

INDUSTRIA DE DISEÑO TEXTILE, S.A.,  
Opposer,

-versus-

CAI YIREN,  
Respondent - Applicant.

x-----x

} IPC No. 14-2009-00274  
} Opposition to:  
} Appln. No. 4-2006-013845  
} Date Filed: 22 December 2006  
} TM: "AISHA AND DESIGN  
} with CHINESE CHARACTERS"

**NOTICE OF DECISION**

**VERALAW (Del Rosario Raboca Gonzales Grasparil)**  
Counsel for the Opposer  
2<sup>nd</sup> Floor, A & V Crystal Tower  
105 Esteban Street, Legaspi Village  
Makati City

**CAI YIREN**  
Respondent- Applicant  
Unit 2007 Chinatown Steel Towers  
Asuncion-San Nicolas Streets  
Binondo, Manila

**GREETINGS:**

Please be informed that Decision No. 2016 - 261 dated July 26, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 26, 2016.

For the Director:

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

<b>INDUSTRIA DE DISENTO TEXTILE, S.A.,</b>	} <b>IPC NO. 4-2009-00274</b>
Opposer,	} Opposition to:
	}
-versus-	} Appln. Ser. No. 4-2006-013845
	} Date Filed: 22 December 2006
	}
<b>CAI YIREN,</b>	} Trademark: <b>"AISHA and DESIGN</b>
Respondent-Applicant.	} <b>with CHINESE CHARACTERS"</b>
	}
x-----x	} Decision No. 2016- <b>261</b>

**DECISION**

INDUSTRIA DE DISENTO TEXTILE, S.A. (Opposer)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2006-013845. The application, filed by CAI YIREN, (Respondent-Applicant)<sup>2</sup>, covers the mark "AISHA and DESIGN with CHINESE CHARACTERS", for use on "handkerchief, bedsheet, towels, curtains and blankets" under Class 24 and "t-shirts, shirts, blouses, pants, slacks, jeans, polo, polo shirts, shorts, skirts, men's underwear and women's underwear" under Class 25 of the International Classification of Goods<sup>3</sup>.

The Opposer relies on the following grounds for its opposition:

"12. Opposer is the leader in the apparel industry and is in fact ranked by 'Business Week' in the ninth place in its 'World's best Companies of 2009'. Opposer is also the owner of the mark 'OYSHO'.

"13. Opposer's mark, 'OYSHO' is well known not only in the Philippines but also abroad, as shown by the following circumstances.

"14. First, Said mark is registered in the Philippines under Registration No. 4-2006-004390 for goods under Classes 3, 9, 14, 18, 21, 24, 25, 26 and 35.

<sup>1</sup> A corporation organized and existing under the laws of Spain with office address at Avenida de la Diputacion, Edificio Inditex, 15142 Arteixo, A Coruna, Spain

<sup>2</sup> A Chinese citizen with address at Unit 2007 Chinatown Steel Towers, Asuncion – San Nicolas St., Binondo, Manila

<sup>3</sup> 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.

“15. ‘OYSHO’ is likewise registered and/or pending application in various countries around the world. More specifically in at least one hundred and eight (108) countries and jurisdiction, namely Albania, Andorra, Angola, Antigua & Barbuda, Argelia, Argentina, Armenia, Azerbaijan, Bahrain, Bangladesh, Belarus, Bhutan, Bosnia-Herzegovina, Brasil, British Virgin Islands, Bulgaria, Cambodia, Canada, Chile, China, Colombia, Costa Rica, Croatia, Cuba, Cyprus, Czech Republic, Dominican Republic, Egypt, El Salvador, Estonia, European Union, Georgia, Guatemala, Honduras, Hong Kong, Hungary, Iceland, India, Indonesia, Israel, Japan, Jordan, Kazakhstan, Kenya, Kuwait, Krygstan, Laos, Latvia, Lebanon, Lesotho, Liberia, Liechtenstein, Lithuania, macau, Macedonia, Madagascar, Malaysia, Malta, Mauritius, Mexico, Moldavia, Monaco, Mongolia, Montenegro, Morocco, Mozambique, Nicaragua, North Korea, Norway, Oman, Pakistan, Panama, Paraguay, Peru, Philippines, Poland, Puerto Rico, Qatar Romania, Russia, San Marino, Saudi Arabia, Serbia, Sierra Leone, Singapore, Slovakia, Slovenia, South Africa, Spain, Sri Lanka, Sudan, Swaziland, Switzerland, Syria, Taiwan, Tajikstan, Thailand, Tunisia, Turkey, Turkmenistan, U.A.E., Ukraine, Uruguay, U.S.A., Uzbekistan, Venezuela and Vietnam.

