



GEOFFREY LLC (formerly Geoffrey Inc.),
Opposer,

-versus-

DENNIS ROSTATA,
Respondent-Applicant.

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}
} **IPC No. 14-2010-00049**
} Opposition to:
} Application No.4-2008-014174
} Date filed: November 20, 2008
} **TM: "PC R US"**
}

NOTICE OF DECISION

VERALAW
[DEL ROSARIO RABOCA GONZALES GRASPARIL]
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Legazpi Village, Makati City

DENNIS ROSTATA
Respondent-Applicant
No. 427 Bulacan Street
Tondo, Manila

GREETINGS:

Please be informed that Decision No. 2015 - 137 dated June 29, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 29, 2015.

For the Director:


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



GEOFFREY LLC (formerly Geoffrey Inc.),	} IPC NO. 14-2010-00049
Opposer,	} Opposition to:
	}
-versus-	} Appln. Ser. No. 4-2008-014174
	} Date Filed: 20 November 2008
DENNIS ROSTATA,	} Trademark: PC R US
Respondent-Applicant.	}
x-----x	} Decision No. 2015- 197

DECISION

GEOFFREY LLC (formerly Geoffrey Inc.), , (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2008-014174. The application, filed by **DENNIS ROSTATA**, (Respondent-Applicant)², covers the mark “PC R US”, for use on “Retail Store Services” under Class 35 of the International Classification of Goods³.

The Opposer believes that it will be damaged by the registration of the mark “PC R US” and that its registration is contrary to Sec. 123.1 pars. (d), (e), (f) and (g) of the Rep. Act. No. 8293, otherwise known as the Intellectual Property Code of the Philippines.

According to the Opposer:

“10. TOYS R US and other stores under the ‘R’ ‘US’ group are favorite destinations for kids and grown –ups alike with its impressive assortment of toys, games, sporting goods, electronics’, software, baby products, children’s apparel and juvenile furniture.

“11. To date, Toys ‘R’ US and the ‘R US’ group is one of the leading retailers of toys and baby products with more than 1,400 freestanding destination toy and baby specialty stores worldwide. The company sells merchandise through 586 toy stores in the U.S. and over 650 international toy stores, including licensed and franchised stores as well as the internet site. xxx

“17. Opposer has registered the trademark TOYS ‘R’ US and its family of ‘R’ US marks not only in its home country, the United States of America, but in other countries all over the world including the Philippines. xxx

¹ A corporation organized and existing under the laws of Delaware with address at 2002 West 14th St. Wilmington, Delaware, United States of America

² Filipino with address at 427 Bulacan St., Tondo Manila

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

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"18. In the Philippines, Toys 'R' Us stores are located in Robinson's Galleria, Ortigas, Metro Manila, Robinsons's Place Lipa, Robinsons metro east in Pasig and Robinsons Bacolod. Opposer has registered the TOYS 'R' US trademark in the Philippines. xxx

"20. The popularity or well-known-ness of Opposer's TOYS 'R' US and the family of 'R' US marks has been affirmed not only abroad but also in the Philippines.

"21. In a long line of cases, Geoffrey, LLC's right to and well-known-ness of 'TOYS R' US' and its family of 'R' US marks have been repeatedly affirmed. xxx"

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

1. Special Power of Attorney dated 9 February 2010;
2. Verification and Certification against forum shopping;
3. Print-out of Respondent's Trademark Application for "PC R US";
4. Print-outs from Opposer's websites: i.e. www.sportsrus.com; www.toysrus.com; www.babiesrus.com; and
5. Print-out of websites of licensees, i.e. www.toysrus.com.hk, www.toysru.com.sg.⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 21 July 2010. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 2 August 2012 Order No. 2012-1084 declaring the Respondent-Registrant to have waived his right to file an Answer.

Should the Respondent-Applicant be allowed to register the trademark PC R US?

Records show that at the time Respondent-Applicant applied for registration of the mark "PC R US" for goods under class 35, the Opposer already registered the mark "TOYS R US" under Certificate of Registration No. 061966; 4-2001-001899 for goods/services under Class 28/42; "KIDS R US" under Certificate of Registration No. 4-2004-003322 and "BIKES R US" under Certificate of Registration No. 4-2004-003325 both under the class 35, same as that of the Respondent-Applicant.

The question is: Are the competing marks, depicted below, identical or closely resembling each other such that confusion or mistake is likely to occur?

TOYS R US

KIDS R US

⁴ Exhibits "A" to "G" inclusive

TOYS "R" US

Opposer's marks (Exhibit "D")

PC"R"US

Respondent-Applicant's mark

By allowing the Respondent-Applicant's marks "PC R US" to co-exist with the Opposer's marks TOYS "R" US, KIDS "R" US and other "R" "US" marks, there is a likelihood that the buying public may confuse the Respondent-Applicant's mark and/or its services to be under the sponsorship or affiliated with the family of "R US" marks of the Opposer or by the Opposer itself. The trademark "PC R US", particularly "PC" of the Respondent-Applicant, although not identical with the Opposer's mark TOYS R US, will nevertheless, impress upon the unwary public that they are the same or related as to source or mistaken to be an offshoot or a derivative of the Opposer's trademark bearing the "R" US component. Section 123 (d) of the IP Code provide:

Section 123. Registrability.- 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;

Succinctly, the Respondent-Applicant's retail stores could be mistaken as an outlet for the Opposer's various goods. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.⁵


Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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.⁶

With the finding that the Respondent-Applicant's trademark application is proscribed by Section 123.1 (d), (iii) of the IP Code, there is no need to dwell on the other issues.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2008-014174 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 29 June 2015.


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

⁵*Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

⁶*Prihhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).