

**NEW BARBIZON FASHION, INC.,**  
*Opposer,*

**-versus-**

**YUP IN SHI,**  
*Respondent-Applicant.*

X-----X

**IPC No. 14-2013-00059**  
Opposition to:

Appln. Serial No. 4-2012-010109  
Date Filed: 17 August 2012

**TM: MONALIZA SERIES**  
**(IN STYLIZED FORM)**

**NOTICE OF DECISION**

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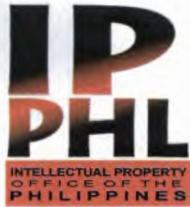
**YUP IN SHI**  
*Respondent- Applicant*  
c/o NELSON TAN  
P.O. Box 2329 Manila Central Post

**GREETINGS:**

Please be informed that Decision No. 2016 - 302 dated 05 September, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 05 September 2016.

**Atty. GINALYN S. BADIOLA**  
Adjudication Officer  
Bureau of Legal Affairs



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IPC No. 14-2013-00059  
Opposition to:

Appln. No. 4-2012-010109  
Date Filed: 17 August 2012  
Trademark: **"MONALIZA SERIES  
(IN STYLIZED FORM)"**

Decision No. 2016 - 302

### DECISION

NEW BARBIZON FASHION, INC. ("Opposer"),<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2012-010109. The application, filed by YUP IN SHI ("Respondent-Applicant"),<sup>2</sup> covers the mark "MONALIZA SERIES (IN STYLIZED FORM)" for use on goods under class 03<sup>3</sup>, namely: *eye shadow, lotion, shampoo and perfume.*

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The Opposer alleges the following grounds for the opposition:

"1. Opposer is the first to adopt, use, apply for registration and register the 'MONA LISA' trademark in the Philippines, for several goods including ladies' undergarments and underwear, and therefore enjoys under Section 147 of Republic Act (R.A.) No. 8293 the right to exclude others from registering or using an identical or confusingly similar mark such as Respondent-Applicant's 'MONALIZA SERIES (IN STYLIZED FORM)' mark for similar and/or related goods, i.e., ladies' cosmetic products.

"2. The 'MONALIZA SERIES (IN STYLIZED FORM)' mark nearly resembles the 'MONA LISA' trademark owned by Opposer, in sound, spelling appearance, and connotation as to be likely to deceive or cause confusion as contemplated under Section 123(d), R.A. 8293.

"3. The Opposer's 'MONA LISA' trademark, used among others, for ladies' undergarments and underwear, is well-known in the Philippines, taking into account the knowledge of the relevant sector of the public, as being trademarks owned by Opposer hence, Respondent-Applicant's 'MONALIZA SERIES (IN STYLIZED FORM)' mark cannot be registered in the Philippines pursuant to the express provision of Section 123(e) of R.A. No. 8293.

"4. The Respondent-Applicant, in adopting 'MONALIZA SERIES (IN STYLIZED FORM)' mark for ladies, cosmetic products, is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association with the Opposer, or as to origin, sponsorship, or approval of its goods by the Opposer, for which it is liable for false designation of origin; false description or representation under Section 169 of R.A. No. 8293.

<sup>1</sup> A corporation duly organized and existing under the laws of the Philippines with business address at 401 VFP-MDC Bldg. 2 Veterans Road, Veterans Center, Taguig City.

<sup>2</sup> With registered address at 490 Jaboneros St., San Nicolas, Metro Manila.

<sup>3</sup> The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

"5. It is reasonable to assume that Opposer may expand its business in producing cosmetic products, inasmuch as it already produces ladies' fashion products. Here, though the goods covered under Respondent-Applicant's 'MONALIZA SERIES (STYLIZED FORM)' mark and Opposer's 'MONA LISA' trademark belong to different classes, Respondent-Applicant's products is such as might reasonably be assumed to originate with Opposer, and the public would then be deceived either into that belief or into the belief that there is some connection between Opposer and Respondent-Applicant which, in fact, does not exist."

The Opposer's evidence consists of the following:

1. Print-out details of Application No. 4-2010-010249 for MONALIZA under Class 03;
2. Certificate of Registration Nos. 35291 and 43854 for MONA LISA;
3. Print-out copy of E-Gazette publication of Application No. 4-2012-010109 for MONALIZA SERIES (Stylized Form);
4. Certificate of Registration No. 4-2010-500102 for MONA LISA AND LIP DEVICE;
6. Various advertisements in billboards, posters, transit advertising, website and newspapers in the Philippines;
7. Sales and shares in Philippine market; and,
8. Affidavit of Irish Hazel G. Manaois.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 19 April 2013. Respondent-Applicant however, did not file an answer. Thus, in Order No. 2015-1043 dated 21 July 2015, Respondent-Applicant is declared in default and this case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark MONALIZA SERIES (IN STYLIZED FORM)?

As culled from the records and evidence, the Opposer has valid and existing registration for its marks "MONA LISA" and MONA LISA AND LIP DEVICE", under the following registration numbers: 35291, 43864<sup>4</sup> and 4-2010-500102<sup>5</sup>, all for class 25, even before the former's application filing date. In the Philippines, a certificate of registration constitutes a prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.<sup>6</sup>

On the other hand, Respondent-Applicant filed its application for the trademark "MONALIZA SERIES (IN STYLIZED FORM)" on 17 August 2012.<sup>7</sup>

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

*Mona Lisa*

*Mona Lisa*

mona lisa

Opposer's Trademarks

<sup>4</sup> Annexes "B" and "C" of Exhibit "B" of Opposer.

<sup>5</sup> Annex "H" of Exhibit "B" of Opposer.

<sup>6</sup> Sec. 138, IP Code.

<sup>7</sup> Filewrapper records.



Respondent-Applicant's Trademark

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.<sup>8</sup> 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 eyes can easily see that the marks are different. While the similarity in the competing marks manifest in most of the letters composing the marks, except for the letter "s" in "MONA LISA" which is changed to letter "z" in "MONALIZA", such resemblance is not sufficient to conclude that confusion is likely to occur. The font used and the visual appearance of separating MONA from LISA or LIZA make the marks easily distinguishable to each other.

Moreover, confusion or mistake, much less deception, is unlikely in this instance because the goods or service covered by Opposer's trademark registration are far different from that of the Respondent-Applicant's. The Opposer's brand covers class 25; while the Respondent-Applicant's goods consist of goods under class 03. The parties' respective goods/service are not related because they do not exactly flow in the same channels of trade or target the same market as to result to any confusion.

Corollarily, the enunciation of the Supreme Court in the case of *Mighty Corporation vs. E. & J. Gallo Winery*<sup>9</sup> aptly states that:

"A very important circumstance though is whether there exists likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the source of the goods in question. The 'purchaser' is not the 'completely unwary consumer' but is the 'ordinarily intelligent buyer' considering the type of product involved. he is 'accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The situation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

<sup>8</sup> *Etepha A.G. vs. Director of Patents*, G.R. No. L-20635, 31 March 1966.

<sup>9</sup> G.R. No. 154342, 14 July 2004.

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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.<sup>10</sup> This Bureau finds that the Respondent-Applicant's mark meets this function.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-010109 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **05 SEP 2016**



**Atty. GINALYN S. BADIOLA**  
*Adjudication Officer, Bureau of Legal Affairs*

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<sup>10</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.