



TESCO STORES LIMITED,
Opposer,

-versus-

FAMILY & FRIENDS FORTUNE
BUSINESS ASSOCIATION,
Respondent-Applicant.

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IPC No. 14-2011-00353
Opposition to:
Appln. Serial No. 4-2010-740112
Filing Date: 01 Sept. 2010
Trademark: "F AND F F AND
HEART DEVICE"

NOTICE OF DECISION

VERALAW
(DEL ROSARIO BAGAMASBAD AND RABOCA)
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Makati City


**FAMILY & FRIENDS FORTUNE
BUSINESS ASSOCIATION**
Respondent-Applicant
5th Floor, Mantex Arcade, San Pedro Street
Davao City

GREETINGS:

Please be informed that Decision No. 2012 – 156 dated August 17, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 17, 2012.

For the Director:


Atty. PAUST U. SAPAK
Hearing Officer
Bureau of Legal Affairs

CERTIFIED TRUE COPY



TESCO STORES LIMITED,

Opposer,

IPC NO. 14-2011-00353

Opposition to:

-versus-

Appln. Ser. No. 4-2010-740112

(Filing Date: 01 Sept. 2010)

TM: "F AND F F AND HEART
DEVICE"

FAMILY & FRIENDS FORTUNE
BUSINESS ASSOCIATION,

Respondent-Applicant.

X-----X

Decision No. 2012 - 156

DECISION

TESCO STORES LIMITED ("Opposer")¹ filed on 04 October 2011 an opposition to Trademark Application Serial No. 4-2010-740112. The application, filed by FAMILY & FRIENDS FORTUNE BUSINESS ASSOCIATION ("Respondent-Applicant")², covers the mark "F AND F F AND HEART DEVICE" for use on "*T-shirts, pants, jeans, jerseys, jackets, jumpers, pajamas, and other personal clothing*" under Class 25 and for "*shopping centers*" under Class 35.³

The Opposer alleges among other things that it is the owner of the trademark "F & F" which is already registered in the Philippines and other jurisdictions. According to the Opposer, F AND F F AND HEART DEVICE is confusingly similar to F & F and its registration therefore will violate Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). The Opposer's evidence consists of the Special Power of Attorney it executed in favor of its counsel of record; Verification and Certification of Non-Forum-Shopping; Cert. of Reg. No. 4-2010-5009798 issued on 07 July 2011; photocopy of trademark registrations for F & F in the Office for Harmonization of the Internal Market, India, Turkey, United Kingdom, Great Britain, WIPO; list of trademark registrations and applications in various countries; and photocopies of "*London Fashion Week Magazine*".⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 19 December 2011. The Respondent-Applicant, however, did not file an Answer.

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

¹ A corporation duly organized and existing under and by virtue of the laws of England and Wales, with principal office at Tesco Hise, Delamare Road, Cheshunt, Hertfordshire, EN8 9SL, England.

² With address at 5th Floor, Mantex Arcade, San Pedro Street, Davao City.

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.

⁴ Marked as Exh. "A" to "M".

It is emphasized that the essence of trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; 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 to 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 product⁵. Thus, Sec. 123.1(d) of Rep. Act 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 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 mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its trademark application on 01 September 2010, the Opposer has an existing trademark application for the mark "F & F" under Serial No. 4-2010-500979. The Opposer's application, filed on 09 July 2010, ripened into Reg. No. 4-2010-500979 on 07 July 2011. The goods and services covered by the Opposer's trademark application/registration include various clothing and footwear under Class 25, and retail services/stores for various goods or merchandise under Class 35. These goods and services are similar and/or closely related to those indicated in the Respondent-Applicant's trademark application.

Also, this Bureau finds that the similarities between the competing marks, as shown below, would likely cause confusion or even deception:

F&F

Opposer's mark



Respondent-Applicant's mark

The Opposer's mark consists only of three features, two letter Fs and the "&" sign which is the stylized representation of the word "and". On the other hand, the defining features - those which give the mark its distinctive character - in the mark applied for registration by the Respondent-Applicant are also the letter Fs. The device of a heart serves only ornamental purpose. Ironically, the heart filled with the color red only enhanced the similarity between the competing marks. While the mark applied for registration by the Respondent-Applicant has three letter Fs, the second F is placed inside the heart which is in turn located above the word "and". The eyes therefore become fixated on the two letter Fs outside the heart and the word "and" between. Thus, the Respondent-Applicant's applied mark looks or appears to be "F and F".

F & F as a mark for use on goods under Class 25 and services under Class 35 is unique. Because of this uniqueness and acquired distinctiveness, any mark which

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 115508, 19 Nov. 1999.

resembles the Opposer's mark and for use on the same goods and services, like the Respondent-Applicant's, is likely to be mistaken or assumed to be the same as or just a variation of the Opposer's. Information, assessment, perception or impression about the Respondent-Applicant's products and services may unfairly cast upon or attributed to the Opposer, and *vice-versa*. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:⁶

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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of letters available, the Respondent-Applicant had come up with a mark identical or so clearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark⁷.

The law on trademarks is based on the principle of business integrity and common justice. It is both in letter and spirit, laid upon the premise that, while it encourages fair trade in every way and aims to foster, and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing others business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another.⁸ Corollarily, the intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

WHEREFORE, premises considered, the Opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-740112 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 17 August 2012.


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

⁶ See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

⁷ *American Wire and Cable Co. v. Director of Patents et. al* (SCRA 544), G.R. No. L-26557, 18 Feb. 1970.

⁸ See *Baltimore Bedding Corp. v. Moses*, 182 and 229, 34A (2d) 338.