



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

YAHOO! INC.,
Opposer,

-versus-

SHI YOUSI,
Respondent-Applicant.

X-----X

IPC No. 14-2014-00500

Opposition to:

Appln. Ser. No. 4-2013-0013215

Date Filed: 04 November 2013

TM: YAGOO

NOTICE OF DECISION

FEDERIS & ASSOCIATES LAW OFFICES

Counsel for Opposer

2004 & 2005 88 Corporate Center

141 Valero corner Sedeño Streets,

Salcedo Village, Makati City

SHI YOUSI

Respondent-Applicant

Unit 601 Tytana Plaza

611 Oriente Street,

Binondo, Manila

GREETINGS:

Please be informed that Decision No. 2017 - 387 dated 29 November 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, 11 December 2017.

MARILYN F. RETUTAL

IPRS IV

Bureau of Legal Affairs

YAHOO!INC.,

Opposer,

-versus-

SHI YOUSI,

Respondent-Applicant.

x-----x} Decision No. 2016 387

} **IPC NO. 14-2014-00500**

} Opposition to:

} Appln. Serial No. 4-2013-0013215

} Trademark: **YAGOO**

}

}

}

}

DECISION

YAHOO! INC. ("Opposer")¹ filed a Verified Notice of Opposition to Trademark Application Serial No. 4-2013-00013215. The contested application, filed by SHI YOUSI ("Respondent-Applicant")², covers the mark "YAGOO" for use on mobile radio, two way radio and handheld radio under Class 9 of the International Classification of Goods and Services.³

The Opposer alleges that it is a branded network of comprehensive products, serving millions of Internet users daily, operating and managing the well-known YAHOO! website, which the Opposer avers as one of the leading Internet websites worldwide in terms of traffic, advertising, household and business user reach. Furthermore, the Opposer alleges that:

"10. x x x In addition to the variety of services offered at Opposer's main website located at the domain name < yahoo.com >, it operates many additional sites under the YAHOO! mark and other YAHOO!-formative trademarks."

"11. Opposer's services reach domestic and international markets, and include Internet search services, publication and distribution of news and information related to a variety of topics, online games, people searches, astrology and horoscopes, greetings, online calendaring, travel reservation services, domain name registration services, photograph services, e-mail, chat and bulletin board services, instant messaging, blogging services, stock quotes, insurance quotes, electronic messaging, small business advice and services, business and financial information and services, movie reviews, news, weather, sports, maps, auctions, online shopping, classified advertising, audio and video streaming, and web store hosting and management, among other services."

"12. In addition to its many online services, Opposer uses the YAHOO! mark on a wide variety of products and services, clothing, games, housewares, computer accessories and equipment, sunglasses, eyewear, mobile device accessories, tablet accessories and power cords, among others."

¹ A company organized and existing under the laws of the State of Delaware, with principal office address at 701 First Avenue, Sunnyvale, California 94089, USA.

² Address of record at Unit 601 Tytana Plaza, 611 Oriete St., Manila, Metro Manila, Philippines.

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.

AB

"13. Opposer also offers a wide variety of services using the YAHOO! mark together with a descriptive name of its services, including but not limited to YAHOO! Shopping, YAHOO! Games, YAHOO! Travel, YAHOO! Small Business, YAHOO! Messenger, YAHOO! Finance, YAHOO! Autos, YAHOO! Health, YAHOO! Mail, and YAHOO! Weather, among others"

"14. The mark YAHOO! is an arbitrary term as applied to the Opposer's services and products"

x x x

"18. Opposer registered the domain name YAHOO.COM with Network Solutions, Inc. on 18 January 1995 and has used the domain name to identify the YAHOO! website since on or about that date."

x x x

"21. Opposer is the owner of the trademark and service marks YAHOO! and YAHOO! (stylized), as well as the trade name YAHOO! and the domain name <yahoo.com>, and variations thereof."

"22. Opposer and its subsidiaries currently own over three thousand four hundred (3,400) trademark applications and registrations in more than 145 countries and jurisdictions worldwide. Opposer owns more than 1200 YAHOO! formative applications and registrations in approximately 134 countries and jurisdictions worldwide."

"23. The mark YAHOO! is registered in the Philippines. Opposer sought trademark protection as early as in 1996. The trademark certificates issued in the Philippines are as follows, covering goods and services in Classes 9, 16, 35, 38, 39, 41, 42, and 43: x x x"

"24. In addition, Opposer also owns YAHOO! formative trademark registrations x x x"

"25. Opposer also owns numerous YAHOO! formative domain names including the well-known www.yahoo.com and www.yahoo.com.ph"

"26. Since at least as early as 1996, Opposer has advertised the YAHOO! brand through various media such as television and radio, in publications and on signage, in the USA, Philippines and internationally. Advertising has reached hundreds of millions of people around the world."

"27. Opposer provides products and services in more than 45 languages and in over 60 countries, regions and territories x x x"

"28. x x x Outside of Yahoo!'s English-speaking markets, it has built independent, localized-language directories, websites and other content, developed by native speakers of each language."

