



**PAUL FRANK INDUSTRIAL LLC,**  
*Opposer,*

**-versus-**

**DING PEI ZHEN,**  
*Respondent-Applicant.*

X-----X

} **IPC No. 14-2014-00555**  
}  
} Opposition to:  
} Appln. Serial No. 4-2014-005871  
} Date Filed: 12 May 2014  
}

**XM**



**TM:**

**NOTICE OF DECISION**

**FEDERIS & ASSOCIATES LAW OFFICES**

*Counsel for Opposer*  
Suite 2005 88 Corporate Center  
141 Valero Street, Salcedo Village  
Makati City

**FIRST IP CONSULTANCY AND TECHNICAL SERVICES**

*Respondent- Applicant's Representative*  
#59 Giardini Street, Casa Milan Subdivision  
L113 B152, Brgy. Greater Lagro  
Quezon City

**GREETINGS:**

Please be informed that Decision No. 2017 - 281 dated 29 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, 03 July 2017.

**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs

PAUL FRANK INDUSTRIAL  
LLC.,

IPC NO. 14 – 2014 - 00555

Opposer,

- versus -

Opposition to:

TM Application No. 4-2014-005871

TM: **XM**



DING PEI ZHEN,

Respondent -Applicant.

DECISION NO. 2017 - 281

x-----x

## D E C I S I O N

PAUL FRANK INDUSTRIES LLC., (Opposer)<sup>1</sup> filed an Opposition to Trademark Application No. 42014005871. The application filed by DING PEI ZHEN (Respondent-Applicant)<sup>2</sup>, covers the mark "XM", for use on "*clothing, footwear and headgear*" covered under Classes 25 of the International Classification of Goods.<sup>3</sup>

The Opposer based its Opposition on the following grounds:

a. The Device is an exact copy of Opposer's JULIUS MONKEY DESIGN trademark used on the same goods that is subject of an earlier filed application (in 2013), which earlier filing bars the subject application (in 2014) under Section 123.1 (d) of the IP Code.

b. Opposer's JULIUS MONKEY DESIGN mark has been declared well-known by this Hon. Office, which further protects it against the subject application under Sections 123.1 (e) and (f) of the IP Code.

c. The fact that the Device is an exact copy of Opposer's mark indicates its adoption as one in bad faith which is sufficient to reject the subject application.

<sup>1</sup> A corporation organized and existing under the laws of the State of Delaware, United States of America (U.S.A.) with address at 10100 Santa Monica Blvd. Ste 600, Los Angeles, CA 90067, USA.

<sup>2</sup> A natural person with address at 224 F. Roxas St. 4<sup>th</sup> Ave. Caloocan Metro Manila

<sup>3</sup> 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.

d. Granting registration to the subject application will enable Respondent-Applicant to unfairly take advantage of the goodwill of Opposer's trademark, contrary to Section 168 of the IP Code.

The Opposer's further allegations on the Opposition are quoted as follows:

8. Opposer is the true owner of the mark JULIUS MONKEY DESIGN consisting of a face of a monkey x x x

9. Its ownership has been affirmed in two (2) final and executory decisions of this Hon. Office. x x x

10. As could be gleaned also from the ODG Decision, Opposer's JULIUS MONKEY DESIGN has the status of a well-known, trademark.

11. Opposer's true ownership of the monkey face mark is traced to Opposer's founder, Mr. Paul Frank, who started Opposer's garments and merchandising business in 1995 from a small garage at his residence in Huntington Beach, California, U.S.A., where he and his friends made wallets and handbags with old scraps of Naugahyde fabric.

12. They then sold the wallets to family and friends, decorating such goods with creative, fun and colorful designs and logos, which are known as the PAUL FRANK family of trademarks, x x x

13. As to this whimsical monkey face design, Mr. Frank named the monkey Julius, and the mark is known as the JULIUS MONKEY DESIGN.

14. Thereafter, in 1997, Opposer was formally established and organized as a business enterprise creating, manufacturing various goods generally designated as clothing and accessories falling under the International Classes 18 and 25.

