

SUYEN CORPORATION,
Opposer,

-versus-

RAMON S. UY, JR.,
Respondent- Applicant.

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}
} IPC No. 14-2013-00378
} Opposition to:
} Appln. Serial No. 4-2013-00001162
} Date Filed: 4 February 2013
} TM: "FRESHSTART
} ORGANICS"

NOTICE OF DECISION

MIGALLOS AND LUNA LAW OFFICES

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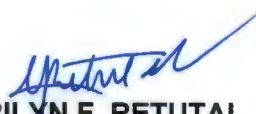
RAMON S. UY, JR.
Respondent- Applicant
Santa Veronica St., Santa Clara Subdivision
Bacolod City, Negros Occidental

GREETINGS:

Please be informed that Decision No. 2016 - 478 dated December 20, 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, December 23, 2016.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

SUYEN CORPORATION,
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-versus-

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} **IPC NO. 14-2013-00378**

} Opposition to:

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} Appln. Ser. No. 4-2013-00001162

} Date Filed: 4 February 2013

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} Trademark: **FRESHSTART
ORGANICS**

} Decision No. 2016- **478**

DECISION

SUYEN CORPORATION, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2013-00001162. The application, filed by RAMON S. UY, JR., (Respondent-Applicant)², covers the mark “FRESHSTART ORGANICS”, for use on “personal care products, namely all-natural soaps, natural body scrubs, natural lip balm, natural hand sanitizer, natural mouthwash, natural massage oil, natural burner oil, natural room spray, all-purpose cleaner for cleaning purposes” under class 3 and “natural repellants for personal use (original, lemon, eucalyptus, lavender)” under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the ground that it will be damaged by the registration of the mark “FRESHSTART ORGANICS”, which is identical and confusingly similar to Opposer’s registered trademark. According to the Opposer, Respondent-Applicant’s mark will mislead the public into believing that the products bearing the said mark are the products marketed and sold by the Opposer, that originate from the same source. The Opposer contends that it has exclusive rights to own and use the trademark FRESH START for goods under class 3 and Respondent-Applicant’s mark may be used as a tool for unfair competition.

The Opposer alleges the following facts:

“2.1 Suyen was incorporated in 1985 as a manufacturing company dealing in clothing apparel, garments and accessories. At present, Suyen manufactures, distributes, markets and sells apparel and lifestyle products carrying different brands and trademarks, including its flagship BENCH.

¹ A domestic corporation duly organized and existing under Philippine laws with principal address at Bench Tower, 30th St. corner Rizal Drive, Crescent Park West 5, Bonifacio Global City, Taguig

² Filipino with address at Sta. Veronica St., Sta. Clara Subdivision, Bacolod 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.

Suyen continues to make its mark a leading lifestyle retailer in the Philippines and in the region.

“2.2 When BENCH started in 1987, it initially offered only men’s t-shirts. Since then, Suyen has expanded its business to a complete range of apparel and lifestyle products. The company now provides baby care, fix hair care, organics and personal care products, as well as underwear, fragrances, houseware, snacks, and other lifestyle products for men and women under different brands and trademarks, with the distinction of being present in virtually every retail space in the Philippines and with a worldwide network of stores and outlets, reaching as far as the United States, the Middle East, and China.

“2.3 Suyen grew and continues to grow at an unparalleled rate by being the pioneer in the use of celebrity endorsers, television and giant billboards to propel fashion brands that offer premium and quality products at affordable prices. Other popular and successful brands owned by Suyen include ‘HUMAN’, ‘KASHIECA’, ‘FIX BENCH SALON’, ‘DIMENSIONE’, ‘PCX’, ‘FIRST AID’, and ‘BE CONNECTED’, among others.

“2.4. Suyen, together with its sister companies, has successfully penetrated even the service industry. Suyen now provides services in connection with the internet café industry, furniture industry, beauty salon and skin care industry. At present, Suyen has over 900 stores in the Philippines alone, which include franchises of foreign brands. Suyen-owned and operated stores outside the Philippines have also continuously grown. At present, Suyen has more than 80 stores outside the Philippines, which include the U.S.A. xxx

“2.10 On 28 November 2008, Suyen launched the 'BENCH DAILY SCENTS,' a collection of colognes classified into six (6) different fragrances which combines a variety of scents for both men and women. The success of the Bench Daily Scents was overwhelming.

