

FACTON LIMITED,
Opposer,

-versus-

ZHENJIANG WANG,
Respondent-Applicant.

X-----X

} **IPC No. 14-2015-00003**
}
} Opposition to:
} Appln. Serial No. 4-2014-0010169
} Date Filed: 13 August 2014
}
}
} **TM: E-STAR**
}

NOTICE OF DECISION

DEL ROSARIO & DEL ROSARIO

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ZHENJIANG WANG

Respondent- Applicant
3rd Floor, 111 J. Fernando Street,
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GREETINGS:

Please be informed that Decision No. 2017 - 05 dated 12 January 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 16 January 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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IPC NO. 14-2015-00003

Opposition to:
App.Serial No. 4-2014-0010169
Date Filed: 13 August 2014
TM: "E-STAR"

Decision No. 2017- 05

DECISION

FACTON LIMITED¹ ("Opposer"), filed an opposition to Trademark Application Serial No. 4-2014-0010169. The application, filed by ZHENJIANG WANG² ("Respondent-Applicant"), covers the mark "E-STAR" for use on "*clothing, namely, shirts, t-shirts, undershirts, sandos, long sleeves, coats, jackets, sweaters, sweatshirts, pants, slacks, jeans, shorts, sport shorts, jogging pants, briefs, swimming trunks, bathing suits, dresses, skirts, blouses, blazers, shawls, scarves, cardigans, brassieres, panties, half slips, under wears, pajamas, belts, socks, neckties; wristbands, sleepwear, pajamas; footwear, namely, shoes, slippers, boots, sandals, topsiders; headgear, namely, hats, caps and visors*" under Class 25 of the International Classification of Goods.³

The Opposer alleges that the applied mark E-STAR cannot be registered as it nearly resembles the previously registered marks belonging to the it and that the goods upon which their marks are used are the same or closely related such that, the registration of Respondent-Applicant's mark will likely cause confusion or deception, to the detriment of the Opposer. According to Opposer, the confusing similarity of Respondent-Applicant's mark to that of Opposer's shows an obvious attempt to pass off his goods as those of the latter. Thus, to allow Respondent-Applicant's registration and subsequent use of the mark will actually create confusion, mistake and deception to the buying public as to the origin and sponsorship of the goods, and cause great and irreparable injury and damage to Opposer's business reputation and goodwill as a senior user.

The Opposer's evidence consists of the following:

1. Printout from IPOPHL's Trademark Database regarding Registration No. 4-2009-0006920 for the mark G-STAR granted on 04 December 2009;
2. Printout from IPOPHL's Trademark Database regarding Registration No. 4-

¹ A corporation organized and existing under the laws of Hungary with principal address at Strawinskylaan 3105, 1077 ZX, Amsstredam, The Netherlands.

² An Indian national with address at 1973 Spring Street, San Miguel Village, Brgy. Poblacion, Makati City.

³ The 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.

- 2002-0003766 for the mark G-STAR INSIDE A STRETCHED LETTER G ENCLOSED IN A RECTANGLE granted on 01 August 2007;
3. Printout from IPOPHL's Trademark Database regarding Registration No. 4-2004-004311 for the mark G-STAR (OUD) LOGO granted on 25 March 2010;
 4. Printout from IPOPHL's Trademark Database regarding Application Serial No. 4-2014-0010169 for the mark E-STAR applied on 13 August 2014;
 5. Legalized and authenticated Affidavit of Johannes Christian de Bil;
 6. List of registrations for the trademark G-STAR and variants in various countries;
 7. Representative samples of registrations for the mark G-STAR issued in Benelux, OHIM, U.S.A., Japan, and Australia;
 8. List of Projects and Milestones of G-STAR;
 9. Printouts of relevant pages from Opposer's website www.g-star.com;
 10. Representative samples of advertisements in magazines throughout the world;
 11. Certificate authorizing Johannes Christian de Bil to sign the verification and certificate of non-forum shopping.

