

SPEEDO HOLDINGS B.V.,

Opposer,

IPC NO. 14-2008-00066

Opposition to:

-versus-

Serial No. : 4-2006-008994

Filed : 15 August 2006

Trademark: "SPEED"

WILSON T. ANG

Respondent-Applicant.

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DECISION

Before this Bureau is an opposition filed by Speedo Holdings B.V., a corporation duly organized and existing under and by virtue of the laws of The Netherlands with principal offices at Claude Debussylaan 24, 1082 MD Amsterdam, The Netherlands, against the application for registration of the trademark "SPEED" for *t-shirts, polo shirts, sandos, jerseys, underwear, socks, jeans, sweatshirts, shorts, scarves, jackets, rainwear, swimsuits, slippers, sandals, rubber shoes, headbands, caps, hats, visors and bonnets under Class 25*, with Application Serial No. 4-2006-008994 and filed on 15 August 2006 in the name of Respondent-Applicant, Wilson T. Ang, with business address at 145 Int. H. Soler St. Sta. Cruz, Manila.

The grounds for opposition to the application for registration of the trademark SPEED are as follows:

"1. Opposer is the lawful owner of the trademark "SPEEDO" either singly or in combination with other words and/or devices, in various jurisdictions around the globe.

- 1.1. "Attached as Annex "A" to form an integral part hereof is an inventory of the Opposer's "SPEEDO" trademark registrations and pending applications around the world, singly or in combination with other words and/or devices, evidencing a more than substantial level of protection for the mark worldwide, notably in International Class 25.
- 1.2. "Attached as Annexes "B" are select registration certificates for the Opposer's mark "SPEEDO" in major foreign jurisdictions in International Class 25.

"2. Opposer is likewise the owner of several in-force and valid/subsisting trademark registrations in the Philippines in Class 25 for the mark "SPEEDO", singly or in combination with other words and/or devices, viz:

- 2.1. "Renewal Trademark Registration No. 032411 renewed on 11 August 2003 for the mark "SPEEDO" in Class 25, copy of which is hereto attached as Annex "C";
- 2.2. "Trademark Registration No. 053619 issued on 28 September 1992 for the mark "SPEEDO ON TOP OF ARROW DEVICE" in Classes 09, 12, 18, 25 and 28, copy of which is hereto attached as Annex "C-1";
- 2.3. "Trademark Registration No. 057669 issued on 20 April 1994 for the mark "SPEEDO AND ARROW DEVICE" in Classes 9, 12, 18, 25 and 28, copy of which is hereto attached as Annex "C-2";

- 2.4. "Trademark Registration No. 4-2003-003919 issued on 23 July 2005 for the mark "SPEEDO SCULPTURE" in Class 25, a computer print out of which downloaded from the IPO website is hereto attached as Annex "C-3";
- 2.5. "Trademark "SPEEDO AUTHENTIC FITNESS (WORD & DEVICE MARK" deemed registered by the Intellectual Property Office (IPO) under Registration No. 4-1995-103273 with Registration Date of 16 June 2006, a computer print out of which downloaded from the IPO website is hereto attached as Annex "C-4";
- 2.6. "Trademark "SPEEDO ENDURANCE" deemed registered by the Intellectual Property Office (IPO) under Registration No. 4-2007-008866 with Registration Date of 07 January 2008, a computer print out of which downloaded from the IPO website is hereto attached as Annex "C-5";

"3. Opposer maintains a website (www.speedo.com) that showcases, inter alia, its various products in Class 25. As can be gleaned from the website, Opposer's product reach and actual geographical presence is considerably extensive, with Class 25 products bearing the mark "SPEEDO", singly or as the dominant feature, in actual commercial use and circulation in at least ONE HUNDRED SIX (106) countries worldwide, the PHILIPPINES included. This, indeed, is undisputed testimony of the mark's world renown.

- 3.1. "The website, which offers a facility for on-line purchase of Class 25 goods, is readily accessible to everyone;
- 3.2. "Attached as Annex "D" to form integral parts hereof are pertinent pages of Opposer's website that contain various relevant information, including dealership details for the Philippines;
- 3.3. "In the Philippines, Opposer's products in Class 25 are commercially available at 17 stand-alone Speedo concept stores in Ayala and SM Malls and through multi-branded sports retail chains like Tobys, Olympic World, Plant Sports Inc and through 34 reputable major department stores of SM, Robinson, Rustans and Duty Free nationwide.

