



KING'S SAFETYWEAR LIMITED,
Opposer,

IPC NO. 14-2010-00287
Opposition to:

-versus-

Appln. Ser. No. 4-2010-001465
Date Filed: 10 February 2010

HI-SAFETY INDUSTRIAL
SUPPLIES INC.,
Respondent-Applicant.

Trademark: KINGATE

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Decision No. 2012- 28

DECISION

King's Safetywear Limited, ("Opposer")¹ filed on 25 November 2010 an opposition to Trademark Application Serial No. 4-2010-001465. The application, filed by Hi-Safety Industrial Supplies, Inc. ("Respondent-Applicant")², covers the mark KINGATE used on "*protective eyewear and safety helmet*" under Class 9 of the International Classification of Goods/Services³. The Opposer alleges among other things, the following;

- "1. Opposer is the first to adopt, use and register worldwide and in the Philippines the trademark KING'S & DEVICE, under Registration No. 4-2009-001104; Registration Date: 12 November 2009; Claim of Priority-Australia (Registration No. 1255007, 04 August 2008), for safety apparatus including safety helmets, safety gloves for protection against accident full body harness; safety footwear for protection against accident injury, respiratory mask; safety lanyards, in class 9, further, footwear specified as boots, boots for sports, sports shoes, sandals, slippers, in Class 25. That under Section 147 of the Intellectual Property Code herein opposer has the right to exclude others from registering or using identical or confusingly similar trademarks such as protective eyewear and safety helmets.
- "2. The use and appropriation by respondent-applicant of the trademark KINGATE infringes upon the opposer's exclusive right to use its registered trademark KING'S & DEVICE under Section 147 of the Intellectual Property Code.
- "3. KINGATE is confusingly similar to KING'S & DEVICE visually, phonetically and connotatively, as to likely when used in connection with the goods of respondent-applicant, specifically for protective eyewear and safety helmet, will cause mistake, confusion and deception to the buying

¹ A foreign coporation, duly organized and existing under and by virtue of the laws of the Republic of Singapore, with principal office address at 22 Defu Lane 1, Singapore 539493.

² A corporation duly organized and existing under laws of the Republic of the Philippines, with office address at Unit 8 Topmark Commercial Building 1763 P.M. Guanzon Street, Paco Manila.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

of KINGATE for its products will falsely indicate a connection to opposer. Therefore, pursuant to Section 147.2 of the Intellectual Property Code, the trademark KINGATE cannot be registered in the Philippines.

- “4. In adopting and using KINGATE for its goods, respondent-applicant is likely to cause confusion or mistake or to deceive the buying public as to the affiliation, connection or association with opposer, or origin, sponsorship or approval of its goods by the opposer, for which under Section 169 of the Intellectual Property Code, respondent is liable for false designation of origin, false description or representation.
- “5. Opposer’s KING’S & DEVICE 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 the trademark of the opposer.”

The Opposer submitted the following pieces of evidence:

1. Exhs. “A” to “A-2”: original Cert. of Authentication issued by Vice Consul Catherine Rose G. Torres pertaining to the Affidavit of Tan Wai Kang;
2. Exhs. “A-3” to “A-5”: original authenticated Affidavit of Tan Wai Kang;
3. Exhs. “A-6-a” to “A-6-d”: certified copies of newspaper and magazine advertisements bearing the Opposer’s mark;
4. Exhs. “A-7” to “A-7-i”: certified copies of promotional materials and advertisements bearing the Opposer’s mark;
5. Exhs. “A-8” to “A-11”: certified copies of Opposer’s invoice and debit note;
6. Exh. “A-12”: certified copy of a product catalogue bearing the Opposer’s mark;
7. Exh. “A-13”: certified copy of Opposer’s Directory Statement of Account dated 01 June 2009;
8. Exh. “A-14”: certified copy of promotional material of the Opposer’s mark;
9. Exh. “A-15”: certified copy of contract executed between Opposer and Directories Philippines Corporation for June 2008 to May 2009;
10. Exhs. “A-16” to “A-134”: certified copies of Opposer’s Tax Invoices, Delivery Orders, Purchase Orders;
11. Exhs. “A-135” to “A-136”: computer printouts showing the Opposer’s mark;
12. Exhs. “A-137” to “A-140”: computer printouts showing the Opposer’s history and manufacturing tradition;
13. Exhs. “A-141-“A-142”: printouts of Status Report of Marks of the Opposer; and
14. Exhs. “A-143” to “A-145”: certified copy of Cert. of Reg. No. 4-2009-001104 for the mark KING’S & DEVICE.

