

GA MODEFINE S.A.,
Opposer,

-versus-

MARILOU O. CHUA,
Respondent-Applicant.

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}	IPC No. 14-2015-00369
}	Opposition to:
}	Appln. Serial No. 4-2006-007634
}	Date Filed: 14 July 2006
}	
}	
}	TM: HARMAN JEANS & DEVICE

NOTICE OF DECISION

ORTEGA DEL CASTILLO BACORRO
ODULIO CALMA & CARBONELL
Counsel for Opposer
No. 140 L.P. Leviste Street,
Legaspi Village, Makati City

CRISTINA FRANCISCO
Respondent- Applicant's Agent
1515 Union Street, Paco
Manila

GREETINGS:

Please be informed that Decision No. 2016 - 525 dated 23 December 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, 06 January 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

GA MODEFINE S.A.,
Petitioner,

-versus-

MARILOU O. CHUA,
Respondent-Applicant .

} **IPC NO. 14-2015-00369**

} Opposition to:

}

} Application Serial No. 14-2006-007634

} Filing date: 14 July 2006

}

} Trademark: **HARMAN JEANS
& DEVICE**

x-----x} Decision No. 2016- **525**

DECISION

GA MODEFINE S.A., (Opposer)¹ filed an Opposition to application serial number 14-2006-007634. The application, in the name of **GA MODEFINE S.A.** (Respondent-Applicant)², covers the mark “**HARMAN JEANS & DEVICE**”, for use on “shirts and jeans (pants)” under class 25 of the International Classification of Goods³.

The Opposer relies on the following grounds in support of the opposition:

“1. Pursuant to Section 123 (d) of R.A. 8293 otherwise known as the Intellectual Property Code (‘IP Code’), respondent-applicant’s **HARMAN JEANS AND DEVICE** cannot be registered.

“1.1. Section 123 (d) of the Code reads as follows:

‘Sec. 123. Registrability. 123.1 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.

¹ A corporation duly organized and existing under the laws of the United States of America with business address at 11 Wall St. New York, N.Y. 10005, USA

² Filipino with address at 2418 R. Fernandez St., Gagalangin, Tondo Manila

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.

"1.2. The trademark HARMAN JEANS AND DEVICE nearly resembles Opposer's registered trademarks GIORGIO ARMANI, EMPORIO ARMANI, ARMANI EXCHANGE, and A/X ARMANI EXCHANGE as to be likely to cause confusion.

"1.2.1. The trademark HARMAN JEANS AND DEVICE is unquestionably similar, and confusingly so, to the above mentioned family of 'ARMANI' trademarks. It will be noted that the common and dominant element among the foregoing trademarks of oppose is the word 'ARMANI'.

"1.2.2. HARMAN resembles ARMANI in terms of spelling and pronunciation. In fact, when pronounced, 'HARMAN JEANS' sounds almost exactly like 'ARMANI JEANS'.

"1.3. Not only is the trademark HARMAN JEANS AND DEVICE confusingly similar to the above mentioned registered trademarks of oppose, it is also used for goods in class 25 like opposer's trademarks.

Hence, under Section 123 (d) (iii) of the Code, the trademark HARMAN JEANS & DEVICE is not entitled to registration.

"2. Under Section 123 (e) of the Code, a trademark which is confusingly similar to an internationally well-known mark and which is used for identical or similar goods cannot be registered. xxx

"2.2. AJ ARMANI JEANS and AJ, respectively, are the subject of trademark applications filed on 2 February 2007 and pending before this Honorable Office.

"2.2.1. The trademark HARMAN JEANS &DEVICE subject of the present opposition is even more confusingly similar to opposer's trademarks AJ ARMANI and AJ in terms of spelling , composition, pronunciation and over-all impression.

