

**BURBERRY LIMITED,**  
Opposer,

**-versus-**

**ALEX UY KHONG HUN,**  
Respondent- Applicant.

x-----x

}  
} **IPC No. 14-2012-00315**  
} Opposition to:  
} Appln. Serial No. 4-2011-013511  
} Date Filed: 11 November 2011  
} **TM: "BEAUBERY"**  
}  
}  
}  
}  
}

**NOTICE OF DECISION**

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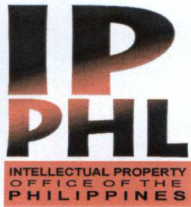
**GREETINGS:**

Please be informed that Decision No. 2016 - 123 dated May 03, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 03, 2016.

For the Director:

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



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**IPC NO. 14-2012-00315**

Opposition to:

App.Serial No. 4-2011-013511

Date Filed: 11 November 2011

**TM: "BEAUBERY"**

**Decision No. 2016- 123**

**DECISION**

BURBERRY LIMITED<sup>1</sup> ("Opposer"), filed an opposition to Trademark Application Serial No. 4-2011-013511. The application, filed by ALEX UY KHONG HUN<sup>2</sup> ("Respondent-Applicant"), covers the mark "BEAUBERY" for use on "beauty soap, lotions, creams" under Class 03 of the International Classification of Goods.<sup>3</sup>

The Opposer alleges the following grounds:

"I. Respondent-Applicant's 'BEAUBERY' mark is confusingly similar to Opposer's 'BURBERRY' mark.

"II. Opposer's 'BURBERRY' mark is a well-known mark and entitled to protection under Article 6bis and Article 8 of the Paris Convention, Section 123.1 (e) of the IP Code and Rule 102 of the Trademark Rules and Regulations.

"III. The registration of Respondent-Applicant's 'BEAUBERY' mark will cause dilution to Opposer's 'BURBERRY' mark. Thus, the registration of the subject mark is proscribed by the IP Code."

The Opposer's evidence consists of the following:

1. Authenticated Special Power of Attorney and Appointment of Resident Agent;
2. Authenticated Certification;
3. List of Registration of BURBERRY worldwide;
4. Various Certificate of Registration of the mark BURBERRY for Class 3 in various countries;
5. Certified true copies of Certificates of Registration for the mark BURBERRY issued by IPOPHL;
6. Sample of various advertisements in magazines & outdoor and press articles worldwide;
7. Sample of various Press Coverage for the BURBERRY mark;
8. Extracts from the BURBERRY website showing its various products;

<sup>1</sup> A corporation organized and existing under the laws England, with office address at Horseferry House, Horseferry Road, London, SW1P, England.

<sup>2</sup> A Filipino resident with address at #6 South A-A Street, Diliman, Quezon City.

<sup>3</sup>The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

9. Printout of Burberry Facebook Page;
10. Printout of Interbrand's Best Global Brands from 2006-2011; and
11. Samples of Historical Product Catalogue and advertisement showing BURBERRY.

This Bureau issued on 19 September 2012 a Notice to Answer and served a copy thereof to the Respondent-Applicant on 27 September 2012. However, despite receipt of Notice, Respondent-Applicant failed to file the Answer. On 26 February 2013, this Bureau issued an Order declaring Respondent-Applicant in default. Hence, this case is submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended.

Should the Respondent-Applicant be allowed to register the mark **BEAUBERY**?

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>4</sup>

At the time the Respondent-Applicant filed its trademark application on 11 November 2011, Opposer has existing trademark registrations for the mark BURBERRY in the Philippines. According to the IPOPHL Trademark Database, the earliest registration for the mark BURBERRY dates back to 07 October 1991. Opposer's goods consists of "*non-medicated toilet preparations, perfumes, cosmetics preparations for the teeth and for the hair, soaps, shampoos, anti-perspirants, eau de cologne and toilet water, essential oils, shaving preparations, pot pourri*" under Class 03 which covers Respondent-Applicant's goods such as "*beauty soaps, lotions and creams*" under Class 03 also.

