

**LA EUROPA CERAMICA TILE CENTER INC.,** }  
Opposer, }  
}

**-versus-** }

**STAR TRENDS APPAREL CORPORATION,** }  
Respondent-Applicant. }

x-----x

**IPC No. 14-2014-00509**  
Opposition to:  
Appl. Serial No. 4-2014-003622  
Date filed: 24 March 2014  
**TM: "UROPA"**

**NOTICE OF DECISION**

**BETITA CABILAO CASUELA SARMIENTO**  
Counsel for the Opposer  
Suite 1104, Page One Bldg., 1215 Acacia Avenue  
Madrigal Business Park, Ayala Alabang  
Muntinlupa City


**JONAS T. ANG**  
Representative of Respondent-Applicant  
Block 4, Lot 3, Acefree Street  
Sterling Industrial Park  
Iba, Meycauayan  
Bulacan

**GREETINGS:**

Please be informed that Decision No. 2015 - 295 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

LA EUROPA CERAMICA TILE CENTER INC. }  
*Opposer,* }  
 -versus- }  
 STAR TRENDS APPAREL CORPORATION, }  
*Respondent-Applicant.* }  
 x-----x

IPC No. 14-2014-00509  
 Opposition to:  
 Application No. 4-2014-003622  
 Date Filed: 24 March 2014  
 Trademark: "UROPA"  
 Decision No. 2015- 295

**DECISION**

LA EUROPA CERAMICA TILE CENTER INC.<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2014-003622. The application, filed by Star Trends Apparel Corporation<sup>2</sup>("Respondent-Applicant"), covers the mark "UROPA" for use as "specialty store/retail store" under Class 35 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer alleges:

x xx

"1. The grounds for opposition are as follows:

"1. The registration of the UROPA mark is contrary to the provisions of Section 123.1 (d) of Republic Act No. 8293, as amended, which prohibit the registration of a mark that:

x xx

"2. The Opposer is the owner and prior user of the EUROPA mark, which is used on floor and wall tiles, among others, and in connection with its business of retailing the same.

"3. The Opposer's EUROPA mark is registered with the Intellectual Property Office of the Philippines covering 'apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes' in class 11 and on 'building materials (non-metallic), non-metallic rigid pipes for building, asphalt, pitch and bitumen, non-metallic transportable buildings, monuments, not of metal' in class 19. The registration details of sad mark appear below:

x xx

<sup>1</sup>A domestic corporation organized and existing under the laws of the Republic of the Philippines, with business address at 112G Skyrise Compound, Old Samson Road, Balintawak, Quezon City, Metro Manila, Philippines.

<sup>2</sup>With address at Block 4 Lot 3 Acefree St., Sterling Industrial Park, Iba, Meycauayan, Bulacan, Philippines.

<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.

"4. The Respondent-Applicant's UROPA mark is almost identical and confusingly similar in terms of appearance, spelling and pronunciation to the Opposer's registered EUROPA mark as to be likely to deceive or cause confusion.

"5. The EUROPA mark has been used by the Opposer in the Philippines as early as 2004 or long before the Respondent-Applicant applied for registration of its UROPA mark on 24 March 2014. The Opposer continues to use the EUROPA mark until today.

"6. Being the owner and prior user of the registered EUROPA mark, Opposer's right to the EUROPA mark is superior to the right of Respondent-Applicant to the UROPA mark.

"7. Opposer has also extensively promoted the EUROPA mark. Over the years, products bearing the EUROPA mark have obtained significant public exposure in various media including store signage of dealers, boxes of products, brochures, leaflets, promotional events, sponsored marketing materials such as display cabinets, stands, etc. Opposer also maintains a website, <http://www.laeuropa.com.ph>, which is accessible to users worldwide, including those from the Philippines.

"8. Respondent-Applicant's appropriation of the UROPA mark was made knowingly, willfully and in bad faith, with prior knowledge of the Opposer's prior rights to the EUROPA mark, and with the intention to ride on the fame, established reputation, and goodwill of the Opposer's mark by blatantly copying the dominant feature of Opposer's EUROPA mark. Respondent-Applicant knew or ought to have known Opposer's prior and exclusive rights to the registered EUROPA mark. Hence, Respondent-Applicant's bad faith precludes the ripening of a right to the mark in its favor. In *Montrail Corporation vs. Jacqueline Chu*, this Honorable Office, in sustaining the notice of opposition, held that the copying of the mark of another shows willful intent to exploit the goodwill of such mark, to wit:

x xx

"9. The Opposer has not consented to the Respondent-Applicant's use and registration of the UROPA mark, or any other mark identical or similar to the Opposer's registered EUROPA mark.

"10. The use by Respondent-Applicant of the UROPA mark in connection with the services in class 35, which are identical or closely-related to the business of the Opposer or within the zone or natural expansion of Opposer's business using the registered EUROPA mark, will mislead the purchasing public into believing that the Respondent-Applicant's services are produced by, originate from, or are under the sponsorship of the Opposer, thus causing mistake or deception to the consuming public as to the source of these goods. In the case of *Societe Des Produits Nestle, S.A. vs. Dy, Jr.*, the Supreme Court held that:

x xx

"11. Potential damage to the Opposer will be caused as a result of its inability to control the quality of the services offered or put on the market by Respondent-Applicant under the UROPA mark.

