

MARIA GENE L. TAN,
Opposer,

-versus-

SUYEN CORPORATION,
Respondent-Applicant.

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IPC No. 14-2012-00538

Opposition to:

Appln. Serial No. 4-2012-009891

Date Filed: 13 August 2012

TM: B LOGO AND DEVICE

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 422 dated 24 November 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 the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 24 November 2016.

MARILYN F. RETUAL
IPRS IV

Bureau of Legal Affairs

MARIA GENE L. TAN,

Opposer,

-versus-

SUYEN CORPORATION,

Respondent-Applicant.

X -----X

IPC No. 14-2012-00538

Opposition to Trademark

Application No. 4-2012-009891

Date Filed: 13 August 2012

Trademark: **"B LOGO AND DEVICE"**

Decision No. 2016- 422

DECISION

Maria Gene L. Tan¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-009891. The contested application, filed by Suyen Corporation² ("Respondent-Applicant"), covers the mark "B LOGO AND DEVICE" for use on *"personal care, beauty and cosmetic products, namely: body spray; deodorants (body spray, roll-on and stick); cologne / eau de toilette; perfume / eau de parfum; hand and body lotions; face, hand and body creams; skin moisturizer; sunscreen / sun block; talcum powder; facial cleanser; facial moisturizer; astringent; shampoo; hair conditioner; hair styling gel; hair spray gel; hair mousse; bath beads; shower gel; liquid soap; bath soap; liquid hand soap; moisturizing soap; hand and body wash; massage oil; mineral spray; lipstick; make-up; nail care preparations; nail polish; false nails; eyebrow cosmetics; air & linen mist, alcohol for personal care and hygiene purposes, band aid, wipes for personal care and hygiene purposes", "hand sanitizer; hand sanitizer spray, band aid; alcohol for medical and sanitary purposes; wipes for medical and sanitary purposes", "leather goods such as bags, wallets, belts, attache case, stirrups; purses; umbrellas", "clothing, namely, shirts, t-shirts, undershirts, sandos, long sleeves, coats, jackets, sweaters, sweatshirts, pant, slacks, jeans, shorts, sport shorts, jogging pants, briefs, swimming trunks, bathing suits, dresses, skirts, blouses, blazers, shawl, scarves, cardigans, brassieres, panties, half slips, under wears, pajamas, belts, socks, neckties; wristbands, sleepwear, pajamas; footwear, namely, shoes, slippers, boots, sandals, topsiders; headgear, namely, hats, caps and visors" and "boutiques; retail stores; wholesale outlets" under Classes 03, 05, 18, 25 and 35, respectively, of the International Classification of Goods³.*

The Opposer alleges, among others, that she is the registered owner of the trademarks "STYLIZED B" under Certificate of Registration No. 4-2008-008605 issued on 22 December 2008 and "BALENO AND DEVICE (Consisting of Stylized

¹ A Filipino, of legal age, with residence and postal address at No. 218 Mayon Street, Quezon City.

² A corporation duly organized and existing under Philippine law with offices located at Bench Tower, 30th Street, corner Rizal Drive, Crescent Park West 5, Bonifacio Global City, 1634 Taguig 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.

Letter B)" under Certificate of Registration No. 4-2007-013242 issued on 12 May 2008. She contends that the Respondent-Applicant's mark is confusingly similar with her registered marks and that the goods covered by the latter's application, particularly those under Classes 18 and 25, are identical to and/or closely related to those covered by her registrations. In support of her opposition, the Opposer submitted the following:⁴

1. certified copies of the above-mentioned registrations;
2. certified copies of the Declarations of Actual Use ("DAU");
3. representative sales invoices of Cadilac Shirt Manufacturing, a sole proprietorship registered in the name of the Opposer's husband, Julius Caesar Tan;
4. representative products bearing her registered marks;
5. printout of the Respondent-Applicant's mark as published; and
6. the Opposer's affidavit.

The Respondent-Applicant filed its Answer alleging, among other, that it has long been manufacturing, marketing advertising, distributing and selling clothing apparel in the Philippines under its trademark "BENCH". In 1987, "BENCH" offered men's t-shirts. Since then, "BENCH" expanded to a complete range of apparel and lifestyle products. It claims to have grown to an unparalleled rate by being in the use of celebrity endorsers, television and giant billboards to propel a fashion brand that offers quality products at affordable prices. Its other brands include "HUMAN", "KASHIECA", "FIX BENCH SALON", "T-STUDIO" "DIMENSIONE", "PCX" and "BE CONNECTED". It has also been recognized numerous times by local and international award-giving bodies for its performance in different industries and disciplines.

According to the Respondent-Applicant, it is the owner of several "BENCH" registrations in the Philippines. It has used the marks on different goods and has exerted substantial efforts and has spent substantial amounts in promoting the same. Sometime in 2012, as part of its overall marketing and promotions campaign for its "BENCH" trademarks and products, it developed a brand that attaches to or may be easily recalled with its marks and developed the mark "B LOGO AND DEVICE". On January 2013, it launched a new marketing campaign featuring the applied mark to further promote the "BENCH" brand. It contends that the applied mark is not confusingly similar with the Opposer's registered marks. The Respondent-Applicant's evidence consists of the affidavit of its General Manager, Jude W. Ong, with annexes.⁵

⁴ Marked as Exhibits "A" to "G", inclusive.

⁵ Marked as Exhibits "1" to "10", inclusive.

Pursuant to Office Order No. 154, s. 2010, the case was referred to mediation. The parties, however, failed to settle amicably. Accordingly, the Hearing Officer conducted a preliminary conference and the same was terminated on 16 October 2013. Thereafter, the parties submitted their respective position papers. After which, the case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark "B LOGO AND DEVICE"?

Section 123.1 (d) of the R.A. No 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") 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; xxx"

Records reveal that at the time the Respondent-Applicant filed the contested application on 13 August 2012, the Opposer has valid and existing registrations for "STYLIZED B" under Certificate of Registration No. 4-2008-008605 issued on 22 December 2008 and "BALENO" under Certificate of Registration No. 4-2007-013242 issued on 12 May 2008.

Perusing the competing marks, as reproduced below,



B BALENO

Opposer's marks

MS



Respondent-Applicant's mark

it can be gleaned that they are differently presented and distinguishable from each other. The Opposer's marks are composed of the letter "B", either alone or in conjunction with the word "BALENO". The said letter is styled in a way that it looks enclosed in a square or box. On the other hand, the Respondent-Applicant's mark consists of a blocked letter "B", completely shaded, with the word "BENCH/" at the lower right portion thereof. The only similarity between the competing marks is the use of the letter "B". Just like any other letter of the alphabet, no person or entity can claim exclusive use thereof. The only reason the marks are allowed registration is the fanciful presentations of the logos. Since the styles or presentation of the competing marks are distinct from each other, there is no likelihood of confusion between the marks.

Noteworthy, the Trademark Registry shows other marks appropriating the letter "B" registered to other proprietors also for goods under Classes 18 and/or 25, including:



Reg. No. 4-2011-011400



Reg. No. 4-2016-000176



Reg. No. 1194663




Reg. No. 4-2013-001358

Finally, it is emphasized that 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 The Respondent-Applicant's sufficiently met this function.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-009891 is hereby **DISMISSED**. 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, **24 NOV 2016**


Atty. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

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