



MICHELIS, INC.,
Opposer,

-versus-

JUDE SY,
Respondent-Applicant.

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}
} IPC No. 14-2011-00077
} Opposition to:
} Appln. Serial No.4-2010-008103
} Date filed: 23 July 2010
} TM: "MICHE"
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NOTICE OF DECISION

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WILLIAM QUE

For Respondent-Applicant
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Tondo, Manila

GREETINGS:

Please be informed that Decision No. 2015 - 234 dated October 30, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 30, 2015.

For the Director:


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



MICHELIS, INC.,
Opposer,

-versus -

JUDE SY,
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IPC No. 14-2011-00077
Opposition to:

Appln. Serial No. 4-2010-008103
Date Filed: 23 July 2010
Trademark: "MICHÉ"

Decision No. 2015 - 234

DECISION

MICHELIS, INC., ("Opposer")¹, filed an opposition to Trademark Application Serial No. 4-2010-008103. The application, filed by **JUDE SY** ("Respondent-Applicant")², covers the mark "**MICHÉ**" for use on "*stockings, singlets, corsets, garters, underpants, wind-resistant, jackets, ski pants, belts, fur coats, scarves, gloves, dressings, gowns, shoes, slippers, sports shoes and boots*" under class 25 of the International Classification of Goods and Services.³

The Opposer alleges the following:

"I. Oppositor is the owner of the mark 'MICHELIS' and, by virtue thereof, Respondent-Applicant's application for the registration of MICHÉ should be denied.

- A. MICHÉ is confusingly similar and identical to the mark 'MICHELIS' which is owned by the Opposer.
- B. The fact that Respondent-Applicant's application for the registration of the mark MICHÉ is for a different class with that of the goods of MICHELIS still does not entitle Respondent-Applicant to the registration it applies for as it is well-settled in jurisprudence that confusing similarity, and prejudice to the public and Opposer, may arise between marks that cover goods which, though non-competing, are related.
- C. Allowing the registration of Respondent-Applicant's application for the mark MICHÉ will result in 'confusion of source' as to MICHÉ and MICHELIS.

"II. Opposer, MICHELIS, INC., is the owner of the mark "MICHÉ" thus, Respondent-Applicant may not register the same mark as his own.

"III. Opposer has made substantial investments in promoting and developing both the brand names of MICHELIS and MICHÉ. Opposer has not only spent substantial sums for advertisements in print ads, billboards and magazines, but has also hired, as its endorser, a famous celebrity in the

¹ A domestic corporation with principal address at 55A 11th Street, New Manila, Quezon City.

² With address at 1084 Yuseco St., Tondo, Manila.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

person of Rovilson Fernandez of the Amazing Race Asia. Respondent-Applicant's use of the mark MICHE for his clothing and shoe brands is clearly not only an attempt to ride on the efforts and expense of the Opposer but also has the effect of diminishing Opposer's brands, to the grave prejudice and damage of the Opposer who should be entitled to the payment of damages."

The Opposer's evidence consists of the following:

1. Exhibit "A": Verified Opposition;
2. Exhibit "B": Notarized Verification and Certification of Non-Forum Shopping;
3. Exhibit "C": Notarized Secretary's Certificate;
4. Exhibit "D": Opposer's Certificate of Incorporation;
5. Exhibit "E": Affidavit of Norma Dabu, Corporate Secretary of Opposer;
6. Exhibit "F": Summary of Year-To-Date for 2010 and estimated sales for 2011 for the marks "MICHELIS" and "MICHÉ"; and,
7. Exhibit "G": copies of expenses and payments to advertisers for the promotion of the brand "MICHELIS" and "MICHÉ".

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 06 April 2011. Respondent-Applicant however, did not file an answer.

Should the Respondent-Applicant be allowed to register the trademark MICHÉ?

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 out 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.⁴

This Bureau takes cognizance via judicial notice of the Trademark Database Registry⁵ which shows that at the time Respondent-Applicant filed its application for the mark MICHÉ on 23 July 2010, the Opposer has a pending application for the registration of the mark MICHELIS, filed on 21 May 2003. The application matured into registration issued on 13 January 2006.⁶ The Registry also reveals that the Opposer applied for the registration of the mark MICHÉ on 13 January 2011, and was issued registration on 18 February 2012.⁷ The Opposer's marks and the Respondent-Applicant's are depicted below:

michelis miché

Opposer's Trademarks

miché

Respondent-Applicant's Trademark

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91, of the Trade Related Aspect of Intellectual Property (TRIPS Agreement).

⁵ Available at <http://www.ipophil.gov.ph/>.

⁶ Par. I of the Verified Notice of Opposition; IPOPHL Trademark Database available at <http://www.wipo.int/branddb/ph/en/>.

⁷ Par. II of the Verified Notice of Opposition; IPOPHL Trademark Database available at <http://www.wipo.int/branddb/ph/en/>.

There is no doubt that the mark applied for registration by the Respondent-Applicant is identical to or closely resembles the Opposer's marks.

This Bureau noticed that Opposer's mark MICHELIS cover goods under class 14, particularly sterling silver gifts made of silver, base metal silver and silver plated items namely, photo frames, boxes, dishes specialty server, desk top items, candle holders, incense burners, bells and other table top items namely, rattles, spoon, napkin rings and other accessories for personal use in the offices and/or homes.⁸ The Opposer's mark MICHE likewise covers goods under class 14, particularly sterling silver gifts and jewellery for men.⁹ On the other hand, Respondent-Applicant's applied mark cover goods under class 25.

Sec. 123.1(d) of the IP Code provides that a mark shall not 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; (Emphasis supplied)

While the goods covered by the Opposer's trademark registrations may be different from those indicated in the Respondent-Applicant's trademark application, the likelihood of confusion subsists. MICHE or MICHELIS is highly distinctive as a mark. Moreover, the market intended for clothing apparels may be the same market for men's jewellery. Thus, these goods flow on the same channels of trade and maybe seen in the same store. It is therefore likely that the consumers will have the impression that these goods or products originate from a single source or origin. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:¹⁰

Callman notes two 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. Hence, 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.

The Respondent-Applicant despite the opportunity given, did not file an Answer to the opposition and thus failed to explain how he arrived at using the mark MICHÉ. The marks MICHÉ and MICHELIS are unique and highly distinctive with respect to the goods they are attached or used. It is incredible for the Respondent-Applicant to have come up with the same mark by pure coincidence. Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why, of the millions of terms and combination of letters and designs available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.¹¹

⁸ IPOPHL Trademarks Database, available at <http://www.wipo.int/branddb/ph/en/>.

⁹ Id.

¹⁰ Converse Rubber Corporation v. Universal Rubber Products Inc., et al., G.R. No. L-27906, 08 Jan. 1987.

¹¹ American Wire & Cable Company v. Director of Patents, G.R. No. L-26557, 18 February 1970.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the file wrapper of Trademark Application Serial No. 4-2010-008103 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 30 October 2015.


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