

FRED PERRY HOLDINGS, LTD.	}	IPC No. 14-2005-00004
<i>Opposer</i>	}	Mark: <i>GLADIATOR AND</i>
	}	<i>WREATH DEVICE</i>
-versus-	}	Appln. No. 4-2001-08643
	}	Date Filed: 19 November 2001
SUPERIOR RUBBER CORPORATION	}	
<i>Respondent-Applicant</i>	}	
x-----x		Decision No. 2006-12

DECISION

This is an opposition proceeding that Fred Perry Holdings, Limited (Opposer) instituted against Superior Rubber Corporation (Respondent-Applicant) concerning Respondent-Applicant's application for registration of the mark *GLADIATOR AND WREATH DEVICE* under application number 4-2001-08643 dated 19 November 2001 involving goods under class 25.

Opposer Fred Perry Holdings, Limited is a corporation duly organized and existing under the laws of England with principal address at 24 West Street, Covent Garden, London, WC2H 9NA, England. On the other hand, Respondent-Applicant Superior Rubber Corporation is allegedly a corporation duly organized and existing under the laws of the Philippines with principal address at 1400 Antonio Rivera Street, Tondo, Manila.

Respondent-Applicant seeks to register the mark *GLADIATOR AND WREATH DEVICE* for rubber, pvc, and plastic sandals, boots, slippers, and shoes – generally footwear – in class 25. It filed an application for registration of its mark on 19 November 2001 and correspondingly, its application was assigned application number 4-2001-008643, and was published in Volume VII, Number 6 of the Official Gazette dated 29 September 2004.

Opposer seasonably instituted this opposition proceeding. In its verified Opposition, it has pointed out the grounds for opposing Respondent-Applicant's application, viz.:

GROUND FOR OPPOSITION

- "7. OPPOSER had adopted and continuously used the trademarks "16 LEAF LAUREL WREATH DEVICE" and "FRED PERY AND LAUREL WREATH DESIGN" in actual trade and international commerce for a long period of time and had acquired goodwill and international consumer recognition.
- "8. It had registered the marks and used it in many countries that are members of the Paris Convention.
- "9. The registration of RESPONDENT'S trademark will violate section 123.1 of Republic Act 8293 (The New Philippine Intellectual Property Code).
- "10. The registration of RESPONDENT'S trademark contravenes the provisions of Article 6bis of the Paris Convention on the Protection of Industrial Property and TRIPS agreement.
- "11. OPPOSER'S marks are well known. It has been widely identified with the products of the OPPOSER throughout the world and the relevant sector of the Philippine public.
- "12. The Philippine Intellectual Property Office had already recognized that OPPOSER'S marks are well known marks.

- “13. Philippine jurisprudence likewise recognizes the rights of owners of well known marks.
- “14. The registration of RESPONDENT’S mark “GLADIATOR AND DEVICE” will cause confusion, mistake, and deception on the part of the purchasing public.
- “15. The registration of RESPONDENT’S trademark will violate OPPOSER’S rights and interests in the trademark and will cause dilution and loss of distinctiveness.
- “16. RESPONDENT’S application exploits and capitalizes on the popularity and goodwill generated by the long-standing use of the OPPOSER’S trademark in the Philippines and the rest of the world.
- “17. RESPONDENT’S application amounts to bad faith.

A Notice to Answer was duly served upon Respondent-Applicant. The Bureau of Post’s registry return card indicates Respondent-Applicant’s receipt made through its counsel on 13 April 2005. After the lapse of the reglementary period for filing and serving the Answer or any motion, manifestation, or other paper, the Opposer filed on 6 April 2005 an Omnibus Motion praying, *inter alia*, to declare Respondent-Applicant as in default and to set the case for reception of its evidence. In our Order 2005-310 dated 25 May 2005, this Office granted Opposer’s prayer and, accordingly, declared Respondent-Applicant in default and set the case for *ex-parte* presentation of its evidence.

Opposer presented a number of documents as exhibits consisting of Exhibits A to V, inclusive of sub-markings, and formally offered them as documentary evidence. In our Order No. 2005-659 dated 1 September 2005, we admitted Opposer’s Formal Offer of Evidence and directed the filing of its Memorandum. On 29 September 2005, the Opposer filed its Memorandum. Respondent-Applicant did not file nor submit any pleading, motion, or other relevant paper.

These documents constitute the entire evidence of the Opposer, viz.:

EXHIBIT NUMBER	DOCUMENT
“A”	Certified true copy of Trademark Registration Certificate no. 4-1980-43884 dated October 18, 2001 for “16 leaf laurel wreath device”.
“B”	The declaration of actual commercial use signed by Mr. John Flynn and filed by Mr. Elmer Solomon last September 23, 2003.
“C”	The petition for recordation of the change of address
“D”	The notice of acceptance of the recordation of the change of address.
“E”	Certified true copy of the trademark Registration Certificate dated January 15, 2002 for “FRED PERRY AND LAUREL WREATH DESIGN.”

