

FERRARI, S.P.A.,
Opposer,
-versus-

IPC No. 14-2009-00121
Case Filed : 20 April 2009
Opposition to:

CAI RONGXUAN,
Respondent.
X-----X

Appln. No. 4-2008-012884
Date Filed : 20 October 2008

TM: "SKY HORSE & DEVICE"
Decision No. 2011-06

DECISION

FERRARI, S.P.A. ("Opposer"), a company duly organized under the laws of Italy, with place of business at Via Emilia 1163-41100 Modena Italy, filed on 20 April 2009 an opposition to Trademark Application Serial No. 4-2008-012884. The application¹, filed by CAI RONGXUAN ("Respondent-Applicant"), a Chinese Citizen with address at 665 Fortune Plaza, Unit 22A, Juan Luna Street, Binondo, Manila on 20 October 2008, covers the mark "SKY HORSE & DEVICE" "t-shirts, polo, shirts, polo, pants, shorts, sandos, and sleeveless for men and women and unisex" under Class 25 of the international Classification of Goods.²

The Opposer alleges the following:

"x x x

"4. The allowance of the mark 'SKY HORSE & DEVICE' in the name of Respondent-Applicant, (described in the application as a 'device composed of the words SKY and HORSE, between the words SKY ad HORSE is an image of the galloping horse)' violates and contravenes Section 123.1 (d), (e), (f), and (g), of the Republic Act No. 8293 ('RA. No. 8293' or the 'IP Code')

"5. The mark 'SKY HORSE & DEVICE' particularly the 'Galloping Horse' figure thereof, is identical to and so resembles the Opposer's well-known marks comprised of a design of a prancing horse, that are covered by the following registrations:

Mark	Registration No.	Date Registered	Class Covered
SF and PRANCING HORSE	4-2006-008986	June 18, 2007	9
PRANCING HORSE DEVICE	4-2006-008987	June 18, 2007	9
SF and PRANCING HORSE	4-2006-006674	April 28, 2008	3, 12, 14, 16, 18, 24, 25, 26, 28, 35, 37, 41
FERRARI PRANCING HORSE DEVICE	4-2006-006675	November 3, 2008	3, 9, 12, 14, 16, 18, 24, 25, 26, 28, 35, 37, 41
PRANCING HORSE (DEVICE)	4-2007-006676	April 28, 2008	3, 12, 14, 18, 24, 25, 26, 28, 35, 37, 41

The Respondent-Applicant's mark, when applied to or used in connection with the sought-to-be covered goods, is to likely deceive or cause confusion with Opposer's goods. Certified true copies of above-enumerated Registrations are marked and attached hereto as Opposer's Exhibits 'A' to 'E' respectively, to form integral parts hereof. Such being registered marks; they are entitled to protection in the Philippines against unauthorized use or expropriation by third parties.

“6. The use by Respondent-Applicant of the mark, ‘SKY HORSE & DEVICE’, particularly the ‘galloping Horse’ figure thereof on goods that are similar, identical or closely related to goods that are produced by, originate from, or are under the sponsorship of Opposer, will greatly mislead the purchasing public into believing that the Respondent-Applicant’s goods are produced by, originate from, or under the sponsorship of herein Opposer.

“7. Opposer has not abandoned the use in many countries around the world of its ‘PRANCING HORSE DEVICE’ mark (that is registered in most countries as the ‘REARING HORSE DEVICE’).

“8. Opposer’s ‘PRANCING HORSE DEVICE MARK’, as well as other marks containing the ‘PRANCING HORSE DEVICE’, are well-known marks which are entitled to broad protection under Article 6bis of the Paris Convention for the Protection of Industrial Property (the ‘Paris Convention’) and Article 16 of the Trade-Related Aspects of Intellectual Property (the ‘TRIPS Agreement’), which the Philippines and the countries where said marks is registered are signatories.

“9. The registration of Respondent-Applicant’s ‘SKY HORSE & DEVICE’ mark contravenes the provisions of R.A No. 8293, the Paris Convention and the TRIPS Agreement, hence, is subject to non-allowance for registration under pertinent provisions or R.A. No. 8293, the Paris Convention, and the TRIPS Agreement.

