



GRANAROLO S.P.A.,  
Opposer,

-versus-

M/S DHARAMPAL SATYAPAL  
SONS PVT LTD.,  
Respondent- Applicant.

} IPC No. 14-2015-00106  
}  
} Opposition to:  
} Appln. Serial No. 4-2014-00009843  
} Date Filed: 06 August 2014  
} TM: "YOMIL"  
}  
}  
}  
}  
}  
}

x-----x

**NOTICE OF DECISION**

**CARAG JAMORA SOMERA & VILLAREAL  
LAW OFFICES**  
Counsel for Opposer  
2<sup>nd</sup> Floor The Plaza Royale  
120 L.P. Leviste Street, Salcedo Village  
Makati City

**KAPUNAN GARCIA & CASTILLO LAW OFFICES**  
Respondent- Applicant's Representative  
Units 301-306 32<sup>nd</sup> and fifth Building  
32<sup>nd</sup> Street corner 5<sup>th</sup> Avenue  
Bonifacio Global City, Taguig City

**GREETINGS:**

Please be informed that Decision No. 2016 - 91 dated March 31, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 31, 2016.

For the Director:

*Edwin Danilo A. Datang*  
**Atty. EDWIN DANILO A. DATANG**  
Director III  
Bureau of Legal Affairs

GRANAROLO S.P.A.,	}	IPC No. 14-2015-00106
Opposer,	}	Opposition to:
	}	
-versus-	}	Application No. 4-2014-00009843
	}	Date Filed: 06 August 2014
M/S DHARAMPAL SATYAPAL	}	
SONS PVT LTD.,	}	Trademark: YOMIL
Respondent-Applicant.	}	
x-----x		Decision No. 2016 - <u>91</u>

## DECISION

GRANAROLO S.P.A.<sup>1</sup> ("Opposer") filed a Notice of Opposition to Trademark Application No. 4-2014-00009843. The contested application, filed by M/S DHARAMPAL SATYAPAL SONS PTV LTD.<sup>2</sup> ("Respondent-Applicant"), covers the mark YOMIL for use on "*chewing gum (non-medicated), candy, sweets, confectionery items*" under Class 30 and "*beverages (aerated, flavoured, mineral water, soda), preparations for beverages*" under Class 32 of the International Classification of goods<sup>3</sup>.

The Opposer alleges, among other things, the following:

"9. Opposer is the owner of numerous trademark registrations/applications for registration for its YOMO and YOMINO marks x x x. In the Philippines, the Opposer was issued by this Honorable Office, particularly through the Bureau of Trademarks (BOT), Statement of Grants of Protection for the Philippine designations under the Madrid Regulations of the Opposer's marks, thereby rendering said marks as being registered on this Office's Trademarks Register, with the following details:

Mark	International Registration (IR) No.	IR Registration Date	Classes/Goods
1. YOMO	1183097	12/25/14	5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax;

1 A company organized by virtue of and under the laws of Italy, with a registered address at Via Cadriano 27/2, 40127 Bologna BO, Italy.  
 2 With address at 4828/24, Prahlad Lane, Ansari Road, Darya Ganj, New Delhi-110002, India.  
 3 Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral 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 the Registration of Marks concluded in 1957.



			<p>disinfectants; preparations for destroying vermin; fungicides, herbicides</p> <p>29: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products, edible oils and fats</p> <p>30: Sugar, rice, tapioca, sago; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey; treacle; yeast, baking-powder; mustard; vinegar, sauces (condiments); spices; ice</p> <p>32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices</p>
2. YOMINO	1206679	11/13/14	<p>5: Food for babies; milk ferments for pharmaceutical purposes; nutritional supplements</p> <p>29: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats</p> <p>30: Sugar, rice, tapioca, sago; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey; treacle; yeast, baking powder; mustard; vinegar, sauces (condiments); spices, ice</p>

"10. The Respondent's application for registration of its YOMIL mark chiefly contravenes Section 123.1 subparagraph (d) of Republic Act No. 8293 ("R. A. No. 8293" or the "IP Code"), that states, to wit: x x x

"11. Respondent-Applicant's mark so resembles the Opposer's marks, particularly in view of the presence in all marks of the letters "Y", "O", "M" and "I", as to be likely when applied to or used in connection with the Respondent-Applicant's goods, to deceive or cause confusion with those of Opposer's goods/lines of business bearing the Opposer's marks.

"12. The use by Respondent-Applicant of its YOMIL mark on goods that are similar, identical or closely related to the Opposer's goods that are produced by, originate from, offered by, or are under the sponsorship of herein Opposer bearing the latter's afore-featured marks, will greatly mislead the purchasing/consumer public into believing that Respondent-Applicant's goods are produced by, originate from, or are under the sponsorship of the Opposer.

