



SUYEN CORPORATION,
Opposer,

-versus-

A. TESTONI S.P.A.,
Respondent-Applicant.

} **IPC No. 14-2011-00188**
} Opposition to:
} Application No.4-2010-500900
} Date filed: 24 June 2010
} **TM: "T DEVICE"**

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NOTICE OF DECISION

MIGALLOS & LUNA LAW OFFICES

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GREETINGS:

Please be informed that Decision No. 2015 - 144 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



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Opposer, } Opposition to:
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-versus- } Appln. Ser. No. 4-2010-500900
 } Date Filed: 24 June 2010
A. TESTONI S.P.A., } Trademark: T DEVICE
Respondent-Applicant. }
 }
x-----x } Decision No. 2015- 144

DECISION

SUYEN CORPORATION, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2010-500900. The application, filed by A. TESTONI S.P.A., (Respondent-Applicant)², covers the mark "T DEVICE", for use on "bags, handbags, clutch bags, travelling bags of leather, mesh bags, (not of precious metals), shoulder bags, pouches, rucksacks, holdalls, shoppers, empty diary cases and document cases, vintage bags and haversacks, wallets, purses, document holders, visiting card holders, luggage, suitcases, suit carriers (for travelling), attache cases, trunks, small cases designed to contain toiletry articles known as vanity cases (empty), make-up cases, key cases of leather, key holders, cases (empty) of leather or like materials for manicure and pedicure, hand sets, diary covers of leather, umbrellas, parasols and walking sticks and saddlery" under Class 18 and "clothing, namely: knitwear, jerseys and sweaters, pullovers, shirts, jackets, bomber jackets, raincoats, anoraks, cloaks, blazers, coats, trousers, salopettes, skirts, bathing costumes and trunks, beach robes, wraparounds, beachwear, underwear, socks and stockings, tights, scarves, shawls, silk handkerchiefs, gloves, neck-ties, waistcoats, belts, casual wear, sportswear, tracksuits, shoes, boots, sandals, clogs, sports and gym shoes, bedroom slippers, flip-flops, hats, caps, berets and visors" under Class 25 of the International Classification of Goods³.

The Opposer anchors its opposition on the ground that it will be damaged by the registration of the mark covered by the Respondent-Applicant's application. It avers that the mark is identical to and confusingly similar with its duly registered trademarks. It further asserts that the Respondent-Applicant's mark will mislead the public into believing that the products bearing the mark are the same products marketed and sold by the Opposer or that the goods originated from the same source. The Opposer also alleges the following:

"21. Suyen has long been in the business of manufacturing, marketing, advertising, distributing and selling clothing apparel in the Philippines under its well-known trademark 'BENCH'. Suyen has expanded its business to include other trademarks and products, such as hair care and

¹ A corporation organized and existing under the Philippine laws with office at 2214 Tolentino Street, Pasay City

² A foreign corporation with address at Piazza XX Settembre, 1 40121 Bologna (BO) Italy

³ 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.

other lifestyle products, intimate apparel, cosmetics, fragrances, body care products, accessories, shoes, bags, watches, housewares, furniture, even snacks, with retail stores nationwide.

"22. On 2 June 2010, Suyen acquired from TEG Bags Company, Inc. ('TBCI'), the following trademarks (hereinafter the 'T Trademarks', under a Deed of Assignment of even date.

"23. Suyen acquired from TBCI not only the T Trademarks, but the entire business relating to the T Trademarks.

a) On 2 June 2010, or simultaneously with the acquisition of the T Trademark, Suyen and TBCI executed a Memorandum of Agreement under the terms of which TBCI sold, transferred and assigned to Suyen all its rights, title and interests in and to the operational assets of TBCI 'related to operating T retail business'

b) On the same date, TBCI assigned, transferred and conveyed to Suyen the Contract of Lease covering the retail outlet 'under the name and style T Bags.Shoes' located at the Power Plant Mall at Rockwell Center, Makati City.xxx"

