



EBAY, INC.,
Opposer,

-versus-

GULF PEARL LTD. [C.A],
Respondent- Applicant.

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}
} IPC No. 14-2013-00044
} Opposition to:
} Appln. Serial No.4-2012-009877
} Date Filed: 13 August 2012
} TM: "TAMBAY"
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NOTICE OF DECISION

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**FIRST IP CONSULTANCY AND
TECHNICAL SERVICES CO.,**
For Respondent-Applicant
L13 B152, Casa Milan Neopolitan V
Commonwealth Avenue, North Fairview
Quezon City

GREETINGS:

Please be informed that Decision No. 2016 - 157 dated May 31, 2016 (copy enclosed)
was promulgated in the above entitled case.

Taguig City, May 31, 2016.

For the Director:


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

EBAY, INC.,

Opposer,

-versus-

GULF PEARL LTD. [C.A],

Respondent-Applicant.

X ----- X

IPC No. 14-2013-00044

Opposition to Trademark

Application No. 4-2012-009877

Date Filed: 13 August 2012

Trademark: **"TAMBAY"**

Decision No. 2016- 157

DECISION

Ebay, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-009877. The contested application, filed by Gulf Pearl Ltd. [C.A.]² ("Respondent-Applicant"), covers the mark "TAMBAY" for use on *"online classified service; advertising; promoting the goods and services of others; marketing; market research and information services; promoting the goods and services of others via computer and communication networks; online retail store services featuring delivery of digital media; charitable services, namely promoting public awareness about charitable, philanthropic, volunteer, public and utility service and humanitarian activities; contest and incentive award programs designated to recognize, reward and encourage individuals and groups; online media monitoring services using computer software to automatically monitor internet websites and online publications for customer-specified topics and to capture relevant content on those topics; providing documentation and analysis of that online content to other for business purposes; providing commercial information updates online and over a global computer network in the fields of business, commerce, and industry; and shopping facilitation services", "online news site/blog; providing on-line electronic journals and publications; and providing on-line information" and "internet based social networking services; providing on-line computer databases and on-line searchable databases in the field of social networking; and providing a social networking website for entertainment purposes"* under Classes 35, 41 and 45, respectively, of the International Classification of Goods³.

The Opposer alleges that it is the owner of the trademark "EBAY", registered under Certificate of Registration Nos. 4-1999-009669 and 4-2007-500868, for use on goods under Class 35. It avers that it also has trademark applications and/or registrations in at least fifty-six (56) different countries long before the appropriation

¹ A corporation duly organized and existing under the laws of the State of Delaware, United States, with business address at 2145 Hamilton Avenue, San Jose California 95125, United States of America.

² With known address at 1704 350 Seneca Hill Drive Toronto, Ontario, M2J 4S7, Canada.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the 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 Purpose of the Registration of Marks concluded in 1957.

Republic of the Philippines

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and/or filing on the contested application by the Respondent-Applicant. It claims that through international marketing and promotion of "EBAY", the mark has become internationally well-known and has acquired worldwide goodwill.

According to the Opposer, its company is the world's largest online marketplace, having over 280 million users and hosts an online service which features over 14 million listings of items being offered for sale or bid in its website www.ebay.com. It contends that under Section 147 of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), it has the right to exclude others from registering or using confusingly similar marks such as the Respondent-Applicant's "TAMBAY" mark. It asserts that the registration of "TAMBAY" is contrary to Section 123.1 subparagraphs (d) and (e) of the IP Code. In support of its opposition, the Opposer submitted the declaration of Valente F. Tolero, with annexes.⁴

This Bureau issued a Notice to Answer dated 17 July 2013 and served a copy thereof upon the Respondent-Applicant. The latter, however, did not file an Answer. Thus, the Hearing Officer issued Order No. 2013-1583 on 20 November 2013 declaring Respondent-Applicant in default and the case submitted for decision.

The issue to be resolved is whether the trademark "TAMBAY" should be allowed registration.

The Opposer anchors its opposition on Section 123.1 (d) and (e) of the IP Code, which 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;

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-

⁴ Marked as Exhibits "A" to "L".

known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark; x x x"

Corollarily, Section 147 of the IP Code provides:

"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."

In this regard, records reveal that at the time the Respondent-Applicant filed its application for the mark "TAMBAY", the Opposer has a valid and existing registration of the mark "EBAY" under Certificate of Registration Nos. 4-1999-9669 and 4-2007-500868 issued on 05 September 2002 and 09 June 2008, respectively. The marks, shown below:

Opposer's marks:



Respondent-Applicant's mark:

TAMBAY

similarly end with the syllable "BAY". This notwithstanding, the Bureau finds that confusion, much less deception, is unlikely. Aside from the identical last three letters, the competing marks are easily distinguishable from each other. The first syllable in the Respondent-Applicant's mark, "TAM", is so different in looks and sound to the first syllable or letter of the Opposer's, "E". This variance is substantial as far as Filipinos are concerned. With "TAM" or its first syllable, the concept or idea created when it is paired with "BAY" is totally different from "EBAY". The "BAY" is

pronounced not as /bey/ as in "EBAY" but /bai/, as in the Filipino word for "bystander" or "to lounge". In this regard, the Opposer has not shown that it has used or is using variations of its mark "EBAY" with "BAY" as its distinctive component. Therefore, it is improbable for a consumer to associate the services of "EBAY" to "TAMBAY", and vice-versa.

Finally, it is emphasized that 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 The Respondent-Applicant's trademark sufficiently met this requirement.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-009877 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **31 MAY 2018**


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

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