"13. Opposer continues to use and has not abandoned the use in various countries around the world, including here in the Philippines, of its afore-featured marks.

"14. By virtue of the prior and continued use of the Opposer's marks in many countries around the globe made by herein Opposer, the said marks have become popular and internationally well-known ones. The Opposer's marks have established valuable goodwill for the Opposer with the purchasing/consumer public, which have identified Opposer as the owner and the source of goods and/or products bearing said Opposer's marks.

"15. In view of the foregoing, the Respondent's YOMIL mark may also be considered in contravention of Section 123.1 (e) of our IP Code, which states to wit:

"Sec. 123.1. *Registrability.* 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 sector 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. x x x"

In support of the Opposition, the Opposer alleges the following:



“(a) The Opposer is the true owner of the YOMIL and YOMINO marks for goods and/or products bearing said marks, which have been registered in the Opposer's name or are the subjects of applications for registration in many jurisdictions around the world. x x x

“(b) Opposer has been commercially using its aforesaid marks in its home country Italy, since at least as early as the year 1947 for the mark YOMO and 2011 for the mark YOMINO and commenced using said marks in the Philippines since 2015. The Opposer's rights over the marks YOMO and YOMINO in the Philippines precede the filing by Respondent-Applicant of its YOMIL application, with this Office's BOT.

“(c) Apart from Opposer being the originator of the YOMO and YOMINO marks used on the Opposer's goods and/or products/lines of business, which goods and/or products/lines of business have been marketed, promoted, distributed, offered for sale, sold in many jurisdictions around the world. Opposer manifests that to date, it had sold 15.7 million Euros' worth of products bearing or offered in connection with its YOMO and YOMINO marks.

“(d) In further support of Opposer's claim that its YOMO and YOMINO marks have gained international fame as ones belonging to the Opposer, the Opposer manifests that it has undertaken and made extensive publicity and promotions of its YOMO and YOMINO marks in internationally-circulated publications and exposure on television, on the Internet, and at world trade/food fairs/exhibitions, that have attracted a large following x x x. One can also log on to the website <http://www.granarolo.com/> to learn about the origins of the YOMO and YOMINO marks, its long history, the products bearing said mark.

“(e) All of the foregoing prove that Opposer's YOMO and YOMINO marks have gained international fame as belonging to herein Opposer, following Rule 102 of this Office's Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Container of Goods that provides for the criteria for determining whether a mark is well-known, as follows: x x x

“(f) In further support of the worldwide fame attained by the Opposer's YOMO mark, x x x is a copy of a Decision rendered by the Opposition Division of the OHIM in favor of herein Opposer in an Opposition case that it had lodged, to assert the Opposer's right over the YOMO mark.”

The Opposer's evidence consists of the following:

1. Statement of Grant of Protection issued by this Office's BOT in the Opposer's name for the mark YOMO with International Reg. (IR) No. 1183097 for Classes 5, 29, 30 and 32 goods;
2. Statement of Grant of Protection issued by this Office's BOT in the Opposer's name for the mark YOMINO with IR No. 1206679 for Classes 5, 29 and 30 goods;