“10. In support of this Opposition, Opposer shall prove and reply upon, among others, the following:

“(a) The Opposer is the true owner of the ‘PRANCING/REARING HORSE DEVICE’ mark which has been registered in the Opposer’s name not only in the Philippines but elsewhere around the world, to wit:

Country of Registration	Mark	Registration No.	Date of Registration	Classes/Goods /Services Covered
Australia	Device of Prancing Horse	805775	06/09/99	6, 9, 16, 18, 25, 28
Bahrain	Device of Prancing Horse	40134	04/12/03	25
Benelux	Club Ferrari Belgio + Device of Prancing Horse	754512	01/12/04	16, 25, 35, 38, 41
Canada	Device of Prancing Horse	TMA544462	03/05/01	3, 9, 12, 14, 16, 18, 24, 25, 28, 37
European Community	Device of Prancing Horse	001616481	03/08/01	3, 6 9, 12, 14, 16, 18, 24, 25, 28, 41
Germany	Ferrari Club Deutschland + Device of Prancing Horse	30368246	15/12/05	16, 25, 35, 38, 41
International	Device of Prancing Horse	681428A	09/07/97	3, 6, 9, 14, 16, 18, 24, 25, 28, 37
Italy	Device of Prancing Horse	715757	09/07/97	3, 6, 9, 14, 16, 18, 24, 25, 28
Malaysia	SF + Device of Prancing Horse	97009651	15/07/97	25
Monaco	Ferrari Club Monaco + Device of Prancing Horse	04.23948	29/03/04	16, 25, 35, 38, 41
Singapore	Device of Prancing Horse	T9707957D	03/07/97	25

Spain	Ferrari Club Espana + Device of Prancing Horse	2574096	29/10/04	16, 26, 35, 38
Turkey	Device of Prancing Horse	1997/10749	28/07/97	25
U.S.A.	Device of Prancing Horse	2217612	12/01/99	25
United Arab Emirates	Device of Prancing Horse	16301	27/06/98	25
United Kingdom	Ferrari + Device of Prancing Horse	1132939	27/03/85	25

Legalized certified true copies of the afore-mentioned registration certifies are marked and attached hereto respectively, as Opposer's exhibits 'F' to 'U', to form integral parts hereof.

"(b) Opposer has been commercially using its 'PRANCING HORSE DEVICE' mark in Italy and elsewhere around the world since 1946.

"(c) Marked and attached hereto as Exhibits 'W', is a duly executed notarized and legalized Affidavit of Mr. Massimiliano Ivan Maestritti, residing at Via Emilia Est 1163, 41100 Modena, Italy, the Head of the Legal department of Opposer-Company, attesting to, among others, the fact of the international fame of the 'PRANCING HORSE DEVICE' mark. Attached hereto as Exhibits 'W-9', and made an integral part hereof, is a list showing hundreds of registrations/applications for the marks containing the 'REARING/PRANCING HORSE DEVICE' in numerous countries all over the world.

"(d) In further support of the Opposer's claim that its aforementioned mark has gained international fame, it asserts that it has undertaken and made extensive publicity and promotions of said mark in internationally-circulated publications and website/s such as www.fca.org.au, www.ferrariclubthailand.com www.fochk.com, www.ferrariorg.nz, www.clubferrari-belgio.be, www.ferrari-club-deutschland.de, www.ferrariclub.fi, www.elenferrari.net/fferrariclubespana.html, www.ferrariclubhellas.gr, www.ferrariclubitalia.it, www.ferrariownersclubluxemburg.li, www.ferrari-club.nl, www.ferrari-club-norway.info, www.ferrari-club-oesterreich.at, www.ferrariclubswitzerland.ch, www.ferrariownersclub.dk, www.ferrariownersclub.co.uk, www.ferrariclubuae.com www.ferraristisvezia.com, www.ferrariclub.com.ar, www.faca.org, aside from Opposer's own websites, i.e. www.ferrari.com, www.ferraristore.com and www.ferrariworld.com. A list of the websites of the Ferrari clubs worldwide is attached hereto as Exhibit 'W-1', and made an integral part hereof. Also attached as Exhibit 'W-2', and made an integral part hereof, is a list of the numbers of visitors/pages viewed/hits received by the websites www.ferrariworld.com and www.ferraristore.com, where it is evident that the said websites received millions of hits /pages viewed in the recent years. The duly executed, notarized and legalized Affidavit of Opposer's witness that is identified as Opposer's Exhibit 'W' in sub-paragraph(c) thereof includes: copies/webpage print-outs of sample advertisements featured in various publications/websites, including Opposer's own websites; picture of a wide variety of licensed goods, including goods in class 25, bearing the 'PRANCING HORSE DEVICE'; catalogs of Ferrari licensed products from authorized sellers throughout the world photographs of Ferrari products bearing the 'PRANCING HORSE DEVICE' offered for sale by Internet retailers, which are available to Internet users around the world, including in the Philippines further marked and attached hereto as Exhibits 'W-4' to 'W-8'. (enumerated and identified in detail in the accompanying Compliance with Submissions and Manifestations document).