“16. Opposer has likewise spent substantial sums in promoting the mark ‘OYSHO’

2009	249,649 Euros (as of September 2009)
2008	178,156 Euros
2007	139,050 Euros
2006	101,666 Euros

“17. Opposer likewise maintains several websites where information about ‘OYSHO’ are accessible around the world, including the following:

<http://www.oysho.com/en/>  
[http://www.inditex.com/en/who we are/concepts/oysho](http://www.inditex.com/en/who_we_are/concepts/oysho)  
<http://www.oysho.com/es/>

“18. Since its launch the ‘OYSHO’ marks popularity has grown exponentially. There are currently three hundred eighty six (386) ‘OYSHO’ stores spread across twenty three (23) countries around the world.

“19. Because of Opposer’s efforts, the mark ‘OYSHO’ has become one of the world’s most recognized name in the apparel industry and one of the most profitable member of the Industria de Disensio Textil, S.A. group. As a matter of fact, the annual net turn over for ‘OYSHO’ during the periods 2002 to 2005 amounted 247.2 million Euros. xxx”

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

1. Special Power of Attorney dated 9 November 2009;
2. Verification and Certification Against Forum Shopping dated 17 November 2009;
3. Print-out of E-Gazette showing publication of trademark application ;
4. Print –out of IPO Website showing registrations of “OYSHO” mark; **D**
5. List of registrations and pending applications of “OYSHO” mark abroad;
6. Print-out of articles about “OYSHO” published online; and
7. Affidavit of Antonio Abril Abadin dated 9 November 2009<sup>4</sup>

This Bureau served upon the Respondent-Applicant a “Notice to Answer” on 28 January 2010. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark AISHA AND DESIGN WITH CHINESE CHARACTERS?

Sec. 123.1. Registrability. 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.

The records show that when the Respondent-Applicant filed its application on 22 December 2006, the Opposer already has an existing registrations for the trademark OYSHO under Certificate of Registration No. 4-2006-004390<sup>5</sup> issued on 26 April 2006 covering goods under Class 24 namely, “textiles and textile goods, not included in other classes, bed and table covers, both linen (except clothing), tissues of textile removing make-up, lingerie fabric, washing mitts, wall hanging of textile, handkerchiefs of textile, curtains of textile or plastic, household lines, towels of textile, travelling rugs (lap robes), eiderdowns, covers for furniture, covers for cushions, mattress covers, pillow shams, mosquito nets, glass cloth, towels, billiard cloth, traced cloths for embroidery, upholstery fabrics, face towels of textile, sleeping bags (sheeting)” and goods under Class 25 namely, “clothing for men, women and children, bathing suits, bathing caps and sandals, wet suits for water skiing, undergarments, etc.”. The Respondent-Applicant’s trademark application therefore indicates goods that are identical/similar and/or closely related to those covered by the Opposer’s trademark registration.

But are the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

Opposer’s mark

Respondent-Applicant’s mark

<sup>4</sup> Exhibits “A” to “G” inclusive of submarkings

<sup>5</sup> Exhibit “D”

OYSHO

AI (爱莎) HA

Both marks consist of two syllables. When pronounced, the marks can hardly be distinguished from one another. The ears will find it difficult to distinguish between "OY" and "AI". In the same vein, "SHO" is practically the same sound as "SHA". The Supreme Court in the case of *Marvex Commercial Co., Inv. V. Petra Hawpia & Co.* and the Director of Patents<sup>6</sup> is instructive on the matter, to wit:

Two letters of "SALONPAS" are missing in "LIONPAS"; the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance (*Co Tiong Sa vs. Director of Patents*, 95 Phil. 1 citing *Nims, The Law of Unfair Competition and Trademarks*, 4th ed., vol. 2, pp. 678-679). xxx

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 "Jazz-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 "TradeMark Law and Practice", pp. 419-421, cites, 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 "Cordura" 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.

In the case at bar, "SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (see *Celanese Corporation of America vs. E. I. Du Pont*, 154 F. 2d. 146, 148).

Succinctly, the public interest, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is immaterial that Respondent-Applicant employed a stylized letter "S" and Chinese Characters in her mark because when pronounced, AISHA and OYSHO are the same. Opposer has shown that it has numerous registrations and trademark applications worldwide<sup>7</sup> on goods that are similar/identical to the goods upon which she intends to use her mark. It is emphasized that the function of a trademark is to point out distinctly the origin or ownership of the goods to which it is

<sup>6</sup> G.R. No. L-19297, 22 December 1966


<sup>7</sup> Exhibit "D"

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>8</sup> Under Section 123.1. of the IP Code, a mark cannot be registered if it is identical with a registered mark in respect of the same goods or closely related goods or if it nearly resembles such mark, as to be likely to deceive or cause confusion.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2006-013845 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 26 JUL 2016.

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

---

<sup>8</sup>*Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).