



ORANGE BRAND SERVICES LIMITED,
Opposer,

-versus-

ORANGE & BRONZE SOFTWARE LABS INC.,
Respondent – Applicant.

X-----X

}
} IPC No. 14-2010-00222
} Opposition to:
} Appln. Serial No. 4-2009-008787
} Date filed: 02 September 2009
} TM: "ORANGE & BRONZE"
}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 30 dated February 06, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 06, 2014.

For the Director:


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



ORANGE BRAND SERVICES LIMITED,

Opposer,

-versus-

ORANGE & BRONZE SOFTWARE LABS INC.,

Respondent-Applicant.

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IPC No. 14-2010-00222

Opposition to Trademark

Application No. 4-2009-008787

Date Filed: 02 September 2009

Trademark: "**ORANGE & BRONZE**"

Decision No. 2014- 30

DECISION

Orange Brand Services Limited¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2009-008787. The application, filed by Orange & Bronze Software Labs Inc.² ("Respondent-Applicant"), covers the mark "ORANGE & BRONZE" for use on *"software development, expertise in enterprise java as well as agile software development, research, design and specialized consulting, provides initial planning and design for major projects and helped troubled software development projects, training, training in advanced java. Agile software development and enterprise software design. Rfp/brs development. Provides comprehensive business analysis. Develop request for proposal or business requirements specifications"* under Class 09 of the International Classification of Goods³.

The Opposer alleges the following⁴:

"2. Opposer is the assignee of the following trademark registrations having acquired the same from Orange Personal Communications Services Limited on December 8, 2009, to wit:

- (a) Reg. No. 4-1996-107442 ORANGE in Class 9;
- (b) Reg. No. 4-2008-006116 ORANGE in Classes 9, 38 & 42;
- (c) Reg. No. 4-2008-008185 ORANGE CEVICE (in colour) in Classes 41 & 42;
- (d) Appln. No. 4-2009-008631 in Class 37;
- (e) Appln. No. 4-2009-008632 in Classes 9, 37 & 3.

¹ A corporation existing under the laws of United Kingdom with principal office at St. James Court, Great Park Road, Almondsbury Park, Bradley Stoke, Bristol, United Kingdom

² With office address at Penthouse, Carlos J, Valdes Building, 108 Aguirre Street, Legaspi Village, Makati 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.

⁴ As culled from the Opposition.

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3. In previous Oppositions filed by Opposer's predecessor, Orange Personal Communications Services Limited, its ownership of the mark has been previously upheld by this Honorable Office in similar cases (sic), IPC No. 14-2004-00115 Orange Personal Communications Services Limited vs. Shenzhen Xinhongda Electronic Co., Ltd., involving the word 'ORANGE'. In this case, the IP Office ruled that:

'In the instant case, the dominant features of the competing trademarks is the word 'ORANGE' which is the same in *spelling, pronunciation and meaning* as well, and it is that same word or feature that attracts the mind or attention of the ordinary purchasers. The presence of the *device* in both trademarks is of less importance and will not in anyway avoid confusing similarity' (Decision No. 2008-65, p. 7).

'It is further observed that the mark of the Opposer have been registered in several countries of the world including the Philippines. It was first registered on 16 February 1990 in Italy for goods under classes 9 and 15' (Decision No. 2008-65, p. 9).

'The exclusive right of the Opposer to use the trademarks 'ORANGE' and 'ORANGE Device' under its Certificate of Registration No. 4-1996-10799 extends to the following goods or services and those that are related thereto to wit: Electrical and electronic communications, optical, electro-optical, monitoring (other than in-vivo monitoring), radio, television, electrical control, testing (other than in-vivo testing), signalling, checking (supervision), teaching apparatus and instruments; apparatus and instruments for recording, transmission or reproduction of sounds or images; video films, electrical and electronic apparatus and instruments all for processing, logging, storing, transmission, retrieval or reception of data; computers; discs, tapes and wires all being magnetic data carriers; computer programmes; computer software; microprocessors; keyboards' (Decision No. 2008-65. P, 9).

'It is likewise worthy to emphasize that the word 'ORANGE' also forms an integral part of the company name and trading style of the Opposer, as well as other companies in the Orange Group – Orange France, S.A., Orange Romania S.A., Orange Slovenko A.S., Orange Cote (Liechtenstein) AG, Orange Dominica Ltd, Orange Dominicans SA, Orange Cote D'Ivoire Orange Cameroon SA, Orange (Madagascar), Orange (Botswana) Pty.' (Decision No. 2006-65, p.9).

4 .Opposer is the owner of the mark 'ORANGE' and 'ORANGE DEVICE', having used, registered and popularized the same in various countries of the world. In the Philippines, Opposer is the owner of several registrations, for the mark 'ORANGE', which were issued as early as 1998 and 2008 to wit:

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On the other hand, the application, subject of the present opposition, was only filed on September 2, 2009 for the following goods under Class 9: xxx

5. Opposer has applied for and registered its marks 'ORANGE' and 'ORANGE DEVICE' in numerous countries. xxx

6. Opposer has been using its marks 'ORANGE' and 'ORANGE DEVICE (in colour)' for over 15 years now, having first used and adopted the same as early as April 1994.

7. Clearly, Opposer is the rightful owner of the mark ORANGE and ORANGE DEVICE having been used, adopted and registered the same in numerous countries in the world much earlier than Respondent.

8. Through widespread and extensive use by the Opposer in most parts of the world, Opposer's mark has acquired inherent distinction.

9. Opposer has developed goodwill and reputation for its mark 'ORANGE' and 'ORANGE DEVICE' though extensive promotion, worldwide registration and use.

10. Opposer has built, for its mark 'ORANGE' and 'ORANGE DEVICE', superior quality-image and substantial reputation among the public worldwide through its long use of these marks. The Opposer exerts strict controls over the use of its ORANGE and ORANGE DEVICE marks by all persons authorized to use these marks.

11. From the foregoing, it is apparent that Opposer's mark satisfies the criteria set by the Rules and Regulations Implementing RA 8297 to be considered as a well-known mark, entitled to protection under Section 123 (e) and (f) of R.A. 8293.

12. Whether it is in presentation, general appearance or especially in pronunciation, Respondent-Applicant's mark ORANGE & BRONZE and Opposer's 'ORANGE' and 'ORANGE DEVICE' are identical and/or confusingly similar and hence, will cause confusion among their prospective market, considering that the goods are similar or related, belonging to the same class and sold in the same channels.

13. Considering the above circumstances, registration is proscribed by R.A. 8293 Section 123 (d).

14. If allowed contrary to existing laws and jurisprudence, Respondent's use of the mark ORANGE & BRONZE, which is confusingly similar to Opposer's 'ORANGE' and ORANGE DEVICE, will indicate a connection between the latter's goods and services and those of Respondent's, and will likely mislead the buying public into believing that the goods of Respondent's are produced or originated from, or under the sponsorship of Opposer, to the detriment and damage of Opposer's interests, considering the range and services for which Opposer's mark is being used, which includes Class 9, the goods of interest of Respondent.

Likewise, the use of Respondent of the mark ORANGE & BRONZE will diminish or demean the superior quality image and reputation of Opposer's products and services

characterized by high standards which Opposer has carefully built through its long use and strict control that Opposer exerts over the use of its trademarks.

15. Opposer hereby alleges that Respondent-Applicant's adoption of ORANG & BRONZE trademark which is similar to that of Opposer's 'ORANGE' and "ORANGE DEVICE" was clearly done with illegal intent of riding on the popularity and goodwill of Opposer's quality-built reputation and will cause great and irreparable damage and injury to the Opposer.

16. Further, Respondent-Applicant is clearly in bad faith in so using and adopting the subject trademark because Opposer has, because of its prior use and registration, gained worldwide notoriety for its marks 'ORANGE' and ORANGE DEVICE."

In support of its allegations in the Opposition, the Opposer submitted the following as evidence:

1. copies of the recordal assignments⁵;
2. list of Opposer's trademark registrations worldwide;
3. labels of Opposer's marks; and,
4. affidavit-testimony of Rachel Deborah Ann Marks.

For its part, Respondent-Applicant counters the above allegations as follows:⁶

"4.1. In 2005, Respondent-Applicant's President and Chief Executive Officer, Mr. Calen Martin D. Legaspi, and Chief Technical Officer, Mr. Renato Landingin, together with Ms. Lyra Alvarez, founded the company 'Orange & Bronze Consulting, Inc.'

4.2. It was Ms. Alvarez who conceptualized the company name 'Orange & Bronze' when she was eating an *orange* in front of a *bronze* relief sculpture at the East Wing of the Philippine Stock Exchange Building.

4.3. In 2006, Orange & Bronze Consulting, Inc. ceased operations, following the departure of Ms. Alvarez from the company. Mr. Legaspi and Mr. Landingin, on the other hand, established 'Orangae & Bronze Software Labs, Ltd. Co.'

4.4. In 2009, Orange & Bronze Software Labs, Ltd. Co. was incorporated. Accordingly, the company name was changed to Respondent-Applicant's present name 'Orange & Bronze Software Labs, Inc.'

⁵ Annexed as Exhibits "RDAM1" to "RDAM5".

⁶ See Verified Answer, pp. 7-10.

