

POMAIR TRADING INC.,
Opposer,
- versus -

IPC 14-2005-00034

Opposition to:
TM Application No. 04-2003-011586
(Filing Date: 17 December 2003)

CP OPTICS INC.,
Respondent-Applicant.

TM: "TECHNOSPORT BY
TECHNOMARINE"

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Decision No. 2007-52

DECISION

This pertains to the opposition to the registration of the mark "TECHNOSPORT BY TECHNOMARINE" bearing Serial No. 4-2003-011856 filed on December 17, 2003 covering the goods "Eyewear, optical frames, sunglasses cases falling under Class 9 of the international classification of goods which trademark application was published in the Intellectual Property Philippines (IPP) Electronic Gazette which was officially released January 24, 2005.

The Opposer in this opposition proceedings is POMAR TRADING INC., a corporation under the laws of the British Virgin Islands, which is a member-state of the Paris Convention for the Protection of Industrial Property as well as the WTO-TRIPS with business address at Chambers Building, Tortola, British Virgin Islands.

On the other hand, the Respondent-Applicant is "CP OPTICS, INC.," a corporation organized under the laws of the Philippine with address at 233 D. Tuazon Street, Quezon City.

The grounds for the opposition are as follows:

- "1. Opposer is the first to adopt and use the trademark "TECHNOMARINE" for its goods such as watches, jewellery, eyewear, clothes, caps, belts, luggage, perfume, cigar boxes, shoes, wallets and agendas under international classes 3, 9, 14, 16, 18, 24, 25 and 34 in the Philippine and other countries worldwide:
- "2. There is a likelihood of confusion between Opposer's trademark "TECHNOMARINE" covering goods under international classes 3, 9, 14, 16, 18, 24, 25 and 34 and Respondent-Applicant's trademark "TECHNOSPORT BY TECHNOMARINE" for goods falling under international class 9, because the latter is identical to and/or closely resembles Opposer's trademark in appearance, spelling, sound, meaning and goods covered. Opposer's "TECHNOMARINE" trademark and Respondent-Applicant's "TECHNOSPORT BY TECHNOMARINE" trademark cover products, which are identical and/or

related (Section 123 (d), Republic Act No. 8293) and falling under the same class.

- “3. The Opposer’s “TECHNOMARINE” trademark is well-known internationally and in the Philippines, taking into account the knowledge of the relevant sector of the public, rather than the public at large, as being trademarks owned by the Opposer. There is no doubt therefore, that the Respondent-Applicant intends to ride on the popularity and goodwill of Opposer’s “TECHNOMARINE” trademark in adopting and using the trademark “TECHNOSPORT BY TECHNOMARINE” covering goods falling under international class 9 as such use would indicate a connection between such goods and those of the Opposer’s. Likewise, the interests of the Opposer are likely to be damaged by Respondent-Applicant’s use of the trademark “TECHNOSPORT BY TECHNOMARINE” for goods falling under class 9.
- “4. The Respondent-Applicant, by using “TECHNOSPORTS BY TECHNOMARINE” as its trademark for goods which are identical and/or related to those of the Opposer’s, has given its products the general appearance of the products are of the Opposer, which would likely to influence purchasers to believe that the “TECHNOSPORS BY TECHNOMARINE” products are of the Opposer’s, thereby deceiving the public and defrauding the Opposer of its legitimate trade hence, Respondent-Applicant is guilty of unfair competition as provided in Section 168.3 of Republic Act No. 8293.
- “5. Respondent-Applicant, in adopting the trademark “TECHNOSPORTS BY TECHNOMARINE” for its products is likely to cause confusion, mistake or deception as regards its affiliation, connection or association with the Opposer, or as to the origin, sponsorship or approval of its products by the Opposer, for which it is liable for false designation of origin, false description or representation under Section 169 of Republic Act No. 8293

Opposer relied on the following facts to support its opposition:

- “1. The Opposer is the first to adopt, use and register the “TECHNOMARINE” trademark in the Philippine and many countries worldwide.
- “2. There is a likelihood of confusing similarity between Respondent-Applicant’s trademark “TECHNOSPORTS BY TECHNOMARINE” and Opposer’s “TECHNOMARINE” trademark.
- “3. The Opposer’s “TECHNOMARINE” trademark is well-known internationally and in the Philippines.
- “4. The use of Respondent-Applicant’s trademark “TECHNOSPORTS BY TECHNOMARINE” for goods under international class 9 would indicate a connection to the products covered in Opposer’s “TECHNOMARINE” trademark, hence, the interest of the Opposer are likely to be damaged.

During the preliminary conference, the parties were encouraged to settle the case amicably and were given ample time to discuss the issue relating to the mark subject of the instant opposition, however, no amicable settlement have been reached.

Due to the parties' failure to reach an amicable settlement, they were required to submit their respective position paper after which the case is considered submitted for decision.

The only to be resolved in this particular case is:

WHETHER OR NOT THE RESPONDENT-APPLICANT IS ENTITLED TO REGISTER THE MARK "TECHNOSPORTS BY TECHNOMARINE".

The applicable provision of law is Section 123.1 (d) of Republic Act No. 8293, which provides:

"Sec. 123. Registrability – 123.1. A mark cannot be registered if it:

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing date, in respect.

