

NELSON CHAN

Opposer

- versus -

CHEROKEE INC.

Respondent-Applicant

X-----X

IPC No. 14-2013-00282

Opposition to:

Appln. No. 4-2013-002928

Date Filed: 15 March 2013

TM: "CHEROKEE"

NOTICE OF DECISION

SIOSON SIOSON AND ASSOCIATES

Counsel for Opposer
Unit 903, AIC – Burgundy Empire Tower
ADB Avenue cor Garnet And Sapphire Roads
Ortigas Center, Pasig City


FEDERIS AND ASSOCIATES LAW OFFICES

Counsel for Respondent-Applicant
Suite 2004 and 2005, 88 Corporate Center
141 Valero cor. Sedeno Streets
Makati City

GREETINGS:

Please be informed that Decision No. 2016 - 284 dated August 15, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 15, 2016.


Atty. **Leonardo Oliver Limbo**
Adjudication Officer
Bureau of Legal Affairs

NELSON CHAN,
Opposer,

- versus -

CHEROKEE INC.,
Respondent·Applicant.

IPC NO. 14 – 2013 · 00282

Opposition to:
Appln Serial No. 42013002928

TM: “CHEROKEE”

DECISION NO. 2016 - 284

x-----x

D E C I S I O N

MR. NELSON CHAN (Opposer)¹ filed an Opposition to Trademark Application No. 42013002928. The application filed by CHEROKEE INC. (Respondent·Applicant)², covers the mark “CHEROKEE”, for use on “Soaps for facial and body use, cleaning preparations for facial use, cosmetic creams for beauty, cold creams, skin moisturizing creams, shrink water for cosmetic purpose, vanishing cremes, shaving cremes, hair rinse, lipsticks, rouge, cosmetics for leg use, eyebrow pencils, eyelash oils, nail varnish, suntan milks, perfumeries, and essential oils” covered under Class 3 of the International Classification of Goods.³

The Opposer based its Opposition on the following grounds:

1. The approval of application SN 4-2013-002928 is contrary to Sections 123.1 (d), 138, and 147 of the Republic Act No. 8293 or the IP Code.
2. The approval of Application SN 4-2013-002928 has caused and will continue to cause great and irreparable damage and injury to herein opposer.

The Opposer’s pertinent allegations are quoted as follows:

- "1. Opposer is a Filipino, of legal age, with business and postal address at 1318 Franco corner Moriones Streets, Tondo, Manila.
- "2. Opposer is the registered owner of the trademark “CHEROKEE” under Registration No. 037830 issued on

¹ A natural person with address at 1318 Franco cor. Moriones Streets, Tondo, Manila

² A corporation with address at Sepulveda Boulevard, Suite 600, Sherman Oaks, California 91411, U. S. A.

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

January 11, 1998, and renewed last January 11, 2008, for use on wallets; handkerchiefs; jeans, pants, slacks, shirts, polo, t-shirts, jackets, shorts, jogging pants, belts, briefs, socks falling under Classes 18, 24 and 25. x x x

- "3. Opposer is also the registered owner of the trademark 'CHEROKEE' under Registration No. 4-1993-087775 issued on March 11, 2006 for use on shoes, sandals, slippers, boots, handbags, overnight bags, travel bags, school bags, clutch bags, sweatshirts, suits, coats, neckties, vest, blouses, overcoats, topcoats falling under Classes 18 and 25 x x x.
- "4. The approval of opposer's Application SN 4-1993-087775 filed on August 30, 1993 and the issuance of Certificate of Registration No. 4-1993-087775 on March 11, 2006, came about after the opposition of respondent-applicant docketed as Inter Partes Case No. 14-2004-00162, was dismissed with finality on February 1, 2006. x x x
- "5. Opposer has not abandoned its registered trademark 'CHEROKEE' and both registrations under which it has been registered subsist up to the present. x x x
- "6. Likewise, submitted herewith are representative invoices of the company of opposer's wife (Private Labels, Inc.), as well as photographs of representative products bearing the trademark CHEROKEE x x x
- "7. Respondent-Applicant's mark "CHEROKEE", subject of Application SN 4-2013-002928 is identical and therefore, confusingly similar to opposer's registered trademark 'CHEROKEE.'
- "8. Being identical and therefore, confusingly similar to opposer's registered trademark 'CHEROKEE', approval of the registration in favor of respondent-applicant of the mark 'CHEROKEE', is contrary to section 123.1(d) of Republic act No. 8293 x x x
- "9. The approval of respondent-applicant's application violates the right of opposer to the exclusive use of its registered trademark 'CHEROKEE' on the goods listed in its certificates of registration (Exhibit "A" and "B") and those related thereto. x x x
- "10. In addition, approval of respondent-applicant's application violates Section 147 of the IP Code x x x
- "11. Finally, the approval of the application in question violates the right of opposer to the natural expansion of the coverage of his registered mark to other classes of goods closely related to goods falling under Classes 18, 24 and 25.

