

CALVIN KLEIN TRADEMARK TRUST, 00088	}	INTER PARTES CASE NO. 14-2006-
<i>Opposer,</i>	}	Opposition to:
	}	
-versus-	}	Serial No. : 4-2003-011669
	}	Date Filed : 18 December 2003
	}	Trademark : "CALVEN"
ALEXANDER UY,	}	
<i>Respondent-Applicant .</i>	}	
x-----x		Decision No. 2006-114

DECISION

This is an opposition for the registration of the mark "CALVEN" bearing Serial No. 4-2003-011669 filed on 18 December 2003 for clothing under class 25 of the International Classification of goods, which application was published for opposition in the E-Gazette of the Intellectual Property Office (IPO) and released for circulation on April 25, 2006.

The Opposer in this particular case is "CALVIN KLEIN TRADEMARK TRUST" a Delaware Business Trust, Wilmington Trust Company, trustee, at Rodney Square North, North Market Street, Wilmington, Delaware 19890 c/o CALVIN KLEIN, Inc., Services, 205 W. 39th, New York, NY 10018.

The Respondent-Applicant on the other hand is "ALEXANDER UY" with address at 1093 General San Miguel Street, Sangandaan, Caloocan City.

This Bureau issued a Notice to Answer dated 30 June 2006, addresses to the counsel of Respondent-Applicant through registered mail with return card bearing No. E-06-00097, directing Respondent-Applicant to file his verified answer within thirty (30) days from receipt.

The Notice to Answer was duly delivered by letter carrier Nancy Yuzon and received by the addressee (Atty. Chito Dimaculangan) on 18 July 2006 as per certification issued by the Makati Central Post Office, 1200, Makati City dated 19 September 2006.

The grounds of the opposition are as follows:

- "1. The trademark "CALVEN" of the Respondent-Applicant so resembles the trademark CALVIN KLEIN of the Opposer that the use of CALVEN on the goods of the Respondent-Applicant would indicate a connection between the Opposer's goods and those of the Respondent-Applicant to the damage and prejudice of the Opposer's goodwill and interests. Furthermore, the corporate name of the beneficial owner of all products other than underwear, sleepwear and loungewear is Calvin Klein, Inc., a New York corporate frequently referred to us CKI and CK, Inc., in other words, the use of Respondent-Applicant's "CALVEN" will cause confusion or mistake upon or deceive purchasers in that purchasers will tend to believe that Respondent-Applicant's goods are those of, or coming from the Opposer. Hence, under Section 123 (e) and (f), Section 147 and other pertinent provisions of Republic Act No. 8293 (Intellectual Property Code of the Philippines) the trademark "CALVEN" cannot be registered in favor of the Respondent-Applicant.
- "2. The trademark "CALVEN" sought to be registered by the Respondent-Applicant is confusingly similar to the trademark "CALVIN KLEIN" of the herein Opposer since the primary element of the Respondent-Applicant's

mark is identical to the Opposer's mark which the latter had much earlier adopted, used in commerce and registered in the Philippines. Applying the test of dominancy, the Respondent-Applicant's mark could be considered as confusingly similar with the Opposer's mark since the former contains the main or dominant features of the latter.

- "3. Opposer has registered and commercially used the trademark "CALVIN KLEIN" and its variations in different countries of the world including the Philippines under Certificate of registration Nos. 43542, issued on September 27, 1989; 4-1996-110657 issued on August 28, 2000; 4-1996-108419 and 4-1996-110658 both issued on March 1, 2001.
- "4. Opposer has already spent much for the advertisement and promotion of the trademark "CALVIN KLEIN" and its variations. Hence, Opposer's business and goodwill will clearly be damaged and will suffer irreparable injury by the registration and use of the confusingly similar mark "CALVEN" by Respondent-Applicant.
- "5. The United States of America, the country where Opposer is subject, is a member of the Convention of Paris 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:

- "a. The trademark "CALVEN" of the Respondent-Applicant is confusingly similar to the trademark "CALVIN KLEIN" of the Opposer in terms of general appearance, manner and styles of presentation, sound/pronunciation and in respect of the goods to which they are respectively used.
- "b. The trademark "CALVIN KLEIN" has been used and registered in the United States of America by the Opposer since 1968 and 1978 respectively. In the Philippines, the Opposer has already registered the mark "CALVIN KLEIN" in Classes 3, 9, 14, 16, 18, 24 and 25 under the above-mentioned Trademark Registration Nos. 46542, 4-1996-110657, 4-1996-108419 and 4-1996-110658. The trademark "CALVIN KLEIN" is likewise registered/applied for in different countries of the world and has pending application in the Philippines for Class 14.
- "c. The trademark "CALVIN KLEIN" has been popularized internationally by the Opposer since 1993 in different media of advertisement at the great expense of the Opposer and its licensees, including those under CK/Calvin Klein, CK/One, CK/Be and others.
- "d. The trademark "CALVIN KLEIN" has been extensively used in commerce in the Philippines since the late 1980's and 1990's through local distributors. As such, it already acquired tremendous amount of goodwill. In other words, the "CALVIN KLEIN" products are already well-known in the Philippines as those of the Opposer.
- "e. "CALVIN KLEIN" is a recognized well-known mark of the Opposer not only in the United States of America, but also in most countries of the world that are members of the Paris/Convention and/or WTO. Hence, the Opposer is entitled to the mantle of protection afforded under the Paris Convention provisions and WTO.

listed under Memorandum dated 20 November 1980 of the then Honorable Minister Luis R. Villafuerte of the Ministry of Trade, hence, it deserves protection under the Paris Convention.

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby, SUSTAINED. Consequently, trademark application bearing Serial No 4-2003-011669 for the trademark "CALVEN" filed on 18 December 2003 by Alexander Uy for all kinds of article of outer and underwear clothing and others falling under class 25 is, as it is hereby, REJECTED.

Let the filewrappers of the trademark "CALVEN" subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 17 October 2006.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs