



APPLE INC.,
Opposer,

-versus-

ARIS MIRANDA,
Respondent-Applicant.

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} IPC No. 14-2011-00275
}
} Opposition to:
} Appl. Serial No. 4-2011-001655
} Date filed: 15 Feb. 2011
} TM: "APPLEWERKZ & DESIGN"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 – 199 dated October 12, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 12, 2012.

For the Director:


Atty. **EDWIN DANILO A. DATING**
Director III
Bureau of Legal Affairs



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IPC No. 14-2011-00275
Opposition to:

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(Filing Date: 15 Feb. 2011)
TM: "APPLEWERKZ
& DESIGN"

Decision No. 2012- 199

DECISION

APPLE INC. ("Opposer")¹ filed on 11 October 2011 an opposition to Trademark Application Serial No. 4-2011-001655. The application, filed on 15 February 2011 by ARIS MIRANDA ("Respondent-Applicant")², covers the mark "APPLEWERKZ & DESIGN" for use on "*presentation of goods for retail purposes*" under Class 35 of the International Classification of goods.³

The Opposer alleges among other things, that it is the prior user and first registrant of the APPLE trademarks in the Philippines, well before the filing date of the Respondent-Applicant's trademark application. According to the Opposer, APPLEWERKZ mark is confusingly similar, if not identical, to its APPLE trademarks, and thus runs contrary to the provisions of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). The Opposer's evidence consists of the following:

1. Exh. "A" - original legalized Verified Notice of Opposition;
2. Exh. "B" - original legalized Affidavit of Thomas R. La Perle;
3. Exh. "B-1" - listing of a sampling of trademark registrations for the Apple Logo in a variety of jurisdictions;
4. Exh. "B-2" - listing of a sampling of some of the Opposer's registrations for the APPLE word mark in a variety of jurisdictions;
5. Exh. "B-3" - copy of the Opposer's external use policy, published under the title "*Guidelines for Using Apple Trade Marks and Copyrights*";
6. Exh. "B-4" - copies of materials featuring the Opposer's APPLE trademarks, specifically the Apple Logo, in connection with its Mac OS products;
7. Exh. "B-5" - screenshot of the homepage of the iTunes Store service website in the Philippines which shows use of the Apple Logo;
8. Exh. "B-6" - screenshots of the Apple Store service website for the United States ("U.S."), France, Japan, the Philippines and the United Kingdom;

¹ A corporation organized under the laws of the State of California, U.S.A., with business address at 1 Infinite Loop, Cupertino, California 95014, U.S.A.

² With address c/o Margarita C. Nacua, Unit 104, Minnesota Mansion No. 267 Ermin Garcia Street, Cubao, Quezon City

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the 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.

9. Exh. "B-7" - list of current Apple Store Retail Store locations worldwide;
10. Exh. "B-8" - collection of images illustrating the use of the Opposer's APPLE trademarks, specifically the APPLE Logo in connection with the Apple Retail Stores;
11. Exh. "B-9" - samples of the Opposer's print and outdoor advertising distributed in the Asia Pacific region;
12. Exh. "B-10" - true copy of an article obtained from the PC World magazine website at pcworld.com titled "Apple Tops in Consumer Satisfaction" dated 24 Aug. 2004, and a true copy of an article obtained from the Wired magazine website at wired.com entitled "Apple: It's All About the Brand" dated 4 Dec. 2002;
13. Exh. "B-11" - true copy of an article which appeared on 24 Apr. 2006 in Business Week Magazine entitled "The World's Most Innovative Companies";
14. Exh. "B-12" - copies of Millward Brown Optimor's 2006, 2007, 2008, 2009, 2010 and 2011 rankings;
15. Exh. "B-13" - copies of the brandchannel.com 2008 and 2009 Brandjunkie Survey Results, and the Brandchannel Reader's Choice Awards results for the years 2001 through 2006;
16. Exh. "B-14" - copies of Fortune Magazine's "Most Admired Company" rankings for the years 2008, 2009, 2010 and 2011;
17. Exh. "B-15" - copies of some worldwide decisions that acknowledge the fame and recognition of the APPLE and/or APPLE Logo marks;
18. Exh. "B-16" - true copy of the relevant pages from Apple's 2010 Annual Report as filed with the U.S. Securities and Exchange Commission;
19. Exh. "B-17" - examples of the Opposer's advertisements in the Philippines;
20. Exh. "B-18" - pictures of stores and signages depicting the APPLE Name and Marks as used in the Philippines.
21. Exh. "B-19" - copies of IPO Decision No. 2008-161 dated 3 Sept. 2008 and Res. No. 2009-30 dated 18 May 2009, in "Apple Inc. v. Herbanext Inc.," docketed as IPC No. 14-2007-00193; declaring the APPLE Trade Marks as well-known.
22. Exh. "B-20" - screenshots and computer print-outs taken from the website, www.applewerkz.com.
23. Exh. "C" - original certified true copy of the Phil. TM Reg. No. 040034 for the mark in class 9;
24. Exh. "D" - original certified true copy of the Phil. TM Reg. No. 4-2002-002618 for the mark in classes 9 and 38;
25. Exh. "E" - original certified true copy of Phil. TM Reg. No. 4-2002-004056 for the mark in class 42;
26. Exh. "F" - original certified true copy of the Phil. TM Reg. No. 4-2011-006624 for the mark in class 35; and
27. Exh. "G" - original legalized and notarized Certificate and Power of Attorney showing the authority of Thomas R. La Perle's to verify the notice of opposition and execute the certificate of non-forum shopping and the undersigned's authority to represent Opposer in these proceedings.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 11 November 2011. However, the Respondent-Applicant did not file his Verified Answer.

Should the Respondent-Applicant be allowed to register the mark APPLEWERK & DESIGN?

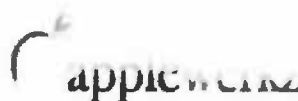
It is emphasized that the essence of trademark registration is to give protection to the owner

of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacture against and sale of an inferior and different article of his products.⁴ In this regard, Sec. 123.1 (d) of the 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 a mark as to be likely to deceive or cause confusion.

While the competing marks, as shown below, are not exactly identical:



Opposer's mark



Respondent-Applicant's mark

the differences, like the presence of the term "applewerkz" in the Respondent-Applicant's mark, are inconsequential and would not avoid a conclusion that the marks convey the same idea or concept to the senses, which is still the "apple" fruit.

Significantly, 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 ingenious 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 other.⁵ Colorable imitation does not mean such similitude as amounts to identity, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.⁶

In this regard, records show that at the time the Respondent-Applicant filed his trademark application on 15 February 2011,

1. the Opposer has several trademark registrations for the mark APPLE and its variations, registration Nos. 040034 (class 9), 4-2002-002618 (classes 9 and 38), and 4-2002-004056(class 42); and
2. this Bureau had already declared the Opposer's APPLE trademarks well-known marks.

But, on whether a mark utilized by one party for the purpose of presentation of goods for retail purposes is confusingly similar to a registered mark belonging to another, it is important to

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

⁵ *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No. 112012, 4 April 2011, 356 SCRA 207, 217.

⁶ *Emerald Garment Manufacturing Corp. v. Court of Appeals*, G.R. No. 100098, 29 Dec. 1995.

determine or establish the goods involved.

In this instance, the Opposer's trademark registration covers a wide range of goods that include personal computing products, mobile communication and media devices, and portable digital music players, as well as a variety of related software, services, peripherals, networking solutions and various third-party hardware and software products. The Respondent-Applicant's trademark application, on the other hand, does not indicate or specify the goods that will be "presented" through the mark APPLEWERKZ & DESIGN for retail purposes.

Hence, without explicit limitation in respect of goods, the Respondent-Applicant, if allowed to register APPLEWERKZ & DESIGN, will be able to use the mark on any goods. If it uses the mark on goods covered by the Opposer's trademark registrations, the likelihood of confusion therefore arises. This Bureau finds merit in the Opposer's assertions:

"Hence, the registration of Respondent's APPLEWERKZ mark in connection with presentation of goods for retail purposes' under Class 35 will confuse consumers into believing that APPLEWERKZ originates from Opposer, or are otherwise sponsored by or associated with Opposer, particularly as Respondent's mark is intended for use in connection with the sale of various accessories for Mac, iPod, iPod Nano, iPhone, and iPad, which are products designed, manufactured by Opposer, and are products distributed and sold by Opposer and its authorized affiliates.

"Opposer is the owner of the well-known APPLE Trademarks, which have long been used and are in continuous use all over the world by Opposer in relation to a wide range of personal computing products, mobile communication and media devices, and portable digital music players, as well as a variety of related software, services, peripherals, networking solutions and various third-party hardware and software products starting in 1977."

The Opposer even submitted screenshots and computer print-outs taken from the website, www.applewerkz.com to show that the Respondent-Applicant will use the mark he applied for registration for products which appear to be computers, mobile phones and accessories. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court.⁷

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

Succinctly, because the Respondent-Applicant will use or uses the mark APPLEWERKZ & DESIGN in selling goods that are similar and/or closely related to those covered by the Opposer's registered trademarks, there is the likelihood that information, assessment, perception or impression, whether good or positive, on the goods sold by the Respondent-Applicant may unfairly be cast upon or attributed to the Opposer. It is very difficult to understand and highly improbable if the circumstance was purely coincidence. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of letters are unavailable, the Respondent-Applicant had come up

⁷ *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al*, G.R. No. L-27906, 08 Jan. 1987.

with a mark identical or so nearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁸

The Respondent-Applicant was given the opportunity to defend his trademark application and explain his side. However, the Respondent-Applicant did not file an Answer to the opposition.

Accordingly, this Bureau finds and concludes that the registration of the mark APPLEWERKZ & DESIGN in favor of the Respondent-Applicant is within the prohibition imposed not only by paragraph (d) of Sec. 123.1 of the IP Code, but also by paragraph (e) thereof which provides that a mark cannot be registered if it:

(e) Is Identical with, or confusingly similar to, or constitutes a translation of 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;”[Underscoring supplied]

WHEREFORE, premises considered, the instant opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2011-001655 be returned, together with a copy of this DECISION, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 12 October 2012.


ATTY. NATHANIEL S. AREVALO
Director W, Bureau of Legal Affairs

⁸ *American Wire and Cable Co. v. Director of Patents, et. al* (SCRA 544) G.R. No. L-26557 18 Feb. 1970.