

SUYEN CORPORATION and FUTURE STATE, INC., }
Opposers, }

-versus-

HITACHI SYSTEMS, LTD., }
Respondent-Applicant. }

IPC No. 14-2014-00218
Opposition to:

Appln. Serial No. 1177634
Date Filed: 26 April 2013

TM: HUMAN IT

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NOTICE OF DECISION

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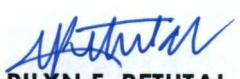
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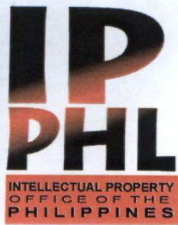
GREETINGS:

Please be informed that Decision No. 2017 - 165 dated 22 May 2017 (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, 23 May 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



**SUYEN CORPORATION and
FUTURE STATE, INC.,**
Opposers,

IPC No. 14-2014-00218
Opposition to:

- versus -

Appln. No. 1177634
Date Filed: 26 April 2013
Trademark: "**Human*IT**"

HITACHI SYSTEMS, LTD.,
Respondent-Applicant.

Decision No. 2017 - 165

X-----X

DECISION

SUYEN CORPORATION¹ and FUTURE STATE, INC.² ("Opposers"), filed an opposition to Trademark Application Serial No. 1177634. The application, filed by HITACHI SYSTEMS, LTD. ("Respondent-Applicant")³, covers the mark "Human*IT" for use on the following classes of goods and services⁴: 9 namely, *measuring or testing machines and instruments; power distribution or control machines and apparatus; rotary converters; phase modifiers; electric wires and cables; telecommunication devices and apparatus; electronic machines, apparatus and their parts; electronic circuits and CD-ROMs recorded with programs for hand-held games with liquid crystal displays; exposed cinematographic films; exposed slide films; slide film mounts; downloadable image files; recorded video discs and video tapes*; 35 namely, *advertising and publicity services; business management analysis or business consultancy; marketing research; providing information concerning commercial sales; business management of hotels; providing information concerning preparation or auditing of financial statements; document reproduction; office functions, namely filing, in particular documents or magnetic tape; providing business assistance to others in the operation of data processing apparatus namely, computers, typewriters, telex machines and other similar office machines; business administration relating to document forwarding in the field of delivery services; invoicing; business management of telemarketing center; business management analysis or business consultancy of marketing; business administration relating to the processing of credit card applications*; 36 namely, *management of buildings; real estate agencies and brokerage for rental of buildings; leasing or renting of buildings; real estate services relating to the purchase*

¹ A corporation duly organized and existing under Philippine law with office located at Bench Tower, 30th St., corner Rizal Drive, Crescent Park West 5, Bonifacio Global City, Taguig 1634.
² Sister company of Suyen is a corporation duly organized and existing under Philippine law with office located at the same address above.
³ A corporation duly organized and existing under the laws of Japan, with principal office address at 1-2-1 Osaki, Shinagawa-ku, Tokyo 141-8672, Japan.
⁴ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

and sale of buildings; real estate services and brokerage for the purchase or sale of buildings; real estate appraisal; land management; real estate agencies and brokerage for leasing or renting of land; leasing of land; real estate services relating to the purchase and sale of land; real estate services and brokerage for the purchase or sale of land; providing information on buildings or land (real estate affairs); antique appraisal; art appraisal; precious stone appraisal; business credit verification services; rental of paper money and coin counting or processing machines; rental of cash dispensers or automated-teller machines; brokerage of membership contracts of credit cards and providing information thereof; credit guarantee services of usage of credit cards; financial services relating to the recruitment and administration of memberships of credit cards; financial consultancy; insurance consultancy; providing payment information on e-commerce; payment services of the goods which are bought by points of point cards; issuance of credit cards; 37 namely, general building construction works; dredging; construction and maintenance services relating to civil engineering; road paving; masonry; installation of glass for windows and doors; steel structure construction works; plastering; carpentry; tile laying, bricklaying or block laying; joinery; building reinforcing; painting; scaffolding, earthworks or concrete construction; upholstery; installation services related to sheet metal working; building damp-proofing; roofing services; plumbing; machinery installation; drilling of wells; electrical installation services; telecommunication wiring; thermal insulating for buildings; construction consultancy; repair or maintenance of building equipment; repair or maintenance of office machines and equipment; repair or maintenance of electronic machines and apparatus; repair or maintenance of telecommunication machines and apparatus; safe maintenance or repair; setting up, installation and upgrading (function enhancement and addition) of computers and information services relating thereto; 38 namely, mobile telephone communication; telex services; communications by computer terminals; communications by telegrams; communications by telephone; facsimile transmission; paging services; television broadcasting; cable television broadcasting; radio broadcasting; news agencies; rental of telecommunication equipment including telephones and facsimile apparatus; 39 namely, transport; warehousing services; rental of warehouse space; management of parking places; rental of loading-unloading machines and apparatus; rental of packaging or wrapping machines and apparatus; collection of waste and trash; 40 namely, paper treating and working; rental of machines and apparatus for pulp-making, papermaking or paper-working; rental of waste compacting machines and apparatus; rental of waste crushing machines; printing; sorting and disposal of waste and trash; rental of printing machines and apparatus; rental of air-conditioning apparatus; 41 namely, educational and instruction services relating to arts, crafts, sports or general knowledge; arranging, conducting and organization of seminars; providing electronic publications; services of reference libraries for literature and documentary records; production of radio or television programs; production of video tape films in the fields of education, culture, entertainment or sports (not movies, radio or television programs and not for advertising and publicity); rental of television sets; rental of radio sets; rental of records or sound-recorded magnetic tapes; rental of image-recorded magnetic tapes; 42 namely, architectural design; surveying; designing of machines, apparatus, instruments (including their parts) or systems composed of such machines, apparatus and instruments; designing; computer software design, computer programming, or maintenance of computer software; technical advice relating to computers; research on building construction or city planning; testing or research on prevention of pollution; testing or research on electricity; testing or research on civil engineering; rental of computers; providing computer programs in