"(e) By representation and appearance, the mark 'PRANCING HORSE DEVICE' is identical to and/or confusingly similar to Opposer's 'PRANCING HORSE DEVICE' mark.

"(f) Opposer continues to use the 'PRANCING HORSE DEVICE' mark worldwide, including here in the Philippines. Attached hereto as Exhibit 'W-6', and made an integral part hereof, are

copies of the Invoices of the goods bearing the 'PRANCING HORSE DEVICE' which were exported to different countries around the world in the recent years. These Invoices prove that the 'PRANCING HORSE DEVICE', is indeed, commercially used worldwide.

“(g) By virtue of the prior registrations of the Opposer’s ‘PRANCING HORSE DEVICE’ mark in the Philippines and worldwide, coupled with the prior, long and continued use of said mark in said other countries around the globe by herein Opposer, said mark has become popular and internationally well-known and has established valuable goodwill for the Opposer with the general purchasing public, which has identified Opposer as the owner and that source of goods bearing the said marks.

“(h) By virtue of the prior registration of the ‘PRANCING HORSE DEVICE’ mark in various countries around the world, including in the Philippines, as well as the prior and continued use of the said mark worldwide and in the Philippines by herein Opposer, said mark has become popular and internationally well-known and have established valuable goodwill for the Opposer with the general purchasing public, which have identified Opposer as the owner and the source of goods bearing said mark.”

The Opposer’s evidence consists of the following:

1. EXH. "A" – Certified true copy of Cert. of Reg. No. 4-2006-008986 issued b the Intellectual Property Office of the Philippines for the mark "SF AND PRANCING HORSE" issued in the Opposer’s name for goods falling under Class 9;
2. EXH. "A-1" – Certified Copy of the Power of Attorney³ in favor of the Opposer’s counsel with respect to the mark "SF AND PRANCING HORSE" in Class 9;
3. EXH. "B" – Certified true copy of Cert. of Reg. No. 4-2006-008987 issued by the IPPhil for the mark "PRANCING AND HORSE DEVICE" issued in the Opposer’s name for the goods falling under Class 9;
4. EXH. "B-1" – Certified Copy of the Power of Attorney in favor of the Opposer’s counsel with respect to the mark "PRANCING HORSE DEVICE" in Class 9;
5. EXH. "C" – Certified true copy of Cert. of reg. No. 4-2007-006674 issued by the IPPhil for the mark "SF AND PRANCING HORSE" issued in the Opposer’s name for falling under Classes 3, 12, 14, 16, 18, 24, 25, 26, 28, 35, 37, and 41;
6. EXH. "C-1" – Certified Copy of the Power of Attorney in favor of the Opposer’s counsel with respect to the mark "SF AND PRANCING HORSE" in Classes 3, 12, 14, 16, 18, 24, 25, 26, 28, 35, 37, and 41;
7. EXH. "D" – Certified true copy of Cert. of reg. No. 4-2007-006676 issued by the IPPhil for the mark "PRANCING HORSE (DEVICE)" issued in the Opposer’s name for the goods falling under Classes 3, 12, 14, 16, 18, 24, 25, 26, 28, 35, 37 and 41;
8. EXH. "D-1" – Certified Copy of the Power of Attorney in favor of the opposer’s counsel with respect to the mark "PRANCING HORSE (DEVICE)" in Classes 3, 12, 14, 16, 18, 24, 25, 26, 28, 35 and 41;
9. EXH. "E" – Certified true copy of Cert. of Reg. No. 4-2007-006675 issued by the IPPhil for the mark "FERRARI AND PRANCING HORSE DEVICE" issued in the Opposer’s name for goods falling under Classes 3, 9, 12, 14, 16, 8, 24, 25, 26, 28, 35, 37, and 41;
10. EXH. "E-1" – Certified Copy of the Power of Attorney in favor of the Opposer’s counsel with respect to the mark "PRANCING HORSE (DEVICE)" in Classes 3, 9, 12, 14, 16, 18, 24, 25, 26, 28, 35, 37 and 41;

