



SUYEN CORPORATION,
Opposer,

-versus-

CHINA TOBACCO JIANGSU
INDUSTRIAL CO., LTD.,
Respondent- Applicant.

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IPC No. 14-2012-00577
Opposition to:
Appln. Serial No. 4-2012-006835
Date Filed: 06 June 2012
TM: "SUYAN"

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NOTICE OF DECISION

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LAGUNA LAKE TRADE MARKS

For Respondent-Applicant
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GREETINGS:

Please be informed that Decision No. 2014 - 198 dated July 31, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 31, 2014.

For the Director:

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



SUYEN CORPORATION,

Opposer,

-versus-

**CHINA TOBACCO JIANGSU
INDUSTRIAL CO., LTD.,**

Respondent-Applicant.

IPC No. 14-2012-00577

Opposition to Trademark

Application No. 4-2012-006835

Date Filed: 06 June 2012

Trademark: **"SUYAN"**

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Decision No. 2014- 198

DECISION

Suyen Corporation¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-006835. The contested application, filed by China Tobacco Jiangsu Industrial Co., Ltd.² (Respondent-Applicant), covers the mark "SUYAN" for use on "*cigarettes; tobacco; cigarettes containing tobacco substitutes, not for medical purposes; cigarette cases; ashtrays for smokers; cigarette filters; cigarette paper; cigars*" under Class 34 of the International Classification of Goods³.

According to the Opposer, it started as a manufacturing company dealing in wearing apparel, garments and accessories in 1985. At present, it allegedly manufactures, distributes, markets and sells lifestyle products carrying in different brands, including its flagship brand "BENCH". It claims to have grown to an unparalleled rate by being in the use of celebrity endorsers, television and giant billboards to propel a fashion brand that offers quality products at affordable prices. Its other brands include "HUMAN", "KASHIECA", "BENCH FIX SALON", "IMENSIONE", "PCX" and "BE CONNECTED".

The Opposer further avers that it has been a pioneer in franchising business and that it has brought into the local market several foreign brands like "LA SENZA", "ALDO", "CHARLES AND KEITH", "REPETTO", "CALL IT SPRING", "LYN", "PEDRO", "CELIO", "MOTHERCARE", "EALY LEARNING CENTER", "COTTON ON", "CC-OO", "CPS", "CHAPS", "PATCHI", "CAPELLINI" and "THE FACE SHOP", among others. It prides on the recognitions received from local and foreign award-giving bodies for its performance in multiple industries and disciplines. At present, it claims ownership over two hundred (200) brand names and trademarks registered in the Philippines and abroad.

¹ A corporation duly organized and existing under Philippine law with offices located at Bench Tower, 30th Street, corner Rizal Drive, Crescent Park West 5, Bonifacio Global City, 1634 Taguig City.

² With known address at No. 406-3, Zhingsan North Road, Nanjing City, Jiangsu Province, China.

³ 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.

The Opposer contends that the applied mark "SUYAN" is confusingly similar with its own "SUYEN" trademark. It asserts that the "SUYEN" mark was registered as trademark early as 01 July 2004 with the Intellectual Property Office (IPOP HL) as well as a business name with the Department of Trade and Industry (DTI).

In support of its opposition, the Opposer submitted the following as evidence the affidavit of Mr. Jude W. Ong⁴, with its annexes, and a copy of Trademark Application No. 4-2004-007893 dated 27 August 2004⁵.

This Bureau issued and served on 15 April 2013 a Notice to Answer upon the Respondent-Applicant. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued on 04 October 2013 Order No. 2013-1353 declaring the Respondent-Applicant in default and the case submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark "SUYAN"?

The records reveal that the mark "SUYEN AND SUYEN IN JAPANESE CHARACTERS" was registered on 01 July 2004 in favour of Opposer under Certificate of Registration No. 4-1994-093716. The Opposer filed the application for registration of the said mark as early as 06 July 1994. On the other hand, Respondent-Applicant only filed its contested application on 06 June 2012.

Perusing the competing marks as reproduced below

Opposer's mark

Respondent-Applicant's mark

shows that both are composite marks differently presented and markedly distinguishable from each other. The Opposer's mark consists of the word "SUYEN" and its translation in Japanese. On the other hand, Respondent-

⁴ Marked as Exhibit "A".

⁵ Marked as Exhibit "B".

Applicant's mark "SUYAN", although spelled only one letter different from that of the Opposer, is highlighted by the "S" device placed before the word itself.

More importantly, the Opposer itself admits that its mark pertains to unrelated and/or non-competing goods vis-à-vis Respondent-Applicant's. The Opposer's brands deals with apparels, garments, accessories and other lifestyle products, which is completely different and unrelated to cigarette products which Respondent-Applicant's mark covers. It cannot be considered that cigarettes are within the normal expansion of business of the Opposer, and vice-versa. As enunciated by the Supreme Court in the case of **Mighty Corporation vs. E. & J. Gallo Winery**⁶:

"In resolving whether goods are related, several factors come into play:
(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."

To reiterate, none of the above-enumerations apply in the instant case. Echoing the pronouncement in **Esso Standard Eastern, Inc. vs. The Honorable Court of Appeals**, *"the goods are obviously different from each other with "absolutely no iota of similitude" as stressed in respondent court's judgment. They are so foreign to each other as to make it unlikely that purchasers would think that petitioner is the manufacturer of respondent's goods. The mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on unrelated articles of a different kind."*⁷ Thus, it is highly improbable for purchasers of the Opposer to be confused, misled and/or deceived that Respondent-Applicant's products are sponsored by, affiliated to or connected with its company.

On a final note, it is emphasized that the function of trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure

⁶ G.R. 154342, 14 July 2004.

⁷ G.R. No. L-29971, 31 August 1982.

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.⁸ Respondent-Applicant's sufficiently met this function.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-006835 is hereby **DISMISSED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 31 July 2014.


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

⁸ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.