data networks; monitoring of e-mails by computer programs; providing computer programs for discriminating virus infected mails; setting up, installation and upgrading (function enhancement and addition) of computer programs; providing information relating to the setting up, installation and upgrading (function enhancement and addition) of computer programs; rental of computer programs via communication lines; providing application software on a server computer via Internet; monitoring and analysis of computer systems and network systems and consultancy related thereto; monitoring, research and analysis of failures of computer systems and network systems and consultancy related thereto; remote monitoring and analysis of communication network systems; and 45 namely, providing information concerning agencies for procedures relating to industrial property rights; preparation of expert legal opinions; providing information concerning agencies for legal procedures relating to lawsuits; providing information concerning agencies for judicial registration or deposits; providing information concerning agencies for copyright licensing; providing legal information concerning agencies for social insurance; security guarding for facilities; personal body guarding; rental of fire alarms; rental of fire extinguishers; rental of safes.

The Opposers allege that Suyen Corporation was incorporated in 1985 as a manufacturing company dealing in clothing apparel, garments and accessories. At present, it manufactures, distributes, markets and sells apparel and lifestyle products carrying different brands and trademarks, including its flagship brand, BENCH. The company also provides for baby care, fix hair care, organics, and personal care products, as well as intimate apparel, fragrances, house ware, even snack, and other lifestyle products for men and women under different brands and trademarks. Bench is now known not only as a clothing brand but a lifestyle brand as well, together with equally popular brands owned by Suyen and its sister company that includes HUMAN, KASHIECA, FIX BENCH SALON, DIMENSIONE, PCX and BE CONNECTED. Future State, Inc. is charged with the management and operation of all HUMAN outlets in the country owned by Suyen. They are the registered owners of various HUMAN trademarks and derivatives. The trademark HUMAN was first used by Suyen in 1999, and was registered in the Philippines on 10 November 2005. Retail outlets named HUMAN was established on October 1999 offering clothing apparels with over ninety (90) outlets in the country, to date. Several HUMAN trademarks and variations are also registered in the names of the Opposers, both in the Philippines and abroad. HUMAN portfolio are expanded to other lifestyle and personal care products such as bags, shoes, accessories, purses and umbrellas.

The Opposers further allege that they exerted tremendous efforts and spent substantial amounts to market, promote and advertise their HUMAN products. They organized fashion shows, promos through contests and events and put up billboards across the country, maintains website, established social networking sites and engaged the services of costly celebrity endorsers. The Opposers have been in continuous use of the HUMAN trademarks since 1999.

The Opposers put in issue the following grounds for this instant opposition:

1. Respondent-Applicant's Human*It marks is identical to and confusingly similar to Opposers' HUMAN trademarks which contains the main, essential and dominant feature of Opposers' registered trademarks.

2. The fact that Respondent-Applicant seeks registration under a different class of goods and services does not entitle it to registration of its confusingly similar mark. Not only will it create confusion among ordinary purchasers, it will prevent Opposers from expanding its business.
3. Opposers will be damaged by the registration and use of Respondent-Applicant's Human*It mark.

