



NIKE INTERNATIONAL, LTD.,

Opposer,

-versus-

POWER TEC FOOTWEAR

INDUSTRIAL SDN BHD.,

Respondent-Applicant.

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IPC No. 14-2011-00468

Opposition to:

Appln. Serial No. 4-2011-006037

Date Filed: 25 May 2011

Trademark: "A (STYLIZED)"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 – 179 dated September 25, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 25, 2012.

For the Director:

Atty. PAUSI U. SAPAK

Hearing Officer

Bureau of Legal Affairs



NIKE INTERNATIONAL, LTD.,
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INDUSTRIES SDN BHD,**
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TM: "A (STYLIZED)"

Decision No. 2012- 179

DECISION

NIKE INTERNATIONAL, LTD. ("Opposer")¹ filed on 20 December 2011 an opposition to Trademark Application Serial No. 4-2011-006037. The application, filed by **POWER TEC FOOTWEAR INDUSTRIES SDN BHD** ("Respondent-Applicant")², covers the mark "**A (Stylized)**" for use on "*rubber, water repelling footwear and waterproof footwear and other goods*" falling under Class 25³.

The Opposer alleges among other things, that the allowance for registration of the Respondent-Applicant's "**A (STYLIZED)**" mark contravenes Sec. 123.1, pars. (d), (e) and (f) of Rep. Act No. 8293, also known as the Intellectual Property Code ("IP Code"). According to the Opposer, "**A (STYLIZED)**" is identical to and so resembles its "Swoosh Design" mark, as when applied to or used in connection with the Respondent-Applicant's sought-to-be-covered goods, will likely deceive or cause confusion. The use by Respondent-Applicant of the mark "**A (STYLIZED)**" on goods that are similar, identical or closely related to the goods that are produced by, originate from, offered by, and/or are under the sponsorship of Opposer/Nike Group of Companies bearing the latter's "Swoosh Design" mark, will greatly mislead the purchasing/consumer public into believing that Respondent-Applicant's goods are produced by, originate from, and/or are under the sponsorship of herein Opposer/Nike Group of Companies.

The Opposer's evidence consists of the following:

1. Exh. "A": original of a duly signed, notarized and legalized Affidavit of Jaime M. Lemons, Opposer's Assistant General Counsel, and the appendices;
2. Exh. "B": true copies of publications known as Brand Finance's 2008 annual report, "Global 500" and 2007 annual report "Global 250" (identical as Appendix "B" of the Affidavit of Opposer's witness Jaime M. Lemons);
3. Exh. "C": list of registrations and applications for the "Swoosh Design" mark;
4. Exh. "D": original of a legalized and certified copy of U.S. Patent and Trademark Office TM Reg. No. 1,990,180 for the "Swoosh Design" mark for Class 25 goods;

¹ A company organized by virtue of the laws of Bermuda, with postal address at One Bowerman Drive, Beaverton, Oregon, 97005-6453, U.S.A.

² A Malaysian company, with given address at Lot 20, Jalan Pendamar 27/90, Seksyen 27, 4000 Shah Alam, Selangor Darul Ehsan, Malaysia.

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.

5. Exh. "E": original of a legalized certified copy of Japan Patent Office TM Reg. No. 2286631 for the "Swoosh Design" mark for Class 25 goods, together with its English translation;
6. Exh. "F": original of a certified copy of OHIM Community TM Reg. No. 000277517 for the "Swoosh Design" mark for Classes 9, 14, 18, 25, 28 goods and Class 42 services;
7. Exh. "G" to "G-6": originals of a certified copy each of Philippine TM registrations for the "Swoosh Design" mark - No. 4-2001-008167 (Class 14), No. 4-2001-008168 (Class 18), No. 055130 (Class 25), No. 4-2001-008170 (Class 28), No. 4-2001-008646 (Class 35), No. 4-2001-008169 (Class 9), and No. 033713 (Class 18);
14. Exh. "H" to "H-8": copies of news items/blog entries featuring Congressman Manny Pacquiao and his endorsement relationship of the NIKE brand; wearing products bearing the "Swoosh Design" mark; and/or providing details of such products especially created, manufactured, produced, promoted, sold/offered for sale, in Pacquiao's name by the Nike Group;
15. Exh. "I": original of a signed and notarized Affidavit of Atty. Maria Trinidad P. Villareal, attesting to her having personally searched and downloaded and printed out from the internet;
16. Exh. "J": true copies of proof of judicial and administrative (Trademark Office) recognitions obtained in countries around the world for the "Swoosh Design" mark as being a mark that is well-known, notorious, famous or the like; and
17. Exh. "K": a chart summarizing the key portions of over 100 cases, certificates, declarations and recognitions acknowledging the well-known, famous, notorious or similar status of the "Swoosh Design" mark throughout the world and on almost every continent.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 24 January 2012. However, the Respondent-Applicant did not file the required Answer. Hence, the instant opposition is considered submitted for Decision based on the opposition and evidence submitted by the Opposer.

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

The Opposer anchors its opposition on Sec. 123.1, pars. (d) to (f) which state that 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.

(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;

(f) 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 in accordance with the preceding paragraph, which registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, that the use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark; Provided further, that the interests of the owner of the registered mark are likely to be damaged by such use.

Records show that at the time Respondent-Applicant filed its trademark application on 25 Mat 2011, the Opposer has existing trademark registrations in the Philippines for the mark "SWOOSH DESIGN MARK", one of which, bearing Reg. No. 55130, having been issued as early as 28 May 1993 for goods under class 25. The Opposer likewise submitted proof regarding its mark's registration and presence worldwide.

But, are the competing marks, as shown below, identical or confusingly similar?



Opposer's Mark



Respondent-Applicant's Mark

Obviously the marks are not identical. This Bureau also finds the marks not confusingly similar. The Respondent-Applicant's mark employs a stylized arch device, which bears resemblance to the Opposer's "swoosh" design. However, the Respondent-Applicant's mark consists of not one arch but two arches, in an interlocking configuration to form a fanciful representation of the letter "A". The utilization of two interlocking stylized arches gives the Respondent-Applicant's mark a visual character that enables the eyes to instantly recognize the fact that it is different from the Opposer's. The glaring contrasts between the competing marks with respect to the configuration and quantity of lines and curves, makes confusion, much less deception, unlikely.

Because the competing marks are not identical or confusingly similar, the registration of the Respondent-Applicant's mark is not proscribed by Sec. 123.1 (d) of the IP Code. This Bureau also deems that it is not necessary to dwell on the issue of whether the Opposer's mark is a well-known mark. Pars. (e) and (f) of Sec. 123.1 of the IP Code apply only if the mark sought to be registered is identical or confusingly similar to the well-known mark.

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 his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against and sale of an inferior and different article of his products⁴. This Bureau finds and concludes that the Respondent-Applicant's mark serves this function.

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114509, 19 Nov. 1999.

WHEREFORE, premises considered, the Opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-006037 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 25 September 2012.



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