"29. Opposer has established offices worldwide to facilitate the local development of its international operations. For the Philippines, it has established a Philippine company named, Yahoo! Philippines Services, Inc."

"30. Most of Opposer's current Internet services are offered to the public free of charge and the majority of its income is derived from the sale of advertising, marketing and co-branding or sponsorship agreements with other companies. Yahoo! also receives revenues from certain electronic-commerce transactions originating from its site, including YAHOO! Shopping, YAHOO! Travel and YAHOO! Games as well as certain premium services offered to Internet users."

"31. In addition to advertisement, Opposer also sells merchandising units, sponsorships and promotions."

x x x

“35. Opposer has also licensed the sale of merchandise bearing the YAHOO! mark such as computer equipment, toy cars, watches, writing instruments, clothing, hats, posters, watches, clocks, duffel bags, sports equipment, a magazine, and much more. x x x”

“36. The number of visits to the YAHOO! website has increased dramatically each year since Yahoo!’s inception. During September 1998, for example, the YAHOO! site averaged approximately 144 million “page views” per day, and during September 2000 traffic grew to an average of approximately 780 million page views per day. During the month of December 2004, the YAHOO! site received an average of approximately 2.85 billion page views per day, during December 2005, the YAHOO! site received an average of 3.5 billion page views per day, during June 2006, the YAHOO! site received an average of 4.2 billion page views per day. A “page view” is defined as one electronic page of information displayed in response to a user request. One visitor to the site can represent more than one page view. This translates into tens of millions of discrete visits to the YAHOO! site every month.”

“37. As of December 2013 Opposer’s global audience was approximately 800 million monthly users (excluding Yahoo! Japan with more than 400 million of them using Opposer’s services on mobile devices.”

“38. In 2014, the Alexa Internet Inc. ranked the YAHOO! website as the fifth most visited site on the Internet in the United States. In 2014, comScore Networks ranked YAHOO! the number one web property worldwide with more than 196,564,000 unique users in the United States alone.”

“39. Since its inception, the YAHOO! website has been recognized with numerous industry awards x x x”

“40. Yahoo! has likewise received notable accolades and awards x x x”

“41. The YAHOO! trademark has been held by various competent authorities to be well-known in the Philippines and internationally. For example, the Canadian Intellectual Property Office determined the YAHOO! mark is entitled to the status of a famous mark in a 2014 decision. In 2012, the Instituto Mexicano de la Propiedad Industrial declared YAHOO! trademark a famous trademark.”

“42. Due to the worldwide fame of Opposer’s YAHOO mark, among other things, the World Intellectual Property Organization (WIPO) Arbitration and Mediation Center and the National Arbitration Forum have issued over 130 decisions under the Uniform Domain Name Dispute Resolution Policy (UDRP) involving hundreds of domain names using Opposer’s mark, which resulted in the transfer of hundreds of YAHOO-variant domain names to Opposer. More than 40 of these cases expressly found the YAHOO! mark to be famous x x x”

“43. In 2001, noteworthy is the case of Yahoo! Inc. v Yahoo Computer Services where Opposer’s YAHOO! prevailed in a domain name arbitration proceeding under the .PH cc TLD against a Philippine company that registered and used the domain names yahoo.ph and yahoo.com.ph and was awarded transfer of those domain names. The three-member WIPO panel found that Opposer’s YAHOO! trademarks had “become well-known in the Philippine Islands.” x x x”

“44. Because of the global reach of Opposer’s YAHOO! mark, this mark was consequently declared as well-known in the Philippines.

- a. In a Decision dated October 1, 2007 issued by the Office of legal Affairs of the Department of Trade and Industry (“or DTI”) in Administrative Case No. 06-051 entitled “Yahoo! Inc. vs. Lizel B. Imbien, doing business under the name

and style YAHOO SARI-SARI STORE”, said DTI declared YAHOO! as a well-known trademark and trade name YAHOO!.

- b. The fact that YAHOO! is internationally well-known and well-known in the Philippines was likewise recognized in Decision in Adm. Case No. 07-13 “Yahoo! Inc. vs Arturo L. Garcia and Edward Ferrer doing business under the name and style Yahoo! Billiard Bar and Grill” of the DTI.
- c. Such was also the case in DTI’s Decision in Adm. Case No. 07-15 “Yahoo! Inc. vs Dencio K. Tan doing business under the name and style Yahoo! Photo.”

“45. On the other hand, Respondent-Applicant is an individual with an obviously Chinese name: SHI YOUSI. Nothing in the word YAGOO can be associated with this Chinese name, but it has everything for it that makes it confusingly similar to YAHOO!, through the simple expediency of misspelling it with G instead of an H.”

“46. This YAGOO appears to have surfaced only recently, i.e., in 2013 which is antedated in history and origin by Opposer’s YAHOO!. Thus, at the time Respondent-Applicant applied for the registration of YAGOO, Opposer’s YAHOO! mark is already well-known internationally and in the Philippines.”

