



PIRELLI TYRE S.P.A.,
Opposer,

-versus-

SPEED LAND CORPORATION,
Respondent-Applicant.

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IPC No. 14-2011-00264
Opposition to:
Appln Serial No. 4-2010-010301
Date Filed: 20 September 2010
TM: "SCORPION LOGO
AND DEVICE"

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NOTICE OF DECISION

The Law Firm of CONTACTO NIEVALES & ASSOCIATES
Counsel for the Opposer
11th Floor Marc 2000 Tower
1973 Taft Ave., Malate, Manila

MANUEL LAW OFFICE
Counsel for Respondent-Applicant
Suite 2603-D, 26th Floor
Philippine Stock Exchange Centre (East Tower)
Exchange Road, Ortigas Center
Pasig City

GREETINGS:

Please be informed that Decision No. 2015 - 70 dated May 05, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 05, 2015.

For the Director:


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



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- versus-

SPEED LAND CORPORATION,
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IPC No. 14-2011-00264
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(Filing Date: 20 September 2010)

TM: "SCORPION LOGO AND DEVICE"

Decision No. 2015 - 70

DECISION

PIRELLI TYRE S.P.A. ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2010-010301. The application, filed by SPEED LAND CORPORATION ("Respondent-Applicant")², covers the mark "SCORPION LOGO & DEVICE" for use on "*electric locks, anti-theft warning apparatus, anti-theft alarm for vehicles, anti-theft device for vehicles, reversing alarm for vehicles*" under classes 9 and 12 of the International Classification of Goods and Services³.

The Opposer alleges among other things, that it was the first to apply for the registration of the marks "SCORPION" (word) and "SCORPION DEVICE" covering goods belonging to class 12 ("*tyres, pneumatic, semi-pneumatic and solid tyres for vehicles wheels, wheels for vehicles, rims*"). The applications filed on 03 December 2009 bear serial numbers 4-2009-012366 and 4-2009-012367. According to the Opposer, its applications were rejected because of the prior application for the mark "SCORPION & DEVICE" covering goods belonging to classes 7, 9, 11 & 12. The earlier application (Serial No. 4-2009-000206) filed by Chao Ming Ling matured into registration (Reg. No. 4-2009-000206). The Opposer argues that there was a "double-standard" in allowing the Respondent-Applicant's trademark application, to the damage and prejudice of herein Opposer. It points out that because the Respondent-Applicant's trademark application was allowed notwithstanding Chao Ming Lin's existing trademark registration, it did not fulfill the conditions referred to in Subsection 133.1 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code").

In support of its opposition, the Opposer submitted in evidence the following:

1. Exhibits "A" and "B" – two "Registrability Reports" for the two SCORPION trademark applications of the Opposer denominated as paper no. 2;

¹ An Italian Joint Stock company, organized, existing under the laws of Italy, with address at Viale Sarca 222-2026 Milan, Italy.

² With address at 8462 Mayapis St., San Antonio Village, Makati City Philippines 1203.

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.

2. Exhibits "C" and "D" – the corresponding responses to the Registrability Reports were submitted on 23 July 2010 wherein the Opposer traversed the objection;
3. Exhibits "E" and "F" – another office action undertaken by the Examiner denominated paper no. 4 mailed on 27 August 2010; and
4. Exhibits "G" and "H" – Notices of Abandonment for the two applications of the Opposer denominated as paper no. 7.

The Respondent-Applicant filed on 17 January 2012 its Answer, wherein it denies all the material allegations in opposition and argues that its mark is not deceptive or confusingly similar to previously registered marks. The Respondent-Applicant's evidence consists of a copy of the Secretary's Certificate authorizing Jeremy Lester Go to file the Verified Answer, response to the Registrability Report dated 05 January 2011 regarding Trademark Application Serial No. 4-2010-010301 duly signed by Jeremy Lester Go, Notice of Allowance, and Acknowledgement.⁴

Should the Respondent-Applicant's trademark application be allowed?

The two trademarks are reproduced for comparison and scrutiny:



CHAO MING LIN's Mark



SCORPION

Respondent-Applicant's Mark

The two marks are practically identical, in its physical and conceptual properties.

This Bureau, however, noticed that the opposition is anchored on the existence of an earlier trademark registration which does not belong to the Opposer. Nevertheless, this Bureau finds that the Opposer has the legal standing to oppose the Respondent-Applicant's trademark registration. Sec. 134 of the IP Code reads:

Sec. 134. Opposition.-Any person who believes that he would be damaged by the registration of a mark may, upon payment of the required fee and within thirty (30) days after the publication referred to in Subsection 133.2, file with the Office an opposition to the application. Such opposition shall be in writing and verified by the oppositor or by any person on his behalf who knows the facts, and shall specify the grounds on which it is based and include a statement of the facts relied upon. x x x

The Opposer uses the mark SCORPION on goods that are similar and/or closely related to those indicated in the Respondent-Applicant's trademark application. In fact, it filed applications for the registration of its SCORPION marks. Thus, if the Respondent-Applicant is able to register the mark SCORPION in its favor, it would have the exclusive right over the mark, thus adversely affecting the Opposer's interest. Moreover, this would result in two (2) separate registrations in favor of different entities/parties for the same or identical marks.

⁴ Marked as Annexes "1" to "4".

Succinctly, Sec. 123.1(d) of the IP Code provides that a mark shall not 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.

In this regard, the Opposer cites Trademark Registration No. 4-2009-000206, issued on 12 November 2009 to CHAO MING LIN, for the mark SCORPION & DEVICE and which covers "*protective helmets, gauges, batteries, battery charges, speedometers, tachometers, cruise control, battery relay, battery charger, tires tubes, bearing, brake shoe, pedal pad, seat cushion, suspension shaft kit, coil spring, brake disc, horns, armatures, plate protectors, sprocket, chain*" under Classes 9 and 12. The goods indicated in the Respondent-Applicant's trademark application, i.e. "*electric locks, anti-theft warning apparatus, anti-theft alarm for vehicles and reversing alarm for vehicles*", are also car or motor vehicle accessories, and in fact, also belong to Classes 9 and 12. The Supreme Court has held: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. 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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

It is emphasized that the essence of trademark registration is to give protection to the owner of the 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 products⁶. The mark applied for registration by the Respondent-Applicant failed to meet this function.

WHEREFORE, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-010301 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 05 May 2015.


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

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. 114509, 19 November 1999.