

CALVIN KLEIN TRADEMARK TRUST,	}	IPC NO. 14-2008-00364
Opposer,	}	Case filed: 19 December 2008
	}	Opposition to:
-versus-	}	App. Ser No. 4-2006-011107
	}	Date Filed: 10 October 2006
IDM APPAREL PTE. LTD.,	}	TM: GIOVEN KELVIN & GK
Respondent-Applicant.	}	Device
	}	
x-----x	}	Decision No. 2009-81

DECISION

For consideration is the Verified Notice of Opposition filed on 19 December 1008 against the application for registration of the mark "GIOVEN KELVIN & GK Device" for use on of the international classification of goods bearing Application Serial No. 4-2006-011107 which was published for opposition in the Intellectual Property Office Electronic Gazette officially released for circulation on 24 October 2008.

Opposer, CALVIN KLEIN TRADEMARK TRUST, is a Delaware Business Trust duly organized and existing under the laws of the State of Delaware (Wilmington Trust Company, Trustee, at Rodney Square North, North Market Street, Wilmington, Delaware 19890), c/o Calvin Klein, Inc. Services, 205 West 39th Street, New York, New York 10018.

Respondent-Applicant is IDM APPAREL PTE. LTD., a corporation with address at Blk. 51, UBI Avenue, 1 #03-04 Paya UBI Industrial Park, Singapore 408933.

The grounds for Opposition to the registration of the mark are as follows:

"1. Calvin Klein Trademark Trust and/or Calvin Klein, Inc. are the owners of the trademark CALVIN KLEIN and other registrations in the U.S.

2. The trademark GIOVEN KELVIN & GK Device of the Respondent-Applicant resembles the trademark CK and CK CALVIN KLEIN of Opposer such that the use of GIOVEN KELVIN & GK Device with the goods and/or services of the Respondent-Applicant would indicate a connection between the Opposer's goods and those of Respondent-Applicant to the damage and prejudice of the Opposer's goodwill and interest. There is a very close similarity of the Respondent-Applicant's mark to that of Opposer specifically when used in the same or related class of goods. In other words, the use of Respondent-Applicant's mark GIOVEN KELVIN & GK Device will cause confusion or mistake upon and/or deceive purchasers or customers in that they will tend to believe that Respondent-Applicant's goods come from the Opposer. Hence, under the trademark law and rules, the trademark GIOVEN KELVIN & GK Device cannot be registered in favor of Respondent-Applicant for being deceptive and likely to cause confusion.

3. The trademark GIOVEN KELVIN & GK Device sought to be registered by Respondent-Applicant is deceptively and confusingly similar to Opposer's CK logo mark and to Opposer's CK CALVIN KLEIN mark and when used in the same or a related class of goods, Opposer's mark will be damaged, considering that they are very famous, thus, Opposer will be greatly damaged and prejudiced.

4. Opposer has registered the CK mark under Certificate of Registration Nos. 4-1994-90400, 4-1996-107278, 4-1996-107279, 4-1996-111158, 4-1996-111165, 4-1996-111166, and has registered the CK/CALVIN KLEIN mark under

Certificate of Registration Nos. 4-1996-127862, 4-1996-110656 and 4-1997-119613.

5. Opposer has already spent much for the advertisement and promotion of the marks CK and CK CALVIN KLEIN. Hence, its business and goodwill will clearly be damaged and will suffer irreparable injury by the registration and use of the confusingly similar mark GIOVEN KELVIN & GK Device by the Respondent-Applicant.

6. The United States, the country where Opposer is subject, is a member of the Paris Convention for the Protection of Industrial Property (Paris Convention) and the World Trade Organization (WTO). Opposer is thus entitled to protection under the said Paris Convention and WTO.”

Opposer relied on the following facts to support its opposition:

“1. The trademark GIOVEN KELVIN & GK Device of the Respondent-Applicant is deceptively similar to CK and CALVIN KLEIN of Opposer and similar also in respect to the goods to which they are used.

2. The trademarks CK and CK CALVIN KLEIN had been long registered here and in countries all over the world that it has become famous;

3. CK and CK CALVIN KLEIN are recognized and well known marks, not only in the United States but in almost all countries in the world that are members of the Paris Convention and/or the WTO. Hence, Opposer is entitled to the mantle of protection afforded under the Paris Convention provisions and the WTO.

10. Considering that Opposer’s trademark CK and CK CALVIN KLEIN are known locally and internationally, it deserves protection under the Intellectual Property Code of the Philippines, particularly Sections 123, 134, 147 and relevant sections thereof.”

In support of the opposition, Opposer submitted the following evidence:

Exhibits	Description of Documents
“A”	Affidavit of Stephen G. Soliven
“B”	Certified copies of Certificates of Registration issued by the USPTO for the marks CK and CK CALVIN KLEIN to Opposer under Classes 18 and 25
“C”	Copy of the Birth Certificate of Calvin Richard Klein
“D”	Copy of Calvin Klein Trademark Trust Assignment
“E”	Copy of CKI Ownership Certificate
“F”	Copy of Assignment to CKI
“G”	Affidavit Deirdre Miles-Graeter (Not Authenticated)
“H”	Copy of Schedule of Trademark Registrations and Applications
“I”	Picture of Calvin Klein stores in the Philippines, list of advertising publications and photocopy of sample ads

On 14 January 2009, a Notice to Answer the Verified Notice of Opposition was issued by the Bureau and personally served to Respondent-Applicant's representative firm Cesar C. Cruz & Partners on 02 February 2009. Despite having received said notice, Respondent-Applicant failed to file its Answer within the reglementary period. As a consequence, Order No. 2009-809 was issued on 12 May 2009 waiving Respondent's right to file the answer and supporting documents and submitting the case for decision.

The sole issue to be resolved in this case is: WHETHER OR NOT RESPONDENT-APPLICANT'S MARK "GIOVEN KELVIN & GK DEVICE" IS CONFUSINGLY SIMILAR TO OPPOSER'S MARKS "CK" AND "CK CALVIN KLEIN".

Section 123.1 (d) of Republic Act No. 8293, as amended, provides:

SEC. 123. *Registrability.* – 123.1 A mark cannot be registered if it:

x 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;"

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 the mark would likely cause confusion or mistake on the part of the buying public. The law does not require that the competing marks must be so identical as to produce actual error or mistake. It would be sufficient that the similarity between the two marks is such that there is possibility of the older brand mistaking the newer brand for it. Whether or not a trademark causes confusion and likely to deceive the public is a question of fact which is to be resolved by applying the "test of dominancy," meaning, if the competing trademark contains the main or essential or dominant features of another by reason of which confusion and deception are likely to result, then infringement takes place; and that duplication or imitation is not necessary, a similarity of the dominant features of the trademark would be sufficient. The test of dominancy is now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code, which defines infringement as the "colorable imitation of a registered mark . . . or a dominant feature thereof."

Colorable imitation does not mean such similitude as amounts to identity. Nor does it require that all the 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 in their over-all presentation or in their essential, substantive and distinctive parts as would likely mislead or confuse in the ordinary course of purchasing the genuine article.

In the case of *Societe Des Produits Nestle vs. Court of Appeals*, the Supreme Court stated that:

"Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser giving such attention as a purchaser usually gives, and to cause him purchase the one supposing it to be the other."

To determine whether Respondent-Applicant's mark is confusingly similar to Opposer's mark, the parties' marks are illustrated below for purposes of comparison:



Opposer's Marks



Respondent-Applicant's Mark

As can be observed from the above-illustrations of the competing marks and by applying the dominancy test, the mark GIOVEN KELVIN & GK Device so resembles the trademarks CK and CK Calvin Klein marks of Opposer that it will likely cause confusion, mistake or deception on the part of the purchasing public. Respondent-Applicant's marks is confusingly similar to Opposer's in the sense that GK is aurally the same as CK; the CK mark and the GK Device are composed of two letters and both contain the letter K; Klein in the CK Calvin Klein mark is also aurally similar to Kelvin in Respondent-Applicant's mark Gioven Kelvin. Except for the font used and the fact that in the CK marks the letters CK are written side by side while in the GK Device, the letter K is written inside the letter G and interlocking with the letter G, such differences, however, pales into insignificance because of their similarity in sound and their indistinguishable appearance. In one American case, the rule applied was that, the conclusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term. Analogously, confusion cannot also be avoided by the merely changing one of the letters of a registered mark, as in this case. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.