"12. The use by the Respondent-Applicant of the UROPA mark in relation to its services in class 35, being identical or closely-related to the Opposer's products,



services and business, will take unfair advantage of, dilute and diminish the distinctive character or reputation of the Opposer's prior and registered EUROPA mark. Although Respondent-Applicant had in its disposal a myriad of words and symbols to choose from, Respondent-Applicant opted to employ the almost identical UROPA word for use on identical or closely-related services, thereby expressing plan and design to exploit the goodwill associated with the Opposer's prior and registered EUROPA mark.

"13. The registration of the UROPA mark will violate the exclusive rights of the Opposer on the use of its trade name, LA EUROPA CERAMICA TILE CENTER, INC., contrary to the provisions of Section 165.2 of Republic Act No. 8293, as amended, which provides that:

"165.2 (a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

"165.2 (b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

"Since 'EUROPA' constitutes the trade name of the Opposer, Respondent-applicant may not appropriate or copy such trade name or a confusingly similar name such as UROPA as its trademark. Furthermore, UROPA also forms part of the domain name of the Opposer, <http://www.laeuropa.com.ph>, which Respondent-Applicant may likewise not appropriate or copy as its own.

"14. Thus, the denial of the Respondent-Applicant's application for the UROPA mark under Trademark Application No. 4-2014-003622 by this Honorable Office is authorized and warranted under the provisions of the Intellectual Property Code of the Philippines.

x xx

The Opposer's evidence consists of the notice of opposition; the affidavit of Mr. Rick Robinson Robins, the Vice President of Sales of the Opposer attaching thereto copies of the Securities and Exchange Commission Certificate of Incorporation, Articles of Incorporation and By-Laws of the Opposer and sample materials used in the promotion of the EUROPA mark; printout of the trademark details report for the EUROPA mark under Registration No. 4-2013-005935 downloaded from the Intellectual Property Office website; printout of the trademark details report for the EUROPA CERAMICA mark under Application No. 4-2007-009365 downloaded from the Intellectual Property Office website; representative copies of sales invoices showing use of the EUROPA mark issued from 2006 to 2014; screenshots taken from the Opposer's website, [www.laeuropa.com.ph](http://www.laeuropa.com.ph) showing use of the EUROPA mark ; the certificate and special power of attorney signed by Mr. Rick Robinsons Robins, the Vice President of Sales of the Opposer, regarding his authority to verify the notice of opposition and





execute the certificate of non-forum shopping, and on the authority of Betita Cabilao Casuela Sarmiento to represent Opposer in this inter-partes case bearing IPC No. 14-2014-00509; and the Secretary's Certificate signed by Ms. Helen Cortes, the Corporate Secretary of the Opposer, on the authority of Mr. Rick Robinson Robins to sign the verification and certification of non-forum shopping of the notice of opposition in this inter-partes case bearing IPC No. 14-2014-00509 and the authority to execute the Officer's Certificate and Special Power of Attorney on behalf of the Opposer. <sup>4</sup>

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant, Star Trends Apparel Corporation, on 31 January 2015. Said Respondent-Applicant, however, did not file an Answer.

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

The Opposer anchors its opposition on Sec. 123 and Sec. 165 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

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

x xx

- (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;"

Sec. 165. *Trade Names or Business Names.* - 165.1. A name or designation may not be used as a trade name if by its nature or the use to which such name or designation may be put, it is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

165.2. (a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

Records show that at the time the Respondent-Applicant filed its trademark application on 24 March 2014, the Opposer has an existing trademark registration for the mark EUROPA under Trademark Reg. No. 5935 issued on 03 April 2014. The registration covers "apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes" under Class 11 and "building materials (non-metallic); non-metallic rigid pipes for building; asphalt,

---

<sup>4</sup>Marked as Exhibit "A" to "H", inclusive.

pitch and bitumen; non-metallic transportable buildings; monuments, not of metal" under Class 19. On the other hand, Respondent-Applicant filed its trademark application for UROPA for use as "specialty store/retail store" under Class 35.

The marks are shown below:

**EUROPA**

*Opposer's trademark*

**UROPA**

*Respondent-Applicant's mark*

Although the contending marks have the same letters UROPA and number of syllables, the visual and aural properties in respect of the Respondent-Applicant's mark has rendered said mark a character that is distinct from the Opposer's. Moreover, the goods/services covered by the marks are different. EUROPA are apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply, sanitary purposes, building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal while UROPA is a service mark for specialty store/retail store. Also, from the Respondent-Applicant's name Star Trends Apparel Corporation, the specialty/retail store deals with apparel and not the industrial goods dealt in by the Opposer under the mark EUROPA. Thus, confusion, mistake and deception is unlikely among the purchasing public.

Since confusion, much less deception, is unlikely in this instance, the protection under Section 165.2 of the IP Code does not apply.

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>5</sup> This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.


---

<sup>5</sup>Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2014-00003622 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