On 24 March 2011, the Respondent-Applicant filed its Verified Answer denying the material allegations in the opposition and arguing that KINGATE is not confusingly similar with the Opposer’s mark KING’S & DEVICE. The Respondent-Applicant’s evidence consists of print-out of the competing marks and brochures for the mark KINGATE.⁴

The essence of trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; to secure to him who has been

⁴ Exhs. “1” to “3” (inclusive).

ownership of the goods to which it is applied; to secure to him who has been instrumental in bringing into the market a superior article of merchandise; the fruit of the industry and skill; to assure to the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁵ Thus, Sec. 123.1 (d) of R.A. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such mark as to be likely to deceive or cause confusion.

Records show that the time the Respondent-Applicant filed its trademark application on 10 February 2010, the Opposer has an existing registration for the mark KING's & DEVICE under Reg. No. 4-2009-001104, issued on 12 November 2009. The goods covered by the said registration are similar and closely related to the goods indicated in the Respondent-Applicant's application. These are "*safety apparatus including safety helmets, safety gloves for protection against accident full body harness; safety footwear for protection against accident injury, respiratory mask; safety lanyards*" under Class 9, and "*footwear specified as boots, boots for sports, sports shoes, sandals, slippers*" under Class 25.

But, are the competing marks, as shown below, identical or resemble each other that confusion or deception is likely to occur?



Opposer's mark



Respondent-Applicant's mark

The feature or part, which is common to the competing marks and which immediately draws the eyes and ears is the word "KING". The prominence of this word renders inconsequential the differences with respect to the other features of the marks. In this regard, confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other⁶. The conclusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term⁷.

⁵ *Pribhdas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999

⁶ *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 April 2001, 356 SCRA 207, 217

⁷ *Continental Connector Corp., vs. Continental Specialties Corp.*, 207 USPQ 60

The additional letters "A", "T" and "E" in the Respondent-Applicant's mark failed to give the said feature a character that is sufficiently distinct from that of the Opposer's. The Opposer is a manufacturer of safety helmets, safety gloves for protection against accident or injury, protective shoes and safety spectacles, eyewear and others which was established since 1965.⁸ Considering that the competing marks are used on similar or closely related goods, particularly eyewear under class 9, confusion, mistake, or even deception, as to the goods or products or with respect to the origin or manufacturers thereof are likely. Consumers may even assume that one mark is just a variation of the other and there is a connection or association between the two marks and/or between the contending parties themselves, when in fact there is none.

The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the answered riddle is why, of the millions of terms and combination of letters and available, the Respondent-Applicant had come up with a mark identical or so clearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark⁹.


It is stressed that the laws on Trademarks and Tradenames is based on the principle of business integrity and common justice. This law, both in letter and spirit is laid upon the premise that, while it encourages fair trade in every way and aims to foster, and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing others business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another.¹⁰

Accordingly, this Bureau finds that the registration of the Respondent-Applicant's mark is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is **SUSTAINED**. Let the filewrapper of Trademark Application serial No. 4-2010-001465 be returned, together with a copy of this Decision, to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 17 February 2012.


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

⁸ Affidavit of Tan Wai Kang (Exh. "A-3").

⁹ *American Wire and Cable Co. v. Director of Patents et. al* (SCRA 544), G.R. No. L-26557, 18 Feb. 1970.

¹⁰ See *Baltimore Bedding Corp. v. Moses*, 182 and 229, 34A (2d) 338.