

ARABELLA PTE. LTD.,
Opposer,

-versus-

ALEX AND ANI, LLC,
Respondent- Applicant.

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}
} IPC No. 14-2013-00178
} Opposition to:
} Appln. Serial No. 4-2012-503010
} Date Filed: 19 November 2012
} TM: "(+) ENERGY"
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}
}

NOTICE OF DECISION

VERALAW (DEL ROSARIO RABOCA GONZALES & GRASPARIL)
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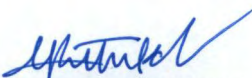
SAPALO VELEZ BUNDANG AND BULILAN
Counsel for the Respondent-Applicant
11th Floor, Security Bank Centre
6776 Ayala Avenue, Makati City

GREETINGS:

Please be informed that Decision No. 2016 - 146 dated May 12, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 12, 2016.

For the Director:


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

ARABELLA PTE. LTD.,
Opposer,

-versus-

ALEX AND ANI, LLC,
Respondent-Applicant.

X ----- X

IPC No. 14-2013-00178

Opposition to Trademark
Application No. 4-2012-503010
Date Filed: 19 November 2012

Trademark: **"(+)
ENERGY"**
Decision No. 2016- 146

DECISION

Arabella Pte. Ltd.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-503010. The contested application, filed by Alex and Ani, LLC² ("Respondent-Applicant"), covers the mark "(+) ENERGY" for use on *"precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments"*, *"advertising, auctioneering and retail services connected with the sale of precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments"* and *"providing online services for advertising, auctioneering ad selling of precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments"* under Classes 14, 35 and 42 of the International Classification of Goods³.

According to the Opposer, the Sixty Group was created in 1990 and was launched in 1991. The said company established the first branch in United States in 1992 and acquired the Murphy & Nye brand in 1993. In 1999, the Sixty Group opened the first Miss Sixty monobrand store in London. The company launched its own line of footwear in 2000, eyewear in 2001 and kid's line of clothing in 2004. It also partnered with Coty in 2004 to launch a new line of fragrance. In 2005, it partnered with other companies to launch its own brand of jewelry and leather goods. The year after, it launched underwear and beachwear in partnership with CSP. The Sixty Group has consolidated its worldwide market in more than five hundred (500) retail and franchising stores worldwide and operates various websites.

¹ A corporation organized and existing under the laws of Singapore with address at 80 Raffles Place # 16-20 UOB Plaza, Singapore.

² A corporation organized and existing under the laws of Rhode Island, United States of America with address at 2000 Chapel View Blvd., Suite 360, Cranston, Rhode Island 02920, USA.

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.

Republic of the Philippines

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The Opposer alleges that one of the brands marketed by the Sixty Group is "ENERGIE". To protect the latter's goodwill thereto, there are around 500 trademark applications and/or registrations worldwide. In the Philippines, the said mark was registered as early as 1997 and a franchisee store offering "ENERGIE" products was opened in December 2011 in Robinsons Place, Ermita, Manila. The Opposer avers that Sixty International S.A., a company under the Sixty Group, transferred, ceded and assigned to it the mark "ENERGIE" through a Deed of Transfer on 23 November 2011.

The Respondent-Applicant claims that its mark "ENERGIE" is well-known under Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Tradenames and Marked or Stamped Containers and Section 123.1 (e) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It asserts that the Respondent-Applicant's "(+) ENERGY" mark should not be allowed registration for being confusingly similar, if not identical, to its own "ENERGIE" mark. In support of its opposition, the Opposer submitted a copy of Trademark Application Np. 4-2012-503010 and the affidavit of Mr. Paolo Bodo, with annexes.⁴

For its part, the Respondent-Applicant filed its Answer on 24 October 2013 alleging, among others, that the Opposer's trademark registrations for "ENERGIE" have been abandoned and expired and that the latter only has Application No. 4-2011-501848, which is still pending examination. It refutes the allegation that the subject mark is confusingly similar to the Opposer's "ENERGIE" mark in sound, spelling, meaning, style, connotation, configuration, presentation and appearance. It asserts that the Opposer's goods cater specifically to men and are priced higher than its own products, which cater to both men and women. It moreover contends that the Trademark Registry is crowded with registrations and/or applications that incorporate the word "ENERGY".

