



IMAX CORPORATION,
Opposer,

-versus-

HENRY YO SO,
Respondent- Applicant.

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} IPC No. 14-2012-00025
}
} Opposition to:
} Appln. Serial No. 4-2009-006991
} Date filed: 15 July 2009
} TM: "I MAXX & DEVICE"
}
}
}
}

NOTICE OF DECISION

SAPALO VELEZ BUNDANG & BULILAN

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11th Floor, Security Bank Centre
6776 Ayala Avenue, Makati City

MR. HENRY YO SO


Respondent-Applicant
267 Tres de Abril Street
Saniculas Proper, Cebu City

GREETINGS:

Please be informed that Decision No. 2013 - 156 dated July 31, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 31 July 2013.

For the Director:


Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



IMAX CORPORATION,
Opposer,

IPC No. 14-2012-00025
Case Filed: 19 March 2012

-versus-

Opposition to:
Appln. Serial No.: 4-2009-006991
Date Filed: 15 July 2009

HENRY YO SO,
Respondent-Applicant.

TM: "I MAXX & DEVICE"

X-----X

Decision No. 2013- 156

DECISION

IMAX CORPORATION ("Opposer")¹ filed an opposition on 19 March 2012 to Trademark Application Serial No. 4-2009-006991. The application, filed by HENRY YO SO ("Respondent-Applicant")², covers the mark "I MAXX & DEVICE" for use on "washing machine, electric blender, speakers, dvd player, amplifier, tv, microphone, electric fan, electric and gas stove, electric airpot and jug, oven toaster" under Classes 7, 9 and 11 of the International Classification of Goods and Services³.

The Opposer alleges, among other things the following:

1. The registration of the mark subject of this opposition is contrary to the provisions of Sections 123.1 (d), (e) and (f) of R.A. No. 8293; and
2. The Opposer is the registered owner of the mark IMAX in the Philippines and in many countries of the world for goods under Classes 9 and 41 of the International Classification of Goods and Services.

The Opposer's evidence consists of the following:

1. Exhibit "A" – Declaration of Ed MacNeil, Senior Vice President of the Opposer containing appendixes 1 up to 7;
2. Exhibit "B" – Copy of Certificate of Reg. No. 4-1997-116726 for the mark IMAX issued on 18 October 2001 for goods under Class 41;
3. Exhibit "C" – Copy of Certificate of Reg. No. 4-1997-116725 issued on 15 January 2002 for the mark IMAX for goods under Class 9; and

¹ A foreign corporation duly organized, existing and in good standing under the laws of Canada, with address at 2525 Speakman Drive, Mississauga, Ontario L5K 1B1.

² With address at 267 Tres De Abril Street, Saniculas Proper, Cebu City, Philippines.

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.

4. Exhibits "D" series – Promotional and advertising materials using IMAX trademark.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant. However, the Respondent-Applicant did not file the required Verified Answer, hence Order No. 2012-1353 dated 16 October 2012 was issued declaring Respondent-Applicant in default and the instant opposition is deemed submitted for Decision based on the opposition and evidence submitted by the Opposer.

Should the Respondent-Applicant's trademark application be allowed?

Jurisprudence says that a practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of the prospective buyer. The trademark complained should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some factors such as sound; color; idea connoted by the mark; the meaning; spelling and pronunciation of the words used; and the setting in which the words appear may be considered for indeed, trademark infringement is a form of unfair competition⁴.

In this regard, Section 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 is nearly resembles such a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed his trademark application on 15 July 2009, the Opposer has already an existing Trademark Registration No. 4-1997-116726 issued on 18 October 2001 for the mark IMAX and Reg. No. 4-1997-116725 issued on 15 January 2002 also for the mark IMAX under Class 9 of the International Classification of Goods and Services.

A scrutiny of the mark applied for registration by the Respondent-Applicant shows that it resembles the Opposer's mark, as shown below:

IMAX

Opposer's Mark

i MAXX

Respondent-Applicant's Mark

The difference in the composition of the marks as only one (1) X in the last letter of the Opposer's and double (XX) in the last two (2) letters of the Respondent-Applicant's mark is insignificant. The changes did little in conferring upon the Respondent-Applicant's mark a

⁴ Clarke v. Manila Candy Co. Phil. 100, Co Tiong S.A. v. Director of Patents, 95 Phil. 1, 4.

character that would make it clearly distinct from the Opposer's. The resemblances in the visual and aural properties render the marks confusing similarity. In fact, the competing marks sound exactly the same. On this regard, it is stressed that 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 purchasers as to cause him to purchase the one supposing it to be the other⁵.

Colorable imitation does not mean such similitude as amount to identity, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in the form, content, 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 genuine article⁶.

The public interest, therefore, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception and even fraud, should be prevented.

It is stressed that the Law 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 other 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.

Considering therefore, that the competing marks are confusingly similar, consumers will likely assume, that the Respondent-Applicant's mark is just a variation of or related to the Opposer's and/or the goods or services originate or provided by one party alone or the parties themselves are connected or associated with one another while in fact there is none. The likelihood of confusion would subsist not only on the purchaser's perception of the goods but on the origins thereof as held by the Supreme Court⁷:

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 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.

⁵ Societe Des Produits Nestle S.A. v. Court of Appeals G.R. No. 112012, 04 April 2001.

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

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

In the instant opposition proceedings, the Respondent-Applicant was given the opportunity to explain his side and defend his trademark application, however, he failed and/or chose not to do so.

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

WHEREFORE, premises considered the instant opposition id hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2009-006991 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 31 July 2013.



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



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