



AMAZON TECHNOLOGIES, INC.,

Opposer,

-versus-

STHENOS VENTURES, INC.,

Respondent-Applicant.

IPC No. 14-2012-00592

Opposition to Trademark

Application No. 4-2012-006487

Date Filed: 31 May 2012

Trademark: "**KIND LED**"

X ----- X

Decision No. 2014- 203

DECISION

Amazon Technologies, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-00592. The contested application, filed by Sthenos Ventures, Inc.² ("Respondent-Applicant"), covers the mark "KIND LED" for use on "*electric apparatus and instruments/apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity/light-emitting diodes (LED)*" under Class 09 of the International Classification of Goods³.

The Opposer is the owner of the trademark "KINDLE" and other KINDLE-formative marks ("KINDLE" marks), which it has registered and/or applied for with the Intellectual Property Office of the Philippines (IPOP), consisting of the following:

1. Certificate of Registration No. 4-2009-010211 registered on 08 October 2009 for the mark "KINDLE";
2. Certificate of Registration No. 4-2010-010449 registered on 20 January 2011 for the mark "KINDLE";
3. Trademark Application Serial No. 4-2011-014001 filed on 22 November 2011 for the mark "KINDLE FIRE";
4. Trademark Application Serial No. 4-2012-010987 filed on 07 September 2012 for the mark "KINDLE POWERFAST"; and
5. Trademark Application Serial No. 4-2012-010986 filed on 07 September 2012 for the mark "KINDLE FREETIME".

It also maintains that it owns trademark registrations in other countries as well as domain names that incorporate the "KINDLE" marks such as www.kindle.com. Likewise, it avers that "KINDLE" products are available for sale

¹ A corporation organized under the laws of the State of Nevada, USA, with business address at 8329 West Sunset Road, Suite 220, Las Vegas, Nevada, 89113, USA and PO Box 8102, Reno, Nevada 89507, USA.

² With address at #13 Hercules St., Tivoli Greens Subdivision, Matandang Balara, Quezon 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.

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and delivery to Philippine customers through purchases transacted at the online store at www.amazon.com. It moreover claims that it has extensively promoted its products in various media, including television commercials, outdoor and online advertisements, internationally well-known print publications, and other promotional events.

The Opposer contends that Respondent-Applicant's mark "KIND LED" and its own "KINDLE" trademarks are almost identical, if not for the additional letter "d" in the former, and thus, the registration thereof will run counter Section 123.1 (d), (e) and (f) of RA No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"). It furthers that as the competing marks both involve goods under Class 09, consumers will be led to believe that the marks bearing "KIND LED" originates or are otherwise sponsored or associated with the Opposer. It also recalls Respondent-Applicant's previous attempt to register the mark for Class 11 as "KINDLED", without a space, which application was refused.

In support of its allegations, the Opposer submitted the original notarized and legalized affidavits of Ms. Dana Northcott, with annexes, and Mr. Jaime S. dela Cruz.⁴

For its part, the Respondent-Applicant denies that its applied mark and the Opposer's "KINDLE" marks are confusingly similar. It asserts that "KIND LED" uses Hasteristico font, size 72 and in green color. Also, it insist that although the marks have the same letters except for the additional letter "d", the competing marks produce different sound effects in view of the space between the words "kind" and "led" in its applied mark. It likewise claims that the labels and packaging of its goods are entirely different from that of the Opposer's. Lastly, it refutes the Opposer's claim that their goods are similar or closely related explaining that "KIND LED" is used or to be used on light bulbs, down light, led par lights, led tubes, flood lights, strip lights and high bay lights while Opposer's "KINDLE" marks are applied on electronic/digital devices that allow people to read books, newspaper and other documents, widely known as e-reader or tablet.

The evidences submitted by Respondent-Applicant consist of a print-out of its mark "KIND LED" and sample of its labels and packaging.⁵

The Hearing Officer conducted and terminated the preliminary conference on 23 January 2014 wherein the parties were directed to submit their respective position papers within ten (10) days from the said date. After which, the case is deemed submitted for resolution.

⁴ Marked as Exhibits "B" and "C", inclusive.

⁵ Marked as exhibits "1" and "2".

The issue to be resolved in this case is whether the trademark application by Respondent-Applicant for the mark "KIND LED" should be allowed.

Section 123.1 (d)) of the 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 show that as early as 08 October 2009, the Opposer successfully registered its mark "KINDLE" with this Office. On the other hand, Respondent-Applicant only applied for registration of its mark "KIND LED" on 31 May 2012.

Now, to determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the two are shown below for comparison:

Opposer's Marks:

KINDLE POWERFAST KINDLE FREETIME

KINDLE KINDLE FIRE

Respondent-Applicant's Mark:

kind led

The determinative factor in a contest involving registration of trade mark is not whether the challenged mark would *actually* cause confusion or deception of the purchasers but whether the use of such mark would *likely* cause confusion or mistake on the part of the buying public.⁶

⁶ American Wire & Cable Company vs. Director of Patents, G.R. No. L-26557, 18 February 1970.

From the above illustration, it can be observed that the compositions of the two marks are essentially the same. What the Respondent-Applicant has done was only to put a space between the letters "D" and "L", and added the letter "D" after the letter "e". In this regard, the word "kindle" in the dictionary is a verb which means "to start a fire burning". Thus, the additional letter "D" in Respondent-Applicant's mark gives rise to an impression that "KIND LED" is simply the past tense of the word "KINDLE". Noteworthy, the Respondent-Applicant's previous application for the mark "KINDLED" under Trademark Application Serial No. 4-2012-000181, which was earlier refused by the Bureau of Trademarks, only shows its intention to register a mark that is confusingly similar to "KINDLE".

Succinctly, 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.⁷ As the Supreme Court held in the case of **Del Monte Corporation vs. Court of Appeals**⁸:

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

Moreover, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."⁹ In **Mighty Corporation vs. E. & J. Gallo Winery**¹⁰, the Supreme Court held:

⁷ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁸ G.R. No. L-78325, 25 January 1990.

⁹ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

"In resolving whether goods are related, several factors come into play:

- (a) the business (and its location) to which the goods belong***
- (b) the class of product to which the goods belong***
- (c) the product's quality, quantity, or size, including the nature of the package, wrapper or container***
- (d) the nature and cost of the articles***
- (e) the descriptive properties, physical attributes or essential characteristics with reference to their form, composition, texture or quality***
- (f) the purpose of the goods***
- (g) whether the article is bought for immediate consumption, that is, day-to-day household items***
- (h) the fields of manufacture***
- (i) the conditions under which the article is usually purchased and***
- (j) the channels of trade through which the goods flow, how they are distributed, marketed, displayed and sold."***

In this instance, the goods indicated in Respondent-Applicant's trademark application are, like those covered by the Opposer's marks, electrical or electronic devices. There is the likelihood that the purchasers of one be confused, misled, deceived, or at the very least be reminded of the other in view of the close resemblance of the competing marks and of the Opposer's extensive advertising and sale of its product through the internet. Of course, as in all other cases of colorable imitations, the unanswered riddle is why, of the millions of terms and combinations of letters and designs available, the appellee had to choose those so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark.¹¹

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.¹² Based on the above discussion, Respondent-Applicant's trademark fell short in meeting this function. The latter was given ample opportunity to defend its trademark application but Respondent-Applicant did not bother to do so.

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

¹⁰ G.R. No. 154342, 14 July 2004.

¹¹ America Wire & Cable Co. vs. Director of Patents, G.R. No. L-26557, 18 February 1970.

¹² Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-006487 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 08 August 2014.


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