To support its opposition, the Opposer submitted as evidence the following:

1. Affidavit of Dale Gerald G. Dela Cruz dated 10 May 2011;
2. Copy of Deed of Assignment dated 2 June 2010;
3. Copy of Trademark Registration No. 4-2002-004767 issued on 10 March 2006 for the mark "T WITH WORD STUDIO";
4. Copy of Trademark Registration No. 4-2006-010207 issued on 6 August 2007 for the mark "T INSISDE A STANDING RECTANGULAR DESIGN";
5. Copy of Trademark Registration No. 4-2007-002066 issued on 1 October 2007 for the mark "LITTLE T AND DEVICE";
6. Copy of Trademark Registration No. 4-2007-002067 issued on 1 October 2007 for the mark "T LUXE & DEVICE";
7. Memorandum of Agreement dated 2 June 2010;
8. Deeds of Assignment dated 2 June 2010;
9. Deed of Assignment dated 2 June 2010; and
10. Letters addressed to Suyen Corporation dated 8 June 2010
11. Photographs of stores, signage, products of with mark "T", shoes and bags ⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 17 June 2011. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 1 October 2012 Order No. 2012-1311 declaring the Respondent-Applicant to have waived its right to file an answer.

⁴ Exhibits "A" to "M"

Should the Respondent-Applicant be allowed to register the trademark T DEVICE?

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.⁵ Thus, Sec. 123.1 (d) of R. A. 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 an 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 a mark as to be likely to deceive or cause confusion.

Records show that at the time Respondent-Applicant applied for registration of the mark "T DEVICE" the Opposer already obtained the following trademark registrations: Trademark Registration No. 4-2002-004767 issued on 10 March 2006 for the mark "T WITH WORD STUDIO for retails of ladies handbags, shoes and accessories under class 35; Trademark Registration No. 4-2006-010207 issued on 6 August 2007 for the mark "T INSIDE A STANDING RECTANGULAR DESIGN"; Trademark Registration No. 4-2007-002066 issued on 1 October 2007 for the mark "LITTLE T AND DEVICE"; Trademark Registration No. 4-2007-002067 issued on 1 October 2007 for the mark "T LUXE & DEVICE" for goods under classes 18 and 25 namely: Ladies shoes, ladies slippers, children's shoes, ladies handbag, clutch bags". The goods covered by the Opposer's trademark registration are also under classes 18 and 25, the same goods as indicated in the Respondent-Applicant's trademark application.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

The competing marks are reproduced below:



Opposer's mark

Respondent-Applicant's mark

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.



The competing marks consist of, or in the case of the Opposer, mainly of the letter "T". The font styles notwithstanding, these marks are practically identical. The marks are just two different representations of the letter "T". Because these marks are applied or used on similar or closely related goods, confusion is likely to occur. The purchasing public seeing goods bearing the mark "T DEVICE" may mistakenly associate the goods with those of the Opposer or that they originate or are sponsored by the Opposer.

The Supreme Court in *McDonald's Corporation v. Macjoy Fastfood Corporation*⁶ held:

To begin with, both marks use the corporate "M" design logo and the prefixes "Mc" and/or "Mac" as dominant features. The first letter "M" in both marks puts emphasis on the prefixes "Mc" and/or "Mac" by the similar way in which they are depicted i.e. in an arch-like, capitalized and stylized manner. For sure, it is the prefix "Mc," an abbreviation of "Mac," which visually and aurally catches the attention of the consuming public. xxx


In the case at bar, the predominant features such as the "M," "Mc," and "Mac" appearing in both McDonald's marks and the MACJOY & DEVICE" easily attract the attention of would-be customers. Even non-regular customers of their fastfood restaurants would readily notice the predominance of the "M" design, "Mc/Mac" prefixes shown in both marks. Such that the common awareness or perception of customers that the trademarks McDonalds mark and MACJOY & DEVICE are one and the same, or an affiliate, or under the sponsorship of the other is not far-fetched.

In conclusion, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-500900 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark 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