15. As to the PAUL FRANK family of trademarks built around PAUL FRANK, and the JULIUS MONKEY DESIGN mark, Opposer promptly acquired trademark protection by securing registrations from and filing numerous application before registries in various states and countries, x x x

16. These trademarks cover goods in connection with backpacks, wallets, travelling bags, purses, handbags, coin purses, hold alls, waist bags, pouches, vanity cases, wallets, billfolds, key holders, purses, book bags, rucksacks, knapsacks, school bags, beach bags, tote bags, sport bags, shoulder bags, travelling bags, duffel bags, credit card cases and holders, cosmetic cases, lunch boxes, articles made of leather or imitations of leather and other materials, suitcases, travelling cases, valises, briefcases, portfolios, attache cases, luggage, walking sticks, credit card cases and holders, satchels, athletic bags, shoulder belts, umbrellas, check book covers made of leather or imitation of leather, parts and fitting for the aforesaid goods as well

as for clothing namely, t-shirts, socks, hats, beanies, baseball caps, shoes, floppy hats, jeans, shorts, sweatshirts, pajamas, and pants.

17. In sum, Opposer owns around 189 trademark registrations/applications for the "JULIUS MONKEY DESIGN" mark and variations thereof in numerous countries around the world. These countries include but not limited to the United States of America, Algeria, Mexico, Canada, Switzerland, Morocco, Philippines, Israel, China, Taiwan, Hong Kong, Japan, Thailand, Indonesia, Australia, New Zealand and Singapore.

18. In the Philippines, on the strength of its having been affirmed as the true owner, Opposer filed on September 13, 2013 an application for trademark registration for the JULIUS MONKEY DESIGN mark covered by App. No. 4-2013-011090. x x x

19. Prompt protection was sought because Opposer's brand and products met phenomenal commercial success and world-wide fame.

20. Worldwide total sales figures, which include the Philippines, have grown from approximately US \$10,000,000 in the year 2000 to greater than US \$ 100,000,000 annually.

21. The way it achieved global presence is by actively selling via distributors in many countries of the world. Opposer sells its products through distributors in many countries around the world. Aside from the United States, Opposer's products are available in other countries including but not limited to China, Colombia, Dominican Republic, Hong Kong, Malaysia, Panama, Philippines, Singapore, Slovakia, Thailand and Venezuela. This does not include those countries whose consumers purchase Opposer's products online through the internet. Opposer's products' may also be purchased at [www.shop.paulfrank.com](http://www.shop.paulfrank.com).

22. Opposer's international distribution outside of the United States results in millions of dollars of sales each year, measured in wholesale prices. This does not include sales in the U.S.

23. And after it established itself as a leader in fashion accessories, it expanded into clothing, including a long line of must-have t-shirts and pajamas that have solidified Opposer's brands' standing in the global apparel industry. Opposer's success has continued and grown with the introduction of several divisions over the ensuing years: men's and women's sportswear, children's clothing, swimwear, eyewear, watches, and home furnishings.

24. The success of its commercial activities, and the expansion of its presence into countries and into new business ventures, have given worldwide fame to Opposer's "PAUL FRANK", "PAUL FRANK AND DESIGN" and "JULIUS MONKEY DESIGN" marks.

25. And not surprisingly, these brands became subject of media attention and accolades. In 2001, Opposer was recognized by Brandweek magazine as the "Marketers of the Next generation" for its innovative marketing and promotion of its brands including the



"PAUL FRANK", "PAUL FRANK HOUSE DESIGN" and "JULIUS MONKEY DESIGN" marks.

26. The "PAUL FRANK" and "JULIUS MONKEY DESIGN" trademarks have also appeared in at least eighteen (18) feature-length motion pictures, including blockbusters such as the two "Austin Powers" films, "American Pie 1 & 2", "Charlie's Angels 2", "National Treasure" and "Just Friends". In addition, Opposer's "PAUL FRANK" and "JULIUS MONKEY DESIGN" marks have also been featured on several hit television shows, including "The West Wing", "CSI", "ER", "Saturday Night Live", "The OC", "Extreme Makeover: Home Edition", and "MTV's Punk'd". All of the foregoing films and television shows were exhibited worldwide, including the Philippines.

