

**SUYEN CORPORATION,**  
Opposer,

**-versus-**

**MAN SOCKS ITALIA S.r.L.,**  
Respondent-Applicant.

} **IPC No. 14-2011-00125**  
} Opposition to:  
} Appln. Serial No. 4-2010-500275  
} Date filed: 17 Feb. 2010  
} **TM: "THINK PINK (LOGO)"**  
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### NOTICE OF DECISION

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#### GREETINGS:

Please be informed that Decision No. 2015 - 293 dated December 23, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 23, 2015.

For the Director:

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

SUYEN CORPORATION,  
*Opposer,*  
  
-versus-  
  
MAN SOCKS ITALIA S.r.L.,  
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IPC No. 14-2011-00125  
  
Opposition to:  
Application No. 4-2010-500275  
Date Filed: 17 February 2010  
Trademark: "THINK PINK  
(LOGO)"  
  
Decision No. 2015- 293

**DECISION**

SUYEN CORPORATION<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2010-500275. The application, filed by then G.B. International S.P.A., now Man Socks Italia S.r.l.<sup>2</sup> ("Respondent-Applicant"), covers the mark "THINK PINK (LOGO)" for use on "clothing, namely dresses, shirts, hosiery, skirts, jackets, coats, sweaters, t-shirts, track suits (sports jerseys), clothing for sports, bathing suits, belts, gloves, scarves, foulards (neckerchieves), socks, hats, sports shoes, footwear, namely slippers, sandals" under Class 25 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer alleges:

x x x  
"III.  
"GROUND FOR OPPOSITION"  
x x x

"3.1 'A mark cannot be registered if it x x x [I]s identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of: (1) 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

"3.2 Respondent-Applicant's THINK PINK mark is confusingly similar with Suyen's registered TICKELD PINK trademark in respect of closely related goods or services. Both marks consist of two words written in plain upper case letters. The first word in both marks begins with the letter 'T' and both marks incorporate the word 'PINK.' The words 'THINK' and 'TICKLED' are visually almost identical especially when seen on products displayed in stores.

<sup>1</sup> A domestic corporation organized and existing under and by virtue of the laws of the Republic of the Philippines, with offices located at 2214 Tolentino Street, Pasay City, Metro Manila, Philippines.

<sup>2</sup> With address at Via Guizza 55 31030 Pederobba Frazione Covoio (TV), Italy.

<sup>3</sup>The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

"3.3 While the application for registration of the THINK PINK mark covers Class 25, and the TICKLED PINK trademark of Suyen covers Class 03, these are closely related classes of goods. Clothing products are closely related to fragrances and lotions. They are lifestyle products which are sold in the same channels of trade.

"3.4 There will therefore be confusion of business (source or origin confusion), where a product bearing the mark THINK PINK might reasonably be assumed to originate from the registrant of the TICKLED PINK trademark, and the public would then be deceived either into that belief or into the belief that there is some connection between the two parties, though inexistent. x x x

"3.5 It is settled that likelihood of confusion is not eliminated by the fact that the marks in question cover different classes of goods and/or services. As held in the Dermaline case, the Supreme Court aptly ruled:

"3.6 Suyen's TICKLED PINK products are sold in the same stores where Suyen sells its BENCH clothing or Class 25 products.

"3.7 There is no doubt that the TICKLED PINK and THINK PINK marks are used in the same trade or industry. As a matter of fact, respondent-applicant previously sought registration of the mark THINK PINK under Classes 03, 06, 09, 18, 22, 25 and 28 but was eventually cancelled by order of the Bureau of Trademarks. Attached to this Opposition as Exhibit 'F' is a copy of the Cancellation Order dated 06 December 2007. Likewise attached as Exhibit 'G' hereof is a copy of the cancelled THINK PINK trademark information download.

"3.8 If registration of THINK PINK is allowed, the public will be misled into thinking that Suyen has extended the use of its TICKLED PINK trademark to Class 25 products.

"3.9 In fact, the registration of respondent-applicant's THINK PINK mark will prevent Suyen from expanding its TICKLED PINK trademark to other closely related classes of goods, or unfairly limit the same.

"3.10 Registration of respondent-applicant's mark will result in substantial and irrevocable damages to opposer, who has exerted substantial efforts and incurred considerable expense to conceptualize, promote and use its THINK PINK trademark.

"3.11 The registration of respondent-applicant's mark will undoubtedly violate Suyen's rights to and interest in its TICKLED PINK trademark and will most assuredly result in the dilution and loss of distinctiveness of Suyen's trademark. Suyen will suffer substantial and irreparable damage from such registration.

