

PUMA AG RUDOLF DASSLER REPORT  
Opposer,

IPC 14-2006-00086

-versus-

Opposition to:  
TM Application No. 4-2006-00086  
(Filing Date: 30 June 2004)

LT2 LLC,  
Respondent-Applicant,  
x-----x

TM: "RUNNING TIGER LOGO"

Decision No. 2007-41

## DECISION

This is an opposition to the registration of the mark "RUNNING TIGER LOGO" bearing Serial No.4-2004-005784 filed on June 30, 2004 for the goods which application was published for opposition purpose on page 11 of the E-Gazette of the Intellectual Property Philippines (IPP) and released officially for circulation on February 15, 2006.

The Opposer in the instant opposition is "PUMA AG RUDOLF DASSLER SPORT", a corporation organized and existing under the laws of Deutschland, Germany.

On the other hand, the Respondent-Applicant is "LT2, LLC", a corporation organized and existing under the laws of the State of Delaware of the United States of America, with address at 152 Madison Avenue, 3<sup>rd</sup> Floor, New York 10016.

The grounds of the opposition are as follows:

- "1. The trademark "RUNNING TIGER LOGO" of the Respondent-Applicant consisting of a "tiger device in running motion" so resembles the Opposer's mark "JUMPING CAT DEVICE" and that the use of the "RUNNING TIGER LOGO" on the goods of the Respondent-Applicant would indicate a connection between said goods and those of the Opposer's to the damage and prejudice of the Opposer's goodwill and interests. In other words, the use of Respondent-Applicant's "RUNNING TIGER LOGO" will cause confusion or mistake upon, or deceive purchasers in that purchasers will tend to believe that the Respondent-Applicant's goods are those of, or coming from the Opposer; Hence under Section 123 (e) and (f), and Section 147 of Republic Act No/ 8293 (Intellectual Property Code of the Philippines), the trademark "RUNNING TIGER AND LOGO" cannot be registered in favor of the Respondent-Applicant. Enclosed are specimen's marks for a better appreciation of their similarities.
- "2. The trademark "RUNNING TIGER LOGO" as described above and sought to be registered by the Respondent-Applicant is confusingly similar to the trademark "JUMPING CAT DEVICE" of the herein Opposer that the latter had much earlier adopted and used in commerce in the Philippines and in other countries of the world.
- "3. Opposer has registered/applied for the registration of the trademark "JUMPING CAT DEVICE" and its variations in different countries of the world including the Philippines in Class 25. "JUMPING CAT DEVICE" is now well-known mark, both internationally and locally, and is entitled to protection under the new Intellectual Property Code.
- "4. Opposer has already spent much for the advertisement and promotion of its trademark "JUMPING CAT DEVICE" and its variations. Hence, Opposer's

business and goodwill clearly be damaged and suffer irreparable injury by the registration and use of a confusingly similar "RUNNING TIGER LOGO" by the Respondent-Applicant.

- "5. Germany, the country where Opposer is a subject, is a member of the Convention of Paris for the protection of Industrial Property (Paris Convention). Opposer is thus entitled to protection under the said Paris Convention. Besides, Germany and the Philippines are both members of the World Trade Organization (WTO).

Opposer relied on the following facts to support its opposition:

- "A. The trademark "RUNNING TIGER LOGO" of the Respondent-Applicant is confusingly similar to the "JUMPING CAT DEVICE" of the Opposer in terms of general appearance, manner and style of presentation, and in respect of the goods to which they are respectively used. There is a manifest intent on the part the Respondent-Applicant to imitate the Opposer's well known mark because the two designs, although not patently identical, are substantially similar so that the purchasers of the Respondent-Applicant's products in Class 25 will likely be deceived or confused as those made and sold by the Opposer, which also make and sell goods under Class 25. Thus, to the latter's prejudice.
- "B. The trademark "JUMPING CAT DEVICE" and its variants have been used and registered in Germany by the Opposer since 1970. In the Philippines, the Opposer has registered and applied for registration the mark "JUMPING CAT DEVICE" and variations thereof obtained by the Opposer.
- (a) Certificate of Registration No. 4-1996-111275 ("JUMPING CAT DEVICE") covering goods in Class 9;
  - (b) Certificate of registration No. 4-1991-075842 ("JUMPING CAT DEVICE") covering goods in Classes 18, 24, 25 and 28;
  - (c) Certificate of registration No. 4-1996-111274 ("JUMPING CAT DEVICE") covering services in Classes 41;
  - (d) Certificate of registration No. 036547 ("PLAN CIRCULAR BACKGROUND WITH JUMPING CAT DEVICE") covering goods in Class 25;
  - (e) Certificate of Registration No. 4-197-122702 ("PUMA WITH JUMPING CAT DEVICE") covering goods in Class 3;
  - (f) Certificate of Registration No. 4-1997-116889 ("PUMA CELL & DEVICE") covering goods/services in Classes 28;
  - (g) Certificate of registration No. 41861 ("PUMA AND JUMPING CAT DEVICE") covering goods/services in Classes 4; and
  - (h) Trademark Application No. 4-2004-04400 ("PUMA AND JUMPING CAT DEVICE") covering goods in Classes 18 and 25;
- "C. Moreover, the trademark "JUMPING CAT DEVICE" has been registered/applied for in different countries of the world. Attached is a list of trademark Registrations issued and trademark applications filed and pending several countries of the world covering the said mark and its variations. Likewise attached are copies of some representative foreign trademark registrations.

