



APPLE INC.,  
Opposer,

-versus-

DANILO F. EVANGELISTA,  
Respondent-Applicant.

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}  
} IPC No. 14-2010-00211  
} Opposition to:  
} Appln. Ser.No. 4-2009-990081  
} Date filed: 9 September 2009  
} TM: "X-PAD AND DESIGN"

**NOTICE OF DECISION**

**QUISUMBING TORRES**  
Counsel for the Opposer  
12<sup>th</sup> Floor, Net One Center  
26<sup>th</sup> Street corner 3<sup>rd</sup> Avenue  
Crescent Park West, Bonifacio Global City  
Taguig City

**JOHN ANDREW R. DE GUZMAN**  
Counsel for the Respondent-Applicant  
Rm. 4 De Guzman Apartment II  
N. Pascual St., San Isidro  
Taytay, Rizal

**GREETINGS:**

Please be informed that Decision No. 2015 - 233 dated October 28, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 28, 2015.

For the Director:

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



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} Date Filed: 9 September 2009

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} Trademark: "X-PAD AND

} DESIGN"

} Decision No. 2015- 233

### DECISION

APPLE INC. (Opposer)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2009-990081. The application, filed by DANILO F. EVANGELISTA (Respondent-Applicant)<sup>2</sup>, covers the mark "X-PAD & DESIGN", for use on "mini notebook computer" under Class 9 of the International Classification of Goods<sup>3</sup>.

The Opposer invokes Sec. 123.1 (d), (e) and (f) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") which provide:

Sec. 123.1. Registrability. 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;
  
- (e) Is identical with, or confusingly similar to, or constitutes a translation of a mark with which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

<sup>1</sup> A corporation organized and existing under the laws of the State of California with address at 1 Infinite Loop, Cupertino California 95014, U.S.A.

<sup>2</sup> Filipino with address at 2F Security Bank Bldg. Km 23 Ortigas Ave. Bgy. San Isidro, Taytay

<sup>3</sup> The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

- (f) Is identical with or confusingly similar to, or constitutes a translation of a mark, considered well known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods and services which are not similar to those with respect to which registration is applied for: Provided, that the use of the mark in relation to the goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, that the interests of the owner of the registered mark are likely to be damaged by such use.”

According to the Opposer:

“2. The Opposer is the successor-in-interest to IP Application Development LLC over the world-famous trademark IPAD and the current owner thereof. The mark IPAD is pending application with the Philippine Intellectual Property Office (‘IPO’) under class 9, among other classes, for computers and related products. xxx

“3. Respondent-Applicant’s mark X-PAD is confusingly similar to the Opposer’s trademark IPAD as to be likely to deceive or cause confusion. Xxx Except for the letter ‘X’, the mark X-PAD is visually and phonetically identical to Opposer’s trademark IPAD. Hence, the registration of the Respondent-Applicant’s mark will be contrary to Section 123.1 (d) of Republic Act No. 8293. xxx

“5. The Opposer’s trademark IPAD is well-known and world famous. Since its launch, it has quickly become one of the most recognized brands in the world. Hence, the registration of the Respondent-Applicant’s mark X-PAD will constitute a violation of Articles 6bis and 10bis of the Paris Convention in conjunction with section 3, 123.1 (e), and 123.1 (f) of Republic Act No. 8293.

“6. Opposer has used the trademark IPAD in the Philippines and elsewhere in connection with its state of the art tablet computer. The Opposer continues to use the trademark IPAD in the Philippines and in numerous other countries.

“7. The Opposer has extensively promoted the trademark IPAD worldwide. As such, the Opposer has obtained significant exposure for the goods upon which the trademark IPAD is used in various media, including television commercials, online advertisements, internationally well-known print publication, and other promotional events.

“8. Opposer has not consented to the Respondent-Applicant’s use and registration of the trademark X-PAD, or any other mark identical or similar to the Opposer’s trademark IPAD.

“9. The use by the Respondent-Applicant of the mark X-PAD for ‘mini-notebook computer’ in class 9 will mislead the purchasing public into believing that the Respondent-Applicant’s goods are produced by, originate from, or are under the sponsorship of the Opposer. Potential damage to the Opposer will also be caused as a result of its inability to control the quality of the products of the products offered or put on the market by Respondent-Applicant under the mark X-PAD.xxx”

To support its opposition, the Opposer submitted as evidence the following:

1. Legalized and verified Notice of Opposition dated 21 November 2010;
2. Notarized and legalized Affidavit of Liza G. Widup dated 17 September 2010;
3. Certified true copy of Philippine Trademark Application No. 4-2010-000532 for “IPAD”;
4. Original legalized Certification signed by Thomas Le Perle dated 20 August 2010;
5. Certified true copy of Trademark Assignment agreement between IP Application Development LLC and Apple Inc. dated 25 June 2010; and
6. Print-out of relevant pages of website, [www.apple.com/ipad](http://www.apple.com/ipad).<sup>4</sup>

The Respondent-Applicant filed its Answer on 25 November 2011, alleging among other things, the following:

“3. Except for the presence of the word ‘PAD’, Responent-Applicant’s mark is in no way similar or identical to that of the Opposer. As can be seen from a comparison herein below, the X-PAD logo is an outline inclined arial font with the ‘X’ letter being overlapped by an inclined eclipse.

The ‘X’ letter is upper case, followed by a hyphen, an upper case ‘P’ followed by letters ‘s’ and ‘d’, which are both lower case arial fonts. Its official color is 70% black (gray shade). Curiously, Opposer in its own comparison (par. No. 4 of Opposition) omitted the inclined ellipse overlapping the ‘X’ as an obvious ploy to put some semblance of similarity between the two marks.

