NYSE GROUP, INC.	}	**IPC No. 14-2011-00014**
Petitioner,	}	Cancellation of :
	}	Reg. No. 4-2003-002168
	}	Date Issued: 19 March 2007
-versus-	}	TM : **"NYSE"**
RYAN ONG and /or MICHELLE ONG,	}	
Respondent-Registrant.	}	

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 343 dated October 04, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 04, 2016.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

NYSE GROUP, INC., Petitioner, -versus- **RYAN ONG and/or MICHELLE ONG,** Respondents. x----------x	}**IPC NO. 14-2011-00014** }Petition for Cancellation: } }Cert of Reg. No. 4-2003-002168 }Date issued: 19 March 2007 } }Trademark: **NYSE** } Decision No. 2016- 343

DECISION

NYSE GROUP, INC. (Petitioner)[1] filed a Petition for Cancellation of Registration No. 4-2003-002168. The registration, in the name of **RYAN ONG and/or MICHELLE ONG** (Respondent-Registrant)[2], covers the mark "NYSE", for use on "wallets, coin purse, traveling luggage, suitcases, traveling bags, attache cases, school bags, shoulder bags, clutch bags, overnight bags, pilot cases" under class 18; "T-shirts, polo shirts, polo pants, jeans, slacks, jackets, briefs, panties, belts, caps, blouses, skirts, socks, suspender coats, vests, sweatshirts, jogging suits, swimming trunks, swimsuits, shorts, shoes, slippers, boots" under class 25 and "outlet for clothing apparel, footwear and accessories" under Class 30 of the International Classification of Goods[3].

The Petitioner invokes Section 151.1, pars. (b) and (c), of Rep. Act. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") which provides that that a trademark registration may be cancelled on any of the following reasons/grounds: (a) the registered owner without legitimate reason fails to use the mark within the Philippines; (b) the registered owner without legitimate reason fails to cause the mark to be used in the Philippines by virtue of a license during an uninterrupted period of three (3) years or longer (c); the registered owner abandons the mark; (d) if the registration of the mark was obtained fraudulently or contrary to the provisions of the IP Code. In addition, Petitioner claims to be the registered owner of a well-known mark and has the right to ask for the cancellation of a mark that is identical with or confusingly similar to or constitutes a translation of the well known mark as long as the use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark and the interests of the owner of

[1] A corporation duly organized and existing under the laws of the United States of America with business address at 11 Wall St. New York, N.Y. 10005, USA

[2] Filipino with address at 33 Panalturan St., Del Monte 1, Quezon City

[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.

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the registered mark are likely to be damaged by such use, as found in Section 123.1 (e) and (f). The Petitioner claims exemplary and moral damages and attorney's fees.

The Petitioner alleges, among other things, the following facts:

"4. Petitioner NYSE is the successor of the New York Stock Exchange, Inc. which was founded in 1972. New York Stock Exchange, Inc. is a foreign corporation duly organized and existing under the laws of the United States of America, which is a signatory to the Convention of Paris for the Protection of Industrial Property, otherwise known as the Paris Convention. The Republic of the Philippines is also a signatory to the Convention.

"5. On February 4, 2005, the Philippine Intellectual Property Office ('IPO') granted Petitioner NYSE the Certificate of Registration No. 4-1999-005068 for the mark 'NYSE' for Class 36. In addition to the 'NYSE' mark, Petitioner NYSE is also the owner of several marks registered with the IPO containing the mark 'NYSE' as follows:

(a) 'NYSE MILLENIUM INDEX' for class 36 with Certificate of Registration No. 41999005069 issued on October 30, 2004.

(b) 'NYSE COMPOSITE INDEX' for class 36 with Certificate of Registration No. 41999005071 issued in October 30, 2004.

(c) 'NYSE LIFFE' for classes 9, 35, 41, 42, 16 with Certificate of Registration No. 42008011214 issued on May 25, 2009.

"6. Since 1863, Petitioner NYSE (through its predecessor, the New York Stock Exchange, Inc.) has been engaged in the operation of a securities exchange and related stock market services. It spends a substantial amount of time and money in promoting the 'NYSE' mark throughout the world and maintaining the mark's credibility. As a result of these efforts, the mark has been exclusively associated with the Petitioner NYSE in the mind of the international public.

"7. In the United States of America, Petitioner NYSE is the registered owner of the 'NYSE' mark, which was first registered on March 2, 1971 with Certificate of Registration Number 909,350. The trademark was recorded as having been first used as early as January 1863.

"8. In various countries such as Norway, South Korea, Japan, Canada and the European Union, Petitioner NYSE is also the registered owner of 'NYSE' mark xxx

"9. Aside from the above-mentioned registrations, Petitioner NYSE has advertised the 'NYSE' mark in several publications and in the Internet. The popular search engine 'Google' will readily show that 'NYSE' refers

only to 'New York Stock Exchange', the predecessor of Petitioner NYSE. In Google, 'NYSE' has more than Seventeen Million (17,000,000) entries, and these entries refer only to the mark registered in the name of Petitioner NYSE.xxx

To support its petition, the petitioner submitted as evidence the following:

1. Secretary's Certificate signed by Janet L. McGinness dated 10 December 2010;
2. Copy of Certificate of Registration No. 4-1999-005068 dated 24 February 2005 for the mark "NYSE" for services under class 36;
3. Copy of Certificate of Registration No. 4-1999-005069 dated 30 October 2004 for the mark "NYSE MILLENIUM INDEX" for services under class 36;
4. Copy of Certificate of Registration No. 4-1999-005071 dated 30 October 2004 for the mark "NYSE COMPOSITE INDEX" for services under class 36;
5. Copy of Certificate of Registration No. 4-2008-011214 dated 25 May 2009 for the mark "NYSE LIFFE" for goods/services under class 9, 16, 35,36, 41, 42;
6. Copy of Certificates of Trademark Registration in the United States of America, Norway, Korea, Japan, Canada and OHIM;
7. Print-out of website showing NYSE entries in the internet;
8. Print out of status of "NYSE" registration in the IPO website in the name of Michelle Ong;
9. Copy of demand letter from the firm J.P. Garcia & Associates dated 6 May 2010; and
10. Copy of letter signed by Jorge Cesar Sandiego dated 21 May 2010[4]

The Respondents filed their Answer on 6 July 2011 alleging, among things, the following affirmative defenses:

"2.1.1. It cannot be denied that the goods covered are different-

a) Respondent's registration cover goods under classes 25 and 18 (garments and leather goods) and services under class 35 for and outlet selling clothing apparel, footwear and accessories

b) Petitioner's marks NYSE, NYSE Millenium Index, NYSE Composite Index were issued to cover a very different line of services, i.e. securities and exchange services namely-providing a market for the trading of securities and providing financial and securities information, compiling and disseminating trade and quote index value and other market information

c) Petitioner's mark NYSE LIFFE was issued for computers and computer softwares for various purposes, publications, financial consultations and the like

[4] Annexes "A" to "L"

2.1.2 Consequently, there being a difference of goods and services covered, the competing marks can co-exist as Section 138 of RA 8293 which provides xxx

2.1.3. On this issue, it is interesting to note that in par. 16 of the Petition, Petitioner's cited Section 147.2 of R.A. 8293 where it claimed that: Section 147.2 of R.A. 8293 allows the registered owner of a well known mark such as Petitioner NYSE, the exclusive rights to the use thereof extending to goods and services which are not similar to those in respect of which the mark is registered.

2.2. In par. 32 of the Petition, the case of Shangri-la Hotel vs. Developers Group of Companies was cited which is respectfully dissected as follows:

a) In the said case, it was ruled that it was not only the words that was exactly copied but also the special design of the logo S-logo. In this case there is no logo involved but only the letters NYSE with both marks written in standard letter font-times new roman-TIMES NEW ROMAN.

b) Consequently, with only the words being the same- the general rule applies that when a trademark copycat adopts the word portion of another's trademark as his own, there may still be some doubt that the adoption is intentional. This is in fact enshrined in Section 147.1 of the law which reads:

Section 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 from 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.

2.3. Finally, this brings the whole matter to the issue on Petitioner's claim of the application of Section 147.2 in relation to the ruling of the Supreme Court in the ROLEX case which reads: xxx

2.3.1. However, the submission in the Prefatory statement that the petitioner failed to submit affidavits of witnesses in its Petition is hereto reiterated. Such being the case, there is therefore no proof of 'connection' as required by law.

2.4. Respondent's also oppose the claim of the mark NYSE being internationally known in the Philippines as the documents presented herein to support such claim are not sufficient and not properly authenticated by Philippine consulates, i.e. there are only five alleged registrations from the following countries:

a) United States (Annex 'C' of the Petition)

b) Norway (Annex 'D' of the Petition)
c) Korea (Annex 'E' of the Petition)
d) Japan (Annex 'F' of the Petition)
e) Canada (Annex 'G' of the Petition)

2.4.1. There being no proof of authentication, these documents should be totally disregarded.

2.5. On the other hand, the registration from the Office of Harmonization in the International Market for Trademarks (Annex 'H' of the Petition) should not be considered totally as the Philippines is not a member thereto.

