

SUYEN CORPORATION,
Opposer,

-versus-

RISHI N. MIRANI,
Respondent-Applicant.

X-----X

IPC No. 14-2013-00163

Opposition to:

Appln. Serial No. 4-2012-009695

Date Filed: 08 June 2012

TM: BC LONDON

NOTICE OF DECISION

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RISHI N. MIRANI

Respondent- Applicant
Kampri Building
2254 Don Chino Roces Avenue,
Makati City

GREETINGS:

Please be informed that Decision No. 2017 - 53 dated 23 February 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHEL 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 February 2017.

MARILYN F. RETUAL

IPRS IV

Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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DECISION

SUYEN CORPORATION¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-009695. The application, filed by RISHI N. MIRANI² ("Respondent-Applicant"), covers the mark "BC LONDON" for use on "*fashion accessories, namely: necklace, bracelet, earrings, ring, set jewelry, fancy jewelry, watches, bangles, charms, cuffs, chokers, brooch*" under Class 14; "*fashion accessories, namely: belts, bags, beads*" under Class 18; "*clothing, namely: sportswear and casual wear for men, women and children, specifically shirts, t-shirts, jogging suits, trousers, jeans, shorts, tank tops, rainwear, cloth bibs, skirts, blouses, polos, dresses, suspenders, sweaters, jacket, coats, raincoats, ties, robes, hats, caps, sunvisors, belts, scarves, sleepwear, pajamas, lingerie, underwear, socks, swimwear, pants, shirts, polo shirts, jumpers, children tops and bottoms, round neck t-shirts, shoes, boots, sandals, women shoes, sneakers, overshoes, clogs & tongs*" under Class 25; and "*hair accessories, namely: headband, ribbon, hair pins, hair clips, pony tail, hair stick, hair claw, hair barrette, 3 pong hair forks, hair clamps, bobby pins, banana pins, bun holder, ponytail holder and point pins*" under Class 26 of the International Classification of Goods.³

The Opposer alleges the following grounds:

"A. Opposer Suyen will be damaged by the registration of the mark covered by the questioned application. The said mark is identical to and confusingly similar with Opposer's trademark. The said mark will also mislead the public into believing that the products bearing the said mark are the same products marketed and sold by the Opposer or that the goods originated from the same source.

"B. The mark of the Respondent-Applicant may and will be used as an instrument of unfair competition.

"C. The application for registration of the mark 'BC LONDON' is of doubtful nature. The said application appears to be a spurious one and should not be allowed."

¹ A domestic corporation with address at Bench Tower, 30th Street corner Rizal Drive, Crescent Park West 5, Bonifacio Global City, Taguig.

² A Filipino resident with KAMPRI Bldg., 2254 Don Chino Roces Avenue, Makati City.

³The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

Opposer's evidence consists of the following:

1. Exhibit "A" - Affidavit of Mr. Dale Gerald G. Dela Cruz;
2. Exhibits "B" - List of registration and applications for the Bench Trademarks;
3. Exhibits "C" - copy of Application Serial No. 4-2009-001196 for the mark BC BENCH;
4. Exhibits "D" - printout of the details of registration of the mark BC Bench downloaded from IPOPHL Trademark Database;
5. Exhibits "E" - photograph of BC Bench products;
6. Exhibits "F" and sub markings - sample promotional materials that have been posted in the market;
7. Exhibits "G" and sub markings - advertisement of BC Bench in various newspapers;
8. Exhibit "H" - certified true copy of the Declaration of Actual Use for BC Bench;
9. Exhibit "I" - copy of Application Serial No. 4-2012-013003 for the mark BC BENCH/COLLECTION INSIDE A SQUARE DEVICE for Class 14;
10. Exhibit "J" - Certified copy of Application Serial No. 4-2012-013004 for the mark BC;
11. Exhibit "K" - printout of the details of registration for the mark BC BENCH/COLLECTION INSIDE A SQUARE DEVICE downloaded from IPOPHL Trademark Database;
12. Exhibits "L" - Copy of the Registrability Report of the examiner for the mark BC;
13. Exhibits "M" - Response Letter to the Registrability Report for the mark BC;
14. Exhibits "N" and sub markings - printout of relevant pages of www.bcl58.co.uk;
15. Exhibit "O" - Copy of the search result for various applications of marks filed by Respondent-Applicant;
16. Exhibit "P" - copy of the Articles of Incorporation of Vogue Concepts, Inc.; and
17. Exhibit "Q" - copy of the New Trends International Corp.

