JESUS ONG TIU, Opposer, **-versus-** **NEW LOOK LIMITED,** Respondent-Applicant.	}	**IPC No. 14-2012-00143** Opposition to: Application No.4-2010-500551 Date filed: 23 April 2010 TM: **"STYLIZED YES YES (HORIZONTAL)**

x----------x

NOTICE OF DECISION

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NEW LOOK LIMITED
Respondent-Applicant
New Look House, Mercery Road
Weymouth, Dorset DT3 5HJ
United Kingdom N/A

GREETINGS:

Please be informed that Decision No. 2015 - 143 dated June 29, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 29, 2015.

For the Director:

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

JESUS ONG TIU, *Opposer*, -versus- NEW LOOK LIMITED, *Respondent-Applicant.*	**IPC No. 14-2012-00143** **Opposition to:** **Application No. 4-2010-500551** **Date Filed: 23 April 2010** **Trademark: "STYLIZED YES YES (HORIZONTAL)** ***Decision No. 2015-143***

DECISION

JESUS ONG TIU[1] (" Opposer") fil ed an opposition to Trademark Application Serial No. 4-2010-500551. The application, filed by New Look Limited[2] ("Respondent-Applicant"), covers the mark "STYLIZED YES YES (HORIZONTAL)" for use on *"headgear for wear; jackets (clothing); jackets (stuff-) (clothing); shirts fronts, shirt yokes, shirts, skirts, suits, trousers straps; trousers; underwear and leggings"* under Class 25 of the International Classification of Goods and Services.[3]

The Opposer alleges:

x x x

"GROUNDS

x x x

"1. The approval of the application in question is contrary to Sections 123.1 (d), 138, and 147 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines x x x

"2. Respondent-Applicant is not entitled to register the trademark 'STYLIZED YES YES (HORIZONTAL)' in its favor and the approval of Application SN 4-2010-500551 has caused and will continue to cause great and irreparable injury to herein Opposer.

"FACTS

x x x

"1. The trademark 'YES' is duly registered in favor of Opposer under Registration No. 4-1995-100766 issued on March 18, 2006 for use on the following goods, namely: t-shirts, jeans, slacks, shorts, polo shirts, skirts, jackets, pants, brief, jogging pants, sweatshirts, blouses, swimsuits, shoes, sandals and boots falling under Class 25.

x x x

[1]A single proprietor with address at D11 Bldg., Km 21 West Service Road, South Super Highway, Muntinlupa, Metro Manila.
[2]With address New Look House, Mercery Road Weymouth, Dorset DT3 5H.
[3]The Nice Classification is a classifi6, ascation of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

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"2. The trademark 'YES' is also registered in favor of Opposer under Registration No. 4-2007-002748 issued on April 28, 2011 for use on personal and skin care products, namely: perfumes, cologne, lotions, essential oils, soaps, deodorant, shampoo, conditioner, skin fresheners, body and face powder, creams, masks, foundation, eye shadow, eye liner, eyebrow pencils, lipstick, mascara, blush-on, concealer, make-up remover, gel, wax, toner, scrub, hair dye, nail polish falling under Class 03.

x x x

"3. The 'YES label' is duly copyrighted in favor of Opposer.

x x x

"4. Opposer adopted and started using the trademark 'YES', as well as the 'YES label' on January 3, 1994 on t-shirts, jeans, slacks, shorts, polo shirts, skirts, jackets, pants, briefs, jogging pants, sweatshirts, blouses, swimsuits, shoes, sandals and boots, while Republic Act No. 166, as amended, was in full force and effect.

x x x

"5. Opposer has continued the use of the trademark 'YES', as well as the 'YES label' while the application was undergoing examination. A certified copy of the Declaration of Actual Use filed by Opposer on December 3, 2001, including the annexes thereto, is hereto attached x x x

"6. Opposer has not abandoned the use of the trademark 'YES', as well as the 'YES Label'. Certified copies of representative sales invoices showing present use of the mark are hereto attached x x x

"7. Opposer has extended the use of the trademark YES on personal and skin care products, namely: perfumes, cologne, lotions, essential oils, soaps, deodorant, shampoo, conditioner, skin fresheners, body and face powder, creams, masks, foundation, eye shadow, eye liner, eyebrow pencils, lipstick, mascara, blush-on, concealer, make-up remover, gel, wax, toner, scrub, hair dye, nail polish falling under Class 03, and to protect such use, last March 16, 2007, Opposer filed Application Serial No. 4-2007-002748. In connection with said application, Opposer filed on March 15, 2010 the required Declaration of Actual Use, x x x

"8. The trademark 'STYLIZED YES YES (HORIZONTAL)' being applied for registration by Respondent-Applicant is confusingly similar, if not outright identical to the trademark YES owned by Opposer and duly registered in his favor.