The Opposer's evidence consists of the affidavit of Mr. Gerald D. Dela Cruz, Suyen's Group Manager; photographs of the various products of Suyen bearing the TICKLED PINK trademark; a copy of Certificate of Registration No. 4-2010-002845 for the "TICKLED PINK" trademark; photos of Suyen's products bearing the TICKLED PINK trademark as sold in the market; photo of the sample promotional material that

has been posted, displayed or distributed in the market; and copy of the Cancellation Order issued by the Bureau of Trademarks dated 06 December 2007.<sup>4</sup>

This Bureau issued a Notice to Answer and sent a copy thereof upon Respondent-Applicant on 10 May 2011. The Respondent-Applicant filed their Answer on 26 August 2011 and avers the following:

"SPECIAL AND AFFIRMATIVE DEFENSES

"4. Respondent-applicant repleads and incorporates by reference all the allegations in the preceding paragraphs.

"5. Respondent-applicant Man Socks Italia S.r.l. is the successor-in-interest of G.B. International S.p.A. The portfolio for the trademark 'THINK PINK' has been transferred to Man Socks Italia S.r.l., Via Mazzini 105, 46043 Castiglione delle Stiviere (MN). Consequently, Respondent-applicant filed with the Intellectual Property Office (IPO) a request for the recordal of the assignment of the trademark application for THINK PINK on 29 July 2011. A copy of the notarized assignment document showing the assignment of the trademark to Man Socks Italia S.r.l and bearing the proof of receipt by the Intellectual Property Office on 29 July 2011 is attached hereto as Annex 1.

"6. The mark originated in 1979, when a group of young Italian rock climbers began to adapt a free-climbing technique with minimal equipment in order to enjoy freedom of movement and connect with nature without the burden of gear. They introduced a different approach to staying in tune with nature as well as a new style of attire which places equal emphasis on both style and function. At that time, the color pink was known to stand for freedom and so it was used as the signature for THINK PINK to represent the longing for a lifestyle free of burden.

"7. Eventually, THINK PINK became the precursor of a new trend by mixing sportswear with the casual taste. The first and most important source of inspiration of THINK PINK is California in the '80s which is a symbol of innovation and change. From surfing to beach-volley, rafting to climbing, all new sport trends were born there. Free climbers became the symbol of the values, which the brand has drawn on; freedom, energy, positive thinking & creativity.

"8. As the very beginning, Think Pink marked the 80s generation and has always recognized for its casual items and that unmistakable hot-pink dot. Not just a part of the logo, but the symbol of a philosophy. The philosophy of nature and freedom lovers, of those who lead their daily life as a never ending conquest.

"9. To protect its global reputation and image for producing high quality goods, Respondent-applicant has sought protection for the mark ever since.

x x x

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<sup>4</sup> Marked as Exhibits "A" to "F", inclusive.



"10. Since its inception, Respondent-applicant's predecessor-in-interest has invested in the advertisement and promotion of the trademark THINK PINK making the said trademark a well-known mark.

x x x

"11. The immense success of the trademark THINK PINK, due to its extensive publicity and promotion, and its reputation for products of superior quality, is manifested in the fact that it has generated very substantial sales. Relevant figures for the past five (5) years are as follows:

x x x

"12. On 17 February 2010, a trademark application was filed by G.B. International S.p.A in the Philippines under Serial No. 42010500275 for goods in class 25, namely 'clothing, namely dresses, shirts, hosiery, skirts, jackets, coats, sweaters, t-shirts, track suits (sports jerseys), clothing for sports, bathing suits, belts, gloves, scarves, foulards (neckerchieves), socks, hats, sports shoes, footwear, namely slippers, sandals. A printout of Philippine Trademark Application No. 2010500275 is marked as Exhibit '1-s'.

"13. Opposer filed its Opposition on April 12, 2011. The main thrust of the Opposition is that Respondent-applicant's 'THINK PINK' is allegedly confusingly similar with Opposer's 'TICKLED PINK' and that the mark THINK PINK designates Class 25 which are allegedly related to Class 03 goods which are designated by Opposer's mark 'TICKLED PINK'.