In addition, both trademarks cover the same goods, that is, fashion accessories under Class 28 and clothing and shoes belonging to Class 25 of the International Classification of goods. As such, both products flow through the same channels of trade, therefore, confusion between the two trademarks would likely result to prospective buyers.

It bears stressing 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 to 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.

Thus, having found that the herein subject mark is confusingly similar to a registered trademark, this Bureau cannot allow its registration.

WHEREFORE, premises considered, the Notice of Verified Opposition filed by Opposer, CALVIN KLEIN TRADEMARK TRUST against Respondent-Applicant IDM APPAREL PTE. LTD. is, as it is hereby SUSTAINED. Consequently, the trademark application for the registration of the mark "GIOVEN KELVIN & GK Device" bearing Serial No. 4-2006-011107 filed on 10 October 2006 by Respondent-Applicant for use on skins (cattle-); skin (goldbeaters`-); gold beaters' skin; cattle skins; leather board; curried skins; pelts; animals skins; leather, unworked or semi-worked; butts {parts of kids}; imitation leather; leather (imitation -); skins of chamois, other than for cleaning purposes; chamois leather, other than for cleaning purposes; bags (net -) for shopping; beach bags; passport folder (made by leather); trimmings of leather for furniture; furniture (leather trimmings for -); card cases [notecases]; music cases; bags (game -) [hunting accessory]; straps for skates; boxes of vulcanized fiber; traveling bags; valises; bags (garment -); for travel; traveling trunks; traveling sets [leatherware]; garment bags for travel; bags for

climbers; husk bedsheets; straps (leather -); straps of leather [saddlery]; leather mat; tool bags of leather [empty]; boxes of leather or leather board; bands of leather; valves of leather; leather thread; cases, of leather or leather board; leather leashes; leather straps; coverings (furniture-) of leather; furniture coverings of leather; hat boxes of leather; leads (leather -) leather twist; chin straps, of leather; laces (leather-); purses; pocket wallets; leatheroid box; soldier's equipment (straps for -); handbags; frames (handbags -); handles (suitcase-); school satchels; file folder (made by leather); wallets (pocket-); satchels (school-); school bags; coverings of skin [furs]; bags for campers; suitcases; suitcase handles; vanity cases [not fitted]; key cases [leatherware]; cheque folder (made by leather); belts (leather shoulder -); pouches, of leather, for packaging; bags [envelopes, pouches] of leather, for packaging; envelopes, of leather, for packaging; sling bags for carrying infants; backpacks; skates (straps for -); trunks [luggage]; wheeled shopping bags; springs (casings, of leather, for plate -); casings, of leather, for springs; haversacks; canvas box; chain mesh purses, not of precious metal; purses, not of precious metal; briefcases; attaché cases; shopping bags; parasols; umbrellas; umbrella sticks; umbrella handles; umbrella rings; covers (umbrella -); umbrella or parasol ribs; ribs (umbrella or parasol-); and frames for umbrellas or parasols; all included in class 18 and for use on bath robes; bath sandals; bath slippers; bathing caps; bathing drawers; belts [clothing]; breeches [for wear]; clothing; coats; coats (top-); footwear; galoshes; garters; girdles; gloves [clothing]; gowns (dressing-); gymnastics [clothing]; gymnastic shoes; headgear; hosiery; jackets [clothing] jerseys [clothing]; jumpers [shirt fronts]; knitwear [clothing]; leather (clothing of-); leather (clothing of imitations of-); liveries; mittens; neckties; overalls; overcoats; pants; pelisses; pullovers; pyjamas; sandals; shirts; shoes; singlets; skirts; slippers; smocks; sock suspenders; socks; soles for footwear; sports (boots for-); sport jerseys; sport shoes; stockings; stuff jackets [clothing]; suits; suit (bathing-); suspenders; sweat-absorbent underclothing [underwear]; sweaters; swimsuits; tee-shirts; togas; top hats; trouser straps; trousers; underclothing; underclothing (anti-sweat-); underpants; underwear; underwear (anti-sweat); uniforms; vests; waistcoats; and waterproofing clothing, all included in class 25 of the international classification of goods is, as it is hereby, REJECTED.

Let the filewrapper of "GIOVEN KELVIN & GK Device" subject matter of the instant case together with a copy of this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 15 June 2009.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office