



NORDSTROM INC.,
Opposer,

-versus-

BENEDICT HENRICO DELA CRUZ,
Respondent-Applicant.

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IPC No. 14-2014-00525

Opposition to:

Appln. Serial No. 4-2014-0011443

Date Filed: 15 September 2014

TM: CASLON

NOTICE OF DECISION

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BENEDICT HENRICO DELA CRUZ

Respondent- Applicant
1495 Antonio Rivera Street,
Tondo, Manila

GREETINGS:

Please be informed that Decision No. 2017 - 240 dated 20 June 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, 20 June 2017.

MARILYN F. RETUAL
IPRS IV

Bureau of Legal Affairs

NORDSTROM INC.,
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} **IPC NO. 14-2014-00525**

} Opposition to:

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} **Application No. 4-2014-0011443**

} **Date filed : 15 September 2014**

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} **Trademark: "CASLON"**

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} **Decision No. 2017 - 240**

DECISION

NORDSTROM INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2014-0011443. The application, filed by BENEDICT HENRICO DELA CRUZ (Respondent-Applicant)², covers the mark "CASLON", for use on "Bags and all included under class 18" under Class 18 and "Clothing, shoes and all included in class 25" under Class 25 of the International Classification of Goods³.

The Opposer relies on the following grounds in support of its Opposition:

"1. Opposer is the first to adopt, use and register worldwide the 'CASLON' trademark and as the legal capacity to sue and exclude others from registering the or using identical or confusingly similar marks such as Respondent-Applicant's trademark 'CASLON' for goods falling under international class 18 and 25 based on Section 160 in relation to Section 3 of R.A. No. 8293, which provides: xxx

Opposer is a corporation duly organized under the laws of the State of Washington U.S.A. and base its cause of action under Article 6 of The Convention of Paris for the Protection of Industrial Property, otherwise known as the Paris Convention, wherein both the United States and the Philippines are signatories. xxx

"2. Opposer's 'CASLON' trademark is well-known internationally taking into account the knowledge of the relevant sector of the public, rather than the public at large, as being a distinctive trademark owned by Opposer, who is internationally recognized as one of the leading specialty fashion retailer in the world.

¹ A foreign corporation duly organized and existing under the laws of State of Washington, U.S.A. with address at 1617 Sixth Avenue, Suite 500, Seattle Washington, U.S.A.

² with address at 1495 Antonio Rivera St. 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.

“3. There is a likelihood of confusion between Opposer’s ‘CASLON’ trademark and Respondent-Applicant’s ‘CASLON’ mark because the latter’s ‘CASLON’ mark is identical the Opposer’s ‘CASLON’ trademark, in sound, spelling, appearance, meaning and connotation as to likely cause confusion, mistake and deception to the public.

“4. Respondent-Applicant, by adopting the ‘CASLON’ mark for its goods, is likely to cause confusion, or to cause mistake, or to deceive as to affiliation, connection or association with the Opposer, or as to origin, sponsorship, supervision, authorization or approval of his products by the Opposer, for which he is liable for false designation of origin, false description or representation under Section 169 of R.A. No. 8293.”

The Opposer submitted as evidence the following: Special Power of Attorney; Judicial Affidavit of Robert B. Sari; Amended and Restated Articles of Incorporation of Nordstrom, Inc.; Copies of Trademark Registrations in the United States and other territories; Print-out of web pages of Nordstrom, Inc. showing "CASLON" mark; print-out of IPO database showing Respondent-Applicant's application; and Judicial Affidavit of Avril Elaine U. Gamboa.⁴

This Bureau served upon the Respondent-Applicant a “Notice to Answer” on 18 February 2016. The Respondent-Applicant, however, did not file an Answer.

The records show that the Respondent-Applicant filed his application on 3 November 2014. The Respondent-Applicant uses its mark on goods under classes 18 and 25. The Opposer registered its mark in countries outside the Philippines. The Respondent-Applicant's mark is shown below:



Respondent-Applicant’s mark

Should the Respondent-Applicant be allowed to register the trademark CASLON?

The Opposer’s contention is that it is recognized as one of the leading fashion retailers in the world and that it owns the internationally well-known mark CASLON. If CASLON is an internationally well-known, the registration by Respondent-Applicant is prohibited and contrary to Section 123.1, subparagraph (e) of the Intellectual Property Code of the Philippines, which provides that:

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

⁴⁴ Annex "A"; Exhibits "A" to "D"

A handwritten signature in blue ink, appearing to be the initials "AJ" or "AS", located at the bottom right of the page.

x x x

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark with which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

Furthermore, the registration of the trademark CASLON in the name of the Respondent-Applicant will also violate Section 6bis of the Paris Convention for the Protection of Industrial Property, to which the Philippines is a party having acceded to as early as September 27, 1965, as follows:

Article 6bis

Marks: *Well-known Marks*

(1) The countries of the Union Undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use of a trademark which constitutes a reproduction, an imitation, or a translation considered by competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of the registration shall be allowed for requesting the cancellation of such mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.

The Opposer's mark CASLON, as it appears in its U.S. Registration is in block style lettering, while Respondent-Applicant's mark is in stylized font. In appearance, the marks are not the same. The commercial impression generated by the marks is dissimilar. More importantly, the Bureau finds that the evidence is insufficient to establish that the Opposer's mark has gained fame and distinctiveness in the Philippines. While the Opposer has established that it promotes and advertises the trademark CASLON in its Nordstrom website at www.nordstrom.com, the submission is not enough to prove that products bearing CASLON are promoted and sold in the Philippines, in such magnitude, to conclude that the mark CASLON has garnered a

market share, reputation, and distinction to qualify it as a well-known mark. The Opposer failed to establish that the mark CASLON has attained a well-known status in the Philippines, as required under the law.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-0011443 is hereby **DISMISSED**. 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, 20 JUN 2017



ATTY. ADORACION U. ZARE, LL.M.

Adjudication Officer
Bureau of Legal Affairs