3.1. With due respect, this Honorable Office has no jurisdiction over claims for damages in inter partes case.

3.2. As this case involves cancellation of trademarks, par. 101 should apply where there are no provision on damages.

3.3. On the other hand, damages can only be granted in cases of violation of intellectual property rights such as infringement and unfair competition which is not the cause of action in this Petition."

The Preliminary Conference was held on 8 March 2012. On 14 March 2012, Order No. 2012-4022 was issued wherein Annexes "C" to "H" were stricken off the records.

Should the Respondent-Registrant's trademark registration for "NYSE" be cancelled?

Records show that at the time Respondent registered the mark "NYSE" on 19 March 2007, the Petitioner already obtained Certificate of Registration No. 4-1999-005068 dated 24 February 2005 for the mark "NYSE" ; Certificate of Registration No. 4-1999-005069 dated 30 October 2004 for the mark "NYSE MILLENIUM INDEX" and Certificate of Registration No. 4-1999-005071 dated 30 October 2004 for the mark "NYSE COMPOSITE INDEX", all for services under class 36. The Respondent-Registrant uses its mark "NYSE" for goods under classes 18 and 24 and 30.

The competing marks are reproduced below are identical:

Petitioner's mark	Respondent-Registrant's mark
NYSE	**NYSE**

The Petitioner's other marks are depicted below:

NYSE
COMPOSITE INDEX

NYSE
MILLENNIUM INDEX

NYSE LIFFE

Section 151 of the IP Code provides:

> Section 151. Cancellation – 151.1. A petition to cancel a registration of a mark under this Act may be filed with the Bureau of Legal Affairs by any person who believes that he is or will be damaged by the registration of a mark under this Act as follows:
>
> (a) Within five (5) years from the date of registration of the mark under this Act.
> (b) At any time if the registered mark becomes the generic name for the goods or services or a portion thereof, for which it is registered or has been abandoned, or its registration obtained fraudulently, or contrary to the provisions of this Act, or if the registered mark is used by, or with the permission of the registrant so as to misrepresent the source of the goods or services or in connection with which the mark is used.

The Petitioner alleges that it is the owner of the well known mark NYSE. Records show that the goods of the Respondent-Registrant are different from the services of the Petitioner. The Petitioner uses its mark NYSE in the business of securities exchange and stock market services while the Respondent-Registrant uses the mark NYSE on garments, leather goods and outlet for clothing apparel. Filipinos would not immediately have in mind the New York Stock Exchange when confronted with the mark NYSE on goods under classes 18, 25 and 30.

The use, therefore, of identical marks on unrelated and non-competing goods is allowed.

It is basic in trademark law that the same mark can be used on different types of goods. The Supreme Court in Philippine Refining Co. Inc. v. Ng Sam[5] held:

> A rudimentary precept in trademark protection is that "the right to a trademark is a limited one, in the sense that others may used the same mark on unrelated goods." Thus, as pronounced by the United States Supreme Court in the case of *American Foundries vs. Robertson*, "the mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description."
>
> Such restricted right over a trademark is likewise reflected in our Trademark law. Under Section 4(d) of the law, registration of a trademark which so resembles another already

[5] GR. No. L-26676 July 30, 1982
[7] G R. 120900 July 20, 2000

registered or in use should be denied, where to allow such registration could likely result in confusion, mistake or deception to the consumers. Conversely, where no confusion is likely to arise, as in this case, registration of a similar or even Identical mark may be allowed.

In Canon Kabushiki Kaisha v. Court of Appeals[6] likewise held:

xxx petroleum products on which the petitioner therein used the trademark ESSO, and the product of respondent, cigarettes are "so foreign to each other as to make it unlikely that purchasers would think that petitioner is the manufacturer of respondent's goods". Moreover, the fact that the goods involved therein flow through different channels of trade highlighted their dissimilarity xxx

Thus, the evident disparity of the products of the parties in the case at bar renders unfounded the apprehension of petitioner that confusion of business or origin might occur if private respondent is allowed to use the mark CANON."

Thus, both may co-exist as long as the goods/services are not similar or closely related. The parties' respective businesses are so unrelated to even think that Petitioner is producing such goods.

WHEREFORE, premises considered, the instant Petition to Cancel Trademark Registration No. 4-2003-002168 is hereby **DENIED.** 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, 04 OCT 2016.

Adoracion Zare

Atty. ADORACION U. ZARE, LL.M.
Adjudication Officer
Bureau of Legal Affairs