“2.11 On 1 October 2010, Suyen introduced a sub-collection called the 'BENCH DAILY SPELL'. It is a special collection of body sprays which highlights the use of fragrance oils imported from Grasse, France - the world's capital of perfume'. It was developed to cater to teenagers and young adults. The Bench Daily Spell includes the fragrances: 'CLEAN FUN, 'FRESH START', 'HIGH NOON', 'MORNING RUSH,' and 'PARTY TIME'.

“2.12 The mark 'FRESH START' was adopted and used by Suyen to identify a variant of its Daily Spell body mist collection which combines both a floral and fruity fragrance. Suyen first used the 'FRESH START' trademark in October 2010, and since then has continuously used the said mark. xxx”

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

1. Affidavit of Dale Gerard G. Dela Cruz dated 4 November 2013;
2. Certified copy of Certificate of Registration No. 4-2010-005483 for the mark "FRESHSTART" for goods under class 3, namely "body spray, body mist, splash cologne, eau de toilette, deo body spray, talcum powder, hand and body lotion";
3. Pictures of products with the marks, "BENCH" "DAILY SPELL" and "FRESH START";
4. Pictures of advertising and promotional materials;
5. Print-out of pages of website showing BENCH DAILY SPELL products including "FRESH START"; and
6. Print-out of pages of website showing "FRESH START ORGANICS" product advertising⁴.

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 13 January 2014. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 17 October 2014 Order No. 2014-1381 declaring the Respondent-Applicant to have waived its right to file an Answer.

Should the Respondent-Applicant be allowed to register the trademark FRESHSTART ORGANICS?

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.⁵ Thus, Sec. 123.1 (d) of 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 is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

Records show that at the time Respondent-Applicant applied for registration of the mark "FRESH START ORGANICS", (the words, FRESH and ORGANICS are disclaimed) the Opposer already registered the mark "FRESH START" under certificate of Registration No. 4-2010-005483⁶ issued on 7 July 2011. The goods covered by the Opposer's trademark registrations are under Class 03, while the Respondent-Applicant's trademark applications are for goods under Classes 3 and 5.

⁴ Exhibits "A" to "J", inclusive of submarkings

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.

⁶ Exhibit "B"

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

FRESH START

Respondent-Applicant's mark

**FRESH START
ORGANICS**

Opposer and Respondent-Applicant's marks are similar in so far as the words "FRESH START" in Respondent-Applicant's mark is exactly identical to Opposer's mark. As such when applied to goods such as "body spray, body mist, splash cologne, eau de toilette, deo body spray, talcum powder, hand and body lotion" under class 3, there is some likelihood of confusion. However, this Bureau finds that the presence of the words "FRESH START" in both marks are insufficient to establish a finding of confusing similarity between the computing marks to sustain the opposition, when applied to different goods. As such, Respondent-Applicant may use the mark "FRESH START ORGANICS" on "natural repellants for personal use (original, lemon, eucalyptus, lavender)" under Class 5, that are products remote to "body spray, body mist, splash cologne, eau de toilette, deo body spray, talcum powder, hand and body lotion", confusion is unlikely. A consumer intent on buying, natural repellants for personal use (original, lemon, eucalyptus, lavender) will not be confused by buying Opposer's products, namely "body spray, body mist, splash cologne, eau de toilette, deo body spray, talcum powder, hand and body lotion" instead. Besides, the brand name BENCH and DAILY SPELL are strategically placed to highlight its branded products.

A perusal of the contending marks when applied to the goods, show that they are presented in distinct and individually unique way. As seen from a photograph⁷ of Opposer's goods, as it appears below:

⁷ Exhibit "C"-4



the Opposer's flagship brand is "BENCH". As explained by Opposer, it introduced a sub-collection of special body sprays with fragrance oils imported from France. This special collection is known as "DAILY SPELL" of which "Fresh Start" is a variant. The others variants in the collection are 'CLEAN FUN, 'HIGH NOON', 'MORNING RUSH,' and 'PARTY TIME'. The words "DAILY SPELL" are presented in big, bold, block type white letters against a red background and the mark, "Fresh Start" is written in smaller font. Below these is the main or flagship brand, "BENCH". On the other hand, Respondent-Applicant's mark is portrayed in this manner as seen from pictures of its webpage:

Exhibit "J"



Exhibit "J"-10



The mark "FRESH START ORGANICS" is depicted with a representation of a flower on top of the letter "t". The marks are shown on products such as citronella mosquito insect repellent, and salad greens. The background color is white/pink, green and aqua blue in the other containers. The over-all appearance of the marks when attached to the goods are not confusingly similar.