According to the Respondent-Applicant, its company, founded in 2004, offers eco-friendly, positive energy products that adorn the body, enlighten the mind and empower the spirit, designed by Carolyn Rafaelian. To protect its ownership over the mark, it registered and/or applied the same for registration in different countries. In the Philippines, Alex and Ani accessories bearing the "(+) ENERGY" marks were introduced through Three Point Retail Concepts, Inc., which held a Brunch & Bangles event last 20 April 2013 at St. Francis Shangri-La Place, Ortigas Center. Its products are currently sold in Bitsie Boutique, Rockwell Center, Makati and SM AURA Premier, Bonifacio Global City, Taguig.

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. This Bureau's Alternative Dispute Resolution Services submitted a report that the parties refused to mediate. Accordingly, the Hearing Officer

⁴ Marked as Exhibits "A" and "D".

conducted and terminated the preliminary conference on 31 March 2014 wherein the parties were directed to submit their respective position papers. After which, the case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the mark "(+) ENERGY" in its favor?

Records reveal that the Opposer filed an application for the mark "ENERGY" on 07 December 2011 under Trademark Application No. 4-2011-501848 for use on "clothing, namely, shirts, pants, shorts, trousers, dresses, blouses, coats, shirts, slacks, suits, sweaters, blazers, jackets, belts, boxer shorts, briefs, sports coats, dugarees, fishing vests, jogging suites, gloves, mittens, neckerchiefs, sweat pants, sweat shirts, polo shirts, rain coats, robes, bathing suits, t-shirts, wrist bands, wet suits, blouses, skirts, culottes, dresses, undergarments, pantyhose, leotards and scarves; footwear, namely, shoes, sandals, boots, sports shoes, socks, stocks and innersoles; headgear, namely, caps, hats, sun visors" under Class 25. On the other hand, the Respondent-Applicant's application for the mark "(+) ENERGY" was filed only on 19 November 2012.

To determine whether the competing marks are confusingly similar, the two are reproduced below:

ENERGIE **(+) ENERGY**

Opposer's mark

Respondent-Applicant's mark

What constitutes the Opposer's mark is the coined word "ENERGIE". While it is true that "ENERGIE" and "ENERGY" are pronounced identically, this Bureau does not agree with Opposer's contention that the competing marks are confusingly similar. The Respondent-Applicant's mark is composed of the symbol "(+)" and the word "ENERGY". Thus, the said mark should be appreciated as a whole and should be read as either "POSITIVE ENERGY" or "PLUS ENERGY".

Moreover, the term "ENERGY" is a common English word and hence, what will determine whether the marks are indeed confusingly similar are the words and/or device that accompany the same. In this regard, the Opposer was able to lend to its mark distinctiveness by substituting the letters "IE" for the "Y". The Respondent-Applicant also made its mark distinguishable by adding the "(+)" sign before the word "ENERGY". Noteworthy, the Trademark Registry shows many already registered marks, belonging to different entities using the term for goods also under Class 25, which the Opposer's mark is applied for. These marks include "ENERGY" under Certificate of Registration No. 4-2005-002293 issued on 22 October 2007; "S-

ENERGY" under Certificate of Registration No. 4-2015-010768 issued on 18 February 2016 and "L.E.I. LIFE ENERGY INTELLIGENCE" under Certificate of Registration No. 4-2014-007693 issued on 26 September 2014.

Furthermore, because of the disparity of the goods covered by the Opposer's mark on one hand and the goods indicated in the Respondent-Applicant's application on the other, it is doubtful if the consumers in encountering the mark "ENERGIE" will have in mind or be reminded of the trademark "(+) ENERGY". The Opposer's goods are clothing, footwear and headgears while the Respondent-Applicant deals in jewelry and precious stones and metals. Not only are they evidently different, the products involved in the case at bar are not your ordinary household items. Accordingly, the casual buyer is predisposed to be more cautious and discriminating and would prefer to mull over his purchase. Confusion and deception is less likely.⁵


Finding no confusing similarity between the marks, there is no to determine whether the Opposer's mark is well-known and is protected under Section 123.1 (e) of the IP Code.

Finally, 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 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 It is found that Respondent-Applicant's mark sufficiently met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application No. 4-2012-503010 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **12 MAY 2016**


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

⁵ Victorio P. Diaz vs. People of the Philippines, G.R. No. 180677, 18 February 2013.

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.