

GEOFFREY LLC,
Opposer,

-versus-

MA. GLADYS G. DEL ROSARIO,
Respondent-Applicant.

X-----X

IPC No. 14-2016-00027

Opposition to:

Appln. Ser. No. 4-2015-000500562

Date Filed: 03 February 2015

TM: SPA ARE US

NOTICE OF DECISION

VERALAW (Del Rosario Raboca Gonzales Grasparil)

Counsel for Opposer
A & V Crystal Tower,
105 Esteban Street, Legaspi Village
Makati City

MA. GLADYS G. DEL ROSARIO

Respondent- Applicant
Block 1 Lot 19 Goldridge Subdivision
Guiguinto, Bulacan 3015

GREETINGS:

Please be informed that Decision No. 2017 - 158 dated 10 May 2017 (copy enclosed) was promulgated in the above entitled case.

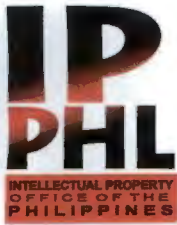
Pursuant to Section 2, Rule 9 of the IPOPHEL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 16 May 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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GEOFFREY, LLC,
Opposer,

- versus -

MA. GLADYS G. DEL ROSARIO,
Respondent-Applicant.

X ----- X

IPC No. 14-2016-000237
Opposition to:

Appln. Ser. No. 4-2015-000500562
Date Filed: 03 February 2015
Trademark: "SPA ARE US!",

Decision No. 2017 - 158

DECISION

GEOFFREY, LLC ("Opposer")¹, filed a Verified Opposition to Trademark Application Serial No. 4-2015-000500562. The application, filed by MA. GLADYS G. DEL ROSARIO ("Respondent-Applicant")², covers the mark "SPA ARE US" for use on "hygienic and beauty care for human beings" under class 44 of the International Classification of Goods and Services.³

The Opposer alleges that in 1948, Charles Lazarus started a baby furniture store by the name of Children's Bargain Town, in Washington D.C.. He also introduced infant products and toys for older children. As early as 1960, Mr. Lazarus settled on the name TOYS R US with a backward "R". He expanded his fledging business into a toy conglomerate that became a public company in 1978 with its iconic mascot Geoffrey the Giraffe and catchy jingles. Opposer also diversified into children's clothing and baby products, and launched Toysrus.com in June 1998 which became one of the fastest growing sites in the toy and baby products shopping categories. In addition to expanding "R" Us stores and brands in the U.S.A., Opposer launched a worldwide presence. To date, Toys "R" Us and Babies "R" Us merchandise are sold in more than 893 stores in the United States and Puerto Rico, and in more than 730 international stores and over 205 licensed stores in 36 countries and jurisdictions, including the Philippines.

According to the Opposer, the Toys "R" Us trademarks are well-known internationally, due in part to Opposer's aggressive and extensive promotions and advertisements. The Toys "R" Us trademarks are invented registered trademarks in various jurisdictions. In the Philippines, the marks Toys R Us, Toys "R" Us, Toys "R" Us Express, Toys R Us Toy Box, Toys R Us With Star Device, Toys R Us, Babies R Us With Star Device, Babies R Us, Bikes R Us, and Kids R Us are registered trademarks under the name of the Opposer which are valid and subsisting to date. Thus, the instant opposition cites the following grounds: (a) The Toys R Us trademarks,

¹ A limited liability company formed under the laws of the State of Delaware with office at One Geoffrey Way, Wayne, New Jersey 07470, United States of America.
² With registered address at Block 1 Lot 19 Goldridge Subd. Guiguinto, Bulacan, 3015, Philippines.
³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks, which was concluded in 1957 and administered by the World Intellectual Property Organization.

owned and used by Opposer, are well-known marks that must be afforded protection under prevailing laws and jurisprudence; and (b) Respondent-Applicant's "Spa Are Us!" trademark application should not be granted considering that the mark sought to be registered is confusingly similar with Opposer's well-known Toys R Us trademarks.

The Opposer submitted the following evidence:

1. Computer print-out of Trademark Application No. 4201500500562;
2. Consent of the Sole Member of Geoffrey, LLC dated 13 February 2015;
3. Special Power of Attorney/Secretary's Certificate;
4. Affidavit-Direct Testimony of Ms. Elizabeth Irwin;
5. Certified true copy (Ctc) of the Certificate of Conversion from a Corporation to a Limited Liability Company;
6. Certificate of Formation of Geoffrey, LLC;
7. Certificate of Trademark Registration of Toys "R" Us and variances in various jurisdictions;
8. Trademark Registry List of Toys "R" Us and variances marks;
9. Certificate of Trademark Registration of Toys "R" Us and variances marks issued by the Intellectual Property Office of the Philippines;
10. Copies of advertisements, promotions and website information of the marks; and,
11. Verification and Certification against Forum Shopping.

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 13 February 2016. Said Respondent-Applicant, however, did not file an Answer. Hence, this case is submitted for decision⁴.

Should the Respondent-Applicant be allowed to register the trademark SPA ARE US!?

Records and evidence show that the Opposer has valid and existing registrations for the mark Toys "R" Us and variances in different jurisdictions worldwide⁵, including the Philippines⁶. It presents a registration date prior to that of Respondent-Applicant's subject trademark SPA ARE US! which was filed for trademark application only on 03 February 2015.

But are the competing marks, as shown below, confusingly similar?

TOYS 'R' US

TOYS R US

TOYS "R" US

BABIES R US

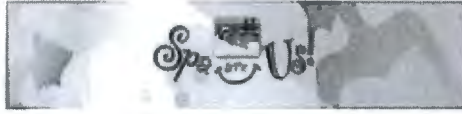
Opposer's Trademarks

⁴ Order of Default dated 22 July 2016.

⁵ Annex "D" of Opposer.

⁶ Annex "E" of Opposer.

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Respondent-Applicant's Trademark

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a 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.⁷ Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

The eyes can see that the marks are different. The resemblance, consisting of the word "US" has minor representation in the subject mark's overall appearance and thus, displays insignificant impression. Such resemblance is not sufficient to conclude that confusion is likely to occur. The visual entirety of Respondent-Applicant's mark, including the font used is obviously distinct from that of Opposer's. The specific description of Respondent-Applicant's mark, as it appears, displays the use of the colors purple and golden brown in the word marks SPA, US and ARE. There also appears an image of a cartoon photo of a girl having massage while winking and the smiley image. The background of which is in light mint green color.⁸

Moreover, confusion or mistake, much less deception, is unlikely in this instance because the goods covered by Opposer's trademark registrations are different from that of Respondent-Applicant's. Opposer's Toys "R" Us cover classes 25, 28, 35, 42, referring to retail store services and apparels. On the other hand, Respondent-Applicant's SPA ARE US! cover class 44 for hygienic and beauty care for human beings. Thus, the parties' respective goods/service neither flow in the same channels of trade nor target the same market as to result to any confusion. A consumer could easily discern that there is no connection between the two marks where the Opposer's goods and retail store with its brands are substantially different to Respondent-Applicant's specialized service store. Buyers and patrons of branded and particular products and/service are highly aware of the channels of trade either to make a purchase, or to avail its specialized service. The buying public should be credited with a modicum of intelligence and discernment.

⁷ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

⁸ Filewrapper records.

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Corollarily, the enunciation of the Supreme Court in the case of *Mighty Corporation vs. E. & J. Gallo Winery*⁹ aptly states that:

"A very important circumstance though is whether there exists likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the source of the goods in question. The 'purchaser' is not the 'completely unwary consumer' but is the 'ordinarily intelligent buyer' considering the type of product involved. he is 'accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The situation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

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.¹⁰ This Bureau finds that the Respondent-Applicant's mark meets this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2015-500562 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. **10 MAY 2017**



Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs

⁹ G.R. No. 154342, 14 July 2004.

¹⁰ *Pribhdas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 November 1999.