“F”	The petition for the recordation of the change of address of the owner.
“G”	The notice of acceptance of the recordation of the change of address
“H”	The publication in the Official Gazette of the mark “Gladiator and wreath device”.
“I”	The power of attorney from the OPPOSER authorizing Poblador, Azada and Bucoy to represent it in this case.
“J”	The authentication from the Philippine consular office as attached to the submitted power of attorney.
“K”	A copy of the decision in Inter Partes Case number 1539 promulgated on May 5, 1983 entitled “Fed Perry Sportswear Limited, versus Nylex Industrial Corporation”.
“K-1”	The part of the decision as stated in the last paragraph of page 4 which stated that: “The rejection of respondent-applicant’s application becomes a necessity in the light of our country’s commitment to Paris Convention in 1883, particularly Article 6bis”.
“L”	A copy of the decision in Inter Partes Case
“L-1”	A portion of the decision in the second paragraph of page 9, which stated: “To allow the registration of the herein respondent-applicant’s... for the same class of goods covered by OPPOSER’S registration would be clearly to put a premium to the dubious and malicious actions made by businessman, imitators and pirates to copy well-known marks and to ride on the goodwill generated by the said marks.”
	Label for “16 leaf laurel wreath design.”
	Label for “Fred Perry and laurel

“M”	wreath device”
“N”	Copy of Trademark Registration certificate for “16 leaf laurel wreath device” in Ireland.
“O”	Copy of Trademark Registration certificate for “16 leaf laurel wreath device” in France.
“P”	Copy of Trademark Registration Certificate of “16 leaf laurel wreath device” in Portugal.
“Q”	Copy of Trademark Registration Certificate for “16 leaf laurel wreath device” in the United States.
“R”	Copy of Trademark Registration certificate for “16 leaf laurel wreath device” in the United Kingdom.
“S”	Copy of Trademark Registration Certificate for “Fred Perry and Laurel Wreath device” in SPAIN.
“T”	Copies of the trademark record per country for the marks.
“U”	Copy of sales record to the various customers in the Philippines coming from the OPPOSER’S website.
“V”	

Opposer alleged that its registered marks enjoy having a well-known status, that it has satisfactorily met prior and continuous use requirement, and that Respondent-Applicant’s mark, if allowed, would likely cause confusion on the part of the public and injury to its business. Our determination will focus on the issue of whether the Respondent-Applicant’s application for registration of the mark *GLADIATOR AND WREATH DEVICE* constitutes a violation of Section 123.1 (d), R.A. 8293.

Opposer pleaded and substantiated its claim of having a valid and subsisting right over the trademarks *16 LEAF LAUREL DEVICE* and *FRED PERRY & LAUREL WREATH DESIGN WITHIN A RECTANGLE* in the Philippines and in other parts of the globe. It presented in the Philippines and elsewhere. To put emphasis on its claim, it likewise presented and offered evidences consisting of various documents showing actual use and maintenance of its registered marks in the Philippines.

As earlier noted, Respondent-Applicant did not file any Answer nor did it file any other pleading, motion, manifestation, or paper. In its application for registration of the mark *GLADIATOR AND WREATH DEVICE* published in our official gazette, Respondent-Applicant seeks to register its mark for rubber, pvc, and plastic sandals, boots, slippers, and shoes.

Notably, Section 123, R.A. 8293 proscribes registration of certain marks. In particular, Section 123.1 (d) provides that a mark cannot be registered if it is identical with a registered mark belonging to another or a mark with a earlier filing or priority date, in respect of: (1) the same goods or services; (2) closely related goods or services; or (3) if it nearly resembles such mark as to be likely to deceive or cause confusion.

Construing a substantially similar provision under the old trademark law, Section 4(d), R.A. 166, as amended, the Supreme Court ruled that the statutory prohibition is intended to avoid confusion; to safeguard the right of registered owner or prior user to the mark or trade name or the goodwill, reputation, and name symbolized by such mark or trade name; and to protect the buying public from purchasing the wrong article or brand of from being mistaken as to its source or origin.

Opposer presented and offered as evidence its registered marks in the Philippines, namely: (1) Certificate of Registration No. 4-1980-43884 registered on 18 October 2001 for the mark *16 LEAF LAUREL WREATH DEVICE* for men, women, and children's shirts, knitwear, tracksuits, jackets, trousers, shorts, socks, ladies' skirts, sports bags, sports caps, sport socks, and racquet carriers under classes 18, 25; and (2) Certificate of Registration No. 4-1994-97249 registered on 15 January 2002 for the mark *FRED PERRY AND LAUREL WREATH DESIGN WITHIN A RECTANGLE* for sports and casual clothing, namely: men and women's shirts, shorts, sweaters, jackets, pants, and warm up suits, women's dresses, skirts and tops, children's shirts, shorts, and sweaters, and sport socks under class 25. Having been duly issued by this Office, these certificates of registration are considered certified copies of their original.

On the basis of the foregoing facts, legal precepts, and evidences, this Office finds that Respondent-Applicant's mark *GLADIATOR AND WREATH DEVICE*, is not registrable under Section 123.1 (d), R.A. 8293. Examining the marks and the goods under the Opposer's certificates of registration as well as the Respondent-Applicant's application, it becomes readily apparent that they have identical marks used or applied on closely related goods.