The Opposer’s evidence consists of the following:

1. Affidavit of Kevin Kramer dated 15 December 2014.;
2. Certified true copy of the Amended and Restated Certificate of Incorporation of Yahoo! Inc.;
3. Printouts of Opposer’s website found at www.yahoo.com ;
4. Opposer’s list of all trademark registrations and applications for YAHOO!;
5. Certified true copies of Certificates of trademark registration for YAHOO!;
6. List of Opposer’s YAHOO!-formative domain names;
7. Print ads and advertisements showing Opposer’s YAHOO! Trademarks;
8. Print outs from the Internet showing the localized versions of the Yahoo! Website ;
9. Printouts taken from the Internet showing awards received by Opposer for products using the YAHOO! Trademark;
10. Certified true copies of the relevant Decision wherein the YAHOO! trademark has been held by various competent authorities to be well-known in the Philippines and internationally;
11. Collection of some of the decisions issued by WIPO Arbitration and Mediation Center and the National Arbitration Forum under the Uniform Domain Name Dispute Resolution Policy;
12. Special Power of Attorney and Certification of Authority;
13. Corporate Secretary’s Certificate;
14. Certified true copies of Philippine Certificate of Trademark Registrations for YAHOO!;
15. Decisions of Philippine Authorities declaring and recognizing YAHOO! as a well-known trademark internationally and in the Philippines;
16. Photographs of products bearing the mark YAHOO!;
17. Affidavit of Jan Abigail Ponce dated 8 January 2015;
18. Printout of the home page of Yahoo!’s website;
19. Certificate of trademark applications and registration filed with the Bureau of Trademarks;
20. Printouts of the different websites operated and maintained by Yahoo!;
21. Decisions of the WIPO Arbitration and Mediation Center and the National Arbitration Forum declaring YAHOO! mark as well-known; and
22. Yahoo! Inc.’s Financial Annual Report⁴

This Bureau served upon the Respondent-Applicant a “Notice to Answer” on 13 February 2015. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 9 September 2015 Order No.2015-1409 declaring the Respondent-Applicant in default.

Should the Respondent-Applicant be allowed to register the trademark “YAGOO”?

⁴ Exhibit “A” to “Z” with submarkings

The records show that at the time Respondent-Applicant applied for registration of the mark "YAGOO", the Opposer already has existing registrations for the marks "YAHOO!"⁵ on goods under Class 9, namely: "Pre-recorded sound recordings; computer software for providing multiple-user access to computer networks; and computer software for creating and designing websites". The goods indicated in the Respondent-Applicant's trademark application are, therefore, similar and/or closely related, if not exactly identical to those covered by the Opposer's trademark registration.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

Opposer's mark

Respondent-Applicant's mark

YAHOO!

YAGOO

Both marks are written in block style and contain the same letters "Y-A-O-O". The Respondent-Applicant merely substituted the letter H for G. Scrutinizing the composition of the trademarks involved in this case, it is observed that both marks, YAHOO! and YAGOO are almost identical with respect to the word component except for the third letter. When pronounced, the words YAHOO and YAGOO sound the same and are *idem sonans*. There are no appreciable disparities between the two marks so as to avoid the likelihood of confusing one for the other especially when used on the same goods under Class 9.

Succinctly, because the Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.⁶

The public interest, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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.⁷

⁵ Exhibit "F"

⁶ *Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

⁷ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents*, *supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

The Opposer has established that their mark 'YAHOO!' is a well-known mark, under the criteria laid down under the rules. Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers, which implement R.A. No. 8293, provides:

*Rule 102. Criteria for determining whether a mark is well-known. In determining whether a mark is well-known, the following criteria or **any combination thereof** may be taken into account:*

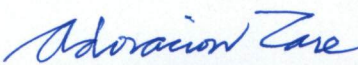
- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;*
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;*
- (c) the degree of the inherent or acquired distinction of the mark;*
- (d) the quality-image or reputation acquired by the mark;*
- (e) the extent to which the mark has been registered in the world;*
- (f) the exclusivity of registration attained by the mark in the world;*
- (g) the extent to which the mark has been used in the world;*
- (h) the exclusivity of use attained by the mark in the world;*
- (i) the commercial value attributed to the mark in the world;*
- (j) the record of successful protection of the rights in the mark;*
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and*
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark. (Emphasis supplied)*

As evidenced by Opposer's submissions, 'YAHOO!' corresponds to its global brand that reaches millions of consumers daily through its various products and services. Opposer also has various registrations in different jurisdictions and has been consistent in its use since first registration. The Opposer has also been consistent in receiving awards from different bodies recognizing the drawing power of their brand especially in advertising sales. Thus, it is clear that Opposer's YAHOO! mark is a well-known mark and it is imperative to accord protection to such a well-known mark when reproduction, imitation, or translation of such mark will likely cause confusion to the relevant sector of the public.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2013-00013215 is hereby **SUSTAINED**. 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, 29 NOV 2017


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