- “D. The trademark "JUMPING CAT DEVICE" and its variants have been popularized internationally and locally in different media of advertisement at the great expense of the Opposer.
- “E. The trademark "JUMPING CAT DEVICE" and its variants have been extensively used in commerce in the Philippines since 1970. As such, it already acquired tremendous amount of goodwill. In other words, the trademarks"JUMPING CAT DEVICE" and variations thereof and the product bearing said trademarks are already too well-known in the Philippines as those of the Opposer.
- “F. Opposer’s “JUMPING CAT DEVICE” is a recognized well-known mark of the Opposer not only in Germany but also in most countries of the world that are members of the Paris Convention. Hence, the Opposer is entitled to the mantle of protection afforded under the Paris Convention provisions.
- “G. Considering the Opposer’s long, continued and exclusive use of its”JUMPING CAT DEVICE”, the opposer has built upon said design a property connotation such that, to the purchasing public, which became associated with the Opposer’s products, thus deserves protection under the Intellectual Property (IP) Code of the Philippines, particularly Section 123, 134, 147 and relevant section thereof.
- “H. Opposer’s mark "JUMPING CAT DEVICE" as a well-known international trademark is entitled to protection under the new Intellectual property (IP)Code of the Philippines so that the use by Respondent-Applicant of the confusingly similar mark "RUNNING TIGER LOGO" on its Opposer, thereby damaging the interests of Opposer.

Opposer submitted its documentary evidence consisting of the following

Exhibits	Description
“A”	Authenticated Special Power of Attorney (SPA) 3 pages
“B”	Verified Notice of Opposition ( 9 pages )
“C”	Authenticated Affidavit of Messrs. Lederhilger & Gansler (7 Pages)
“D”	Worldwide List of :Jumping Cat Device” trademarks from Puma (30 pages)
“E”	Certified copy of Australia Trademark Registration No. A566494 (1 page)
“F”	Certified copy of Australia Trademark Registration No. A536587 (1 page)
“G”	Certified copy of Japanese Trademark Registration No. 1925032 (1 page)
“H”	Certified copy of Japanese Trademark Registration No. 1851825 (1 page)
“I”	Certified copy of South Korean Trademark Registration No. 370140 (2 pages)
“J”	Certified copy of South Korean Trademark Registration No. 370140 (2 pages)
“K”	Certified copy of German Trademark Registration No. 994109 (2 pages)
“L”	Certified copy of International Trademark Registration No. 485390 (2 pages)
“M”	Certified copy of International Trademark Registration No. 480105 (1 pages)
“N”	Certified copy of International Trademark Registration No.

	480510 (2 pages)
"O"	Certified copy of United State of America Trademark Registration No. 1,808,837 (2 pages)
"P"	Certified copy of United State of America Trademark Registration No. 2,062,990 (2 pages)
"Q"	Certified copy of United State of America Trademark Registration No. 1,354,044 (2 pages)
"R"	Certified copy of United State of America Trademark Registration No. 1,109,319 (2 pages)
"S"	Advertising Costs of Puma AG from 2000-2005 (3 pages)
"T"	Advertising Materials (88 pages)
"U"	Sales of Puma AG from 2000-2005 (3 pages)
"V"	2005 Annual Report

On the other hand, the Respondent-Applicant filed its Answer whereby it admitted some of the allegations in the verified notice of opposition and denied some of them and submitted the following as its documentary evidence in compliance to office order No. 79, Series of 2005.