Philippine jurisprudence defined confusing similarity as resembles between two marks or trade names belonging to different persons such that when these marks or trade names are applied to or used on their respective goods, businesses, services would likely cause confusion or mistake on the part of purchasers either as to goods or services themselves or as to their source or origin. Notably, two types of confusion arise from the use of identical, similar, or colorable marks or trade names, namely: (1) confusion of goods or product confusion; and (2) confusion of business or source or origin confusion. In *McDonald's Corporation vs. L.C. Big Mak Inc.*, the High Court, quoting *Sterling Products international vs. Farbenfabriken Bayer Aktiengesellschaft*, distinguished these two types of confusion, viz.: (1) In product confusion, the ordinary prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. (Here the confusingly marks or trade names are used on the same kind of products.); and(2) In source of origin confusion, the products, businesses, or services of the parties are different, but a party's product, business, or service might reasonably be assumed to originate from the other. And the public may then be deceived into that belief or into the belief that there is some connection between the, which, in fact, does not exist. (Here the identical marks or trade names are employed on different products.)

Evidently, the nature of product, business, or service constitutes an essential element in determining confusing similarity of trademarks or trade names. Under the High Court's definition in the case of *Esso Standard vs. Court of Appeals*, goods are closely related when they belong to the same class, when they have the same descriptive properties, or when they flow through same channels of trade. And in *Ang vs. Teodoro*, the high Court set an illustrative example by disallowing the use of the trademark "Ang Tibay" used for shoes and slippers to be used for shirts and pants holding that hey belong to the same general class of goods. Taking note that Opposer and Respondent-Applicant's goods both belong to class 25 and recognizing that they would be sold through the same, if not, similar stores, outlets, or other commercial establishments, we declare that their goods or products are closely related.

To determine likelihood of confusion, we turned to two recognized tests, namely: (1) the dominance test; and (2) the holistic test. The dominance test focuses on the similarity of the prevalent features of the competing trademarks that might cause confusion. In its application, courts give greater weight to the similarity of appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding minor differences. Moreover, what courts consider are aural and the visual impressions created by the marks in the public mind, giving little weight to factors like prices, quality, sales outlets, and market segments. On the other hand, the holistic test requires the court to consider entirely of the marks as applied to the products, including the labels and packaging, in determining confusing similarity.

To ascertain confusing similarity, we applied the dominance test. Under this test, we find that Respondent-Applicant's *GLADIATOR AND WREATH DEVICE* mark demonstrates a strikingly confusing similarity with the Opposer's registered marks resulting to a likelihood of confusion. Notably, the dominant feature of the Opposer's registered marks is the wreath device. This can be ascertained from its separate registrations in the Philippines that each contains a wreath device. Opposer's separate registrations, therefore, confer upon its wreath device a dominant character; thus, giving Opposer the right to prevent others from using it. This similarity confers upon the Opposer the right to prevent others from appropriating or using any fraction of its registered marks in the course of trade.

Considering that Opposer and Respondent-Applicant have identical marks on closely related goods, the likelihood of confusion exists not only as to their goods but also as to the source or origin or their goods or business. Prejudice to the Opposer and to the public may, therefore, likely result. Consequently, we hold that Respondent-Applicant's mark *GLADIATOR AND WREATH DEVICE*, is not registrable under Section 123.1 (d), R.A. 8293.

Concededly, we recognized that the marks *Fred Perry* in Interpartes Case No. 1539 and *Fred Perry and Device* in Interpartes Case No. 1736 were well-known marks. As to correctly pointed out, we declared in Inter Partes Case No. 1539 that rejection of Nylex Industrial Corporation's trademark application is necessary because of our commitment to the Paris Convention particularly those provisions under Article 6bis. And in Inter Partes Case No. 1736, we remarked that allowing Sy Chin's trademark application would clearly put a premium to dubious and malicious actions made by businessmen, imitators, and pirates to copy well known marks and to ride on the goodwill generated by them.

However, while the marks *Fred Perry and Fred Perry and Device* were recognized as well known in Interpartes Case No. 1539 and Interpartes Case No. 1736, nevertheless, we do not find it indispensably necessary to make a ruling on this point to decide the case now before us. We take note that although Opposer presented and offered as evidence its registered marks in Ireland, France, Portugal, United States of America, United Kingdom, and Spain, these noticeably are not certified copies of their original, and some do not even have a duly authenticated copy of their English translation. Neither expressly nor impliedly, however, do we suggest anything contrary to our former decisions.

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Consequently, Application bearing Serial No. 4-2001-08643 for the mark "GLADIATOR AND WREATH DEVICE" filed by SUPERIOR RUBBER CORPORATION on 19 November 2001 is hereby REJECTED.

Let the filewrapper of the trademark *GLADIATOR AND WREATH DEVICE* subject matter of this case be forwarded to the Administrative, Financial and Human Resource Development Services Bureau for appropriate action in accordance with this Decision and a copy thereof furnished the Bureau of Trademarks for information and update of its records.

SO ORDERED.

Makati City, 17 March 2006.

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