4.5. Respondent-Applicant is a corporation organized under the laws of the Philippines and is engaged mainly in software development outsourcing, research, design and specialized consulting, and business requirements specification.

4.6. As a software development outsourcing company, Respondent-Applicant's technology specializations include Java, Groovy, Spring, and Hibernate. Respondent-Applicant also uses Python, Django, Google App Engine, and the Facebook API. Respondent-Applicant is also the Philippine pioneer of Agile software development methodologies.

4.7. Respondent-Applicant's client portfolio includes large companies, both foreign and local, such as PNB Life Insurance, Inc., ABS-CBN, Globe Telecoms, Smart Communications, IBM, HP Invent, Norvax, Misys, Cambridge University Press, and Indra Company.

4.8. Respondent-Applicant maintain a website, www.orangeandbronze.com.

4.9. On 02 September 2009, Respondent-Applicant filed with this Honorable Office an application for the registration of the mark 'ORANGE & BRONZE', covering goods under Class 09, specifically, xxx. The application was assigned Application No. 4-2009-008787.

4.10. As a result of the foregoing, Respondent-Applicant has gained goodwill over the mark 'ORANGE & BRONZE'. The claim that Respondent-Applicant is not entitled to the registration of the said mark is therefore without basis. On the contrary, Respondent-Applicant continues to invest considerable amount of resource, energy, and creativity to market its services under the brand 'ORANGE & BRONZE.'

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5.1. Respondent-Applicant's mark 'ORANGE & BRONZE' is not confusingly similar to Opposer's marks 'ORANGE' and 'ORANGE DEVICE'

5.2. Respondent-Applicant's registration of the mark 'ORANGE & BRONZE' will not prejudice the interests of Opposer over its marks 'ORANGE' and 'ORANGE DEVICE'.

5.3. Respondent-Applicant's use and adoption of the mark 'ORANGE & BRONZE' is not in bad faith and is not intended to ride on the goodwill of Opposer's business."

The Respondent-Applicant's evidence consists of the following:

1. affidavit of Mr. Calen Martin D. Legaspi and Mr. Renato R. Landingin⁷;
2. copy of Respondent-Applicant's brochure⁸; and,
3. copy of Respondent-Applicant's handout⁹.

The Preliminary Conference was terminated on 15 December 2011 and the parties were directed to file their respective position papers. After which, the case was submitted for decision.

The issue to be resolved is whether or not the mark "ORANGE & BRONZE" should be registered in favour of Respondent-Applicant.

Section 123.1 (d) of RA 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that:

"123.1. 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;

xxx."

Records and evidence show that the Opposer was granted certificates of registration Nos. 4-1996-107442, 4-2008-006116 and 4-2008-008185 issued on 30 October 2004, 22 December 2008 and 09 March 2009, respectively. The Opposer has pending Trademark Application Serial Nos. 4-2009-008631 and 4-2009-008632 both applied on 27 August 2009. On the other hand, the Respondent-Applicant filed the contested application only on 02 September 2009.

The competing marks are depicted below for comparison:

⁷ Marked as Exhibit "1".

⁸ Marked as Exhibit "2".

⁹ Marked as Exhibit "3".



ORANGE

Opposer's marks

ORANGE & BRONZE

Respondent-Applicant's mark

The Respondent-Applicant's mark is a composite mark consisting mainly of the words "orange" and "bronze". The word "orange", however, is the Opposer's registered mark. Succinctly, since the Respondent-Applicant will use or uses the mark "ORANGE & BRONZE" to goods that are similar and/or closely related to that of Opposer's registered marks, i.e. Class 09, the addition of the words "& BRONZE" will not diminish the likelihood of the occurrence of confusion, mistake and/or deception.

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 purchased as to cause him to purchase the one supposing it to be the other.¹⁰ The Supreme Court in **Del Monte Corporation vs. Court of Appeals**¹¹ held:

"The question is not whether the two articles are distinguishable by their label when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in

¹⁰ Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

¹¹ G.R. No. L-78325, 25 January 1990.

trade and giving the attention such purchasers usually give in buying that class of goods is the touchstone."


It is highly probable that the purchasers will be led to believe that Respondent-Applicant's mark is a mere variation of Opposer's mark and that its goods are associated with the latter. Withal, the protection of trademarks as intellectual property is intended not only to preserve the goodwill and reputation of the business established on the goods bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods.¹²

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of 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 substitution and sale of an inferior and different article as his product.¹³ Respondent-Applicant's mark fell short in meeting this function.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2009-008787 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 06 February 2014.


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

¹² Skechers, USA, Inc. vs. Inter Pacific Industrial Trading Corp., G.R. No. 164321, 23 March 2011.

¹³ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.