"4. The Opposer's first ever use of the above-named trademark started in Australia in 1993. In the Philippines, the Opposer first used the mark "SPEEDO" in Class 25 goods in August 1983.

"5. Registration of the mark "SPEED" in favor of Respondent-Applicant would be violative of Section 123.1 (e) & (g) of Republic Act No. 8293, otherwise known as the Intellectual Property Code, the pertinent provisions of which reads:

"x x x
x x x

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

x x 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;* (underscoring supplied for emphasis):

(e) *Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, that in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark (emphasis supplied).*

x x x
x x x”

“6. Additionally, being internationally well-known, Opposer’s mark is protected not only under Sections 123 d & e of Republic Act No. 8293, but likewise under Article 6 bis of the Paris Convention for the Protection of Industrial Property. Said provision is quoted in part below:

“x x x
x x x

Article 6 bis

(1) *The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation liable to create confusion, of a mark Considered by the competent authority of the country of registration or use to be well-known in that country as being already the mark of a person entitled to the benefits of this convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.*

x x x
x x x”

“7. Finally, owing to the international renown of the Opposer’s products (not least of which due to said products’ already accessibility internationally at the internet through Opposer’s website, and its ubiquitous presence in Philippine commerce and consumer consciousness, the Respondent-Applicant, in evident bad faith, took advantage of said popularity and now wishes to parlay the same to his advantage by fraudulently misappropriating said mark via a thinly disguised predatory act.

- 7.1. "That the Respondent-Applicant's slovenly attempt to ride on the popularity of Opposer's mark is definitively betrayed by the almost identical representation of the marks, viz:

SPEEDO

SPEED

Opposer's mark

Respondent-Applicant's mark

As well as the description of goods, viz:

sportwears, swimwear, casual wear, including swimsuits, shirts, blouses, singlets, bathing caps, vests, pants, pantsuits, trouser suits, slacks, shorts, skirts, dresses, coats, blazers, (Opposer's TM Registration Nos. 032411 and 0353619

"T-shirts, polo shirts, sandos, jerseys, underwear, socks, jeans, sweatshirts, shorts, scarves, jackets, rainwear, swimsuits, slippers, sandals, rubber shoes, headbands, caps, hats, visors and bonnets" Respondent-Applicant's Appln. Serial No. 4-2006-008994)

- 7.2. "The barefaced attempt to copy the Opposer's mark is indeed obvious, as both marks are almost identical, Respondent-Applicant having simply dropped the letter "O" in his application, and applying for the root word "SPEED" instead. By this simple yet deceitful expedience, the Respondent-Applicant brazenly flaunts his evident bad faith, callously and fraudulently riding on the acknowledged popularity of Opposer's mark. Indeed, *res ipsa loquitur*.

"8. Clearly then, Respondent-Applicant's application for registration of the same mark is manifestly violative of Opposer's right under the aforequoted provisions of Republic Act No. 8293, the Paris Convention and the general principles of good faith, equity and fair play.

"9. Over the years, Opposer's mark has gained distinction and earned tremendous goodwill in International Class 25 throughout the world. Allowing Respondent-Applicant's application to mature into registration will undoubtedly be injurious and prejudicial to Opposer's lawful interests that it has painstakingly cultivated throughout the years. Respondent-Applicant's predatory act, therefore, should not be countenanced.

Opposer relied on the following facts to support its contentions in this Opposition:

"2. Records show that on 15 August 2006, herein Respondent-Applicant filed an application for the registration of the mark "SPEED" with the Intellectual Property Office (IPO, for brevity), in International Class 25 for the goods "t-shirts, polo shirts, sandos, jerseys, underwear, socks, jeans, sweatshirts, shorts, scarves, jackets, rainwear, swimsuits, slippers, sandals, rubber shoes, headbands, caps, hats, visors and bonnets." The application was assigned Application Number 4-2006-008994.

“3. Opposer learned of the filing by Respondent-Applicant of the aforementioned application when the mark was published for purposes of opposition in the IPO’s Electronic Gazette released on 23 November 2007. Seasonable requests for 30-day extensions of time to lodge the Verified Notice of Opposition were filed by Counsel, and favorably granted by this Honorable Office.