"14. It cannot be overemphasized that Respondent-applicant's mark 'THINK PINK' is sufficiently dissimilar to opposer's trademark 'TICKLED PINK' such that there is no likelihood of confusion between the two, and consequently, no damage or prejudice to Opposer.

x x x

"15. Moreover, it is apparent that the marks are conceptually different. 'TICKLED PINK' has a particular sense that it is different from 'THINK PINK'. The phrase 'TICKLED PINK' connotes, in the figurative sense the emotion of being pleased or gratified. On the other hand, the phrase 'THINK PINK' is suggestive of a mentality which is feminine or girly.

x x x

"16. It is also important to note that the products bearing the marks 'THINK PINK' and 'TICKLED PINK' are not likely to travel the same channels of trade.

x x x

"17. Furthermore, the THINK PINK trademark has been in the international market since 1979 and has therefore acquired a reputation and goodwill that is not at all associated with Opposer's TICKLED PINK trademark. Respondent-applicant's trademark is synonymous with a lifestyle characterized by the free-living attitude of Italians.

"18. It is also important to note that the products which the Opposer manufactures and sells do not compete with and are different from those of Respondent-applicant.



"19. In the case of Faberge, Incorporated vs. Intermediate Appellate Court, the Director of Patents allowed the junior user to use the trademark of the senior user on the ground that the briefs (underwear) manufactured by the junior user, for which the trademark BRUTE was sought to be registered, were unrelated and non-competing with after shave lotion, shaving cream, deodorant, talcum powder, and toilet soap, the products of the senior user.

x x x

"20. Likewise, in the case of Esso Standard Eastern vs. The Honorable Court of Appeals, it was held:

x x x

"21. Consumers patronizing the products bearing the mark 'TICKLED PINK' are aware that the trademark is used in connection with toiletries/toilet products and is related to the BENCH trademark. Thus, there is no possibility that the clothing articles bearing the 'THINK PINK' mark will be associated with whatever good name Opposer's TICKLED PINK trademark may have generated. Although Respondent applicant's products are numerous, they are of the same class or line of merchandise which are non-competing with Opposer's products. As stated in the Esso Standard case, 'when a trademark is used by a party for a product in which the other party does not deal, the use of the same trademark on the latter's product cannot be validly objected to.

"22. Thus, in view of the foregoing, respondent-applicant submits that Opposer has failed to prove damage to it if Respondent-Applicant's trademark application for THINK PINK in respect of goods in class 25 were to be registered. The Opposition, therefore, cannot be sustained.

"23. Respondent-applicant submits herewith an affidavit executed by Sergio Zaglio as President of Man Socks Italia S.r.l, marked as respondent-applicant's Exhibit '1'. All documents referred to herein as exhibits have been sequentially marked as respondent-applicant's Exhibits '1-a', '1-b', et. seq. and are attached as Exhibit '1'.

The Respondent-Applicant's evidence consists of the Affidavit of Sergio Zaglio, President of Man Socks Italia S.r.l.<sup>5</sup>

On 06 March 2012, the Preliminary Conference was conducted and terminated. The parties were directed to submit their position papers. Both Opposer and Respondent-Applicant submitted their respective position paper/s on 16 March 2012. Thereafter, the case was deemed submitted for resolution.

Should the Respondent-Applicant be allowed to register the trademark THINK PINK (LOGO)?

The Opposer anchors its opposition on Section 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

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<sup>5</sup> Marked as Exhibit "1", inclusive.

Sec. 123. Registrability. – 123.1. A mark cannot be registered if it:  
x x x

- (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;”

Hence, the question, does THINK PINK (LOGO) of Respondent-Applicant resemble TICKLED PINK of Opposer such that confusion or deception is likely to occur? The marks are shown below:

**TICKLED PINK**

**THINK  
PINK**

Opposer's trademarks

Respondent-Applicant's mark

This Bureau finds that confusion or deception is unlikely to occur at this instance. Opposer's toiletries and Respondent-Applicant's clothing are unrelated. Both Opposer's and Respondent-Applicant's marks bear the first letter T and the second word PINK, however, the use of the letter T and the second word PINK in Opposer's trademarks do not create for or confer upon Opposer the right to exclusively appropriate the letter T and the second word PINK. No one has exclusive use to it. The use of the letter T may constitute a valid trademark particularly in combination with another word and/or logo, and for as long as it can individualize the goods of a trader from the goods of its competitors, as it was in this case. Respondent-Applicant's THINK PINK mark is accompanied by a logo and is used for clothing which are non-competing with Opposer's toiletries.

Moreover, in the Trademark Registry, the contents of which the Bureau can take cognizance of via judicial notice, there are several trademarks carrying the first letter T and the second word PINK, printed and stylized in different ways that are registered under different classes including those in Classes 03 and 25, e.g. the TRANS PINK (Reg. No. 42014504196), THOMAS PINK (Reg. No. 42012005369 and Reg. No. WO1187097), TENDER PINK (Reg. No. 42014010181).

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>6</sup> This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2010-500275 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

**SO ORDERED.**

Taguig City, 23 December 2015.



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

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<sup>6</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.