



ISLAND SOUVENIRS, INC.,  
Opposer,

-versus-

RAMESH GENOMAL,  
Respondent- Applicant.

x-----x

}  
} IPC No. 14-2013-00257  
} Opposition to:  
} Appln. Serial No. 4-2012-015335  
} Date Filed: 20 December 2012  
} TM: "ISLAND TREASURES"

## NOTICE OF DECISION

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### GREETINGS:

Please be informed that Decision No. 2016 - 235 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 01, 2016.

For the Director:

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

Republic of the Philippines  
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IPC No. 14-2013-00257

Opposition to:

Application No. 4-2012-015335

Date Filed: 20 December 2012

Trademark: "ISLAND  
TREASURES"

Decision No. 2016- 235

## DECISION

ISLAND TREASURES, INC.<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-015335. The application, filed by Ramesh Genomal<sup>2</sup> ("Respondent-Applicant"), covers the mark "ISLAND TREASURES" for use on "*precious metals and their alloys & goods in precious metal or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments*" under Class 14, "*paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding materials; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters & office requisites (except furnitures), instructional & teaching materials (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks*" under Class 16, "*furniture, mirrors, picture frames, goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum & substitutes for all these materials, or of plastics*" under Class 20, "*textile and textile goods, not included in other classes; bed & table covers*" under Class 24 and "*clothing, footwear, headgear*" under Class 25 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer alleges:

x x x

### "DISCUSSION

"6. Even a cursory look would readily reveal that 'ISLAND TREASURES' is confusingly similar with 'ISLANDS.' It is obvious that the dominant feature of 'ISLAND TREASURES' is the word 'ISLAND.' The word 'TREASURES' simply means 'RICHES,' 'ASSETS,' 'RESOURCES,' 'RESERVES,' 'MATERIALS,' or 'POSSESSIONS' - such that

<sup>1</sup>A corporation duly organized and existing under the laws of the Republic of the Philippines with principal address at ALAGC Compound, Nasipit, Talamban, Cebu City.

<sup>2</sup>With address at 7000 Santol St., Mon-El Subdivision, Dr A Santos Ave., Sucat Paranaque City, Metro Manila, 1700, Philippines.

<sup>3</sup>The Nice Classification is a classification 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.

*[Handwritten signature]*



'ISLAND TREASURES' could also be called 'ISLAND RICHES,' 'ISLAND ASSETS,' 'ISLAND RESOURCES,' 'ISLAND RESERVES,' 'ISLAND MATERIALS,' or 'ISLAND POSSESSIONS.' In other words, any variation of the word 'TREASURES' may be interchanged or substituted with the word 'TREASURES' in 'ISLAND TREASURES.' The bottom line therefore is the word 'ISLAND,' which is already registered in favor of the Opposer.

"7. In McDONALD'S CORPORATION vs. MACJOY FASTFOOD CORPORATION, G.R. No. 166115, February 2, 2007, it was held:

x x x

"8. The ruling in the MACJOY case is applicable to the instant case. As stated above, the similarity between 'ISLAND TREASURES' and 'ISLANDS' is the dominant word 'ISLANDS.' As illustrated in paragraph 6 herein, the words 'TREASURES' in 'ISLAND TREASURES' is but a minor difference. The aural impression created upon hearing the two marks is definitely the word 'ISLAND.'

"9. Applying the dominancy test, 'ISLAND TREASURES' and 'ISLANDS' are confusingly similar with each other such that an ordinary purchaser can conclude an association or relation between the marks.

"10. In the MACJOY case, the Supreme Court cited with approval the IPO's finding:

x x x

"11 In the same vein, the differences and variations in the styles and fonds of 'ISLAND TREASURES' and 'ISLANDS' are but miniscule variations that are overshadowed by the predominant word 'ISLAND.'

"12. In the case of SOCIETE DES PRODUITS NESTLE, S.A., et al., vs. COURT OF APPEALS, et al., G.R. No. 112012, April 4, 2001, the Supreme Court also quoted with approval the BPTTT's finding that:

x x x

"13. In the same manner, when one looks at 'ISLAND TREASURES,' one's attention is easily attracted to the word 'ISLAND.'

"14. The Opposer has priority over the Respondent because the latter's use and dates of registration for the 'ISLANDS' Family of Marks precede the dates of filing of the Respondent's subject trademark application, which was filed only on December 20, 2012. As early as May 29, 2008, the Opposer filed applications for registration of the word 'ISLANDS' as a trademark for Classes 25, 12, 43, 36, and 29.

"The subject mark is being applied in Class 25 where the Opposer has an 'ISLANDS' registration. Confusion will therefore be unmistakable.