27. Fame and popularity were further achieved by advertising content using famous artists and show business personalities as brand endorsers. Opposer has partnered with various artists (Shepard Fairey, Shag, Mark Ryden, the Andy Warhol Foundation), youth-oriented companies (Sanrio, Nirve, Pro-Keds, Vans, the Elvis Presley estate) and publicly traded institutions listed on New York Stock Exchange (NYSE) such as John Deere, Mattel, Brown Shoe Company and Oscar Mayer.

28. To achieve fame, Opposer spends substantial sum and devote time and effort to advertise the brands in prominent publications. Thus, Opposer has prominently and consistently advertised "PAUL FRANK" "PAUL FRANK HOUSE DESIGN" and the "JULIUS MONKEY DESIGN" in numerous magazines which include, but are not limited to Seventeen, Vogue, InStyle, Glamour and W, all of which are widely sold and circulated in numerous countries worldwide, including the Philippines.

29. Advertising efforts are also devoted to the internet. Opposer's products, including clothing, eyewear, watches and other products bearing the "PAUL FRANK" and "JULIUS MONKEY DESIGN" marks are made accessible through Opposer's main website [www.paulfrank.com](http://www.paulfrank.com). Opposer's products are also sold on online shopping websites such as Yahoo! Shopping, [www.shopping.yahoo.com](http://www.shopping.yahoo.com), Amazon, [www.amazon.com](http://www.amazon.com), and eBay, [www.ebay.com](http://www.ebay.com) among others. Philippine residents' and nationals' orders or purchases for Opposer's "PAUL FRANK" and "JULIUS MONKEY DESIGN" products can be placed through the Internet.

30. By and large, Opposer has spent millions of dollars marketing and advertising its trademark and products all over the world, not including the United States, where Opposer annually spends additional millions of dollars on promotion of the "PAUL FRANK", "JULIUS MONKEY DESIGN" and other marks of the Opposer.

31. With such substantial value generated by its brands, protection and defense of the brands become vital. That is, in addition to securing numerous trademark registrations for "PAUL FRANK", and other marks owned by the Opposer, Opposer has (1) subscribed to trademark watching services for the "PAUL FRANK" family of marks and the "JULIUS MONKEY DESIGN" mark, (2) published warnings

*Yol*

about unauthorized use of the "PAUL FRANK" family of marks and the "JULIUS MONKEY DESIGN" mark, and (3) aggressively defended and protected its trademark rights by instituting legal actions against unauthorized third party users of the "PAUL FRANK" and "JULIUS MONKEY DESIGN" marks.

32. On the other hand, the subject application was filed only recently, May 12, 2014, or much later than Opposer's App. No. 4-2013-011090 filed in September 2013. The filing cannot be seen as not coinciding with the wildly rampant fame of Opposer's brands.

The Opposer submitted the following evidence:

Exhibit "A" – Affidavit of Rami S. Yanni, Senior Vice-President, Business & Legal Affairs of PAUL FRANK INDUSTRIES, LLC;

Exhibit "B" – Certified true copy of the Articles of Merger proving the corporate existence of Opposer;

Exhibit "C" – Printouts of Opposer's website found at [www.paulfrank.com](http://www.paulfrank.com);

Exhibit "D" – Opposer's list of all trademark registrations and applications for JULIUS MONKEY DESIGN mark and variations thereof;

Exhibit "E" – Certified true copies of the certificates of trademark registrations covering the JULIUS MONKEY DESIGN for use on goods falling in Class 25;

Exhibit "F" – Articles and advertisements which feature Opposer and the JULIUS MONKEY DESIGN mark;

Exhibit "G" – Affidavit of Jan Abigail L. Ponce;

Exhibit "H" – Special Power of Attorney and Certification of Authority;

Exhibit "I" – Corporate Officer's Certificate;

Exhibit "J" – Certified true copy of Trademark Application No. 4-2013-011090 for JULIUS DESIGN filed on the Philippines on September 13, 2013 in Classes 03, 16, 18, 21, 24, 25 and 35;

Exhibit "J-1" – Certified true copy of Trademark Registration No. 4-2013-011091 for PAUL FRANK issued in the Philippines on September 24, 2014 in Classes 03, 16, 18, 21, 24, 25 and 35;

Exhibit "K" – Certified true copy of the Decision of the Office of Director General ("ODG") dated December 22, 2009 in Appeal No. 14-09-19 entitled "Paul Frank Industries, Inc. vs. Alan Sia Yu.";

