



**ABS-CBN CORPORATION (formerly ABS- CBN }  
BROADCASTING CORPORATION, }  
Opposer, }**

**-versus-**

**ESTHER AGUSTIN, }  
Respondent-Applicant. }**

X-----X

**IPC No. 14-2012-00414  
Opposition to:  
Appln No. 4-2011-012380  
Date Filed: 14 October 2011  
TM: "BERKS (Stylized)"**

**NOTICE OF DECISION**

**POBLADOR BAUTISTA & REYES**  
Counsel for the Opposer  
5<sup>th</sup> Floor SEDCCO I Building  
120 Rada corner Legaspi Streets  
Legaspi Village, Makati City

**ESTHER AGUSTIN**  
Respondent-Applicant  
No. 10 St. Peter Street  
Remerville Subdivision  
Baesa, Quezon City

**GREETINGS:**

Please be informed that Decision No. 2014 - 221 dated September 09, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 09, 2014.

For the Director:

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



**ABS-CBN CORPORATION (formerly ABS-CBN BROADCASTING CORPORATION),**

Opposer,

-versus-

**ESTHER AGUSTIN,**

Respondent-Applicant.

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IPC No. 14-2012-00414

Opposition to Trademark  
Application No. 4-2011-012380  
Date Filed: 14 October 2011

Trademark: **BERKS (Stylized)**

Decision No. 2014- 221

### DECISION

ABS-CBN Corporation (formerly ABS-CBN Broadcasting Corporation)<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. No. 4-2011-012380. The contested application, filed by Esther Agustin<sup>2</sup> ("Respondent-Applicant"), covers the mark "BERKS (Stylized)" for use on *"all kinds of outer and underwear for women, teenagers, children (sic), infants, namely, shirts, blouses, skirts, suits, pants, trousers, jeans, vests, dresses, ties, coats, jackets, lingerie, panties, slips, camisoles, bras, girdles, briefers, briefs, sandos, robes, bathing suits (sic), socks, globes scarves; footwear, namely, boots, sandals, shoes, slippers, inner soles and soles; headwares, namely caps and hats"* under Class 25 of the International Classification of Goods<sup>3</sup>.

The Opposer claims to be the true owner of the mark "BERKS" for which it filed an application for registration on 22 November 2002. The application was eventually granted on 01 July 2005 and the Opposer was issued Certificate of Registration No. 4-2009-007193. It avers that "BERKS" is its weekly youth television program which aired every Saturday afternoon in nationwide coverage from November 2002 to March 2004. It asserts that as the popularity of the said program was complemented by the use of the "BERKS" trademark not only as a title thereof but also in merchandising goods and promotional materials used in mall tours and events held in and outside Metro Manila.

According to the Opposer, it has used and protected its "BERKS" mark during the show was aired on regular programming and in its runs in the The Filipino Channel ("TFC"). It maintains that even after the show stopped airing, it continuously protects the mark because of the goodwill acquired and associated thereto. It furthers that it has been meticulous in complying with the requirements

<sup>1</sup> A corporation duly organized and existing under the laws of the Philippines with business address at Sgt. E.A. Esguerra Ave. Cor. Mother Ignacia Street, Quezon City.

<sup>2</sup> With known address at #10 Peter Street, Remerville Subdivision, Baesa, Quezon City.

<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.

Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center, 28 Upper McKiñley Road, McKinley Hill Town Center  
Fort Bonifacio, Taguig City 1634 Philippines

T: +632-2386300 • F: +632-5539480 • www.ipophil.gov.ph

of continued protection as evidenced by its filing of the 5<sup>th</sup> year Declaration of Actual Use ("DAU") filed on 30 June 2011. Thus, the Opposer insists that Respondent-Applicant's mark should not be allowed for being identical to its own registered mark.

In support of its allegations, the Opposer presented the following:

1. copy of its Articles of Incorporation;
2. print-out of Respondent-Applicant's application from the website of this Office;
3. details of its registration as downloaded the website of this Office;
4. photograph showing the actors of the show wearing a merchandising shirt with the mark "BERKS"; and
5. copy of the 5<sup>th</sup> year DAU.<sup>4</sup>

A Notice to Answer was served to and received by the Respondent-Applicant on 19 February 2013. This Bureau granted first and second motion for extension to file her Answer and, thus, was given until 20 May 2013 to comply. The Respondent-Applicant, however, only filed her Answer on 13 June 2013. Thus, the Hearing officer issued on 18 June 2013 Order No. 2013-871 declaring the Respondent-Applicant in default and the case submitted for resolution.

Now, the issue to be resolved is whether the Respondent-Applicant's trademark "BERKS (Stylized)" should be allowed.

Section 123.1 paragraphs (d) and (e) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that:

**"123.1. A mark cannot be registered if it:**

**(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; x x x"**

Records reveal that at the time Respondent-Applicant filed its application on 14 October 2011, the Opposer has a valid and existing registration of its own

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<sup>4</sup> Exhibits "A" to "E".

"BERKS" mark under Certificate of Registration No. 4-2002-010042 issued on 01 July 2005.<sup>5</sup>

To determine whether the competing marks are confusingly similar, the two are reproduced hereafter for comparison:

**BERKS**

*Opposer's mark*



*Respondent-Applicant's mark*

When one looks at the Opposer's mark, what is impressed and retained in the eyes and mind is the word "berks". This term is the dominant feature of the mark that identifies the goods and/or service and the source thereof. Upon scrutiny of Respondent-Applicant's mark, the same conclusion may be withdrawn therefrom. There is no doubt that the two marks are identical in spelling and the same sounding when pronounced. That Respondent-Applicant's mark is stylized with claim of colors will not lend it the distinctiveness required by law to distinguish its goods from that of the Opposer's. In this regard, "BERKS" is a unique mark, and thus, highly distinctive. Thus, 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 purchased as to cause him to purchase the one supposing it to be the other.<sup>6</sup> As pronounced by the Supreme Court in the case of **Del Monte Corporation vs. Court of Appeals**<sup>7</sup>:

***"The question is not whether the two articles are distinguishable by their label when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods is the touchstone."***

Succinctly, the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. Callman notes two

<sup>5</sup> Exhibits "B" and "C" of the Opposer.

<sup>6</sup> Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

<sup>7</sup> G.R. No. L-78325, 25 January 1990.

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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."<sup>8</sup> As in this case where the marks are identical, it is likely that the purchasers of Respondent-Applicant's products will be confused, mistaken or be led to believe that these are in any way connected with the Opposer. At the very least, the buyers will be reminded of the television program "BERKS" of the Opposer.

Verily, when one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark, this not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill.<sup>9</sup> In the case of **American Wire & Cable Company vs. Director of Patents**<sup>10</sup>, it was held that:

***"Of course, as in all other cases of colorable imitations, the unanswered riddle is why, of the millions of terms and combinations of letters and designs available, the appellee had to choose those so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark."***

Finally, it is emphasized that 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.<sup>11</sup>

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

<sup>8</sup> Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 8 August 2010.

<sup>9</sup> McDonald's Corporation vs. MacJoy Fastfood Corporation, G.R. No. 166115, 02 February 2007.

<sup>10</sup> G.R. No. L-26557, 18 February 1970.

<sup>11</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-012380 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 09 September 2014.

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