In determining similarity and likelihood of confusion, case law has developed the Dominancy Test and the Holistic or Totality Test. The Dominancy Test focuses on the similarity of the dominant features of the competing trademarks that might cause confusion, mistake, and deception in the mind of the ordinary purchaser, and gives more consideration to the aural and visual impressions created by the marks on the buyers of goods, giving little weight to factors like prices, quality, sales outlets, and market segments. In contrast, the Holistic or Totality Test considers the entirety of the marks as applied to the products, including the labels and packaging, and focuses not only on the predominant words but also on the other features appearing on both labels to determine whether one is confusingly similar to the other as to mislead the ordinary purchaser. The "ordinary purchaser" refers to one "accustomed to buy, and therefore to some extent familiar with, the goods in question."

Irrespective of both tests, the Court finds no confusing similarity between the subject marks. While both marks use the shape of a shark, the Court noted distinct visual and aural differences between them.⁸

Moreover, in the recent case of Taiwan Kolin Corporation, Ltd. v. Kolin Electronics Co., Inc.⁹, the Supreme Court held:

⁸ *Great White Shark Enterprises, Inc. v. Danilo M. Caralde*, G.R. No. 192294, 21 November 2012

⁹ G.R. No. 209843, 25 March 2015

For a clearer perspective and as a matter of record, the following image on the left is the trademark applied for by petitioner, while the image juxtaposed to its right is the trademark registered by respondent: xxx

While both competing marks refer to the word 'KOLIN' written in upper case letters and in bold font, the Court at once notes the distinct visual and aural differences between them: Kolin Electronics' mark is italicized and colored black while that of Taiwan Kolin is white in pantone red color background. The differing features between the two, though they may appear minimal, are sufficient to distinguish one brand from the other. xxx

Consistent with the above ruling, this Court finds that the differences between the two marks, subtle as they may be, are sufficient to prevent any confusion that may ensue should petitioner's trademark application be granted. xxx"

Aside from the fact that the marks have different commercial impressions, Section 138 of the IP Code states:

A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of 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.

Preceding therefrom, Opposer's trademark protection for the mark, "FRESH START" is limited to "body spray, body mist, splash cologne, eau de toilette, deo body spray, talcum powder, hand and body lotion" under Class 3. The Respondent-Applicant's mark is also applied on different goods under class 5, namely "natural repellants for personal use (original, lemon, eucalyptus, lavender)", which are goods not related thereto and specified in Opposer's trademark registration. The Opposer's exclusive right to the mark "FRESH START" does not encompass these goods which are of a different nature that serve a specific purpose as repellants.

The Supreme Court in the case of *Philippine Refining v. Ng Sam*¹⁰ held that:

A rudimentary precept in trademark protection is that "the right to a trademark is a limited one, in the sense that others may use the same mark on unrelated goods." Thus, as pronounced by the United States Supreme Court in the case of *American Foundries vs. Robertson*, "the mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description."

Such restricted right over a trademark is likewise reflected in our Trademark law. Under Section 4(d) of the law, registration of a trademark which so resembles another already registered or in use should be denied, where to allow such registration could likely result in confusion, mistake or deception to the consumers. Conversely, where no confusion is likely to arise, as in this case, registration of a similar or even identical mark may be allowed.

Thus, confusion is unlikely if identical marks are applied on unrelated goods.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2013-00001162 covering goods under Class 03, is hereby

¹⁰ G.R. No. L-26676, 30 July 1982

SUSTAINED. Insofar as Respondent-Applicant's "natural repellants for personal use (original, lemon, eucalyptus, lavender)" under class 5, the instant opposition to Trademark Application No. 4-2013-00001162, is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 20 DEC 2016



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