Opposer anchors its opposition on Sec. 123.1 (e) of the IP Code which provides:

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

x            x            x

(e) Is identical with or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration and used for identical or similar goods or services; Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant section of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

Pursuant to the above provision, a mark cannot be registered if it is identical or confusingly similar to a mark which has been declared well-known in the Philippines and internationally by the competent authority in the Philippines. In order to determine whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public including knowledge in the Philippines

<sup>4</sup>See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.



which is obtained through the promotion of the mark.

The marks of the parties are herein reproduced:

## BURBERRY

### *Opposer's Marks*

## Beaubery

### *Respondent-Applicant's Mark*

Confusion is likely in this instance because of the resemblance of the competing trademarks. Both marks contain three syllables, BUR/BER/Ry for Opposer's while BEAU/BE/Ry for Respondent-Applicant. In coming up with its mark, Respondent-Applicant added the letters "EA" to replace the letter "U" and dropped the letter "R" in Opposer's mark to create the syllable BEAU instead of BUR and the dropped the second "R" in the word 'berry" in Opposer's mark to produce "BERY. Respondent-Applicant's mark also starts with a capital letter "B" as opposed to the all uppercase letters of Opposer's marks. These differences, however, are very trivial so as to avoid the likelihood of confusion.

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other<sup>5</sup>. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article<sup>6</sup>.

Moreover, trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. When Respondent-Applicant's mark is pronounced, the sound of Opposer's BURBERRY mark is practically replicated. Similarity of sound is sufficient ground to rule that two marks are confusingly similar when applied to merchandise of same descriptive properties. In fact, the Supreme Court has in many cases took into account the aural effects of the words and letters contained in the marks in determining the issue of confusing similarity. In *Marvex Commercial Co., Inc. v Petra Hawpia & Co., et al.*<sup>7</sup>, the Court held:

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, *Unfair Competition and Trade Marks*, 1947, Vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jass-Sea"; "Silver Flash" and "Supper Flash"; "Cascarete" and "Celborite"; "Celluloid" and "Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo." Leon Amdur, in his book "Trade-Mark Law and Practice," pp. 419-421, cites [sic], as coming within the purview of the idem sonans rule, "Yusea" and "U-C-A," "Steinway Pianos" and "Steinberg Pianos," and "Seven-Up" and "Lemon-Up." In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Condura" are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin," as the sound of the two names is almost the same.

<sup>5</sup> *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

<sup>6</sup> *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

<sup>7</sup> G.R. No. L-19297. December 22, 1966 cited in *McDonald's Corporation v. L.C. Big Mak Burger, Inc.*, G.R. No. 143993. August 18, 2004.

Significantly, Opposer's BURBERRY mark is a well-known mark. Rule 102 of the Trademark Regulations sets forth the following criteria in determining whether a mark is well-known:

RULE 102. *Criteria for determining whether a mark is well-known.* - In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

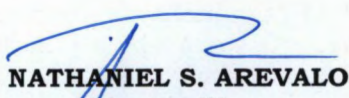
- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.

In this regard, any combination of the above-mentioned criteria may be taken into account to determine whether BURBERRY is a well-known mark. In this case, Opposer adduced evidence showing the registration of BURBERRY in several countries including the Philippines. Opposer submitted certificates of registration for BURBERRY issued in its favor, in the Philippines and in other countries. Opposer also presented evidence that BURBERRY is among the best global brands for many years. These evidence show the extent to which the Opposer has used, registered and promoted BURBERRY not only in the Philippines but also in other countries. These, therefore, is sufficient to considered BURBERRY as a well-known mark under the criteria provided above.

Accordingly, since Respondent-Applicant's mark is confusingly similar to the internationally well-known mark BURBERRY, its registration is proscribed by Sec. 123.1 (e) of the IP Code.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-013511, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

Taguig City. 03 MAY 2016

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