



OFFICE OF THE DIRECTOR GENERAL

BEAUMANOIR ASIA HOLDING SINGAPORE PTE., LTD.,

Appeal No. 04-2011-0020

Applicant-Appellant,

Application No. 4-2009-001342
Date Filed: 09 February 2009

-versus-

DIRECTOR OF THE BUREAU OF TRADEMARKS

Trademark: "CACHE CACHE"

Respondent-Appellee.

X-----X

NOTICE

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Director, Bureau of Trademarks
Intellectual Property Office
Taguig City

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DATE: 09/11/14
BY: [Signature]

GREETINGS:

Please be informed that on 09 September 2014, the Office of the Director General issued a Decision in this case (copy attached).

Taguig City, 10 September 2014.

Very truly yours,

[Signature]

ROBERT NEREO B. SAMSON
Attorney V



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ATTORNEY V
Office of the Director General



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BEAUMANOIR ASIA HOLDING SINGAPORE PTE., LTD., Applicant-Appellant,

Appeal No. 04-2011-0020 Application No. 4-2009-001342 Date Filed: 09 February 2009

-versus-

Trademark: CACHE CACHE

DIRECTOR OF BUREAU OF TRADEMARKS, Respondent-Appellee.

X-----X

DECISION

BEAUMANOIR ASIA HOLDING SINGAPORE PTE., LTD. ("Appellant") appeals the decision¹ of the Director of Bureau of Trademarks ("Director") affirming the final rejection of the Appellant's application to register the mark "CACHE CACHE".

Records show that the Appellant filed on 09 February 2009 Trademark Application No. 4-2009-001342 for CACHE CACHE for use on goods² falling under

¹ DECISION dated 23 August 2011.

² Class 18 - leather and imitation of leather, goods made of these materials [leather and imitation leather] that are not included in other classes, namely: trunks, travel bags and travelling sets; toiletry (vanity) cases, boxes designed to carry toiletries such as vanity cases; trunks, overnight cases, bags, briefcases and portfolios, suitcases, card cases, wallets and purses (not made of precious materials), backpacks, handbags, umbrellas, parasols and canes; whips and saddlery. key cases (leather goods); portfolios; bags and briefcases; purses; suitcases; attache cases; school book bags; beach-bags; shopping bags; bags on wheels; garment carriers (for travel); duffel bags that are not specifically adapted to the items they are to carry; card case (wallet), purse. boxes made of leather or imitation leather, travel toiletry cases. leather or imitation leather lanyards; straps made of leather or imitation leather or leather board; animal collars made of leather or imitation leather; animal clothes; leashes; muzzle; animal hides. leather goods made of leather or imitation leather (except cases adapted to the items they are designed to carry, gloves and belts); umbrellas, purses of precious materials.

Class 25 - clothings, shoes (except orthopaedic), headgear, bath caps, bathing-trunks, swimsuits, smocks, swimming costumes; bath-robos, bathing sandals, bathing shoes, headbands (clothing), berets, bonnets, boots, suspenders, collar protector, underpants, boxer shorts, hoods, caps, dressing gowns, sweaters, hats, jumper, socks, slippers, sports shoes, shirts, short-sleeved shirt, undershirts, belts (clothing), tights, underwear, boiler suits (combination - clothing), combination (clothing), slips (underwear), suits, ear muffs, underpants, biker shorts, scarves, eiderdowns (duvet quilts), espadrilles, furs, gabardine, waistcoat, raincoats, cardigans, baby linens, singlets, skirts, petticoats, underwear, jerseys, muffs, coats, mittens, trousers, slippers, overcoats, parkas, bath robes, pullovers, pyjamas, dresses, t-shirts, body suits, dressing



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Classes 18 and 25 of the Nice Classification.³ Subsequently, the Examiner-in-Charge ("Examiner") issued a "REGISTRABILITY REPORT"⁴ stating that CACHE CACHE may not be registered because it resembles a registered mark belonging to a different proprietor and the resemblance is likely to deceive or cause confusion. The Examiner cited the mark "CACHE AND DEVICE"⁵ registered in the name of Fernandina S. Ong.

The Appellant filed a response⁶ claiming that its mark does not resemble the mark cited by the Examiner and maintained that its mark and the mark cited by the Examiner are visually and aurally dissimilar and that a comparison of these marks will negate any possibility of confusion. The Appellant asserted that its mark covers goods different from those covered by the mark cited by the Examiner.

The Examiner issued another official action⁷ stating that the word "CACHE" is the dominant element of the Appellant's mark and the mark cited by the Examiner and, therefore, the registration of the Appellant's mark would probably cause confusion as to the source of the goods covered by these marks. The Examiner also stated that the goods covered by these marks are related. The Appellant filed another response letter⁸ and submitted labels of its mark to support its position that these marks are not confusingly similar. The Appellant mentioned the differences in its goods and those goods covered by the mark cited by the Examiner and asserted the different market for the goods covered by these marks. Subsequently, the Examiner issued a final rejection of the Appellant's trademark application.⁹ The Appellant appealed to the Director the final rejection of its trademark application but the Director sustained the rejection.