11. EXH. "F" – Legalized certified true copy of Australian Trade Mark no. 805775 for the "DEVICE OF PRANCING HORSE" issued by the Trade Marks Office in the Opposer's name covering goods falling under Classes 6, 9, 16, 18, 25, and 28;
12. EXH. "G" – Legalized certified true copy of Mark No. 40134 for the mark "DEVICE OF PRANCING HORSE" issued by the Industrial Property Office of the Ministry of Commerce of the Kingdom of Bahrain in the opposer's name covering goods falling Class 25;
13. EXH. "H" – Legalized certified true copy of Benelux Reg. no. 754512 for the mark "CLUB FERRARI BELGIO + DEVICE OF PRANCING HORSE" issued by the Benelux Intellectual Property Office in the Opposer's name covering goods falling under Classes 16, 25, 53, 38, and 41;
14. EXH. "I" – Legalized certified true copy of Canadian Trademark Reg. No. TMA544,462 for the "DEVICE OF PRANCING HORSE" issued by the Canadian Intellectual Property Office in the opposer's name for goods falling under Classes 3, 6, 9, 12, 14, 16, 18, 24, 25, 28 and 37;
15. EXH. "J" – Legalized certified true copy of Community Trade Mark ("CTM") Reg. no. 001616481 for the "DEVICE OF PRANCING HORSE" issued by the Office for Harmonization in the Internal Market in the European Union in the opposer's name for goods falling under Classes 3, 6, 9, 14, 16, 18, 24, 25, 28, and 41;
16. EXH. "K" – Legalized certified true copy of Trade Mark Reg. no. 302 68 246 for the "FERRARI CLUB DEUTSCHLAND + DEVICE OF PRANCING HORSE" issued by the German Patent and Trademark office ("DPMA") in the Opposer's name for goods falling under Classes 16, 25, 35, 38 and 41;
17. EXH. "L" – Legalized certified true copy of Trademark Reg. No. 681428 for "DEVICE OF PRANCING HORSE" issued by the World Intellectual Property Organization in the Opposer's name for goods falling under classes 3, 6, 9, 14, 16, 18, 24, 25, 28 , and 37;
18. EXH. "M" – Legalized certified true copy of Italian Trademark reg. Cert. No. 00715757 for the "DEVICE OF PRANCING HORSE" issued by the Italian Patents and trademark Office in the Opposer's name for goods falling under Classes 3, 6, 9, 14, 16, 18, 24, 25, 28 and 37;
19. EXH. "N" – Legalized certified true copy of Malaysian trade Mark No. 97009651 for "SF + DEVICE OF PRANCING HORSE" issued by the Malaysian Trademark registry in the Opposer's name for goods falling under Class 25;
20. EXH. "O" – Legalized certified true copy of Trade Mark Reg. No. 04-23948 for "FERRARI CLUB MONACO + DEVICE OF PRANCING HORSE" issued by the direction De L'Expansion Economique of the Principality of Monaco in the Opposer's name for goods falling under Classes 16, 25, 35, 38 and 41;
21. EXH. "P" – Legalized certified true copy of Trade Mark no. T9707957D for "DEVICE OF PRANCING HORSE" issued by the Registrar of Trade Marks Singapore in the Opposer's name for goods falling under Class 25;
22. EXH. "Q" – Legalized certified true copy of Spanish Trademark No. 2574096 for "FERRARI CLUB ESPANNA + DEVICE OF PRANCING HORSE" issued by the Spanish Patent and Trademarks office in the Opposer's name for goods falling under Class 16;