Accordingly, the approval of the application in question has caused and will continue to cause great and irreparable damage and injury to opposer.

To support its Opposition, the Opposer submitted the following as evidence:

Exhibit "A" – Certified Copy of the Certificate of Renewal of Registration No. 037830 issued on January 11, 1988 for the trademark "CHEROKEE";

Exhibit "A-1" – Copy of the original Certificate of Registration No. 37830 issued on January 11, 1988;

Exhibit "B" – Certified copy of Certificate of Registration No. 4-1993-087775 issued on March 11, 2006 for the trademark "CHEROKEE";

Exhibit "C" – Certified Copy of Notice of Order and Order No. 2006-10(D) promulgated on February 1, 2006 in IPC No. 14-2004-00162 entitled "Cherokee, Inc. vs. Nelson Chan";

Exhibit "C-1" – Certified Copy of the Entry of Judgment / Execution dated March 13, 2006 in IPC No. 14-2004-00162;

Exhibit "D", "D-1" to "D-4" – Affidavits of Use/Declarations of Actual Use filed with this Office on September 6, 1993, January 8, 1998, November 11, 2003, November 13, 2001 and March 7, 2012;

Exhibit "E", "E-1" to "E-24" – Copies of representative invoices of Private Labels, Inc., and photographs of products, bearing CHEROKEE trademark;

Exhibit "F" – Print-out of Respondent-Applicant's mark as published in the e-Gazette last January 3, 2013; and

Exhibit "G" – Duly notarized affidavit of opposer Nelson Chan.

This Bureau issued a Notice to Answer on 6 September 2013 and served a copy thereof to the Respondent-Applicant on 17 September 2013. However, the Respondent-Applicant did not file an Answer. In view thereof, an Order dated 6 January 2014 was issued declaring the Respondent-Applicant in default. On 21 January 2014, the Opposer compared the original copies of the Exhibits "A" to "E" to the attached copies submitted. Consequently, this case was submitted for decision.

The issue to be resolved in this case is whether the Respondent-Applicant should be allowed to register the trademark "CHEROKEE."

The instant Opposition is anchored on Section 123.1, paragraph (d), of the Intellectual Property Code of the Philippines (IP Code) which

provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such mark as to be likely to deceive or cause confusion.

A perusal of the records in the instant case show that the Opposer already has a prior and existing trademark registrations for the mark "CHEROKEE"⁴ when the Respondent – Applicant filed its application for similar wordmark "CHEROKEE" on 15 March 2013.⁵

The contending marks are depicted below for examination and comparison:

CHEROKEE

CHEROKEE

Respondent – Applicant's Mark

Opposer's Mark

Both parties use the distinct word "CHEROKEE" in an identical all capital font word mark. While the font types and styles are different, the differences are not substantial and at best negligible to the buying public. Moreover, this Bureau finds that, the goods covered by the two competing marks are closely related goods. The Respondent-Applicant's mark is being applied for use on *soaps, cosmetic creams, moisturizer, lipsticks, perfumes and essential oils* which are closely related to the goods of the Opposer being used for *wallets, handkerchiefs, jeans, pants, slacks, shirts, polo, belts, shoes, sandals, slippers, boots, handbags, travel bags, sweatshirts, suits, coats, neckties, vest, blouses, overcoats, and topcoats*. Verily, personal care products are often connected and very much associated with fashion and accessory goods. Both group of products are normally found and sold in the same store and trade channels. They are usually displayed side by side with each other. Furthermore, since the competing marks as shown above are identical, it is highly probable that consumers would think that both categories of goods are all came from one source, manufacturer or originator.

The Supreme Court has emphasized that a trademark is a distinctive mark of authenticity through which the merchandise of a particular producer or manufacturer may be distinguished from that of others, and its sole function is to designate distinctively the origin of the

⁴ Exhibit "A", "A-1" and "B"


⁵ Respondent-Applicant's Trademark Application documents

products to which it is attached.⁶ More importantly, the protection of trademarks as intellectual property is intended not only to preserve the goodwill and reputation of the business established on the goods bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods.⁷ Thus, under Section 123.1 of the IP Code, the registration of the Respondent-Applicant's trademark cannot be allowed.

WHEREFORE, premises considered, the instant Opposition to Trademark Application Serial No. 42013002928 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 42013002928 be returned together with a copy of this **DECISION** to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, **15 AUG 2016**


Leonardo Oliver Limbo
Adjudication Officer
Bureau of Legal Affairs

⁶ *Arce Sons and Co. vs. Selecta Biscuit et. al.*, G.R. L-14761, 28 January 1961 citing *Reynolds & Reynolds Co. vs. Nordic, et al.*, 114F 2d, 278

⁷ *McDonald's Corporation v. MacJoy Fastfood Corporation* 215 SCRA 316, 320 (1992); and *Chuanchow Soy & Canning Co. v. Dir. of Patents and Villapania*, 108 Phil. 833, 836 (1960).