

FASHION ONE TELEVISION LLC,
Opposer,

-versus-

HENRY C. UY,
Respondent- Applicant.

X-----X

}
} **IPC No. 14-2015-00202**
} Opposition to:
} Appln. Serial No. 4-2014-006528
} Date Filed: 23 May 2014
} **TM: "FASHION @ YOUR**
} **FINGERTIPS"**
}
}
}
}

NOTICE OF DECISION

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HENRY C. UY [PH]
Respondent-Applicant
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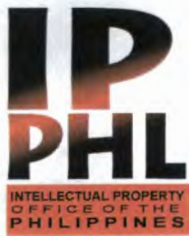
GREETINGS:

Please be informed that Decision No. 2016 - 113 dated April 11, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 11, 2016.

For the Director:

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



FASHION ONE TELEVISION LLC,
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-versus-

HENRY C. UY,
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IPC No. 14-2015-00202

Opposition to:

Serial No. 4-2014-006528

Date Filed: 23 May 2014

Trademark: **"FASHION @ YOUR
"FINGERTIPS"**

Decision No. 2016- 113

DECISION

Fashion One Television LLC¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2014-006528. The contested application, filed by Henry C. Uy² ("Respondent-Applicant"), covers the mark "FASHION @ YOUR FINGERTIPS" for use on *"wholesale and retail services specifically mail order services including but, are not limited to online services; general merchandise, import/export business"* under Class 35 of the International Classification of Goods³.

The Opposer anchors its opposition on Section 123.1 (d) 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 FIRST" on 11 October 2013. It contends that the applied mark "FASHION @ YOUR FINGERTIPS" should be refused registration for being confusingly similar to its own mark.

A Notice to Answer was issued and served upon the Respondent-Applicant on 09 July 2015. The latter, however, did not file an Answer. Thus, on 12 February 2016, the Hearing Officer issued Order No. 2016-296 declaring the Respondent-Applicant in default and the case submitted for decision.

The issue to be resolved is whether the Respondent-Applicant's mark "FASHION @ YOUR FNGERTIPS" 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 FIRST" filed on 11 October 2013.

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

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

² With office address at 119 P. Burgos Street, Sto. Niño, Marikina City.

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.

FASHION FIRST

Opposer's mark

FASHION @ YOUR FINGERTIPS

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.⁴ 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 "FIRST" follow "FASHION" in the Opposer's mark while that of the Respondent-Applicant's, the phrase "@ YOUR FINGERTIPS". They are clearly different visually, aurally and in connotation.

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 35. These include "MIXED FASHION TRENDS" under Certificate of Registration No. 4-2008-006259 issued on 02 March 2009, "FRESH GREEN FASHION" under Certificate of Registration No. 4-2009-04592 issued on 13 May 2010 and "FASHION AUTHORITY" under Certificate of Registration No. 4-2014-503349 issued on 02 July 2015. 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

⁴ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

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.⁵ 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. 4-2014-006528 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 11 April 2016.



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

⁵ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.