



SUYEN CORPORATION,
Opposer,

-versus-

FASHION ISLAND LIMITED,
Respondent-Applicant.

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} IPC No. 14-2012-00330
}
} Opposition to:
} Appln. Serial No. 4-2011-00061
} Date filed: 03 January 2012
} TM: "AM"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 168 dated August 14, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 14, 2013.

For the Director:


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



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FASHION ISLAND LIMITED,
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IPC NO. 14-2012-00330

Opposition to:

Appln. Ser. No. 4-2011-00061

Date Filed: 3 January 2012

Class: 25

Trademark: **AM**

Decision No. 2013 - 168

DECISION

SUYEN CORPORATION ("Opposer")¹, filed on 17 September 2012 a Verified Opposition to Trademark Application Serial No. 4-2012-000061. The application, filed by FASHION ISLAND LIMITED ("Respondent-Applicant")², covers the mark AM for use on "*bras, panties, briefs, girdles, swimwear, lingerie, shirts, t-shirts, sports shirt, muscle shirt, tank tops, sleeveless tops, pants, (jeans, cargo, jogging pants, slacks), dresses, skirts, shorts, blouses, tops and bottoms designed for exercise, shoes, sandals, slippers, caps, socks, shawls, stockings, sun visor, vests*" under Class 25 of the International Classification of goods³.

The Opposer anchors its opposition on the ground that it will be damaged by the registration of the mark covered by the Respondent-Applicant's application. The Opposer argues that the mark is identical to and confusingly similar with the Opposer's duly registered trademark and will mislead the public into believing that the products bearing the said mark originated from the opposer or are products marketed or sold by the Opposer.

The Opposer alleges the following:

"1. Suyen is the owner of one of the Philippine's leading brands-BENCH. Started in 1987, BENCH initially offered men's t-shirts.

¹ A domestic corporation organized and existing under the laws of the Philippines, with office address at 2214 Tolentino Sreet, Pasay City

² A foreign corporation, with address at Suite 100, 25 Upper brook Street London W1k 7QD United Kingdom

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

Since then Suyen has expanded its business to a complete range of apparel and lifestyle products such as fragrances, cosmetics, body care products, accessories, shoes, bags, watches, even snacks with the distinction of being present in virtually every retail space in the Philippines, and with a worldwide network of stores and outlets, reaching as far as the United States, Middle East and China;

"2. BENCH grew and continues to grow at an unparalleled rate by being the pioneer in the use of celebrity endorsers, television and giant billboards to propel a fashion brand that offers premium quality products at affordable prices.

"3. BENCH has made its mark to be one of the country's leading fashion retailer. Other popular and successful brands owned by Suyen include "HUMAN", "KASHIEKA", "FIX BENCH SALON", "DIMENSIONE", "PCX", and "BE CONNECTED".

"4. Having evolved into a lifestyle brand, BENCH offers a wide range of personal care products including a collection of body sprays, colognes and eau de toilettes (EDT). At present, SUYEN has more than two hundred (200) personal care products under BENCH.

"5. BENCH is now known not only as a clothing brand but a lifestyle brand as well.

"6. Suyen continues to expand its product lines to cater to the ever growing demands of the society. Thus, Suyen came up with another fragrance line called "AM" and "PM" collection. Suyen adopted the mark "AM" to represent a new collection of deodorant body spray under the BENCH principal trademark.

"7. On 23 September 2008, SUYEN applied with this Honorable Office for registration of its trademark "AM" under Class 3. This was granted by this Honorable Office and the "AM" trademark was registered in the name of Suyen as of 18 May 2009."

The Opposer's evidence consists of the Affidavit of Dale Gerald Dela Cruz, certified true copy of Certificate of Registration No. 4-2008-11613 dated 18 May 2009 for the mark AM for goods under Class 3 and a certified true copy of Declaration of Actual Use for the mark AM filed by the Opposer.⁴

This Bureau served upon the Respondent-Applicant a "Notice to

⁴ Marked as Exhibits "A" - "C"

Answer” on 5 October 2012. The Respondent-Applicant, however, did not file an Answer and was declared to have waived its right to file an Answer in Order No. 2013-358 dated 28 February 2013 issued by the Hearing Officer.

Should the Respondent-Applicant be allowed to register the mark AM?

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.⁵ 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.

The competing marks, as depicted below, are identical:



Opposer’s mark



Respondent-Applicant’s mark

In this regard, the records show that at the time the Respondent-Applicant filed its trademark application on 3 January 2012, the Opposer already has an existing registration for the trademark AM issued on 18 May 2009 for goods under Class 3 namely: “eau de cologne, perfume, body spray, eau de toilette”. Concededly, the goods are not in actual and direct competition.

The Supreme Court in *Mighty Corporation and La Campana Fabrica de Tabaco, Inc. v. E.J. Gallo Winery and Andresons Group, Inc.*⁶ held that in resolving whether goods are related, several factors come into play:

⁵ Pribhdas J. Mirpuri v. Court of Appeals, G. R. No. 114508, 19 November 1999.

⁶ G.R. No. 154342, 14 July 2004.

- (a) the business (and its location) to which the goods belong
- (b) the class of product to which the goods belong
- (c) the product's quality, quantity, or size, including the nature of the package, wrapper or container
- (d) the nature and cost of the articles
- (e) the descriptive properties, physical attributes or essential characteristics with reference to their form, composition, texture or quality
- (f) the purpose of the goods
- (g) whether the article is bought for immediate consumption, that is, day-to-day household items
- (h) the fields of manufacture
- (i) the conditions under which the article is usually purchased and
- (j) the channels of trade through which the goods flow, how they are distributed, marketed, displayed and sold.

The goods indicated in the Respondent-Applicant's trademark application may be considered related to those covered by the Opposer's trademark registration. These goods are sold in the same channels of trade. Nowadays, clothes, colognes and body spray are sold in one store of an owner. Moreover, Sec. 123.1 (d) of the IP Code also proscribes registration if the mark resembles an earlier registered mark as to be likely to deceive, or cause confusion. As explained by Opposer, BENCH is used as a lifestyle brand on clothing but have come up with its own fragrance line under the mark "AM" that includes a collection of colognes and deodorants under the principal BENCH trademark sold in the same BENCH stores. Hence, even if the parties' respective goods as appearing or indicated in the application and/or registration are not directly in actual competition, confusion or even deception is still likely to occur.


The ruling of the Supreme Court in *Sta. Ana v. Maliwat*⁷ is instructive, to wit:

Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trademark or tradename is likely to lead to a confusion of source, as where the prospective purchasers would be misled into thinking that the complaining party has extended his business into the field (see 148 ALR et seq. 52 Am Jur 576) or is it any way connected with the activities of the infringer; or when it forestalls the normal expansion of his business (v. 148 ALR, 77; 84 52 Am Jur 576, 577).

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-000061, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 14 August 2013.



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