This Bureau issued on 10 June 2013 a Notice to Answer and served a copy thereof to the Respondent-Applicant on 14 June 2013. Despite receipt of the notice, Respondent-Applicant failed to file the answer. Hence, the case is now deemed submitted for resolution.

Should Respondent-Applicant's mark BC LONDON be allowed registration?

Section 123.1 (d) of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines", as amended, provides for the grounds for registration of a mark, to wit:

Section 123.Registrability. - 123.1. A mark cannot be registered if it:

x x x

(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;

Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, or resembles a well-known mark, said mark cannot be registered.

Records will show that at the time Respondent-Applicant filed his trademark application for BC LONDON, Opposer already has an existing registration for BC BENCH COLLECTION INSIDE A SQUARE DEVICE and BC BENCH COLLECTION issued in 2009 and 2013, respectively. In 2016, Opposer was also able to register its mark BC. As such, pursuant to Section 138 of the IP Code, being a holder of a certificate of registration, such "certificate of registration is a prima facie evidence of the registrant's ownership of the mark, and of the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto."

But are the marks of the parties confusingly similar as to likely cause confusion, mistake or deception on the part of the buying public?

The marks of the parties are herein reproduced for comparison:

BC



Opposer's Marks

BC LONDON

Respondent-Applicant's Mark

A scrutiny of the marks of the competing parties would show that they both contain the letters "BC". "BC" is Opposer's mark itself. It is also the distinctive feature of its BC BENCH mark variants. On the other hand, Respondent-Applicant's mark consists of the letters "BC" and



the word LONDON. However, it is worth to note that the Respondent-Applicant disclaimed the word "LONDON". A disclaimer indicates that a registrant or applicant does not claim an exclusive right to the specified element(s) of the mark by itself. It also enables the registration of a mark that is registrable as a whole, but contains matter that would not be registrable by itself. As such, with the disclaimer, Respondent-Applicant seeks exclusive use of the word "BC" and how the composite mark appears as a whole. Since the mark BC and BC Bench variants have already been exclusively appropriated through registration by Opposer, the allowance of registration of Respondent-Applicant's BC LONDON mark will likely cause confusion, mistake or deception to the public, into believing that BC LONDON is just a variant of Opposer's mark or that the goods of Respondent-Applicant is manufactured, sourced or originated from Opposer or vice versa.

Indeed, confusion cannot be avoided by merely adding, removing or changing some letters or words of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other⁴. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article⁵.

The determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.⁶ The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:⁷

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

Moreover, the goods upon which the competing marks are used are closely related or

⁴ See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

⁵ See *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

⁶ See *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

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

competing. Respondent-Applicant's mark is being applied for use on "watches", among others goods that have been indicated in his application. Opposer's "BC" and "BC/Bench Collection" trademarks are used on "wristwatches; watches; watch straps; watch bands; watch chains; watch cases". Because their goods are closely related or competing to each other, the likelihood that the consumers would be mistaken, confused or deceived into believing that the goods come from the same source or origin is more apparent.

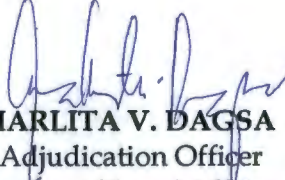
The protection of trademarks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trademark is a merchandising shortcut, which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, due aim is the same -- to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trademark owner has something of value. If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress.⁸

Thus, the registration of Respondent-Applicant's BC LONDON mark is proscribed under Section 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant Opposition is hereby *SUSTAINED*. Let the filewrapper of Trademark Application Serial No. 4-2012-009695 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 FEB 2017


MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs

⁸ *Societe Des Produits Nestle, Et. Al. vs. Court of Appeals. G.R. No. 112012. April 4, 2001*