"15. 'ISLAND TREASURES' is applied in Class 25 for the following products: clothing, footwear, and headgear.

"16. As mentioned herein, Opposer's 'ISLANDS' marks are registered in Class 25 for the following products: shirts, polo shirts, blouses, skirts, tank-tops, sweaters, sweatshirts, jackets, pants, shorts, jeans, jumpers swimwear, brassieres,

camisoles, chemise, hosiery, underwear, lingerie, sando, panties, scarves, belts, suspenders, hats, caps, visors, boots, shoes, slippers, flip-flops, coats, raincoats, pajamas, robes, socks, ties, and vests.

"17. In view of the sameness of the goods (in Class 25) covered by both 'ISLANDS' and 'ISLAND TREASURES,' there will be trademark infringement through confusion of goods. Moreover, there will also be trademark infringement through confusion of business as both parties are engaged in the business of selling Class 25 products.

"The subject mark dilutes the Opposer's 'ISLANDS' marks.

"18. The Respondent's proposed mark will dilute the strength of the Opposer's registered 'ISLANDS' marks as unique indicators of the source of the Opposer's goods, especially that the Opposer's registrations of the mark 'ISLANDS' are spread in different classes. The Respondent's proposed mark will lessen the capacity of the Opposer's distinctive 'ISLANDS' marks to distinguish and identify the Opposer's goods from those of others, thereby diluting the distinctive quality of the 'ISLANDS' marks. Dilution of the marks is the damage that this opposition seeks to obviate.

"In sum, all the foregoing proves that the subject application should be rejected.

The Opposer's evidence consists of a copy of Trademark Certificate of Registration No. PH/4/2008/6281 for the mark ISLANDS AND DEVICE issued on 22 December 2008; a copy of Trademark Certificate of Registration No. PH/4/2008/6280 for the mark ISLANDS AND DEVICE issued on 15 September 2008; a copy of Trademark Certificate of Registration No. PH/4/2009/6287 for the mark ISLANDS AND DEVICE issued on 15 September 2008; a copy of Trademark Certificate of Registration No. PH/4/2008/6285 for the mark ISLANDS AND DEVICE issued on 29 December 2008; a copy of Trademark Certificate of Registration No. PH/4/2008/6282 for the mark ISLANDS AND DEVICE issued on 16 March 2009; a copy of Respondent's Trademark Application Serial No. 4/2012/015335 for the mark ISLAND TREASURES filed on 20 December 2012; a copy of the main page of Opposer's website [www.theislandsgroup.com](http://www.theislandsgroup.com) featuring Opposer's products and services; a copy of the "RETAIL" page of the Opposer's website [www.theislandsgroup.com](http://www.theislandsgroup.com); a copy of the "ADVENTURE" page of the Opposer's website [www.theislandsgroup.com](http://www.theislandsgroup.com); a copy of the "TOURS" page of the Opposer's website [www.theislandsgroup.com](http://www.theislandsgroup.com) featuring its Class 12 products and services; a copy of the "MEDIA" page of the Opposer's website [www.islandsgroup.com](http://www.islandsgroup.com); a copy of the "HOSPITALITY" page of the Opposer's website [www.islandsgroup.com](http://www.islandsgroup.com) featuring its Class 43 services; a copy of the "FOUNDATION" page of the Opposer's website [www.islandsgroup.com](http://www.islandsgroup.com) and a copy of the "DESIGN" page of the Opposer's website [www.islandsgroup.com](http://www.islandsgroup.com).<sup>4</sup>

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<sup>4</sup>Marked as Exhibits "A" to "I", inclusive.



This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 18 October 2013. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark ISLAND TREASURES?

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.<sup>5</sup>

Thus, Sec. 123.1 (d) and Sec. 165 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provide:

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

x x x

(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;"

Sec. 165. *Trade Names or Business Names.* - 165.1. A name or designation may not be used as a trade name if by its nature or the use to which such name or designation may be put, it is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

165.2.(a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

165.3. The remedies provided for in Sections 153 to 156 and Sections 166 and 167 shall apply mutatis mutandis.

165.4. Any change in the ownership of a trade name shall be made with the transfer of the enterprise or part thereof identified by that name. The provisions of Subsections 149.2 to 149.4 shall apply mutatis mutandis.

<sup>5</sup> *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).