23. EXH. "R" – Legalized certified true copy of Turkish Trademark No. 97010749 for "DEVICE OF PRANCING HORSE" issued by the Turkish Patent Institution in the Opposer's name for goods falling under Class 25;
24. EXH. "S" – Legalized certified true copy of U.S. Fed. Reg. No. 2,217,612 for the "DEVICE OF PRANCING HORSE" issued by the United States Patent and Trademark Office in the Opposer's name covering goods falling under Class 25;
25. EXH. "T" – Legalized certified true copy of trademark reg. cert. no. 16301 for the "REARING HORSE DEVICE" issued by the Commercial Registration Department of the United Arab Emirates in the Opposer's name covering goods falling under Class 25;
26. EXH. "U" – Legalized certified true copy of U.S. Fed. Reg. No. 1132939 for the "FERRARI + DEVICE OF PRANCING HORSE" issued by the United Kingdom Intellectual Property Office in the Opposer's name covering goods falling under Class 25;
27. EXH. "V" – Grant of Power of Attorney executed by Luca Cordero Di Montezemolo, the President Of Opposer Company, in favor Massimiliano Ivan Maestrutti, the Head of the Legal Department of the Opposer-Company;
28. EXH. "W" – Duly executed, notarized and legalized Affidavit of Massimiliano Ivan Maestretti, the Head of the Legal Department and Special Procurator of the Opposer-Company, who serves as its witness in the Case (the original of which is attached to the Verification and Certification Against Non-Forum Shopping and Secretary's Certificate);
29. EXH. "W-1" – List of the websites of the Ferrari Clubs worldwide [identified as Exhibit "A" of the Affidavit of Mr. Maestrutti, marked as Opposer's Exhibits "W"];
30. EXH. "W-2" – List showing the number of visitors on the web sites <http://www.ferrariworld.com> and <http://www.ferraristore.com> in the latest years [identified as Exhibits "B" of the Affidavit of Mr. Maestretti, marked as Opposer's Exhibits "W"];
31. EXH. "W-3" – Copies of the following articles: entitled "Formula 1 is born", about the history of FORMULA 1 relevant to the years 199 and 2007; about the f50 – a road – going F1 car [identified as Exhibit "C" of the Affidavit of Mr. Maestretti, marked as Opposer's Exhibit "W"];
32. EXH. "W-4" – Copies of the following articles: entitled "Number one" dedicated to Michael Schumacher; entitled "50th Anniversary"; entitled "Schumacher retires" and some photographs of Michael Schumacher [identified as Exhibit "D" of the Affidavit of Mr. Maestretti, marked as Opposer's Exhibits "W"];
33. EXH. "W-5" – Pictures of a wide variety of licensed goods, including goods in Class 25, bearing the "prancing Horse Device"; catalogues of Ferrari licensed products from authorized sellers throughout the world; photographs of Ferrari products bearing the "Prancing Horse Device" offered for sell by the Internet retailers, which are available to Internet users around the world, including in the Philippines [identified as Exhibits "E" of the Affidavit of Mr. Maestretti, marked as Opposer's exhibit "W"];
34. EXH. "W-6" – Copies of invoices involving the goods of the Opposer, bearing the "Prancing Horse Device", relevant to many different foreign countries [identified as Exhibit "F" of the Affidavit of Mr. Maestretti, marked as Opposer's exhibit "W"];
35. EXH. "W-7" – Photographs/web screen shots of the sites selling Ferrari merchandise with bearing "Prancing Horse device" [identified as exhibit "G" of the Affidavit of Mr. Hodges marked as Opposer's exhibit "L"];

36. EXH. "W-8" – Documents containing information about FERRARI S. P. A. and its origins. [identified as Exhibit "H" of the Affidavit of Mr. Meastretti, marked as Exhibit "L"]; and
37. EXH. "W-9" – List showing all registrations/applications for marks containing the "Rearing/Prancing Horse Device" [identified as Exhibit "I" of the Affidavit of Mr. Maestretti, marked as Opposer's Exhibit "W"];

This Bureau issued a Notice to Answer, a copy of which was served upon the Respondent-Applicant on 04 August 2009. The Respondent-Applicant, however, did not file the Answer. This, Rule 2, Sec. 11 of the Registration on Inter Partes Proceeding, as amended, provides:

Section 11. Effect of the failure to file answer – In case the respondent-Applicant fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the petition or opposition, the affidavits of the witnesses and documentary evidence submitted by the petitioner or opposer.

The issues to be resolved are the following:

1. Whether or not the Opposer's mark PRANCING HORSE DEVICE is well-known, and
2. Whether or not the Respondent-Applicant is entitled to register the mark "SKY HORSE & DEVICE".

