



FASHION ONE TELEVISION LLC,
Opposer,

-versus-

ELITE LICENSING COMPANY, S.A.,
Respondent- Applicant.

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IPC No. 14-2014-00162
Opposition to:
Appln. No. 4-2013-008622
Date Filed: 19 July 2013
TM: "ELITE FASHION
ACADEMY"

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NOTICE OF DECISION

ATTY. NELSON G. LEYCO
Counsel for the Opposer
One Hollywood Blvd., Bigfoot I.T. and Media Park
Mactan, Lapu lapu City, Cebu

CESAR C. CRUZ AND PARTNERS
Counsel for Respondent- Applicant
3001 Ayala Life-FGU Center
6811 Ayala Avenue, Makati City

GREETINGS:

Please be informed that Decision No. 2016 - 136 dated May 04, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 04, 2016.

For the Director:


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

FASHION ONE TELEVISION LLC,
Opposer,

-versus-

ELITE LICENSING COMPANY, S.A.
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IPC No. 14-2014-00162

Opposition to:
Serial No. 4-2013-008622
Date Filed: 19 July 2013
Trademark: **"ELITE FASHION
ACADEMY"**

Decision No. 2016- 136

DECISION

Fashion One Television LLC¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-008622. The contested application, filed by Elite Licensing Company, S.A.² ("Respondent-Applicant"), covers the mark "ELITE FASHION ACADEMY" for use on *"modelling, fashion styling and design, photography, video operator, post-production, hair stylist, make-up artist, digital fashion operator, trend & cool hunter, fashion editing, fashion communication, fashion events, fashion visual merchandising, image consultant, fashion english classes, preparation of beauty contest, acting and theatrical, all the above mentioned services in particular in relation to education, consulting, school, academies, entertainment and training services"* under Class 41 of the International Classification of Goods³.

The Opposer anchors its opposition on Section 123.1 (d), (e) and (g) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines. It alleges that it filed an application for registration of the mark "FASHION ONE" on 17 October 2013, with a claim of priority in view of its earlier application with the Russian Federation filed on 25 April 2013. It contends that the applied mark "FASHION @ YOUR FINGERTIPS" should be refused registration for being confusingly similar to its own mark. It emphasizes that its mark also covers programs for entertainment under Class 41. In support of its opposition, the Opposer submitted a copy of its application for registration of "FASHION ONE" mark with the Russian Federation and in this Office.⁴

A Notice to Answer was issued and served upon the Respondent-Applicant on 02 May 2014. The latter, however, did not file an Answer. Thus, on 13 April 2015, the Hearing Officer issued Order No. 2015-605 declaring the Respondent-Applicant in default and the case submitted for decision.

¹ With business address at 246 West Broadway, New York, NY 10013.

² With known address at 15, Route Des Arsenaux, Fribourg, 1700, Switzerland.

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.

⁴ Marked as Exhibits "A" and "B".

The issue to be resolved is whether the Respondent-Applicant's mark "ELITE FASHION ACADEMY" should be allowed registration.

The records show that at the time the Respondent-Applicant filed its trademark application on 23 May 2014, the Opposer already has a pending application of the mark "FASHION ONE" filed on 17 October 2013. The latter's mark is applied for use on "*television broadcasting*" and "*television programs for entertainment*" under Classes 35 and 41, respectively.

But are the competing marks, as shown below, confusingly similar?

FASHION ONE

Opposer's mark

ELITE FASHION ACADEMY

Respondent-Applicant's mark

A practical approach to the problem of similarity or dissimilarity is to go into the *whole* of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear" may be considered.⁵ Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

The only similarity between the two marks is the word "FASHION". Such similarity, however, is not sufficient to conclude that confusion is likely to occur. The said word is a common English word, which is usually associated with trends and styles. Entities dealing in anything connected to "FASHION" naturally tend to use the said word to give away the idea of the products and/or services they deal with. Thus, what will determine confusing similarity are the words and/or device that accompany the same. In this case, the word "ONE" follow "FASHION" in the Opposer's mark while that of the Respondent-Applicant's, the word "FASHION" is preceded by the word "ELITE" and followed by the disclaimed word "ACADEMY". They are clearly different visually, aurally and in connotation.

⁵ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

Noteworthy, the Trademark Registry of this Office reveals several other trademarks registered to different persons that employ the word "FASHION" in their marks for goods and/or services also under Class 41. These include "SCHOOL OF FASHION AND ARTS (SOFA)" under Certificate of Registration No. 4-2008-011643 issued on 09 February 2009, "STAR CREATION ASIA'S FASHION FUTURE" under Certificate of Registration No. 4-2010-005232 issued on 31 December 2010 and "FASHION INSTITUTE OF" under Certificate of Registration No. 4-2009-90039 issued on 17 June 2010. Hence, similarity in this aspect alone is not enough to prevent a junior user registration of its mark provided that the later mark is endowed with other distinguishing features and characteristics such as that of the Respondent-Applicant's.

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 In this case, the Respondent-Applicant's mark met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-008622 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 04 MAY 2016


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

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