

DEL SOL, L.C.,
Opposer,

-versus-

LINDSEY DIAHNN L. TAN,
Respondent- Applicant.

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IPC No. 14-2011-00386
Opposition to:
Appln. Serial No. 4-2010-001090
Date Filed: February 01, 2010
TM: "DEL SOL AND LOGO"

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NOTICE OF DECISION

JDF LAW
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Bonifacio Global City
Taguig, Metro Manila

LINDSEY DIAHNN L. TAN
Respondent- Applicant
146 Congressional Avenue
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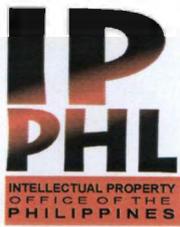
GREETINGS:

Please be informed that Decision No. 2016 - 412 dated November 15, 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, November 16, 2016.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



DEL SOL, L.C.,

IPC NO. 14 – 2011 - 00386

Opposer,

- versus -

**Opposition to:
TM Application No. 4-2010-001090
TM: “DEL SOL AND LOGO”**

LINDSEY DIAHNN L. TAN,

Respondent -Applicant.

DECISION NO. 2016 - 412

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D E C I S I O N

DEL SOL, L.C., (Opposer)¹ filed an Opposition to Trademark Application No. 42010001090. The application filed by LINDSEY DIAHNN L. TAN (Respondent-Applicant)², covers the mark “DEL SOL AND LOGO”, for use on *“Nail Polishes, Sun Glasses, Tote Bags, Plastic Key Chains, Adult Tees, Beachwear Tops, Polos, Board Shorts, Flip Flops, Hats, Visors, Hair Clips, Plastic Hair Accessories”* covered under Classes 3, 9, 18, 20, 25, and 26 of the International Classification of Goods.³

The Opposer based its Opposition on the following grounds:

1. Opposer is the prior adopter, user and owner of the mark “DEL SOL” and “DEL SOL WITH DESIGN” in the United States of America and elsewhere around the world.
2. Respondent-Applicant’s “DEL SOL AND LOGO” is identical and confusingly similar with Opposer’s marks “DEL SOL”, “DEL SOL WITH DESIGN” trademarks.
3. Opposer’s marks “DEL SOL” and “DEL SOL with DESIGN” are internationally well-known.

¹ A corporation organized and existing under the laws of the State of Utah, United States of America (U.S.A.) with principal address at 280 West 10200 South Sandy Utah 84070, U.S.A.

² A natural person with address at 149 Congressional Avenue, Project 8, Quezon City

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.

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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4. Since Opposer's "DEL SOL" and "DEL SOL WITH DESIGN" trademarks are internationally well-known, they are entitled to the protection against confusingly similar marks covering similar or related goods and/or services.

The Petitioner submitted the following evidence:

Exhibit "A" - Secretary's Certificate of the Resolution appointing JDF Law as Attorney-in-Fact;

Exhibits "B" to "B-7" - Affidavit of Mr. Brent Rowser dated 3 August 2011;

Exhibits "B-9" to B-158" - Print copies of the products being traded by the Opposer;

Exhibits "B-160" to "B-192" - Table of the Trademark Applicationa and Registrations of the Opposer for the DEL SOL trademark;

Exhibits "B-194" to "B-352" - Copies of the Opposer's Certificate of Trademark Registrations for the DEL SOL marks;

Exhibits "B-357" to "B-497" - Copies of the Opposer's Brochures and Hand-outs;

Exhibit "B-499" - Table of the Sales of the Opposer for the years 2001 to 2010;

Exhibits "B-501" to "510" - Photos of the Opposer products and packaging;

Exhibit "C" to "C-5" - Affidavit of Mr. Brent Rowser dated 8 August 2011; and

Exhibit "C-7" to "C-9" - Certified True Copies of the Certificate of Registration of Trademark Del Sol from US Patent and Trademark Office.

This Bureau issued a Notice to Answer dated 16 September 2011 and served to Respondent-Applicant on 23 September 2011. However, the Respondent-Applicant did not file an Answer to the Opposition. In view of thereof, an Order declaring the Respondent-Applicant to have waived its right to file the Answer was issued on 8 February 2012. Consequently, the instant case was deemed submitted for decision.

The issue to be resolved in this case is whether the trademark "DEL SOL AND LOGO" covered by Trademark Registration No. 4-2010-001090 should be allowed for registration.

The competing marks are reproduced below for comparison:



Respondent-Applicant's
Trademark

Opposer's Trademark⁴

While there may be difference in the color combinations, the two marks are essentially identical. Both trademark have the words "DEL" and "SOL" in a similar font type with the same distinguishing design of a sun inside a box at the middle of the two words.

The records also show that Respondent-Applicant's trademark application indicates that the mark is to be used for similar goods with that of the Opposer.⁵ No doubt, the possibility that the consumer will be deceived or will commit the mistake of inter-changing the respondent-applicant's products with the products of the opposer's is high. Thus, there is a necessity to determine who between the contending parties own the subject mark.

The function of 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.⁶ Moreover, 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

From the records of the instant case, the Opposer has shown that it has been using the trademark "DEL SOL" and "DEL SOL WITH DESIGN" as early as 1994 and in fact successfully registered the said mark under the name of Opposer, in a number of countries, earliest of

⁴ Exhibit "B-334" and "B-337"

⁵ Respondent-Applicant's Application for Registration; Exhibit "B-9" to "B-158" and "B-356" to "B-510"

⁶ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508 19 Nov. 1999

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).

which was on 8 December 2005.⁸ In contrast, respondent-applicant application for the registration of the same identical mark was only on 1 February 2010. The Respondent-Applicant did not present any evidence showing other registration or commercial use prior to its application or before the first use of the Opposer. The Respondent-Applicant did not rebut the evidence submitted by the Opposer and she failed to give any proof that will show that she is the originator of the identical mark.

The Supreme Court has consistently held that “a trademark, being a special property, is afforded protection by law. But for one to enjoy this legal protection, ownership of the trademark should rightly be established.”⁹ Corollarily, it is not the application or the registration that vests ownership, but it is the ownership of the mark that confers the right to register the same.¹⁰ Succinctly, only the true owner of a trademark should be allowed to apply for its registration.

Definitely, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of design available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another’s mark if there was no intent to take advantage of the goodwill generated by the other mark.¹¹ This is especially true in the instant case, wherein the competing marks including the unique design and devices are the same. Thus, for having failed to prove his right to register the contested identical trademark, Respondent-Applicant’s application for registration of the trademark “DEL SOL AND LOGO” must not be allowed.

WHEREFORE, premises considered, the instant Opposition to Trademark Application Serial No. 42010001090 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 42010001090 be returned together with a copy of this DECISION to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 15 NOV 2016


Leonardo Oliver Limbo
Adjudication Officer
Bureau of Legal Affairs

⁸ Exhibit “B-160” to “B-352”

⁹ *Berris Agricultural Co. Inc. vs. Norvy Abyadang* G.R. 183404, 13 October 2010

¹⁰ *Birkenstock Orthopaedie GMBH and Co. KG vs. Philippine Shoe Expo Marketing Corporation, G. R. No. 194307, November 20, 2013*

¹¹ *American Wire & Cable Company vs. Dir. Of Patent*, G.R. No. L-26557, February 18, 1970.