

SUYEN CORPORATION,
Opposer,

-versus-

NOKINA IMPORT-EXPORT,
Respondent- Applicant.

x-----x

} **IPC No. 14-2015-00377**
}
} Opposition to:
} Appln. Serial No. 4-2014-004795
} Date Filed: 16 April 2015
} **TM: "KRIS I MISS YOU"**
}
}
}
}
}

NOTICE OF DECISION

MIGALLOS & LUNA LAW OFFICES

Counsel for the Opposer
7th Floor, The PHINMA Plaza
39 Plaza Drive, Rockwell Center
Makati City

NOKINA IMPORT-EXPORT
Respondent- Applicant
220 San Nicolas St., Binondo
Manila

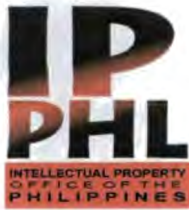
GREETINGS:

Please be informed that Decision No. 2016 - 253 dated July 14, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 14, 2016.

For the Director:

Edwin A. Daning
Atty. EDWIN DANILO A. DANILO
Director III
Bureau of Legal Affairs



SUYEN CORPORATION,
Opposer,

-versus-

NOKINA IMPORT-EXPORT,
Respondent-Applicant.

IPC NO. 14-2015-00377

Opposition to:
App.Serial No. 4-2014-004795
Date Filed: 16 April 2015
TM: "KRIS I MISS YOU"

Decision No. 2016- 253

X-----X

DECISION

SUYEN CORPORATION¹ ("Opposer"), filed an opposition to Trademark Application Serial No. 4-2014-004795. The application, filed by NOKINA IMPORT-EXPORT² ("Respondent-Applicant"), covers the mark "KRIS I MISS YOU" for use on "*cosmetics particularly, lotion products*" under Class 03 of the International Classification of Goods.³

The Opposer alleges the following grounds:

"A. Opposer Suyen will be damaged by the registration of the mark covered by questioned application. The said mark is identical to and confusingly similar with the Opposer's duly registered trademark. The said mark will mislead the public into believing that that the products bearing the said mark are the same products marketed and sold by Opposer or that they originated from the Opposer or they are under the sponsorship of Opposer.

"2. The mark of Respondent-Applicant may and will be used as an instrument of unfair competition.

The Opposer's evidence consists of the following:

1. Exhibit "A" - Affidavit of Mr. Gerald G. Dela Cruz;
2. Exhibits "B" to "B-8" - photograph of various Bench products taken from the website of Opposer;
3. Exhibits "C" to "C-10" - photograph of Bench Body and Bath products sold in the market;
4. Exhibits "D" to "D-7" - photograph of Bench celebrity fragrance line;
5. Exhibits "E" to "E-4" - pictured of the product KRIS EDT and Body Sprays;
6. Exhibit "F" - certified copy of Certificate of Registration No. 4-2005-012470 for

¹ A corporation organized and existing under the laws of the Philippines with address at Bench Tower, 30th Street corner Rizal Drive, Crescent Park, West 5, Bonifacio Global City, Taguig.

² With address at 220 San Nicolas Street, Binondo, Manila

³The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

- the mark "KRIS";
7. Exhibits "G" to "G-2" - photographs of products under the Kris Aquino scents;
 8. Exhibits "H" to "H-2" - copies of promotional posters for the mall shows;
 9. Exhibits "I" to "I-2" - press releases for the Kris Aquino Scent Collection;
 10. Exhibits "J" to "J-3" - promotional and advertising materials to promote the Kris Aquino Scents; and
 11. Exhibits "K" to "K-6" - screen shots of the products bearing the KRIS mark found in Bench website and sold online.

This Bureau issued on 15 October 2015 a Notice to Answer and served a copy thereof to the Respondent-Applicant's address on 28 October 2015. However, despite receipt of Notice, Respondent-Applicant failed to file the Answer. On 07 March 2016, this Bureau issued an Order declaring Respondent-Applicant in default. Hence, this case is submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended.

Should the Respondent-Applicant be allowed to register the mark **KRIS I MISS YOU?**

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.⁴

Sec. 123.1 (d) of the IP Code provides:

SECTION 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;

Records show that at the time the Respondent-Applicant filed its trademark application on 16 April 2014, Opposer already has an existing trademark registration for the mark KRIS issued on 16 April 2007. Opposer's KRIS mark is used on "*Eau de Toilette*". On the other hand, Respondent-Applicant's mark will be used on "*lotion products*". It appears that the Respondent-Applicant's goods are closely related to the Opposer's.

But, are the competing marks, shown below, resemble each other such that confusion or even deception is likely to occur?

⁴See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

Kris

Opposer's Mark

The logo for the Respondent-Applicant's mark features the word "KRIS" in a large, stylized, serif font. Below it, the words "I MISS YOU" are written in a smaller, simpler, sans-serif font.

Respondent-Applicant's Mark

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademark pictured in their manner of display. Inspection should be undertaken from the viewpoint of the prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling and pronunciation, of words used; and the setting in which the words appear" may be considered.⁵ Thus, confusion is likely between marks only if their overall presentation as to sound, appearance or meaning would make it possible for consumers to believe that the goods or products, to which the marks are attached, comes from the same source or are connected or associated with each other.

In this case, Opposer's mark "KRIS" is adopted by Respondent-Applicant in its composite mark "KRIS I MISS YOU". The word "KRIS" in both marks have the same exact spelling and pronunciation. Even with the presence of other words in Respondent-Applicant's mark, what sticks to the mind of the public is the word "KRIS" when uttered. Thus, Respondent-Applicant's mark is confusingly similar to Opposer's as to likely cause mistake, confusion or deception on the part of the public. It is likely that the Respondent-Applicant's mark is seen as just a variation of Opposer's KRIS mark or that its goods originated or sponsored by the Opposer or vice versa. In addition, the words "I MISS YOU" which is a mere expression of feelings does not work to distinguish Respondent-Applicant's goods from the others.

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 purchaser as to cause him to purchase the one supposing it to be the other⁶.

Further, the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer

⁵ *Elepha A.G. v. Director of Patents*, G.R. No. L-20635, 31 March 1966.

⁶ See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.


brand for it.⁷

Accordingly, this Bureau finds that the registration of Respondent-Applicant's mark is proscribed by law.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-004795, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

Taguig City

14 JUL 2016


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

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