- (i) The same goods or services; or
- (ii) Closely related goods or services; or
- (iii) If nearly resembles such mark as to be likely to deceive or cause confusion;

Opposer submitted the following as its evidences in support of its opposition:

Exhibit (s)	Description
"A"	Affidavit of Atty. Ma. Consuelo C. Agno, counsel for Opposer, including the following annexes/exhibits
"A" to "A-24"	List of worldwide registrations and pending applicants for Opposer's trademark "TECHNOMARINE" and its derivatives.
"B" to "B-20"	Samples of advertisement of Opposer's trademark "TECHNOMARINE" and its derivatives in magazine and newspapers circulated in the Philippines.
"C" to "C-7"	Print-out of some vital portions of the website, www.technomarine.com

On the other hand, Respondent-Applicant submitted in evidence the following:

Annex(es)	Description
"1"	Copy of Certificate of Copyright Registration and Deposit of "TECHNO SPORTS BY

	TECHNOMARINE”
“2”	Copy of computer print-out of the IPP application for registration of “TECHNOSPORTS BY TECHNOMARINE”
“3”	Copy of the Application for Copyright filed January 5, 2005.
“4”	Copy of the trademark application filed December 17, 2003.
“5”	Copy of the drawing of “TECHNOSPORTS BY TECHNOMARINE”
“6”	Copy of the Verified Answer to the Opposition filed on March 27, 2007
“7”	Copy of Verification and Certificate of Non-Forum Shopping.
“8”	Copy of Notice of Allowance and Payment of Publication Fee issued by IPP.

A cursory review of the records, the trademark of the Opposer consists of the word “TECHNOMARINE” while that of the Respondent-Applicant consists of the words “TECHNOSPORTS BY TECHNOMARINE”

The ultimate reason why the Opposer is objecting to the registration of the Respondent-Applicant’s mark is the inclusion of the word “TECHNOMARINE” which have been registered by the Opposer with the Intellectual Property Philippines on *February 10, 2003* bearing Registration No. 4-1998-02066 for the goods, jewellery, jewels and articles made of precious metals or coated therewith, namely necklaces, bracelets, earrings, rings, chains, tie pins, cigarette cases, chorological and chromatic instruments, name watches, wrist watches, stop watches, pendulums, clocks, alarm clocks, watch hands, watch cases, bracelets for watches, chains for watches, clock starting springs, clock faces, clock works, chronometers under class 14 of the international classification of goods (Annex “A”) of the Verified Notice of Opposition.

On the other hand, the Respondent-Applicant’s trademark application is covering the goods “eyewear, optical frames, sunglasses, cases” falling under class 9 of the International Classification of goods.

Although it appears that TECHNOMARINE was registered in some countries by Opposer under Class 9, it does not appear that it was applied for or registered in the Philippines. Moreover, the advertisements presented allegedly circulated in the Philippines and marked as Exhibits “B” to “B-20”, showing the mark “TECHNOMARINE, likewise do not show that goods under Class 9, i.e. eyewear, was included.

With respect to the classification of the goods covered by the contending marks, as shown by Opposer’s Registration No. 4-1998-02063 and Respondent-Applicant’s application, there is no doubt that they are entirely distinct and different from each other, the same being class 14 for the Opposer and class 9 for the Respondent-Applicant.

Hence, the remaining question to be answered is whether or not the goods covered by the Respondent-Applicant's mark under Class 9 is related to the Opposer's goods.

In the case of "Esso Standard Eastern, Inc., vs. Court of Appeals", (116, SCRA 336) the Supreme Court stated:

"x x x Infringement of trademark depends on whether the goods of the contending parties using the same trademark, such as "ESSO", are so related as to lead the public to be deceived. The vast majority of courts today follow the modern theory or concept of "related goods" which the court has likewise adopted and uniformly recognized and applied. Goods are related when they belong to same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores. x x x

The trademark "ESSO" which the Petitioner uses for its various petroleum products may also be used as a trademark by a manufacturer of cigarettes, the two products not being related and the public cannot be deceived as to which products they are buying."

Applying the aforementioned ruling of the Supreme Court, the Respondent-Applicant should be permitted to register the trademark "TECHNOSPORTS BY TECHNOMARINE" for its goods falling under class 9 considering that the goods covered by the Opposer's mark "TECHNOMARINE" belong to class 14. In short, the goods covered by the contending marks belong to different class and not related to each other.

In another case "Canon Kabushiki Kaisha vs. Court of Appeals and NSR Rubber Corporation" G.R. No. 120900, promulgated on July 20, 2000, the Supreme Court ruled:

"Since the mark of the Petitioner "CANON" covers the goods belonging to class 2 (paints, chemical products, toner, dyestuff) the Respondent-Applicant can use of the mark "CANON" for its goods classified as class 25 (sandals) clearly, there is a world of difference between the paints, chemical products, toner and dyestuff of Petitioner and the sandals of private Respondent."

Finally, Opposer claimed that it is the first user and adopter of the mark "TECHOMARINE" for its goods under class 3, 9, 14, 16, 18, 24, 25, and 34. However, the records will show that Opposer's mark covers the goods falling under class 14 of the International Classification of goods as indicated in the certificate of registration bearing Registration No. 4-1998-02066 issued on February 10, 2003 by the Intellectual Property Philippines (IPP) (Annex "A") of the Verified Notice of Opposition.

Section 138 of Republic Act No. 8293 provides:

“Section 138. *Certificate of Registration* – A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant’s ownership of the mark and of the registrant’s exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate. (Section 20, Republic Act No. 166)

WHEREFORE, premises considered, the Notice of Opposition is hereby DENIED. Accordingly, application bearing Serial No. 4-2003-011586 for the mark “TECHNOSPORT BY TECHNOMARINE” is hereby GIVEN DUE COURSE.

Let the filewrappers of the trademark “TECHNOSPORTS BY TECHNOMARINE” 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, 11 May 2007.

ATTY. ESTRELITTA BELTRAN ABELARDO
Director
Bureau of legal Affairs