The Notice to Answer dated 10 April 2008 was sent to Respondent-Applicant, Wilson T. Ang, directing him to file his Verified Answer to the Notice of Opposition filed by Opposer within thirty (30) days from receipt of the Notice to Answer. For failure of Respondent to file the required Answer, this Bureau in Order No. 2008-1612 declared Respondent to have waived his right to file the Verified Answer upon filing by Opposer on 1 July 2008 of an Urgent Ex-Parte Motion to Declare Respondent-Applicant in Default and thereafter, this Bureau resolved to submit the case for decision.

Considering that the case was mandatorily covered by the Summary Rules under Office Order No. 79, this Bureau directed Opposer to file all evidence in original and duplicate copies, and in compliance with said Order, Opposer through Counsel filed its evidence on 19 March 2008.

In support of its prayer for the rejection of Application Serial No. 4-2006-008994 for the mark SPEED, Opposer’s evidence consisted, among others, of the Inventory of the Opposer’s worldwide trademark registrations numbering 1,457, covering the mark SPEEDO, singly or in combination with other words and devices, in all classes, notably in Class 25 (*Exhibit “A”*); Certified copy of Opposer’s Certificate of Renewal of Registration No. 32411 for the mark “SPEEDO” registered with the Intellectual Property Office (*Exhibit “B”*); Certified copy of the original Affidavit of Use for the 10th Anniversary with Notice of Acceptance issued by the Intellectual Property Office, evidencing the in-force status of Opposer’s Certificate of Registration No. 53619 for the mark “SPEEDO ON TOP OF ARROW DEVICE” (*Exhibit “C”*); Certified copy of the original Affidavit of Use for the 10th Anniversary with Notice of Acceptance issued by the Intellectual Property Office, evidencing the in-force status of Opposer’s Certificate of Registration No. 57669 for the mark “SPEEDO AND ARROW DEVICE” (*Exhibit “D”*); Certified copy of Opposer’s Certificate of Renewal of Registration No. 4-1995-103273 for the mark “SPEEDO AUTHENTIC FITNESS (WORD AND DEVICE MARK)” registered with the Intellectual Property Office (*Exhibit “E”*); Certified copy of the Notice of Allowance, with stamp of compliance, issued by the Intellectual Property Office (IPO) in favor of Opposer’s Application No. 4-2007-008866 for the mark “SPEEDO ENDURANCE” (*Exhibit “F”*); Pertinent pages of Opposer’s website (www.speedo.com) that contain various relevant information, including dealership details for the Philippines (*Exhibit “G”*).

The issue for this Office’s disposition is the propriety of Application Serial No. 4-2006-008994; whether or not Respondent-Applicant is entitled to register the trademark SPEED covering the following: *t-shirts, polo shirts, sandos, jerseys, underwear, socks, jeans, sweatshirts, shorts, scarves, jackets, rainwear, swimsuits, slippers, sandals, rubber shoes, headbands, caps, hats, visors and bonnets* under Class 25.

After close scrutiny and careful evaluation of the records and evidence presented, this Bureau finds merit on the grounds relied upon to sustain this instant Opposition.

A cursory reading of paragraph (d) of R.A. 8293 with emphasis on prior registration and/or application of the same mark involving same or similar goods states that:

“Section 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 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;”*

xxx

The preceding section provides that the owner of a registered mark or an owner of a mark with an earlier filing date or priority date can oppose an application for registration of another mark being used on the same or related products. The purpose of the Trademark Law is to provide protection not only to the owner of the trademark of proprietor of the mark with an earlier filing or priority date in exact adherence to the First-to-Register or File Rule as one important factor of registrability under R.A. 8293, likewise, and more importantly, to the unwary public that they may not be confused, mistaken or deceived by goods they buy.

The right to register trademarks, trade names and service marks is based on ownership. Only the owner of the mark may apply for its registration (*Bert R. Bagano v. Director of Patents, et. Al.*, G.R. No. L-20170, August 10, 1965). And where a trademark application is opposed, the Respondent-Applicant has the burden of proving ownership (*Marvex Commercial Co., Inc. v. Peter Hawpia and Co.*, 18 SCRA 1178). Opposer, Speedo Holdings BV, obtained its Certificate of Registration No. 32411 for the trademark SPEEDO on 11 August 1983 with the Intellectual Property Philippines (IPP) for the following goods:

Class 9	<i>Driver’s suits and gloves, swimmer’s and diver’s ear plugs and nose clips, wet suits for diving, swimming jackets, bathing floats, life buoys, life belts, life-saving apparatus, and instruments, breathing for underwater swimming, goggles.</i>
Class 18	<i>Bags, suitcases, satchels, knapsacks, purses, pocket wallets and umbrellas</i>
Class 25	<i>Sportweares, swimwear, casual wear, including swimsuits, shirts, blouses, singlets, bathing caps, vests, pants, pantsuits, trousers, trouser suits, slacks, shorts, skirts, dresses, coats, blazers, jackets, pajamas, night dresses, wetsuits for water skiing, underwear, hosiery and footwear.</i>
Class 28	<i>Transportable swimming pools, non-motorized surfboards, skateboards, kickboards, games, toys and playthings, gymnastic and sporting articles, instruments and appliances (except clothing), crickets and golf bags, swimming paddles (hand), and flippers.</i>

On the other hand, Respondent-Applicant filed after twenty-three (23) years of Opposer’s trademark registration for SPEEDO (*Exhibit “B”, Opposer*), his application for registration of the mark SPEED on 15 August 2006 for *t-shirts, polo shirts sandos, jerseys, underwear, socks, jeans, sweatshirts, shorts, scarves, jackets, rainwear, swimsuits, slippers, sandals, rubber shoes, headbands, caps, hats, visors, and bonnets* under Class 25. As it now stands, this Bureau concludes that it is the Opposer, not the Respondent-Applicant, which can claim priority of an earlier registration/filing pursuant to Section 123 of R.A. 8293.

Moreover, it may well be worthy to note that as early as August 1983 Opposer obtained registration of the trademark SPEEDO on products in Class 25 in the Philippines and this registration is subsisting and has not been abandoned. Hence, Respondent-Applicant, by any parity of reasoning, cannot be considered an originator, prior registrant nor a prior applicant of the subject or questioned trademark.

The mark of Respondent-Applicant consisted of the mark SPEED for use on *t-shirts, polo shirts, sandos, jerseys, underwear, socks, jeans, sweatshirts, shorts, scarves, jackets, rainwear, swimsuits, slippers, sandals, rubber shoes, headbands, caps, hats, visors and bonnets* under Class 25. Anyone is likely to be misled by its close resemblance or identity with Opposer's trademark SPEEDO being used and not abandoned by Opposer and applied on the same wearing apparel such as shirts, underwear, swimsuits etc. The subject mark applied for, SPEED and Opposer's SPEEDO trademark as they appear on the goods of the contending parties readily manifest the glaring similarities. The marks are phonetically the same, of identical sounds, with similar consonant and vowel content. To create some variations which is not significantly distinctive, Respondent-Applicant's mark deleted the letter O. However, the deleted letter O is not glaring and striking to the eye since all the five (5) letters consisting of the letters S, P, double E and D remained written in bold letters and horizontal form, in close resemblance to the one used by Opposer (*Exhibit "B", Opposer*), as can be gleaned from the formal drawing and facsimiles submitted by the Applicant in. the court observed in *Philippine Refining Co., Inc., vs. Dir. Of Patents and Sparklets Corp. vs. Walter Kidde Sales Co.*, 104 F. 2d 396, that "a trademark is designed to identify the user. But it should be so distinctive and sufficiently original as to enable those who come into contact with it to recognize instantly the identity of the user. It must be affirmative and definite, significant and distinctive, capable to indicate the origin. "Likewise, our trademark law does not require identity, confusion is likely if the resemblance is so close between two trademarks. Bolstering this observation is the pronouncement by the court in the case of *Forbes, Munn & Co. (Ltd.) vs. Ang San To*, 40 Phil. 272, 275) where is stated that *the test was similarity of "resemblance between the two (trademarks) such as would be likely to cause the one mark to be mistaken for the other. . . . [But] this is not such similitude as amounts to identity."*

The word or term SPEED remains the dominant, prominent and distinctive feature in the new mark, the dropping of the letter "O" in Applicant's mark SPEED is insignificant to yield a distinct appearance not only because it is printed and designed with the style and script used by Opposer but the word SPEED standing alone has continued to create confusion between the competing marks.