On 06 October 2011, the Appellant filed an "APPELLANT'S BRIEF" citing the sole issue of:

WHETHER OR NOT THE SUBJECT MARK "CACHE CACHE" RESEMBLES THE CITED MARK "CACHE AND DEVICE" SO AS TO LIKELY CAUSE CONFUSION AND THUS SHOULD BE DENIED REGISTRATION ON THE BASIS OF SECTION 123.1(D) OF R.A. 8293.

gowns, sandals, underpants, undergarments, sweaters, pea jackets, jackets, sportswear, tank tops, crop tops, visors (hats), gloves (clothing), clothing made of leather or imitation leather.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

⁴ Paper No. 2 with mailing date of 19 March 2009.

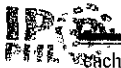
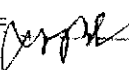
⁵ Cert. of Reg. No. 062033.

⁶ Letter dated 15 May 2009.

⁷ Paper No. 04 with mailing date of 27 July 2009.

⁸ Dated 24 September 2009.

⁹ Paper No. 06 with mailing date of 27 January 2010.


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The Appellant argues that CACHE CACHE is not identical, similar nor resemblant to the mark cited by the Examiner and that its mark does not fall under any of the grounds specified under Sec. 123.1 (d) of the Intellectual Property Code of the Philippines ("IP Code"). The Appellant claims that it is highly improbable that its mark will confuse, mislead, or deceive the public given the distinguishing characteristics of the goods covered by its mark which are inexpensive, trendy, casual, and everyday ready-to-wear women's clothing for ages 16-30, while the mark cited by the Examiner is used on clothing that are more expensive, for formal occasions or events, and for a mature market.

The Director filed a "COMMENT" dated 16 November 2011 adopting her position in the decision that the Appellant's mark is confusingly similar with the mark cited by the Examiner. The Director maintains that the goods of these marks belong to the same classification and that the owner of the mark cited by the Examiner may consider closely-related goods within its potential area of business expansion. According to the Director, the public would be misled in thinking that the owner of the mark cited by the Examiner has expanded its business from formal wear to casual wear.

On 13 December 2011, the Appellant filed a "MANIFESTATION WITH MOTION TO RESOLVE" alleging that the registration of the mark cited by the Examiner has been cancelled for failure by the registrant to file the required Declaration of Actual Use ("DAU"). The Appellant submitted a copy of a certification issued by the Bureau of Trademarks stating the cancellation of the registration of the Appellant's mark.

In this regard, the Appellant's manifestation and submission that the registration of the mark cited by the Examiner has been cancelled is relevant in the resolution of this appeal. Significantly, the Appellant's application to register CACHE CACHE was rejected because of Cert. of Registration No. 062033 for CACHE AND DEVICE. As stated partly in the Examiner's final rejection of the Appellant's trademark application:

After an examination of the application, the undersigned IPRS has determined that the mark subject of the application cannot be registered because the applicant's mark, when used in connection with the identified goods, resembles a registered mark with Registration No. 062033 as to be likely to cause confusion. (Sec. 123.1 (d)[ii] of the IP Code).

Accordingly, this Office can now allow the publication of the Appellant's trademark application. Sec. 133 of the IP Code provides in part that:

SEC. 133. Examination and Publication.- 133.1. Once the application meets the filing requirements of Section 127, the Office shall examine whether the application meets the requirements of Section 124 and the mark as defined in Section 121 is registrable under Section 123.

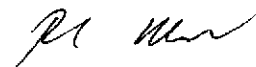
133.2. Where the Office finds the conditions referred to in Subsection 133.1 are fulfilled, it shall, upon payment of the prescribed fee, forthwith cause the application, as filed, to be published in the prescribed manner.



The Appellant's trademark application was not given due course because the Appellant's mark resembles the mark cited by the Examiner which used to be registered under Cert. of Registration No. 062033. With the cancellation of this certificate of registration, the Appellant's Trademark Application No. 4-2009-001342 may now be published in accordance with the provisions of the IP Code and the Trademark Regulations.

Wherefore, premises considered, the appeal is hereby GRANTED and the Appellant's Trademark Application No. 4-2009-001342 for CACHE CACHE is allowed for publication. Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Trademarks for appropriate action. Let a copy of this Decision be furnished also the library of the Documentation, Information and Technology Transfer Bureau for its information and records purposes.

SO ORDERED.

09 SEP 2014 Taguig City


RICARDO R. BLANCAFLOR
Director General


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