"In addition, the goods covered by Respondent-Applicant's application are identical and closely related to the goods of Opposer falling under Class 25. Accordingly, the approval of the application in question is contrary to Section 123.1 (d) of Republic Act No. 8293, which provides:

x x x

"9. The approval of the application in question violates the right of Opposer to the exclusive use of his registered trademark YES on goods listed in the registration certificates issued to him, particularly, goods falling under Class 25, as provided by Sections 138 and 147 of the IP Code. x x x

"10. The approval of the application in question has caused and will continue to cause great and irreparable damage and injury to Opposer. The use and registration

by Respondent-Applicant of the trademark 'STYLIZED YES YES (HORIZONTAL)' will likely cause confusion or mistake or deceive the public as to the source or origin of Respondent-Applicant's goods to such an extent that the public will likely believe that Respondent-Applicant is affiliated or connected with Opposer's business and/or that Respondent-Applicant's goods are sourced from, and/or distributed by or under the sponsorship of Opposer;

x x x

"11. Respondent-Applicant is not entitled to the registration of the trademark 'STYLIZED YES YES (HORIZONTAL)'. Respondent-Applicant has millions of words and phrases to choose from for its mark. There is absolutely no reason why Respondent-Applicant should choose a mark already appropriated and registered in favor of another person or entity such as the mark YES which is duly registered in favor of Opposer and is currently being used by him.

x x x

The Opposer's evidence consists of a copy of Certificate of Registration No. 4-1995-100766 for the trademark "YES"; a copy of Certificate of Registration No. 4-2007-002748 for the trademark "YES"; a copy of Certificate of Copyright Registration No. 0-95-685 for "YES Label" issued on July 13, 1995; a copy of the Declaration of Actual use filed on 03 December 2001; copies of representative sales invoices showing present use of the trademark "YES"; photographs of Opposer's actual sample products falling under Class 25 and bearing the trademark "YES"; copy of the Declaration of Actual Use filed on 15 March 2010; print-out of the e-Gazette showing publication of Respondent-Applicant's trademark application; and, the affidavit of Opposer, Jesus Ong Tiu.[4]

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 20 April 2012. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark STYLIZED YES YES (HORIZONTAL)?

The Opposer anchors its opposition on Sections 123.1 (d), 138 and 147 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

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

x xx

(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

[4]Marked as Annexes "A" and "I", inclusive.

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

Sec. 138. *Certificates of Registration.* – A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.

Sec. 147.*Rights Conferred.* – 147.1. The owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner's consent form using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use, of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

Records show that at the time the Respondent-Applicant filed its trademark application, the Opposer has an existing trademark registration for the mark YES under Certificate of Registration No. 4-1995-100766 issued on 18 March 2006. The registration covers t-shirts, jeans, slacks, shorts, polo shirts, skirts, jackets, pants, brief, jogging pants, sweatshirts, blouses, swimsuits, shoes, sandals and boots falling under Class 25. On the other hand, the Respondent-Applicant filed the trademark application subject of the opposition on 23 April 2010.

The competing marks, as shown below, are confusingly similar:

YES

Opposer's trademark

Respondent-Applicant's mark

The fact that the mark applied for registration by the Respondent-Applicant consists of two "YESES" is of no moment. The Respondent-Applicant will use the mark on goods that are similar and/or closely related to the Opposer's, particularly, wearing apparel. Thus, it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

> Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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.[5]

There is strong likelihood of the consumers being misled to believe that the Respondent-Applicant's mark is just a variation of the Opposer's.

Public interest therefore requires, that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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.[6]

It is incredible for the Respondent-Applicant to have come up with essentially the same mark for use on similar goods by pure coincidence. Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why of the millions of terms and combinations of letters and designs 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.[7]

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 instant Opposition to Trademark Application No. 4-2010-500551 is hereby SUSTAINED. Let the filewrapper of the

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[5] Converse Rubber Corp. v. Universal Rubber Products, Inc. et. al., G.R. No. L-27906, 08 Jan. 1987.

[6] *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepa v. Director of Patents, supra. Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

[7] *American Wire & Cable Company v. Director of Patents*, G.R. No. L-26557, 18 Feb. 1970.

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, 29 June 2015.

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