



NOKIA CORPORATION,
Opposer,

-versus-

**SHENZHEN AINOXING
TECHNOLOGY CO. LTD.,**
Respondent-Applicant.

X-----X

IPC No. 14-2011-00299
Opposition to:
Appln. Serial No. 4-2010-012471
Date filed: 18 Nov. 2010
TM: "ANOKING"

NOTICE OF DECISION

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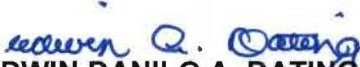
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GREETINGS:

Please be informed that Decision No. 2012 – 204 dated October 16, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 16, 2012.

For the Director:


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



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- versus -

SHENZHEN AINOXING
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IPC No. 14-2011-00299

Opposition to:

Appln. Serial No. 4-2010-012471

(Filing Date: 18 Nov. 2010)

TM: "ANOKING"

Decision No. 20102-204

DECISION

NOKIA CORPORATION ("Opposer")¹ filed on 23 August 2011 an opposition to Trademark Application Serial No. 4-2010-012471. The application, filed by SHENZHEN AINOXING TECHNOLOGY CO. LTD. ("Respondent-applicant")², covers the mark "ANOKING" for use on "notebook computers; portable telephones; cabinets for loud speakers; microphones; personal stereos; ear plugs; electric contact; cameras [photography]; chargers for electric batteries; galvanic cells; under Class 9 of the International Classification of goods."³

The Opposer anchors its opposition on the ground that the mark ANOKING of the Respondent-Applicant is confusingly similar to its registered mark "NOKIA". According to the Opposer, the registration of the mark ANOKING is contrary to the provisions of Sec.123.1, pars. (d) to (f) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). To support its opposition, the Opposer submitted as evidence the following:

1. Verified Notice of Opposition;
2. original affidavit of Bradley Mitchell and Jukka Lonnhalm;
3. table showing the details of Opposer's registrations for the mark NOKIA worldwide;
4. print-out of "Millward Brown Optimor" top 100 most powerful brands for the years 2006, 2007, 2008, 2009 and 2010 rankings;
5. print-out of an article listing NOKIA as the 5th highest performing brand over the last ten years;
6. print-out of "Interband's Ranking from 2002-2007";
7. print-out of the study entitled "Mobile Phones to China";
8. print-out of an article entitled "30 reasons why it's good to be NOKIA";
9. print-out of an article entitled which appeared on 6 Aug. 2007 in Business Week Magazine;
10. print-out of worldwide survey from various sources;
11. list of decisions issued in various jurisdictions worldwide;
12. original notarized and legalized Secretary's Certificate and Special Power of Attorney executed by Bradley Mitchell an Jukka Lonnhalem;

1 A company organized under the laws of Finland, having principal place of business at Keilalahdentie 4, 02150 Espoo, Finland.

2 With address at Room 03, 18/F, Block A, Electronic Technology Building, 2070 Shennan Central Road Futian District Shenzhen City Guangdong Province, China.

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.

13. certified copies of trademark registrations in the Philippines for the mark NOKIA; and
14. certified copies of some of Opposer's trademark registrations in various jurisdictions for the mark NOKIA.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 14 September 2011. The Respondent-Applicant however did not file an Answer.

It is emphasized that the function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure 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 substitution and sale of an inferior and different article as his product⁴.

Records show that at the time the Respondent-Applicant filed its trademark application on 18 November 2010, the Opposer has existing trademark registrations in the Philippines for the mark NOKIA, particularly Nos. 4-1994-95656, 4-1998-005692, 4-2001-001587, 4-2007-006291, and 4-2009-011186, as well as in other jurisdictions. These trademark registrations cover goods that are similar and closely related to the goods indicated in the Respondent-Applicant's trademark application, like mobile telephones; various communication and navigational equipment, devices and systems; computers and computer software; various mechanical, electrical and electronic apparatuses, instruments, devices and gadgets; microphones; cameras; printed matters and materials; games and toys, among other goods.

In this regard, the Opposer anchors its case on Sec. 123.1(d) of the IP Code which provides that a mark shall not 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. It also invokes Sec.123.1, pars. (e) and (f) of the IP Code, to wit:

Sec.123. Registrability. - 123.1 A mark cannot be registered if it:

xxx

(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]

(f) Is identical with, or confusingly similar to, or constitutes a translation of mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines

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

with respect to goods or services which are not similar to those with respect to which registration is applied for. *Provided*, That 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 interest of the owner of the registered mark are likely to be damaged by use."

Corollarily, Rule 102 of the Trademark Regulations sets forth the criteria for determining whether a mark is well-known, to wit:

Rule 102. *Criteria for determining whether a mark is well-known.* In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- 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 of absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark."

This Bureau finds that the Opposer submitted sufficient evidence to show the concurrence of at least a combination of the criteria laid down by the Trademark Regulations. Hence, the Opposer's marks could be considered a well-known mark under Rule 102 of the Trademark Regulations.

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

NOKIA

ANOKING

Opposer's mark

Respondent-Applicant's mark

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 view point of the prospective buyer. The trademark complained should be compared and contrasted with purchaser's memory (not in juxtaposition) of the

trademark said to be infringed. Some factors such as sound; appearance; form; style; shape; size or format; color; idea connoted by the mark; the meaning; spelling and pronunciation of the word used; and the setting in which the word appear may be considered, for indeed, trademark infringement is a form of unfair competition⁵.

The similarity between the marks is the presence of the letters “N”, “O”, “K”, and “I” arranged in that order. The difference, on the other hand, is that in the Respondent-Applicant’s mark, the letter “A” is put before the letter “N” and the letters “N” and “G” are found after the letter “I”. When pronounced, the marks of course sound different, except for the stress on the syllables “noki”.

But, when one glances at the Respondent-Applicant’s mark, it does bear striking resemblance to NOKIA, with the eyes drawn to the syllables “NOKI”. The Opposer is correct in pointing out that,

“A comparison of Opposer’s well-known mark NOKIA and other related NOKIA marks as actually used in commerce and Respondent-Applicant’s mark ANOKING would further highlight the confusing similarity between the contending marks xxx.”⁶

As argued by the Opposer “Respondent-Applicant’s mark ANOKING imitates the distinctive font and style of Opposer’s well-known mark NOKIA and other related NOKIA marks”⁷, as used in advertising and marketing, to wit⁸:



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:⁹

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

⁵ *Clarke v. Manila Candy Co.* 36 Phil. 100; *Co Tiong S.A. v. Dir. of Patents*, 95 Phil. 14.

⁶ Verified Notice of Opposition, par. 3.2, p. 10

⁷ Verified Notice of Opposition, par. 3.1, p. 11.

⁸ Image culled from the Verified Notice of Opposition, p. 11.

⁹ *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

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 ANOKING for 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 with a mark identical or so nearly similar to another's mark, a well-known or famous mark for that matter, if there was no intent to take advantage of the goodwill generated by the other mark.¹⁰

The Respondent-Applicant was given the opportunity to defend its trademark application and explain its side. However, the Respondent-Applicant chose not to.

Accordingly, this Bureau finds and concludes that the registration of the mark ANOKING in favor of the Respondent-Applicant is within the prohibition imposed by pars. (d) and (e) of Sec. 123.1 of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2010-012471 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 16 October 2012.



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

¹⁰ See *American Wire and Cable Co. v. Director of Patents, et. al* (SCRA 544) G.R. No. L-26557 18 Feb. 1970.