This Bureau issued on 06 March 2015 a Notice to Answer and served a copy thereof to the Respondent-Applicant on 10 June 2015. However, despite receipt of Notice, Respondent-Applicant failed to file the Answer. On 19 May 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 **E-STAR**?

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;

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

At the time the Respondent-Applicant filed its trademark application on 13 August 2014, Opposer already has existing trademark registrations for the mark G-STAR and its variants, the earliest of which was issued way back in 01 August 2007. Opposer's G-STAR mark is used on "*clothing namely jeans, trousers, shirts, t-shirts, socks, stockings, jackets, coats, shorts, blouses, sweaters; rainwear and warm-up suits; ski-wear namely anoraks or similar; undergarments; footwear like shoes, sports shoes namely sneakers, boots, headgear namely hats, caps; leather belts (clothing)*" under Class 25. Other registrations for the mark G-STAR is for goods/services belonging to Classes 9, 18, 35 and 41. On the other hand, Respondent-Applicant's mark will be used on "*clothing, namely, shirts, t-shirts, undershirts, sandos, long sleeves, coats, jackets, sweaters, sweatshirts, pants, slacks, jeans, shorts, sport shorts, jogging pants, briefs, swimming trunks, bathing suits, dresses, skirts, blouses, blazers, shawls, scarves, cardigans, brassieres, panties, half slips, under wears, pajamas, belts, socks, neckties; wristbands, sleepwear, pajamas; footwear, namely, shoes, slippers, boots, sandals, topsiders; headgear, namely, hats, caps and visors* " also under Class 25. Thus, the parties' goods are similar and/or closely related.

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



Opposer's Mark

e-star

Respondent-Applicant's Mark

Confusion is likely in this instance because of the close resemblance between the marks. Respondent-Applicant's mark "E-STAR" adopted the dominant feature of Opposer's mark G-STAR. While Respondent-Applicant's mark differs from Opposer because the word star is preceded by the letter "E" and the mark is written in lower case letters in contrast to Opposer's mark which is all written in upper case letters, E-STAR sounds almost the same as Opposer's trademark G-STAR. Respondent-Applicant merely changed the first letter "G" in Opposer's G-STAR with the letter "E" to come up with the mark E-STAR. It could result to mistake with respect to perception because the marks sound so similar. Under the idem sonans rule, the following trademarks were held confusingly similar in sound: "BIG MAC" and "BIG MAK", "SAPOLIN" and LUSOLIN", "CELDURA" and "CORDURA", "GOLD DUST" and "GOLD DROP". The Supreme Court ruled that similarity of sound is sufficient ground to rule that two marks are confusingly similar, to wit:

Two letters of "SALONPAS" are missing in "LIONPAS": the first letter and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance...."SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of

sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties.⁸ *MacDonaldsCorp, et. alv. L. C. BigMakBurger*, G.R. No. L-143993, 18 August 2004. *Sapolin Co. v. Balmaceda and Germarm Co.m* 67 Phil, 705. *Co Tiong SA v. Director ofPatents*, G.R. No. L- 5378, 24 May 1954; *Celanes Corporation ofAmerica vs. E. I. Du Pont de Nemours Co* (1946), 154 F. 2d 146 148.) *Marvex Commerical Co., Inc. v.Petra Hawpia Co., et. ai*, G.R. No. L-19297, 22 Dec. 1966.

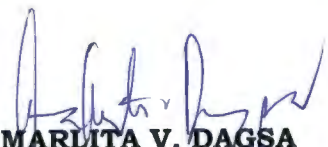
Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. When Respondent-Applicant's mark is pronounced, the sound of Opposer's G-STAR mark is practically replicated. Similarity of sound is sufficient ground to rule that two marks are confusingly similar when applied to merchandise of same descriptive properties.

Accordingly, since Respondent-Applicant's mark is confusingly similar to Opposer's mark G-STAR, its registration is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-0010169, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City **T2 JAN 2017**


MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs