
**Atty. NATHANIEL S. AREVALO**  
*Director IV, Bureau of Legal Affairs*

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

<sup>8</sup> American Wire and Cable Co. v. Director of Patents, et.al. SCRA 544, G.R. No. L-26557, 18 Feb. 1970.

<sup>9</sup> La Chemise Lacoste v. Judge Oscar C. Fernandez, et.al. G.R. No. L-63796-97, 02 May 1984.