The Opposers submitted the following evidence:

1. Affidavit of Mr. Jude W. Ong, General Manager of Suyen and Future State;
2. Certified True Copy (Ctc) of Certificate of Registration No. 4-2000-004504 for the HUMAN trademark;
3. Ctcs of Certificates of Registration issued by the IPOPHL in the name of the Opposers for the HUMAN trademarks;
4. List of HUMAN registrations and applications in the name of the Opposers in the Philippines and in foreign countries;
5. Photographs of various products bearing the HUMAN trademarks;
6. Photographs of fashion shows for HUMAN clothing line;
7. Sample promotional materials bearing the HUMAN trademarks;
8. Sample posters, brochures, raffle coupons and vouchers used by Opposers in connection with its promotion of HUMAN trademarks;
9. Photographs of billboards located all over the Philippines advertising HUMAN products and featuring HUMAN trademarks;
10. Copies of newspaper advertisements and articles featuring HUMAN from 1999 to 2013;
11. Copies of magazine advertisements featuring HUMAN trademarks;
12. Copies of articles in popular lifestyle magazines featuring HUMAN trademarks;
13. Print-outs from HUMAN official website; and,
14. Copies of Declarations of Actual Use for the HUMAN trademarks.

On 27 January 2015, Respondent-Applicant filed its Answer. It alleges that on 01 October 1962, Hitachi Electronics Services Co. Ltd. was founded as information technology services company specializing in system operation, monitoring and maintenance by using a wide variety of IT infrastructure such as data and contact centers and networks. It is likewise engaged in the sale and development of information-related equipment and software. In 01 October 2011, Respondent-Applicant was launched as Hitachi Systems, Ltd. offering superior, impressive services based on its philosophy of Human*IT to support the endeavors of customers beyond the framework of IT and national borders.

Respondent-Applicant further alleges that the subject mark Human*IT trademark was first used on 01 October 2011, and is being used in Japan, Malaysia, Singapore, Thailand, the Philippines, Indonesia and Vietnam. In the Philippines, it renders its services through Hitachi Sunway Information Systems (Philippines), Inc.. According to Respondent-Applicant, it has registrations and pending applications for Human*IT trademark in various countries.

The following are the Affirmative Defenses set forth in the Answer:

1. Respondent-Applicant's Human*IT trademark is not identical or confusingly similar to Opposers' HUMAN trademarks;
2. Section 123.1 (d) of the IP Code is inapplicable as Respondent-Applicant's Human*IT mark does not nearly resemble Opposers' marks as to be likely to deceive or to cause confusion;
3. No confusion of business will arise from the registration of Respondent-Applicant's Human*IT trademark as the goods and services covered by its application are non-competing and so unrelated to Opposers' goods and services that they cannot reasonably be assumed to come from a common source;
4. The Principle of Normal Expansion of Business is inapplicable;
5. Opposers will not suffer any damage by the registration of Respondent-Applicant's Human*IT trademark. The trademark application for Human*IT should thus be allowed to proceed to registration.

The Respondent-Applicant submitted the following evidence:

1. Original duly executed and notarized Officer's Certificate and Special Power of Attorney;
2. Print-out of the Company Overview page in Respondent-Applicant's website;
3. Print-outs from Hitachi Ltd.'s website showing its Corporate Information and its Consolidated Statements of Operations;
4. Print-outs from the homepage of Respondent-Applicant's website showing use of the Human*IT trademark and philosophy;
5. Original Certificate of Registration issued by the Japan Patent Office for Human*IT trademark and its English translation;
6. Original of the international registration certificate issued by the World Intellectual Property Association;
7. List of the trademark applications and registrations for the Human*IT mark;
8. Print-out of the homepage of www.human.ph website;
9. Print-outs from the website of the IPO showing the registration of marks containing the term HUMAN; and,
10. Affidavit of Atty. Rhoda Regina Reyes-Rara.

After the termination of the Preliminary Conference, the parties submitted their respective position papers.⁵ Hence, this case is deemed submitted for decision.

⁵ Opposers submitted Position Paper on 28 June 2016; Respondent-Applicant submitted Position Paper on 17 June 2016.

