



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

BOSSINI GARMENTS CORP.,
Opposer,

-versus-

I.C.C. INTERNATIONAL PUBLIC COMPANY LTD.,
Respondent-Applicant.

X-----X

IPC No. 14-2016-00681
Opposition to:
Appln. Ser. No. 4-2016-503899
Date Filed: 04 August 2016

TM: BSC INTERNATIONAL

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 382 dated 16 November 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, 21 November 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

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TM: **BSC INTERNATIONAL**

Decision No. 2017 - 382

DECISION

BOSSINI GARMENTS CORPORATION¹ ("Opposer"), filed an opposition to Trademark Application Serial No. 4-2016-503899. The application filed by I.C.C. INTERNATIONAL PUBLIC COMPANY LIMITED² ("Respondent-Applicant"), covers the mark "BSC INTERNATIONAL" for use on goods such as "underwear, swimsuits, pyjamas, socks, children's clothes, trousers, shirts, skirts, dresses" under Classes 25 of the International Classification of Goods.³

The Opposer alleges the following grounds:

"1. The approval of Application SN 4-2016-00503899 is contrary to Sections 123.1 (d), 138 and 147 of Republic Act No. 8293 (IP Code);

"2. Application SN 4-2016-00503899 was filed by Respondent-Applicant in bad faith;

"3. Respondent-Applicant is not entitled to register the trademark 'BSC INTERNATIONAL' in its favor and the approval of its Application SN 4-2016-00503899 has caused and will continue to cause great and irreparable damage and injury to herein Opposer."

Opposer's evidence consists of the following:

1. Certified copy of Certificate of Registration No. 4-1997-122235 issued on 16 April 2004 for the mark BSC (Inside a rectangle with stripes from the middle towards the end forming a big letter B);

¹ A domestic corporation with address at 120 Di Aquino Street, Between 3rd and 4th Avenue, Grace Park, Kalookan City.

² A corporation organized and existing under the laws of Thailand with address at 530 SOI Sathupradit 58 Bangpoungpong Yumwua, Bangkok 10120, Thailand.

³ The 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.



2. Certified copy of Certificate of Registration No. 4-1986-058747 issued on 06 January 2005 for the mark BOSSINI;
3. Duplicate copies of Declarations of Actual Use filed in 2001, 2009, 2010, 2014 and 2015;
4. Photographs of polo shirt, a pair of pants and jumper bearing the registered marks B.S.C. and BOSSINI;
5. Printout of Respondent-applicant's Application SN 4-2016-00503899 as published in E-Gazette; and
6. Duly notarized Affidavit of Dennis Laddaran.

This Bureau issued on 13 January 2017 a Notice to Answer and served a copy thereof upon the Respondent-Applicant's counsel on 30 January 2017. Despite receipt of the Notice, Respondent-Applicant failed to file the answer. On 06 June 2017, an order was issued declaring Respondent-Applicant in default. Accordingly, the case is deemed submitted for resolution on the basis of the affidavit and evidence submitted by the Opposer.

Should the Respondent-Applicant's mark **BSC INTERNATIONAL** be allowed registration?

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 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.¹

Section 123.1 (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code), as amended, provides:

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

xxx

(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

¹ *Pribidas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

(iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

Explicit from the above 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, said mark cannot be registered.

The records show that at the time the Respondent-Applicant filed its application for the mark BSC INTERNATIONAL on 04 August 2016, the Opposer already has existing registration for the BSC (INSIDE A RECTANGLE WITH STRIPES FROM THE MIDDLE TOWARDS THE END FORMING A BIG LETTER B) mark issued on 16 April 2004 and the BOSSINI mark issued on 06 January 2005. As such, the certificate of registration in its name is a prima facie evidence of the validity of its registration, its ownership of the mark and its exclusive right to use it in connection with the goods and/or services and those that are related thereto, pursuant to Section 138 of the IP Code. Thus, the Opposer has the right to oppose the application for registration of a mark which is identical or similar to its marks, as in this case.

But are the marks of the parties confusingly similar as to likely cause confusion or mistake on the public? The marks of the parties are shown below:



Opposer's Mark



Respondent-Applicant's Mark

Undoubtedly, Respondent-Applicant's mark is manifestly similar to the Opposer's mark because of the presence of the letters "B-S-C" which is also written in sequential order as that of the Opposer's. In Respondent-Applicant's mark, the letters "B-S-C" are written in lower case letters inside a square together with the word "INTERNATIONAL" below the "BSC". On the other hand, in Opposer's mark, the letters "B-S-C" is written in upper case letters inside a rectangle with stripes from the middle towards the end forming a big letter B. Despite the differences between the contending marks, they are not sufficient to veer away from a finding of confusingly similarity. What is striking to the eye and gives a lasting impression is the letters "B-S-C". Because of their similarity, the consumers will likely be mistaken, confused or deceived into believing that Respondent-Applicant's mark is

just a variation of Opposer's or that they are related, associated or otherwise affiliated with each other.

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 article.⁵

Further, the marks are likewise aurally similar. In actual trade, buyers do not merely rely on the visual representation of a mark but also on its phonetic articulation. The sound or verbalization of a mark plays an important part in its recognition by the public. Aside from visual advertising, most businesses rely on word of mouth in building its goodwill and reputation. Loyal and satisfied customers often recommend a product by word of mouth. Thus, the goodwill created by trademarks likewise spreads, transfers and is conveyed by word of mouth, as applied in the actual conditions in the market.

Moreover, Respondent-Applicant also seeks to register its mark for goods under Class 25, which are already covered by Opposer's goods bearing the BSC mark. Considering the similarity of the marks as well as the similarity of the goods of the parties, it is likely that the purchasing public who is familiar with Opposer's products would commit mistake or be confused into believing that Respondent-Applicant's product originated from or is sponsored by Opposer. If Respondent-Applicant's mark is allowed registration, the interest of the Opposer would likely be damaged.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2016-503899, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 16 NOV 2017


MARLITA V. DAGOSA
Adjudication Officer
Bureau of Legal Affairs

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