Records show that at the time the Respondent-Applicant filed its trademark application on 20 December 2012, the Opposer has existing trademark registrations for ISLANDS AND DEVICE under Certificate of Registration Nos. 4-2008-006281 issued on 22 December 2008, 4-2008-006280 issued on 15 September 2008, 4-2008-006287 issued on 15 September 2008, 4-2008-006285 issued on 29 December 2008 and 4-2008-006282 issued on 16 March 2009. The registrations cover "shirts, polo shirts, blouses, skirts, tank-tops, sweaters, sweatshirts, jackets, pants, shorts, jeans, jumpers swimwear, brassieres, camisoles, chemise, hosiery, underwears, lingerie, sando, panties, scarves, belts, suspenders, hats, caps, visors, boots, shoes, slippers, flip-flops, coats, raincoats, pajamas, robes, socks, ties, and vests" under Class 25, "vehicles, apparatus for locomotion by land, air or water" under Class 12, "services providing food and drink (restaurant), temporary accommodation" under Class 43, "insurance; financial affairs; monetary affairs; real estate affairs" under Class 36 and "meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jam, compotes; eggs, milk and milk products; edible oils and fats" in Class 29. This Bureau noticed that the goods indicated in the Respondent-Applicant's trademark application, i.e., "clothing, footwear, headgear" under Class 25 and "textile and textile goods, not included in other classes; bed & table covers" under Class 24 are similar or closely-related to the Opposer's.

A comparison of the competing marks reproduced below:



Opposer's trademark

**ISLAND TREASURES**

Respondent-Applicant's mark

shows that confusion is likely to occur. What draws the eyes and the ears with respect to the Respondent-Applicant's mark is the word "ISLAND". "ISLAND" is the prominent, in fact, the definitive feature of the Opposer's trademarks ISLANDS AND DEVICE covered under Registration Nos. 4-2008-006281, 4-2008-006280, 4-2008-006287, 4-2008-006285 and 4-2008-006282. Registration No. 4-2008-006281 covers "shirts, polo shirts, blouses, skirts, tank-tops, sweaters, sweatshirts, jackets, pants, shorts, jeans, jumpers swimwear, brassieres, camisoles, chemise, hosiery, underwears, lingerie, sando, panties, scarves, belts, suspenders, hats, caps, visors, boots, shoes, slippers, flip-flops, coats, raincoats, pajamas, robes, socks, ties, and vests" under Class 25, product or goods which the Respondent-Applicant deals in under the ISLAND TREASURES mark. It is likely therefore, that a consumer who wishes to buy clothing, footwear, headgear and textiles and is confronted with the mark ISLAND TREASURES, will think or assume that the mark or brand is just a variation of or is affiliated with the Opposer's ISLANDS AND DEVICE trademarks.



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.<sup>6</sup>

Also, Opposer has been using ISLAND not only as a trademark but also as trade name or business name. As a trade name, ISLAND SOUVENIRS, INC. is protected under Section 165 of the IP Code.

There is no doubt, therefore, that the subject trademark application is covered by the proscription under Sec. 123.1 (d) (iii) and Section 165 of the IP Code. The proscription, however, is only with respect to clothing, footwear, headgears, textiles under Classes 24 and 25 as these are similar or closely-related to Opposer's. As to other goods of Respondent-Applicant's namely *"precious metals and their alloys & goods in precious metal or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments"* under Class 14, *"paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding materials; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters & office requisites (except furnitures), instructional & teaching materials (except apparatus) plastic materials for packaging (not included in other classes); printers' type; printing blocks"* under Class 16, *"furniture, mirrors, picture frames, goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum & substitutes for all these materials, or of plastics"* under Class 20, these are not included for they are not similar or related to the goods covered under Opposer's Trademark Registration Nos. 4-2008-006280, 4-2008-006287, 4-2008-006285 and 4-2008-006282, specifically, vehicles, restaurant, temporary accommodation, insurance, financial affairs, real estate affairs and food products.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2012-015335 covering *"clothing, footwear, headgear"* under Class 25 and *"textile and textile goods, not included in other classes; bed & table covers"* under Class 24, is hereby SUSTAINED. Insofar as Respondent-Applicant's *"precious metals and their alloys & goods in precious metal or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments"* under Class 14, *"paper, cardboard and*

<sup>6</sup> *Converse Rubber Corp. v. Universal Rubber Products, Inc. et. al.*, G.R. No. L-27906, 08 Jan. 1987.

goods made from these materials, not included in other classes; printed matter; bookbinding materials; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters & office requisites (except furnitures), instructional & teaching materials (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks" under Class 16, "furniture, mirrors, picture frames, goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum & substitutes for all these materials, or of plastics" under Class 20, the instant Opposition to Trademark Application No. 4-2012-015335 is hereby DISMISSED. Let the filewrapper of the 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, 30 JUN 2016.

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