Exhibit "K-1" – Certified true copy of Decision of the Bureau of Legal Affairs ("BLA") in IPC No. 14-2009-00158 entitled "Paul Frank Industries, Inc. vs. Alan S. Yu.";

Exhibit "L" – Printout showing Opposer's trademarks PAUL FRANK, PAULFRANK and HOUSE DESIGN and the JULIUS MONKEY DESIGN;

Exhibit "M" – Affidavit of John Oswald;

Exhibit "N" – Certificate of Incorporation of Paul Frank Industries, Inc.;

Exhibit "O" – Database printout of listing the details of Opposer's trademark applications and registrations filed in numerous countries worldwide for PAUL FRANK and JULIUS MONKEY DESIGN;

Exhibit "P" – Sampling of certified true copies of certificates of trademark registrations for PAUL FRANK;

Exhibit "Q" – Sampling of certified true copies of trademark registrations for the JULIUS MONKEY DESIGN mark registered in numerous countries; and

Exhibit "R" to "U" – Printouts of websites [www.paulfrank.com](http://www.paulfrank.com), [www.shopping.yahoo.com](http://www.shopping.yahoo.com), [www.amazon.com](http://www.amazon.com) and [www.ebay.com](http://www.ebay.com) where Opposer's products bearing the JULIUS MONKEY DESIGN are sold.

This Bureau issued a Notice to Answer dated 6 March 2015 and served to Respondent-Applicant on 13 March 2015. However, the Respondent-Applicant did not file an Answer to the Opposition. In view thereof, an Order dated 10 November 2015 was issued declaring the Respondent-Applicant in default. Consequently, the instant case was submitted for decision.

**XM**

The issue to be resolved in this case is whether the trademark covered by Trademark Application No. 4-2014-005871 should be allowed for registration.

The relevant trademarks are reproduced below for comparison:



Respondent-Applicant's  
Trademark



Opposer's Trademark

*6/11/15*

A simple perusal of the above trademarks shows that both contending marks have a similar illustration of a monkey's head. While it is true that the Respondent-Applicant's mark has an additional letters "XM" above the illustration, the same did not provide any distinctive characteristics to the mark. The illustration in the monkey's head remains to be the dominant feature in both the contending trademarks. It is the one that will draw the interest and attention of the buying public.

Records also show that Respondent-Applicant's trademark application indicates that the mark is to be used for similar goods with that of the Opposer.<sup>4</sup> Both of the competing trademarks are used for clothing and other apparels under Class 25. Thus, there is a great possibility that the consumer will be deceived or misled and interchanged the respondent-applicant's products with the products of the Opposer.

The function of 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.<sup>5</sup> Moreover, the protection of trademarks as intellectual property is intended not only to preserve the goodwill and reputation of the business established on the goods bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods.<sup>6</sup>

In this case, the Opposer has shown that it is the prior adopter and registrant of the identical monkey's head mark<sup>7</sup>, which was not controverted by the Respondent-Applicant.

Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of design available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.<sup>8</sup> This is very instructive in this case, where the competing marks have an identical dominant device. Therefore, Respondent's application for registration of the trademark  cannot be allowed to be registered.

<sup>4</sup> Respondent-Applicant's Application for Registration; Exhibit "L", "J" and "J-1"

<sup>5</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508 19 Nov. 1999

<sup>6</sup> *McDonald's Corporation v. MacJoy Fastfood Corporation* 215 SCRA 316, 320 (1992); and *Chuanchow Soy & Canning Co. v. Dir. of Patents and Villapania*, 108 Phil. 833, 836 (1960).

<sup>7</sup> Respondent-Applicant's Application for Registration; Exhibit "L", "J" and "J-1"

<sup>8</sup> *American Wire & Cable Company vs. Dir. Of Patent*, G.R. No. L-26557, February 18, 1970.

7/10

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application Serial No. 4201400005871 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4201400005871 be returned together with a copy of this DECISION to the Bureau of Trademarks (BOT) for appropriate action.

**SO ORDERED.**

Taguig City, 29 JUN 2017

  
**Atty. Leonardo Oliver Limbo**  
Adjudication Officer  
Bureau of Legal Affairs