On the first issue, Rule 102 of the Trademark Regulations sets forth the criteria in determining whether a mark is considered to be well-known, to wit:

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, including advertising or publicity exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of 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 well-known mark; and

- (l) the presence or absence of identical or similar marks validity registered for or used on identical or similar goods or services and owned by person other than the person claiming that his mark is a well-known mark.

The records and evidence show that the Opposer's mark DEVICE OF PRANCING HORSE and its variations have been continuously used and registered not only in the Philippines but in many countries around the world. The pieces of evidence submitted by the Opposer, which includes but not limited proof of trademark registrations and export sales, constitutes a least a combination of the criteria under Rule 102 of the Trademark Regulations. Hence, the Opposer's marks could be considered as well-known.

Going now to the second issue, it is stressed 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 and sale of an inferior and different articles as his product.⁴

In this regard, Sec. 123.1 of Rep. Act no. 8293, also known as the Intellectual Property code of the Philippines ("IP Code"), provides that a mark cannot be registered if it:

(d) is identical with a registered mark belonging to a different proprietor or 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 deceived or cause confusion;

(e) 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-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, of the mark.

Records show that at the time the Respondent-Applicant filed its trademark application on 20 October 2008, the opposer has the following existing trademark registrations or applications: 1) No. 4-2007-00674 for the mark SF and PRANCING HORSE; 2) no. 4-2007-006675 for the mark FERRARI and PRANCING HORSE DEVICE; and 3) no. 4-2007-006676 for the mark PRANCING HORSE (DEVICE). These marks are used by the Opposer on variety of goods including those under Class 25, specifically automobile racing suits, T-shirts, sweat shirts, polo shirts, ties, caps, overalls, wind resistant jackets, waterproof jackets, blazers, trousers, belts, raincoats, track suits, shorts, gloves, pajamas, slippers, swimming costumes. These goods are similar or closely related to the goods covered by the Respondent-Applicant's trademark application.

The question now is: Is the mark applied for registration by the Respondent-Applicant confusingly similar to the Opposer's mark? The marks are reproduces below for comparison.

The Opposer's Marks

Reg. No. 4-2007-006676

Reg No. 4-2007-6675

SF AND PRANCING HORSE
Reg. No. 4-2007-00674

The Respondent-Applicant's Mark

SKY HORSE

Trademark Application Serial No. 4-2008-012884

While there may be differences between the Respondent-Applicant's mark and the Opposer's with respect to some embellishments, the Respondent-Applicant's mark is obviously a colorable imitation of the Opposer's. Colorable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, content, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or trade name with that of the mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article⁵. The depiction or image or silhouette of a prancing horse is highly unique and distinctive mark for use on clothing and similar or related goods. Hence, the mark becomes attached to the proprietor who first thought of using and actually used it, in commerce.

Thus, what are in comparison in this instance are not the minutest details of the features in the marks but the idea or the concept manifested in the visual representations thereof. This is what the consumers will likely remember of the mark as used on clothing and related goods. Aply, the idea or concept of a prancing horse embodied in the trademark that the Respondent-Applicant has applied for registration is the very same idea or concept as that of in the Opposer's. Accordingly, since these marks are used on the same goods, the Opposer is likely to be damaged if the Respondent-Applicant's mark is allowed for registration. There would be confusion or deception as to the source, origin or affiliation of the goods with the Respondent-Applicant riding on in the reputation and goodwill generated by the advertisement and promotion of the Opposer's mark. In *American wire & cable Co. vs. Director of Patents et.al*⁶, the Supreme Court held:

The determinative factor in a contest involving registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark would likely cause confusion or mistake on the part of the buying public. In short, to constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.

Trademark Application Serial No. 4-200-012884 therefore, is proscribed by Sec. 123.1, paragraphs (d) and (e) of the IP Code.

It is emphasized that the law on trademarks and trade names is based on the principle of business integrity and common justice. This law, both in letter and spirit is laid upon the premises that, while it encourages fair trade in every way and aims to foster, and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing others business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another.⁷

WHEREFORE, premises considered, the opposition is hereby SUSTAINED. Let the file wrapper of Trademark Application Serial No. 4-2008-01284 be returned, together with a copy this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Makati City, 04 February 2011.

NATHANIEL S. AREVALO
Director, Bureau of Legal Affairs
Intellectual Property Office