



**SALOMON S.A.S. (formerly known as
SALOMON S.A.),**

Opposer,

-versus-

CP OPTICS, INC.,

Respondent-Applicant.

X-----X

IPC No. 14-2011-00002

Opposition to:

Appln No. 4-2009-002787

Date filed: 18 March 2007

**TM: "SALOMON EYEWEAR
AND DEVICE"**

NOTICE OF DECISION

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For the Respondent-Applicant

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GREETINGS:

Please be informed that Decision No. 2014 - 238 dated October 02, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 02, 2014.

For the Director:

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



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CP OPTICS, INC.,
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IPC No. 14-2011-00002

Opposition to:

Appln. Serial No. 4-2009-002787

Date Filed : 18 March 2007

Trademark : **“SALOMON
EYEWEAR AND DEVICE”**

Decision No. 2014 - 238

DECISION

SALOMON S.A.S. (formerly known as Salomon S.A.),¹ filed an opposition to Trademark Application Serial No. 4-2009-002787. The application, filed by CP OPTICS, INC., (“Respondent-Applicant”)², covers the mark “SALOMON EYEWEAR AND DEVICE” for use on “rubber sandals, beach apparels namely, shorts and tank tops” under class 25 of the International Classification of Goods and Services³.

The Opposer alleges among other things the following:

“I. The mark ‘SALOMON EYEWEAR AND DEVICE’ cannot be registered because Opposer has the exclusive right to use the mark ‘SALOMON’ in connection with related goods covered by its certificate of registration for the mark ‘SALOMON’.

“II. The mark, ‘SALOMON EYEWEAR AND DEVICE’ cannot be registered because it is in violation of Section 123.1 (d) of the IP Code.

- A. Respondent-Applicant’s ‘SALOMON EYEWEAR AND DEVICE’ mark is identical with Opposer’s registered mark ‘SALOMON’ and is likely to cause confusion on the public as to the source of goods.
- B. Respondent-Applicant’s ‘SALOMON EYEWEAR AND DEVICE’ mark has a later filing date than Opposer’s mark ‘SALOMON’.
- C. Respondent-Applicant’s ‘SALOMON EYEWEAR AND DEVICE’ mark covers goods that are closely related to Opposer’s registered ‘SALOMON’.

“III. The mark, ‘SALOMON EYEWEAR AND DEVICE’ cannot be registered because it is in violation of Section 147.1 of the IP Code.

“IV. The registration of the mark ‘SALOMON EYEWEAR AND DEVICE’ will gravely erode the distinctiveness of Opposer’s mark ‘SALOMON’ and dilute Opposer’s goodwill over the same.

¹ A foreign corporation duly organized and existing under the laws of France, with address at Les Croiselets, 74370 METZ-TESSY, France.

² With address at No. 963 JP Rizal, Poblacion, Makati City.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a Multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

“V. The registration of the mark ‘SALOMON EYEWEAR AND DEVICE’ will unduly limit the normal potential expansion of Opposer’s business.

“VI. Opposer has in its name several applications and registrations for the mark ‘SALOMON’ in various countries in the world.

The Opposer submitted the following evidence marked as Exhibits “A” to “K” inclusive of submarkings:

1. Officer’s Certificate;
2. Recordal of Change of Name and Address of Registrant;
3. Trademark Electronic Gazette for the trademark SALOMON EYEWEAR;
4. Certificate of Registration No. 4-2002-004626 for the trademark SALOMON;
5. Declaration of Actual Use for the 3rd Year Anniversary;
6. Declaration of Actual Use for the 5th Year Anniversary;
7. Proof of Actual Use filed by Opposer’s counsel;
8. Response to Official Action No. 02 (Paper No. 2);
9. Trademark Application Form for the trademark SALOMON EYEWEAR;
10. Downloaded article entitled, “About Salomon”;
11. Pictures of SALOMON EYEWEAR’s products;
12. Trademarks List per countries of the trademark SALOMON; and,
13. Certification issued by Jean-Marc PAMBET, President of SALOMON SAS.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 07 February 2011 and on 08 March 2011, addressed to Angel O. Olandres Jr. and CP Optics, Inc., respectively. However, this Bureau did not receive any answer from either addressees. Thus, Respondent-Applicant was declared in default and the case is deemed submitted for decision.⁴

Should the Respondents-Applicants be allowed to register the trademark “**SALOMON EYEWEAR AND DEVICE**”?

The Opposer anchored its opposition on Section 123.1(d) of Republic Act No. 8293, otherwise known as The Intellectual Property Code of the Philippines, which provides that:

A mark cannot be registered if it:

x x x

(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;

As culled from the records and the evidence presented by the parties, at the time the Respondent-Applicant filed its trademark application on 18 March 2009⁵, the Opposer has shown prior use and

⁴ Order No. 2012-968, 12 July 2012.

⁵ File wrapper records.

ownership of the trademark "SALOMON". Opposer is the holder of Registration No. 4-2002-004626 dated 07 February 2004 for the trademark "SALOMON" covering products consisting of clothing, namely sport clothing, ski wear, rain suits and jackets, waterproof overalls, socks, mittens, gloves, bandannas, caps, visors, headbands, belts, parkas, shirts, blouses, short sleeve shirts, short sleeve blouses, polo shirts, tee-shirts, shorts, skirts, Bermudas, swimming suits; footwear, namely sport shoes and boots, leisure shoes, hiking shoes, sneakers, mountain climbing shoes, tennis shoes, sandals, ski and snowboard boots⁶. Opposer has likewise shown prior use of its trademark "SALOMON", including use in Philippine commerce in 14 October 1999.⁷ In fact, Opposer has sports apparel for mountain sports carrying the brand or mark "SALOMON".⁸

In this regard, the competing marks are reproduced below for purposes of comparison, to wit:

SALOMON

Opposers' Trademark

SALOMON 
eyewear

Respondent-Applicant's Trademark

The contending marks are identical in the word marks "SALOMON". The wordmark "eyewear" was disclaimed. It appears that the only distinguishing component in Respondent-Applicant's mark is the device consisting of a rotating blade, however the Opposer has shown prior use of the same since the year 1999.⁹ Thus, except for the difference in the font, the contending marks are almost identical and remarkably confusing in visual and aural properties. On the goods covered, Respondent-Applicant's mark is used on goods that are closely related to the Opposers' goods. Respondent-Applicant's eyewear is a natural extension of clothing apparels and other body accessories. These goods appear closely related to each other because they flow on the same channels of trade.

The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court¹⁰, to wit:

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. Hence, 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.

The public interest, therefore, requires that the 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 emphasized that the function of trademark is to point out distinctly the origin or ownership of the goods to

⁶ Exhibit "D" of Opposer.

⁷ Exhibits "E" and "E-2" of Opposer.

⁸ Exhibits "H" and "I" of Opposer.

⁹ Exhibit "E" of Opposer.

¹⁰ Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.

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.¹¹

Thus, this Bureau finds the likelihood to mislead the public, particularly as to the nature, quality and characteristics or geographical origin of the goods or services;¹² and the likelihood of confusion, or even deception to occur. The competing marks need not be identical or similar in all details. 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 purchaser as to cause him to purchase the one supposing it to be the other.¹³

The field from which a person may select a trademark is practically unlimited. As in all cases of colourable imitation, the unanswered riddle is why, of the millions of terms and combination of letters and designs available, the Respondent-Applicant had come up with a mark identical or so clearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.¹⁴

WHEREFORE, the instant Opposition is hereby **SUSTAINED** on the grounds stated above. Let the file wrapper of Trademark Application No. 4-2009-002787 be returned together with a copy of this Decision to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 02 October 2014.


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

¹¹ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

¹² Section 123(g), IP Code.

¹³ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 4 April 2001, 356 SCRA 207, 217.

¹⁴ American Wire and Cable Co. v. Director of Patents et. al. (SCRA 544), G.R. No. L-26557, 18 Feb. 1970.