Clearly etched in *Converse Rubber Corp. vs. Universal Rubber Products, Inc.* is the concept of likelihood of confusion where it said "The similarity in the general appearance of respondent's trademark and that of petitioner would evidently create a likelihood of confusion among the purchasing public. xxx The risk of damage is not limited to a possible confusion of goods but also includes confusion of reputation if the public could reasonably assume that the goods of the parties originated from the same source. "The law does not require actual confusion, it suffices that confusion is likely to occur in the sale of the goods and adoption of both marks (*Philips Export B.V., et. al vs. Court of Appeals, et. al G.R. No. 96161, February 21, 1992*). Hence, the likelihood that prospective buyers may perceive that Respondent's goods are manufactured by or is associated or connected with Opposer is probable.

Having thoroughly discussed and resolved issues on confusion and priority in use and application, we shall now be delving on the goods involved.

Confusion is likely and/or inevitable when identical or similar marks are applied on similar goods. There is no need to lengthy discuss what goods are involved since the products of the contending parties are almost the same and all falling under the same Class 25; both parties sell the same wearing apparel such as swimsuits, shorts, shirts, underwear etc. including footwear. Thus, the goods involved flow through the same channels of trade.

The Opposer being the registered owner, originator, prior applicant and user of the trademark SPEEDO used on clothing or wearing apparel under Class 25, the subsequent adoption and use by Applicant of confusingly mark SPEED can only mean that Applicant wishes to reap on the goodwill, benefit from the advertising value and reputation of Opposer's SPEEDO trademark.

In the case of American Wire & Cable Co. vs. Director of Patents, 31 SCRA 544, it was observed that:

“Why of the million of terms and combination of letters and designs available the appellee had to choose a mark so closely similar to another’s trademark if there was no intent to take advantage of the goodwill generated by the other mark”

Finally as to Opposer’s claim that the mark SPEEDO is internationally well-known citing provisions for the protection of well-known marks for goods or services as contained in Section 123.1 (e) of the Intellectual Property Code of the Philippines (R.A. 8293), with the evidence on record however, this Bureau finds it difficult to concur with Opposer’s declaration that their trademark is internationally well-known. There are criteria for determining whether a mark is well-known. Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Trade Names, and Marked or Stamped Containers has cited the following:

- “(a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion, of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;*
- “(b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;*
- “(c) the degree of the inherent or acquired distinction of the mark;*
- “(d) the quality-image or reputation acquired by the mark;*
- “(e) the extent to which the mark has been registered in the world;*
- “(f) the exclusivity of registration attained by the mark in the world;*
- “(g) the extent to which the mark has been used in the world;*
- “(h) the exclusivity of use attained by the mark in the world;*
- “(i) the commercial value attributed to the mark in the world;*
- “(j) the record of successful protection of the rights in the mark;*
- “(k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and*
- “(l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other the person claiming that his mark is a well-known mark.*

Applying the above criteria and considering that Opposer has only attached in its Notice of Opposition the following: a certified copy of one (1) Certificate of Renewal of Philippine Registration for SPEEDO under Registration No. 32411 (*Exhibits “B”, Opposer*), a certified copy of another Certificate of Registration bearing Registration No. 4-1995-103273 issued by the Intellectual Property Philippines (IPP) (*Exhibits “E”, Opposer*) and two (2) Affidavit of Use in the name of Opposer Speedo Holdings BV filed with this Office for the trademarks SPEEDO ON TOP OF ARROW DEVICE, SPEEDO AND ARROW DEVICE (*Exhibits “C” and “D”, Opposer*) and one (1) Notice of Allowance for the mark SPEEDO ENDURANCE, the other relevant documents accompanying the Notice of Opposition are mere inventories of foreign registrations for the trademark SPEEDO. This Bureau can not rely on bare allegations of different registrations

abroad without supporting documents that need to be certified by the issuing authority. Hence, it did not satisfy the criteria enumerated in Rule 102 as abovementioned. Therefore, this Bureau or any other competent authority for that matter, can not declare Opposer's trademark to be well-known at the time of Respondent's application notwithstanding Opposer's reliance on some registrations obtained abroad. Also, all supporting papers and documents accompanying the Notice of Opposition should be either in duplicate originals or certified true copies as per requirement in Section 7.1 of Office Order No. 79, Series of 2005 (Amendments to the Regulations on Inter Partes Proceedings) to be appreciated as evidence-in-chief

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby SUSTAINED. Consequently, Application bearing Serial No. 4-2006-008994 filed by Wilson T. Ang on 15 August 2006 for the registration of the mark "SPEED" for use on goods falling under Class 25 is, as it is hereby REJECTED.

Let the filewrapper of SPEED, subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Makati City, 19 December 2008.

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