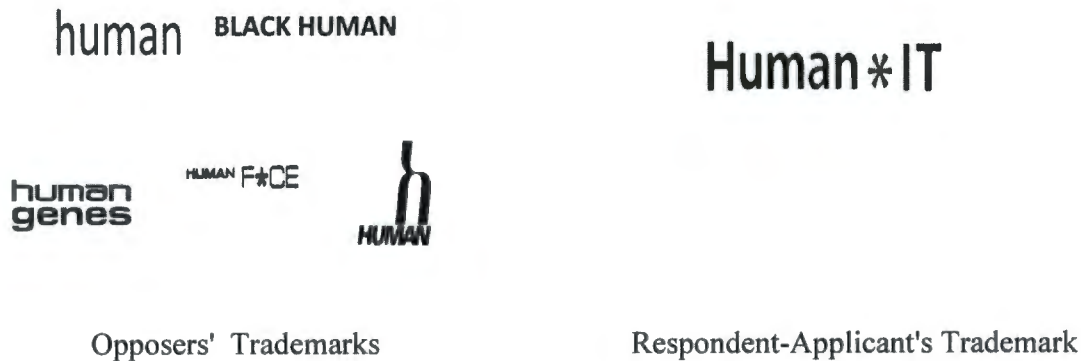


Should the Respondent-Applicant be allowed to register the trademark Human*IT?

It is emphasized that 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 out into the market a superior 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

Records show that at the time Respondent-Applicant filed its application for the trademark Human*IT on 26 April 2013⁷, herein Opposers presented registrations for several marks containing the word HUMAN issued by the Intellectual Property of the Philippines as early as 2004⁸. It likewise presented pending applications for variations of its HUMAN mark⁹. In the Philippines, a certificate of registration constitutes a prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the 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.¹⁰

The competing marks are reproduced below for comparison and scrutiny:



A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear" may be considered.¹¹ Thus, confusion is likely between

⁶ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

⁷ Filewrapper records.

⁸ Exhibits "C" to "L", "M" of Opposers.

⁹ Exhibit "M" of Opposers.

¹⁰ Sec. 138, IP Code.

¹¹ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

From the evidence at hand, the word "HUMAN" appears as the dominant feature of the Opposers' and the Respondent-Applicant's marks. Both have the same configuration in simple block-letter mark with all of the letters forming said mark presented in the simple font and format. In the instant case, however, the test is not simply to take the words and compare the spelling and pronunciation of said words.¹² The two marks as they appear in the respective labels must also be considered in relation to its entirety, commercial impression, and the goods to which they are attached.¹³

The mere fact that one party 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. Significantly, the Opposers' goods fall under Classes 3, 5, 18, 25, and 35¹⁴; while Respondent-Applicant's cover Classes 9, 35, 36, 37, 38, 39, 41, 42 and 45¹⁵. Opposers' products involve clothing apparels, bags and other personal things made of leather and leatherette materials, perfumery, cosmetics and various sorts of toiletries, which are available in specialty shops carrying the same brand/mark. Respondent-Applicant's goods, in contrast, consist of information technology related products, and services which are not directly or indirectly related to that of the Opposers'. The products are not ordinary consumable household items, like catsup, soy sauce, or soap, which are of minimal cost. The products involved are more expensive and of specialized nature and use. Thus, a casual buyer is predisposed to be more cautious and discriminating in and would prefer to mull over his purchase or selection. Confusion and deception in this instance, then, is less likely.¹⁶

Based on the foregoing, the businesses of the parties are non-competitive and their products are so unrelated that the use of trademarks is not likely to give rise to confusion.

It is significant to mention that the word mark HUMAN is a generic word and not invented. This Bureau moreover, takes cognizance via judicial notice of the contents of Trademark Registry which consist of marks that contain the word "HUMAN" covering goods/service similar or different from that of Opposers', such as: **Being human** (Reg. No. 1249362 dated 20 August 2015); **Human Alliance** (Reg. No. 1152505 dated 10 July 2015); **HumanOptics** (Reg. No. 1144793 dated 10 April 2014); **human nature** (Reg. No. 42010002402 dated 28 April 2011); **HUMAN ENERGY** (Reg. No. 42008011246 dated 02 March 2009); **human nature and heart device** (Reg. No. 42009000060 dated 25 March 2010).¹⁷ These marks are owned by entities other than the Opposers. Hence, to sustain this opposition solely on the ground that the competing marks both contain the word "HUMAN" would have the unintended effect of giving the Opposers exclusive use of the same, despite the difference or unrelated character of the goods or service offered.

¹² Bristol Myers Company v. Director of Patents, et al., 17 SCRA 128 (1966).

¹³ Mead Johnson & Company v. N. V. J. Van Dorp Ltd., et al., 7 SRCA 768 (1963).

¹⁴ Id. at 7.

¹⁵ Filewrapper records.

¹⁶ Emerald Garment Manufacturing Corporation v. CA, 251 SCRA 600 (1995).

¹⁷ IPOPHEL Trademarks Database, available at <http://www.wipo.int/branddb/ph/en/> (last accessed 22 May 2017).

WHEREFORE, premises considered, the instant Opposition to Trademark Application Serial No. 1177634 is hereby **DISMISSED**. Let the filewrapper of the subject application be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 22 MAY 2017



Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs