



BURBERRY LIMITED,
Opposer,

IPC No. 14-2011-00093
Opposition to:
Appln. Serial No. 4-2009-004959
Date filed: 20 May 2009
TM: "B. BERRY"

-versus-

FE S. TRINIDAD,
Respondent -Applicant.

X-----X

NOTICE OF DECISION

A.Q. ANCHETA AND PARTNERS
Counsel for the Opposer
Suites 1008-1009 Paragon Plaza EDSA
corner Reliance Street
Mandaluyong City

FE S. TRINIDAD
Respondent-Applicant
Cluster 2 U2, Tutuban
Tondo, Manila

GREETINGS:

Please be informed that Decision No. 2014 - 39 dated February 12, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 12, 2014.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



BURBERRY LIMITED,
Opposer,

-versus-

FE S. TRINIDAD,
Respondent-Applicant.

X ----- X

IPC No. 14-2011-00093
Opposition to Trademark
Application No. 4-2009-004959
Date Filed: 20 May 2009
Trademark: **"B. BERRY"**

Decision No. 2014- 39

DECISION

Burberry Limited¹ ("Opposer") filed on 15 March 2011 an opposition to Trademark Application Serial No. 4-2009-004959. The contested application, filed by Fe S. Trinidad² (Respondent-Applicant), covers the mark "B. BERRY" for use on *"t-shirts, jeans, pants, jackets, dresses, shorts, underwear, polo shirts, sando, shirts, socks and caps"* under Class 25 of the International Classification of Goods³.

Opposer maintains that it is the prior adopter, user and owner of the internationally well-known mark "BURBERRY", its history dating as far back as 1856 when its company was founded and commenced trading. It avers that it has obtained various registrations for wide range of goods in various countries, including the Philippines. It claims that the mark "BURBERRY" has long become distinctive of the business and/or goods and/or its services through long and exclusive use thereof in international commerce. It asserts that in the global market, "BURBERRY" is one of the most reputable or well-known marks as demonstrated by the Interbrand report "Leading Luxury Brands 2008".

According to Opposer, the mark is the name of its founder, Mr. Thomas Burberry, who in 1856 opened an outfitter's shops in Basingstoke, Hampshire, England. By 1870, the shop grew into a virtual emporium with a loyal following enticed by Burberry's commitment to quality and innovation in fabric and outwears design. By 1891, he opened another shop in West End of London and due to the demand, the mark expanded its reach and market throughout the world such that

¹ A foreign corporation organized and existing under the laws of England and Wales, with principal office at Horseferry House, Horseferry Road, Londo SW1P 2AW, United Kingdom.

² With address at Cluster 2 U2, Tutuban, Tondo, 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.

by 2009, Opposer established over four hundred forty (440) shops worldwide. In the Philippines, Opposer alleges that its products have been available for over ten years. It boasts of its increased sales revenue as well as of its efforts to advertise and promote its well-known mark. It also claims to reach its purchasers through its website, www.burberry.com, and through social media.

Opposer contends that Respondent-Applicant's trademark application is proscribed by Section 123 paragraphs (d), (e), (f) and (g) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code")⁴. It insists that Respondent-Applicant's mark "B. BERRY" is confusingly similar to its own mark "BURBERRY" and that the former is very likely to deceive the purchasers not only as to the origin or sponsorship of the goods, but also as to the nature, quality and characteristics of the goods to which the mark is affixed. It accuses Respondent-Applicant of attempting to pass off its "B. BERRY" mark as different by simply removing the letters "UR" from its "BURBERRY" mark and thus, intending to ride on the goodwill Opposer created for its mark.

To support its Opposition, the Opposer submitted the following:

1. list of all its registrations in the Philippines⁵;
2. schedule of Opposer's worldwide registration of its mark "BURBERRY"⁶;
3. copy of the Interbrand report "leading Luxury Brands 2008"⁷;

⁴123.1. 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

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

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark 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 knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use;

(g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services; xxx.

⁵ Marked as Exhibit "A".

⁶ Marked as Exhibit "B".

⁷ Marked as Exhibit "C".

4. examples of its products, branding and packaging⁸;
5. examples of its magazine advertising⁹;
6. examples of various press articles from world renowned fashion magazines¹⁰;
7. examples of various press coverage of the Burberry runway show held each season for men's and women's catwalk collections¹¹;
8. printouts of Opposer's internet website¹²; and
9. affidavit-direct testimony of Stuart Lockyear, Director of Intellectual Property of Burberry Limited¹³.

This Bureau served upon Respondent-Applicant a Notice to Answer on 05 April 2011. The Respondent-Applicant, however, failed to comply. Accordingly, the Hearing Officer issued Order No. 2013-802 on 30 May 2013 declaring the Respondent-Applicant in default and submitting the case for decision.

The issue to be resolved in this case is whether the trademark application for "B. BERRY" may be allowed to be registered in favor of Respondent-Applicant.

Records reveal that at the time Respondent-Applicant sought registration for its mark, "B. BERRY", the Opposer has a valid and existing registrations for its mark "BURBERRY". As early as 07 October 1991, the mark "BURBERRY" was granted registration under Certificate of Registration No. 51663. As to Class 25, "BURBERRY" was issued Certificate of Registration No. 4-2000-001624 on 18 September 2004.

Now, to determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the competing marks are depicted below for comparison:

⁸ Marked as Exhibit "D".

⁹ Marked as Exhibit "E".

¹⁰ Marked as Exhibit "F".

¹¹ Marked as Exhibit "G".

¹² Marked as Exhibit "H".

¹³ Marked as Exhibit "I".

BURBERRY

Opposer's Mark



Respondent-Applicant's Mark

From the illustration, it can be gleaned that the Respondent-Applicant attempted to give its mark a distinct quality through the stylized initial letter "B" and by enclosing the entire mark inside a rectangular device. These features notwithstanding, the competing marks remain visually confusingly similar. When pronounced, both marks likewise reverberate the same sound. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchased as to cause him to purchase the one supposing it to be the other.¹⁴ In the case of **Del Monte Corporation vs. Court of Appeals**¹⁵, the Supreme Court held:

"The question is not whether the two articles are distinguishable by their label when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods is the touchstone."

Succinctly, since the Respondent-Applicant will use or uses the mark "B. BERRY" to goods under Class 25, the aforesaid minor differences will not diminish the likelihood of the occurrence of confusion, mistake and/or deception. It is highly probable that the purchasers will be led to believe that Respondent-Applicant's mark is a mere variation or associated with that of Opposer's mark. In **Skechers, USA, Inc. vs. Inter Pacific Industrial Trading Corp.**¹⁶, the Supreme Court made the following pronouncement:

¹⁴ Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

¹⁵ G.R. No. L-78325, 25 January 1990.

¹⁶ Skechers, USA, Inc. vs. Inter Pacific Industrial Trading Corp., G.R. No. 164321, 23 March 2011.

"Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trade-mark or trade-name is likely to lead to a confusion of source, as where prospective purchasers would be misled into thinking that the complaining party has extended his business into the field (see 148 ALR 56 et seq; 53 Am. Jur. 576) or is in any way connected with the activities of the infringer; or when it forestalls the normal potential expansion of his business (v. 148 ALR 77, 84; 52 Am. Jur. 576, 577). x x x

Indeed, the registered trademark owner may use its mark on the same or similar products, in different segments of the market, and at different price levels depending on variations of the products for specific segments of the market. The purchasing public might be mistaken in thinking that petitioner had ventured into a lower market segment such that it is not inconceivable for the public to think that Strong or Strong Sport Trail might be associated or connected with petitioner's brand, which scenario is plausible especially since both petitioner and respondent manufacture rubber shoes."

Moreover, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. Callman notes two types of confusion. The first is the *confusion of goods* "in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other." In which case, "defendant's goods are then bought as the plaintiff's, and the poorer quality of the former reflects adversely on the plaintiff's reputation." The other is the *confusion of business*: "Here though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff, and the public would then be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."¹⁷

Finally, 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 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.¹⁸ Based on the above discussion, Respondent-Applicant's trademark fell short in meeting this function. The latter was given ample

¹⁷ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 1772276, 08 August 2010.

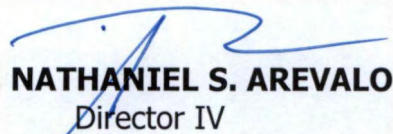
¹⁸ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

opportunity to defend its trademark application but Respondent-Applicant did not bother to do so.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2009-004959 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 12 February 2014.



ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs