



**GLOBE INTERNATIONAL
NOMINEES PTY LTD.,**

Opposer,

-versus-

GLOBE TELECOM, INC.,
Respondent-Applicant.

X-----X

IPC No. 14-2010-00328

Opposition to:

Appln No. 4-2009-011963

Date filed: 23 November 2009

TM: "GLOBE"

NOTICE OF DECISION

FEDERIS & ASSOCIATES LAW OFFICES

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ATTY. IRENE F. SONGCO

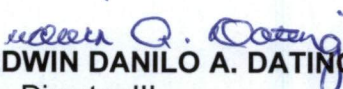
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5 /F, Globe Telecom Plaza 1
Pioneer corner Madison Streets
Mandaluyong City

GREETINGS:

Please be informed that Decision No. 2014 - 312 dated December 02, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 02, 2014.

For the Director:


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



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- versus -

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IPC No. 14-2010-00328

Opposition to:

Appln. No. 4-2009-011963
Date Filed: 23 November 2009
Trademark : "GLOBE"

Decision No. 2014-312

DECISION

GLOBE INTERNATIONAL NOMINEES PTY. LTD. ("Opposer")¹ filed a verified opposition to Trademark Application Serial No. 4-2009-011963. The application, filed by GLOBE TELECOM, INC. ("Respondent-Applicant")², covers the mark "GLOBE" for use of goods under class 25³ namely: t-shirts, jackets, vest, caps.

The Opposer alleges the following:

"GROUNDS:

"a. The trademark 'GLOBE' is identical and therefore confusingly similar to Opposer's already registered 'GLOBE' trademark which has registration and filing dates earlier than that of the subject application, and to Opposer's other 'GLOBE' trademarks subject matter of applications filed earlier than the subject application, and to Opposer's other 'GLOBE' trademarks subject matter of applications filed earlier than the subject application; hence, the subject application must be rejected under Secs. 147.1, 147.2, and Section 123.1 (d) of the IP Code.

"b. Opposer has already identified its goods and services in the mind of the public through its goods bearing the 'GLOBE' trademarks and hence, it is entitled to protection under Section 168.1 of the IP Code.

"c. The use of 'GLOBE' by the Respondent-Applicant on the goods described in the subject application will inevitably indicate an association by the public with the goods of Opposer under the same trademarks and thus, its registration is proscribed under 147.2 of IP Code.

"d. The subject application is filed in bad faith, and the inference, as held in McDonald's Corp. vs. MacJoy Fastfood Corp. and Converse Rubber Corporation vs. Universal Rubber Products Inc. is that 'GLOBE' was chosen deliberately by Respondent-Applicant to deceive the public, and, as held in Shangri-la International Hotel Management, Ltd. vs. Developers Group of Companies, Inc., to take advantage of the goodwill of Opposer's 'GLOBE' trademark.

¹ A foreign corporation duly organized and existing under the laws of Australia with principal office address at 1 Fennell Street, Port Melbourne VIC 3207, Australia.

² With office address at 5th Floor, Globe Telecom Plaza, Tower 1, Pioneer corner Madison Streets, Mandaluyong 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.

"FACTS

"6. Opposer is the owner of, and holder of a certificate of Philippine trademark registration for the trademark 'GLOBE', with date of issue and/or filing date which is much earlier than the filing date of the subject application of November 23, 2009.

Trademark	:	GLOBE
Registration No.	:	42005004827
Date Filed	:	05/25/2005
Date Issued	:	04/30/2007
Registrant	:	GLOBE INTERNATIONAL NOMINEES PTY LTD
Classes	:	18 & 25
Goods	:	<u>Class 18</u> : Bags, namely, back packs, garment bags, wallets and travel bags. <u>Class 25</u> : Men's and women's clothing namely, tee shirts, shirts, sweat shirts, pants, sweat pants, shorts, swim suits, jackets, sneakers, socks, skirts, dresses, blouses, hats and footwear namely, men's and women's sandals and sneakers.

"7. The Opposer's parent company, Globe International Limited (GIL), was launched in 1984. GIL is an Australian publicly listed company which uses the GLOBE trademarks of the Opposer. The Opposer was set by GIL as a dedicated brand owning company. The GLOBE branded products of the Opposer and its licensees are sold throughout the world including extensive sales and brand promotion in Australia, the USA and Europe. GLOBE is one of the most recognised footwear and apparel brands especially in the urban/street fashion markets with a reputation extending into board sports and other entertainment services related to skateboarding, surfing and snowboarding.

"8. GIL's head office is in Melbourne, Australia with regional headquarters in Los Angeles in the USA, and Hossegor on the south-west coast of France.

"9. GIL has been using GLOBE as a trade mark continuously and extensively since 1995. GIL and other licensees of the Opposer have heavily promoted the GLOBE brand through advertising, sponsorship and an active website, and substantial sales of goods bearing the Opposer's GLOBE trade mark have been achieved.

"10. Sales of the Opposer's GLOBE branded products into the Philippines commenced in September 2001.

"11. Opposer enjoys a substantial exclusive use and registration for the trademark 'GLOBE' in many parts of the world which status is achieved by the efforts of Opposer at zealously watching, protecting, and defending their trademark rights in many countries. Opposer has secured trademark registrations in many of these countries.

"12. More information about Opposer and its GLOBE products can be found at the following websites:

- www.globecorporate.com
- www.globe.tv
- www.globeshoes.com
- www.globeskate.tv
- www.slobesurf.tv

- <http://ww.unitedbyfate.tv/>
- "13. Products bearing the mark 'GLOBE' mark are being sold in the Philippines
- "14. The distributors of GLOBE products in the Philippines include the following:
- a. Pacific Sports Network Inc.
Commercial Unit 11 Valencia Hi
Valencia Cor. N. Domingo Street, Quezon City
 - b. Pro Star Marketing
Unit 3601, Summit One Tower
530 Shaw Blvd
Mandaluyong City
 - c. Aloha Boardsports
AFP-RSBS Industrial Park
KM-12 East Service Road
Western Bicutan
Taguig City, Metro Manila

The Opposer's evidence consists of the following:

1. Exhibit "A" - Affidavit of Amando S. Aumento Jr., associate of Federis & Associates Law Offices;
2. Exhibit "B" - Special Power of Attorney in favor of Federis & Associates;
3. Exhibit "C" - Certified true copy of Philippine Trademark Reg. No. 4-2005-004827 for the mark "GLOBE"; and,
4. Exhibit "D" - Certified true copy of Declaration of Actual Use in relation to "GLOBE" registration.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 18 February 2011. Respondent-Applicant however, did not file an answer. Thus, this case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark GLOBE?

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 out into the market a superior 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.⁴

The instant case is anchored on the ground that the trademark application is contrary to the provision of Sec. 123.1 (d) R.A. No. 8293, otherwise known as the Intellectual Property Code ("IP Code"):

A mark cannot be registered if it:

x x x

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

(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;

The contending marks are identical, both carrying the trademark GLOBE, without substantial difference in their font and/or the manner of display. Moreover, the Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's, particularly that both cover and/or include Class 25 goods. While the Respondent-Applicant also owns the registered mark GLOBE, it uses it for different goods or services. This Bureau has observed that the mark GLOBE which the Respondent-Applicant seeks to register is exclusively comprised of the word GLOBE, without any device or other feature that would distinguish it from the Opposer's mark GLOBE. Without such distinguishing feature, it is very difficult for consumers to find out that T-shirts, jackets, vests, caps, etc., with the mark GLOBE, belongs to the Respondent-Applicant and not to the Opposer, and vice-versa. It is likely that the consumers will have the impression that these goods or products originate from a single source or origin. 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 Court, to wit:⁵

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 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.⁶

Records show that at the time Respondent-Applicant filed its application for the trademark "GLOBE" on 23 November 2009, herein Opposer already has existing registration for the trademark "GLOBE" issued on 30 April 2007.⁷ Thus, Respondent-Applicant's mark should not be allowed registration because it resembles Opposer's mark as to be likely to deceive or cause confusion.⁸

In contrast, the Respondent-Applicant despite the opportunity given, failed to explain how it arrived at using the mark "GLOBE" as it failed to file a Verified Answer. The Opposer's mark "GLOBE" is unique and highly distinctive with respect to the goods it is attached with.

⁵ Converse Rubber Corporation v. Universal Rubber Products Inc., et al., G.R. No. L-27906, 08 Jan. 1987.

⁶ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

⁷ Exhibit "C" of Opposer.

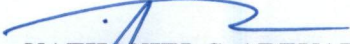
⁸ Sec. 123.1 (d), IP Code.

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2009-011963 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 02 December 2014.


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