"2.2.2. In terms of spelling and word composition, HARMAN JEANS & DEVICE is confusingly similar to AJ ARMANI JEANS and AJ. The device element of the trademark consists of the letters 'HJ' , which obviously stand for 'HARMAN JEANS', just as the letters 'AJ' stand for 'ARMANI JEANS'. xxx

"3. Out of the multitude of words, symbols and concepts, respondent-applicant chose to adopt the trademark HARMAN JEANS & DEVICE to designate goods in class 25, thereby demonstrating its manifest intent to ride on the popularity of opposer's family of ARMANI trademarks, especially the AJ ARMANI JEANS and AJ trademarks and to capitalize on the goodwill associated with such trademarks. xxx

"4. Due to the obvious similarities between HARMAN JEANS &DEVICE and Opposer's trademarks, namely GIORGIO ARMANI, EMPORIO ARMANI, ARMANI EXCHANGE, A/X ARMANI EXCHANGE. AJ ARMANI JEANS and AJ in terms of spelling, composition and over-all impression, respondent-applicant's use of the trademark HARMAN JEANS & DEVICE is likely to mislead the public into believing that respondent-applicant's class 25 goods are

related to opposer's goods or conversely, that opposer's goods came from the respondent-applicant.

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

1. Certified true copies of certificate of registration for the marks "GIORGIO ARMANI"; "EMPORIO ARMANI"; "ARMANI EXCHANGE"; and "A/X ARMANI EXCHANGE";
2. Excerpt from trademark database of IPO;
3. List of registrations and applications for ARMANI marks in other jurisdictions; and
4. Pictures of products bearing the "ARMANI" mark⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 21 September 2015. The Respondent-Applicant, however, did not file an Answer. The Bureau issued on 4 May 2016 an order declaring the Respondent-Applicant in default.

Should the Respondent-Applicant's trademark "HARMAN JEANS AND DEVICE" be registered?

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

Opposer's mark

Respondent-Applicant's mark



The Respondent-Applicant's mark appropriates five letters, A-R-M-A-N from Opposer's mark "ARMANI", differing only in the addition of the letter H and deletion of the letter I. These modifications are negligible because as seen from their presentation in block style, the marks are visually alike. More importantly, when pronounced, the letter "H" in the mark HARMAN, is hardly perceptible. When the word HARMAN is spoken, it sounds phonetically the same as ARMANI.

The Supreme Court in the case of Marvex Commercial Co., Inv. V. Petra Hawpia & Co. and the Director of Patents⁵, is instructive on the matter of confusingly similar marks, it held:

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 special

⁴ Exhibit "A" inclusive of submarkings

⁵ G.R. No. L-19297, 22 December 1966

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).

The records show that when the Respondent-Applicant filed her application on 14 July 2006, the Opposer already had existing registrations for the trademarks⁶ namely: GIORGIO ARMANI under Certificate of Registration No. 38154 issued on 12 February 1988 covering goods under Class 25, namely: "clothing articles for men and women, in particular suits, and dresses, jackets, cloaks, coats, overcoats, trousers, tailleurs, waistcoats, manties, skirts, shirts, scarves, foulards, ties, neckerchiefs, belts and footwear". EMPORIO ARMANI under Reg. No. 59454 for goods in Class 25, namely: "underwear, hoisery, petticoats, night gowns, pajamas, pullovers, dressing gowns, bathrobes, gloves, cardigans, hats, caps, ties, foulards, scarves, sweaters, socks, stockings, trousersa, skirts, jackets, jerkins, shirts, vests, jumpers, shorts, t-shirts, panties, sweat shirts, suits and dresses, overcoats, cloaks, etc." ; ARMANI EXCHANGE under Reg. No. 4-1997-120653 issued on 24 August 2003 for goods under Class 25, namely: "underwear ... jeans, pants, bermuda shorts etc."; A/X ARMANI EXCHANGE under Reg. No. 4-2001-006864 for good under Class 25, namely: "clothing...shirts, t-shirts, sweat pants, half length pants, pullovers, jeans..etc " The Respondent-Applicant uses her mark on goods under Class 25, that are similar or closely related to the Opposer's,

Succinctly, because the Respondent-Applicant uses her mark on goods that are similar or closely related to the Opposer's it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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

⁶ Exhibit "A"; Annex "A"- "E"

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.⁷

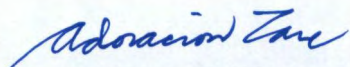
The public interest, therefore, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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.⁸

The Respondent-Applicant despite the opportunity given, did not file an Answer in order to defend her trademark application and explain how she arrived at using a mark that is practically identical/confusingly similar to the Opposer's registered mark.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2006-007634 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, 23 DEC 2016


Atty. ADORACION U. ZARE, LL.M.
Adjudication Officer
Bureau of Legal Affairs

⁷*Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

⁸*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).