3. Original of a signed, notarized and legalized Affidavit of Opposer's witness, Ms. Sara Pasqualetti, Proxy Holder;
4. List of all of the trademark registrations for the Opposer's YOMO and YOMINO marks;
5. WIPO IR No. 1183097 for YOMO;
6. WIPO IR No. 622899 for YOMO & Device;
7. WIPO IR No. 1206679 for YOMINO (logo);
8. Certified copy of Canadian Trademark Registration No. TMA 529555 for YOMO & Device;
9. Certified copy of UK Trade Mark No. UK00001570196 for YOMO & Device;
10. CTM Reg. No. 9786658 for YOMO;
11. CTM Reg. No. 9786708 for YOMO & Device;
12. CTM Reg. No. 4358164 for YOMO & Device;
13. CTM Reg. No. 4358611 for YOMO & Device;
14. CTM Reg. No. 6900922 for YOMO 100% NATURALE;
15. CTM Reg. No. 6901037 for YOMO 100% NATURALE & Device;
16. CTM Reg. No. 8822264 for YOMO 100% NATURALE GRASSI & Device;
17. CTM Reg. No. 8704652 for YOMO 100% NATURALE GOLOSO & Device;
18. CTM Reg. No. 8822355 for YOMO 100% NATURALE GOLOSO & Device;
19. CTM Reg. No. 8995474 for YOMO 100% NATURALE GOLOSO & Device;
20. CTM Reg. No. 8822439 for YOMO 100% NATURALE & Device;
21. CTM Reg. No. 8822521 for YOMO 100% NATURALE & Device;
22. CTM Reg. No. 7441728 for YOMO 100% NATURALE SUPERFRUTTI & Device;
23. CTM Reg. No. 7441851 for YOMO 100% NATURALE SUPERFRUTTI & Device;
24. CTM Reg. No. 8821548 for YOMO 100% NATURALE SUPERFRUTTI & Device;
25. CTM Reg. No. 8945834 for YOMO 100% NATURALE RINFORZO & Device;
26. CTM Reg. No. 8945784 for YOMO 100% NATURALE RINFORZO & Device;
27. CTM Reg. No. 5159843 for YOMO DI STAGIONE & Device;
28. CTM Reg. No. 5159851 for YOMO DI STAGIONE & Device;
29. CTM Reg. No. 11477437 for YOMO GO 100% NATURALE & Device;
30. CTM Reg. No. 10967859 for YOMINO 100% NATURALE & Device;
31. CTM Reg. No. 12090114 for YOMINO DJ LO YOGURT DA MIXARE & Device;
32. CTM Reg. No. 10967891 for YOMINO (logo);
33. Certified copy of Italian Reg. No. 1239505 for YOMO;
34. Certified copy of Italian Reg. No. 1590797 for YOMO & Device;
35. Certified copy of Italian Reg. No. 0001476170;
36. Documents relating to the Opposer's participation in the trade fair that took place in Shanghai, China in November 2013 and April 2014 and in Beijing in 2014;
37. Printouts taken from the website <http://www.worldoffoodbeijing.com/> concerning the WORLD OF FOOD trade fair in Beijing 2014, including the home page, the brochure, the analysis of visitors and the list of Exhibitors;
38. Copies of advertising materials relating to the YOMO mark and printouts from the webpages [www.yomo.it](http://www.yomo.it) and [www.granarolo.i](http://www.granarolo.i) ;
39. Copies of printouts from the website [www.granarolo.com](http://www.granarolo.com) showing the participation of the Opposer in various trade fairs in Asia and Australia and relevant press releases; and



40. Copy of Decision rendered by the Opposition Division of the OHIM in favor of herein Opposer.<sup>4</sup>

This Bureau issued and served a copy of the Notice to Answer upon the Respondent-Applicant on 06 May 2015. The Respondent-Applicant, however, failed to file its Answer. Thus, Order No. 2015-1105 was issued on 31 July 2015 declaring the Respondent-Applicant in default. Hence, this case is now submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark YOMIL?

The Opposer anchored its opposition on Section 123.1 (d) and (e) of R. A. No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"), which provides that a mark cannot be registered if it:

(d) is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) the same goods or services, or
- (ii) closely related goods or services, or
- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion; 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 sector 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; x x x

In this regard, the records and evidence show that at the time the Respondent-Applicant filed its trademark application on 06 August 2014, the Opposer has already filed on 28 March 2014 under the Madrid Regulations designating the Philippines as a contracting party for the grant of protection for the marks YOMO and YOMINO. The marks YOMO and YOMINO were both granted protection in the Philippines on 25 December 2014 and 13 November 2014, respectively. The Opposer's marks indicate goods under Classes 5, 29, 30 and 32.

But do the marks, as shown below, resemble each other such that confusion or even deception is likely to occur?

---

<sup>4</sup> Marked as Exhibits "A" to "NN".



Opposer's Marks

YOMIL

Respondent-Applicant's Mark

The letters "Y", "O", "M" and "I" in the Respondent-Applicant's YOMIL mark are exactly the same as the Opposer's YOMINO. The Opposer's marks end with letters "N" and "O" while the Respondent-Applicant's with letter "L". This slight difference in the spelling, however, is inconsequential and will not negate the possibility of confusion. More so, when the marks are used on similar or related goods such as the Respondent-Applicant's *"chewing gum, candy, sweets, confectionery items; beverages (aerated, flavoured, mineral water, soda), preparations for beverages"* and the Opposer's *"sugar, rice, tapioca, sago, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, mustard, vinegar, sauces (condiments), spices; beers, mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices"*, among other goods, both falling under Classes 30 and 32.

As ruled by the Supreme Court, confusion cannot be avoided by merely dropping, adding or changing some of the 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> It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court.<sup>6</sup>

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

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

<sup>6</sup> *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987

A handwritten signature in blue ink, appearing to be 'AZ', is located in the bottom right corner of the page.



Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code. As to the Opposer's claim that YOMO and YOMINO are well-known marks, the same must fail, for failure to satisfy a combination of the criteria provided for under Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Container of Goods.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-00009843 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 31 March 2016.

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