Exhibits	Description
"1"	Dr4awing of the mark "Running Tiger & Device" and its facsimile.
"2"	An online printout of the Wikipedia, an online free encyclopedia consisting of 4 pages

The main issue to be resolved in this case is:

WHETHER OR NOT RESPONDENT-APPLICANT'S MARK "RUNNING TIGER LOGO" IS CONFUSINGLY SIMILAR TO OPPOSER'S MARK "JUMPING CAT DEVICE",

This bureau rules in the positive.

The test of confusing similarity which would preclude the registration of a trademark is not whether the challenge 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. The law does not require that the competing marks must be so identical as to produce actual error or mistake. It would be sufficient, for purpose of the law that the similarity between the two labels be such that there is a possibility of likelihood of the purchaser of the older brand mistaking the newer brand for it.

Thus, in the determination of likelihood of confusion, two kinds of tests have been developed-the *Dominancy Test and the Holistic Test*.

In several cases decided by the Supreme Court, it has been consistently held that the question of infringement of a trademark is to be determined by the test of dominancy wherein it focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or dominant features of another, and confusion or deception is likely to result. Indeed, the question lies as to whether the use of the marks involved is likely to cause confusion or mistake in the mind of the public or deceive purchases.

Now, as to what constitutes a dominant feature of a label, no set of rules can be deduced. Usually, these are signs, color, design, peculiar shape or name, or some special, easily remembered earmarks of the brand that easily attracts and catches the eye of the ordinary consumer.

Applying the above tenets and after a careful scrutiny of the subject marks, there is no doubt that the marks of opposer and Respondent-Applicant are confusingly similar. This respective label, as can be deduced therein, the peculiar shape and design of the "PUMA" representation is the dominant feature of Opposer's mark since that is the feature that easily attracts and catches the eye of the purchaser and the distinguishing mark which is usually associated as that coming from the Opposer.

To further bolster the striking similarity, the contending marks as appearing in their respective labels are hereby reproduced for scrutiny

As can be inferred from the above presentation, it is obvious that Opposer's mark "JUMPING CAT DEVICE" is represented by a cat displayed in a jumping position while Respondent-Applicant's mark "RUNNING TIGER LOGO" by a tiger displayed in a similar manner. Verily, cat and tiger belong to the same feline specie and a deviation in their particular class of specie will not affect the finding of confusing similarity which is likely to cause confusion. Obviously, a plain examination of the labels themselves will instantly show the existence of likelihood of confusion considering the manner the marks were displayed. The two device is hardly distinguishable as to whether is it in a running or jumping position and whether it's a cat or tiger as ordinary purchasers will ordinarily discern it as running or jumping cat and more often than not, the purchasers involved could not readily distinguish, at a glance, the difference between a cat and tiger.

More, the goods which the marks respectively carry bolster the finding of confusing similarity since they carry related goods falling under Class 25 which basically include clothing and other articles. As has been aptly held in a number of jurisprudence, goods are related when they belong to the 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 sold in grocery stores.

Obviously, the relatedness of the goods of Opposer and Respondent-Applicant's mark is shown by the fact that they belong to the same class, they have the same descriptive properties and they serve the same purpose. Indeed, the goods of Opposer and Respondent-Applicant's are competing and they basically flow through the sane channel of trade.

Finally, being the prior user of the mark, Opposer is undeniably entitled to protection under the law, as can be gleaned from the evidences presented by the Opposer, it is evident that Opposer was able to register the mark in dispute in Germany as early as February 23, 1970 for the same class 25. In the Philippines, Opposer is likewise the prior user and registered the same as early as July 1, 2004.

Thus, applying the law and jurisprudence and the evidences presented, it is wise to conclude the Respondent-Applicant is clearly not entitled to the registration of the mark "RUNNING TIGER LOGO" as the registration of the same runs counter to the provision of Republic Act No. 8293, otherwise known as the Intellectually Property Code of the Philippines, which mandates that:

*" 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 mark with an earlier filing or priority date, in respect of:*

*(i) The same goods or services, or Closely related goods or services, or*

- (ii) If it nearly resembles such a mark as to be likely to deceive or cause confusion. x x x”

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Accordingly, Application bearing Serial No. 4-2004-005784 for the trademark “RUNNING TIGER LOGO” filed on June 30, 2004 by Respondent-Applicant LT2 LLC for the goods falling under Class 25 is, as it is, hereby REJECTED.

Let the file wrapper of the trademark “RUNNING TIGER LOGO” 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, 30 March 2007.

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