

FOREVER 21, INC.,
Opposer,

-versus-

EDMON NGO,
Respondent-Applicant.

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IPC No. 14-2011-00337
Opposition to:
Appln. Serial No. 4-2011-002436
Date Filed: 04 March 2011

TM: FASHION 21

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 248 dated 22 June 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 June 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

FOREVER 21, INC.,
Opposer,

-versus-

EDMON NGO,
Respondent-Applicant.

x-----x } **Decision No. 2017 - 248**

} **IPC No. 14-2011-00337**
 } Case Filed : 26 September 2011
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 } Opposition to:
 } Appln. Serial No.: 4-2011-002436
 } Filing Date : 04 March 2011
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 } **TM: "FASHION 21"**
 }
 } **Decision No. 2017 - 248**

DECISION

FOREVER 21, INC. ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2011-002436. The application filed by EDMON NGO ("Respondent-Applicant")², covers the mark "FASHION 21" for use on "lotion, shampoo, conditioner, cream rinse, make-up, eyebrow, pearl cream, nail color, lipstick, pore cleanser, toners, astringent, blush on, mascara, eyeliner, lip liner, lip gloss, liquid foundation, stick foundation, concealer, and shadow fancier, candy glazed, pressed powder" under Class 3 of the International Classification of Goods³.

The Opposer's alleges among other things the following:

- A. Registration of Respondent-Applicant's Fashion 21 is proscribed under Sec. 123.1 (g) of the IP Code as the same is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services.
- B. Registration of Respondent-Applicant's Fashion 21 is proscribed under Sec. 123.1 (d) (iii) of the IP Code as the same nearly resembles Opposer's locally registered trademark Forever 21 as to be likely to deceive or cause confusion.
- C. Registration of Respondent-Applicant's Fashion 21 is proscribed under Sec. 123.1 (e) and (f) of the IP Code as the same is confusingly similar

¹ A foreign corporation organized and existing under the laws of the State of Delaware, United States of America.

² With address at 601 Peony Tower, Numancia St., Galeria De Binondo, Manila.

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.

with the internationally well-known (and likewise locally registered) mark Forever 21.

- D. Registration of Respondent-Applicant's Fashion 21 is proscribed by Article 6Bis of the Paris Convention for the protection of industrial property.

The Opposer's evidence consists of the following:

1. Exhibit "A" – Corporate Secretary's Certificate duly authenticated by the Philippine Consul in Los Angeles;
2. Exhibit "B" – Copy of Opposer's U.S. registration for the mark FASHION 21 Reg. No. 2,848,238 issued on 01 June 2004 under Classes 3, 9, 14, 18, 25 and 35;
3. Exhibit "C" – Certificate of Reg. No. 4-2005-003126 for the mark FOREVER 21 under Classes 14, 18 and 25 issued by the Intellectual Property Philippine on 15 January 2007;
4. Exhibit "D" – Copy of Notice of Issuance issued by the IPO for the mark FOREVER 21;
5. Exhibit "E" – Affidavit of Ms. Ann Cadier Kim dated 07 September 2011;
6. Exhibits "F" and "F-1" – True copies of pictures of FASHION 21 as it stands in 5637 N. Figueroa St. in Highland Park, District, Los Angeles, California U.S.A.;
7. Exhibits "G Series" – True copy of the Certificate of Ownership and merger of Fashion 21 Inc. with and into Forever 21 Inc.;
8. Exhibits "H" to "SS" – True copies of FOREVER 21 registrations in many countries;
9. Exhibit "TT" – Copy of the Affidavit of the marketing manager of Forever 21, Miss Jane Kingsu-Cheng;
10. Exhibit "UU" – Copy of the Affidavit of the accounting manager of Forever 21 Ms. Glaiza B. Pernito;
11. Exhibit "VV" – True copy of Opposer's Certificate of Reg. No. 4-2006-013905;
12. Exhibit "WW" – True copy of Opposer's Certificate of Reg. No. 4-2006-013906;
13. Exhibit "XX" – True copy of Opposer's Certificate of Reg. No. 4-2010-004823;
14. Exhibit "YY" – True copy of Opposer's Certificate of Reg. No. 4-2010-006182;
15. Exhibit "ZZ" – Copy of Opposer's Certificate of Reg. No. 4-2005-003404;
16. Exhibit "I" – Opposer's trademark registration of Forever 21 in Australia under Class 35;
17. Exhibit "JJ" – Copy of Opposer's South Africa Reg. No. 2005/10433;
18. Exhibit "R" – Opposer's Hong Kong Reg. No. 301173889;
19. Exhibit "U" – Copy of Opposer's Israel Reg. No. 135860;
20. Exhibit "W" – Opposer's Japan Reg. No. 5263547;
21. Exhibit "KK" – Copy of Opposer's Reg. in Korea for Forever 21;

22. Exhibit "CC" – Opposer's New Zealand Reg. No. 729702;
23. Exhibit "OO" – Opposer's Taiwan Registration for Forever 21; and
24. Exhibit "RR" – Opposer's U.S. Service mark Reg. for Forever 21.

On 09 June 2012, Respondent-Applicant filed its Verified Answer denying all the material allegations of the opposition and argued that his mark "FASHION 21" is obviously different from the Opposer's mark FOREVER 21, visually and aurally.

The Respondent-Applicant's evidence consists of the following:

1. Exhibit "1" – Affidavit executed by Respondent-Applicant Edmon Ngo;
2. Exhibit "2" – Affidavit executed by Mr. Jim Ting;
3. Exhibits "3" and "4" – Affidavits executed by Anita Sanchez Mallari and Teresita M. Jawali;
4. Exhibit "5" – Affidavit of Nelly Sumook;
5. Exhibits "1-a", et, seq.,
"2-a", et, seq.,
"3-a", et, seq.,
"4-a", et, seq.,
"5-a" et,seq.

The preliminary conference was terminated on 28 August 2012 where the parties were directed to submit their position papers. The Opposer and Respondent-Applicant submitted their position papers on 10 September 2012 and 7 September 2012, respectively.

Should the Respondent-Applicant's trademark application be allowed?

It is emphasized that the essence of trademark registration is to give protection to the owner of the trademarks. The function of a trademark is to point out distinctly the origin of 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 and sale of an inferior and different article of his products⁴.

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 filed his trademark application on 04 March 2011, the Opposer has already an existing trademark registration

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999.

for the mark "FOREVER 21" Reg. No. 4-2005-003126 issued on 02 March 2007 used on goods under Classes 14, 18 and 25 of the International Classification of Goods⁵. On 07 June 2010, Opposer likewise filed Application No. 4-2010-006096 for the mark "FOREVER 21" for use on goods under Class 35⁶.

Records further show, that Fashion 21 was founded by Mr. Do Won Chang. The first store under the name Fashion 21 was opened on 21 April 1984 in Los Angeles⁷. At present the store is still operational and bears the original name of FOREVER 21, which is Fashion 21⁸.

In February 2002, Fashion 21, Inc. merged itself with Forever 21, Inc. the herein Opposer⁹. On 01 June 2004, Opposer has registered the mark FASHION 21 in the United States Patent and Trademark Office bearing Reg. No. 2,848,238 on goods and services under Classes 3, 9, 14, 18, 25 and 35 and the alleged date of first use in commerce is 21 April 1984¹⁰. However, it appearing in the Certificate of Registration¹¹ that NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "FASHION" APART FROM THE MARK AS SHOWN.

On the other hand, Respondent-Applicant first filed for the registration of the mark FASHION 21 & LOGO on 26 June 1986, and obtained registration on 11 August 1994 under Reg. No. 59100¹² a period of more or less than ten (10) years ahead of the Opposer's registration obtained in the United States of America used on goods under Class 3 of the International Classification of Goods.

Considering therefore that the Opposer has never used the mark FASHION 21 in the Philippines and/or obtained a registration of the same with the Intellectual Property Office, and instead the Respondent-Applicant has registered the mark FASHION 21 with the Intellectual Property Office in 1994 and first used the same on his goods on 16 May 1985 in the Philippines¹³ and has been continuously used from 1985 up to present¹⁴, it is very clear, that FASHION 21 has been popularized by the Respondent-Applicant in the Philippines and not the Opposer.

Opposer's claims that Respondent-Applicant's mark FASHION 21 resembles its trademark FOREVER 21.

⁵ Exhibit "C".

⁶ Exhibit "D".

⁷ Exhibit "E" paragraph 6 of the Declaration of Ann Cadier Kim.

⁸ Exhibit "F" and "F-1".

⁹ Exhibit "G" series.

¹⁰ Exhibit "B".

¹¹ Exhibit "B".

¹² Exhibit "1-a".

¹³ First use and indicated in Cert. No. 59100 Exhibit "1-a".

¹⁴ Exhibits "1-m", "1-m-1" et seq., "1-3", "1-3-1" et seq. and "1-0", "1-0-1" et seq.

The competing marks are reproduced for comparison and scrutiny:

Fashion 21

FOREVER 21

Respondent-Applicant's Mark

Opposer's Mark

Comparison of the marks reveal that no confusing similarity exists. They are entirely distinct and different from each other both in terms of composition, spelling, pronunciation, and meaning as well as in appearance. Forever and Fashion are two different words that do not look alike. Each word has a different meaning. Forever means **without end**¹⁵. Fashion means is a **general term for a popular style or practice, especially in clothing, footwear, accessories, make-up, body piercing or furniture**¹⁶. The only similarity between the competing marks is the presence of the **number 21** which is not considered to be a dominant feature of either of the two competing marks. There is a remote possibility for a consumer to assume or conclude that there is a connection between the parties solely because both marks are accompanied by the **number 21**. As a matter of fact, there are some registered marks that incorporate the number 21 such as the following below:

1. **AIR 21 AND LOGO** – Reg. No. 4-2007-005754 for courier service;
2. **BEEP 21** – Reg. No. 4-2010-008053 for transport;
3. **MUM 21** – Reg. No. 4-1996-115594 Class 3
4. **CENTURY 21 & DESIGN** – Reg. No. 4-1997-120725 for real estate brokerage services;
5. **MUSIC 21 PLAZA** – Reg. No. 4-2002-010664 for restaurant and family KTV
6. **V- 21** – Reg. No. 4-2009-011338 for helmet; and
7. **21** – Registered on 31 May 1988 for goods under Class 1.

In conclusion, therefore, this Bureau finds that the Respondent-Applicant's trademark application is not proscribed by Sec. 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code").

WHEREFORE, premises considered, the instant opposition is hereby **DENIED**. Let the filewrapper of Trademark Application Serial No. 4-2011-002436 be returned,

¹⁵ Thesaurus and Encyclopedia.

¹⁶ Wikipedia.

together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 22 JUN 2017



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