“4. Incidentally, the letter ‘X’ as it appears in Respondent-Applicant’s mark, i.e. with reversed inclined ellipse, is derived from the logo of Xytrix Systems Corporation in order to establish a link, association and recall between the product and Respondent-Applicant’s company name. Hence, the letter ‘X’ is likewise hyphenated to the company’s other brands for which they applied for registration, e.g. ‘X-Stor’ for its optical media and flash drive products.

“5. On the other hand, Oppser’s mark ‘iPad’ is simple bold letters with the letter ‘i’ not hyphenated to the word ‘Pad’. Moreover, what is visually glaring here is the presence of the all too familiar Apple logo above the ipad brand mark in all its products, which cannot be mistaken to have any association with X-PAD.  
xxx

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<sup>4</sup> Exhibits “A” to “F”

"7. It is worthy to note that Respondent-Applicant's applied for the registration of the X-PAD AND DESIGN mark with the Intellectual Property Office on September 9, 2009 or a good four months prior to the Opposer's own application on January 14, 2010.

"8. Thus, when the brand came about, there was no reference to the IPAD brand whatsoever since the latter was not yet launched nor released at the time of said application.

"9. X-PAD is a notebook or small form factor notebook computer, sometimes called ultra-mobile PC, whereas IPAD, as the Opposer declares, is a 'state of the art tablet computer known for its revolutionary mini-touch screen technology and capability to run thousands of software application.'

"10. IPAD is much smaller than X-PAD and does not have a visible keyboard and other physical features that a typical laptop or notebook computer would have. Thus, the physical differences between the two products are readily discernable that even an ordinary person would not mistake one for the other.

"11. Anent the presence of the word 'PAD' in both brands, the same in computer parlance, is shortened generic term for 'netpad' or any tool used to access the World Wide Web (internet). It is now being used by other companies, including PLDT in its 'watch-pad' (a device used to watch internet TV), RedFox in its netbook line 'Wizpad' and Lenovo in its notebooks 'ideapad'.

"12. Apple Inc.'s claim that X-PAD is confusingly similar to IPAD as to likely to deceive or sow confusion among consumers is simply untenable.xxx"

The Respondent-Applicant submitted as evidence, the following:

1. Print-out of "X-PAD AND DESIGN" application in the IPO website;
2. Affidavit of Danilo F. Evangelista dated 23 November 2010; and
3. Pictures of brands with "PAD" in their logos.<sup>5</sup>

The Hearing Officer issued on 16 March 2011 a notice setting the Preliminary Conference on 17 May 2011. On 17 March 2011, the Preliminary Conference was terminated, thereafter, the Hearing Officer issued on 17 May 2011 Order No. 2009-576 directing both parties to file their respective position papers. The Opposer and the Respondent-Applicant filed their position papers on 31 May 2011 and 15 June 2011, respectively.

Records show that Respondent-Applicant applied for registration of the mark "X-PAD AND DEVICE" on 9 September 2009, while the Opposer was assigned trademark application no. 4-2010- 000532 filed on 14 January 2010 by IP Application Development LLC for the mark "IPAD". The goods covered by the Opposer's trademark

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<sup>5</sup> Exhibit "1" to "3"

registration are also under Class 9, same as indicated in the Respondent-Applicant's trademark application.

Should the Respondent-Applicant be allowed to register the trademark X-PAD AND DEVICE?

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

The competing marks are reproduced below:

**IPAD**

*XPad*

Opposer's mark

Respondent-Applicant's mark

While the marks are similar with respect to the word ("PAD"), it is not sufficient to conclude that confusion among the consumers is likely to occur. "PAD" is a generic term for the products: notebook or small form factor notebook computer. A "pad" is defined as short for **P**acket **A**ssembler/ **D**isassembler; a device (hardware or software) used in packet switching to enable data terminal equipment not equipped for packet switching to access a packet switched network.<sup>6</sup> In *Societe Des Produits Nestle v. Court of Appeals and CFC Corporation*<sup>7</sup>, the Supreme Court elaborates on the definition of generic and descriptive terms, to wit:

Generic terms are those which constitute "the common descriptive name of an article or substance," or comprise the "genus of which the particular product is a species," or are "commonly used as the name or description of a kind of goods," or "imply reference to every member of a genus and the exclusion of individuating characters," or "refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular product," and are not legally protectable. On the other hand, a term is descriptive and therefore invalid as a trademark if, as understood in its normal and natural sense, it "forthwith conveys the characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is," or "if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods," or if it clearly denotes what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination.

Clearly, the word "PAD" conveys the nature of the parties products or as explained by the Respondent-Applicant, the common terminology or parlance for "netpad", which is used to access the world wide web (internet), or notebook computers

<sup>6</sup> [www.webopedia.com/TERM/PAD.html](http://www.webopedia.com/TERM/PAD.html)

<sup>7</sup> G.R. No. 112012, 4 April 2001

<sup>7</sup> <http://www.merriam-webster.com/dictionary/my>

or mobile PCs. Thus, one cannot gain exclusive right to appropriate such term given that their products are mobile PCs or notebook computers. The subject of scrutiny would have to be confined to the letters "I" in the Opposer's mark as against the letter "X" in respect of the Respondent-Applicant's. To the eyes, there is striking difference between the words "I" and "X". Moreso, that the Respondent-Applicant's "X" letter is in upper case followed by a hyphen with an inclined ellipse overlapping the "X". There is no resemblance as to the sound produced when pronouncing "I" and "X". As seen from its website, the Opposer's "I" or "i" as part of the name of its different products, i.e. "iPOD", "iPAD" is unique, the meaning of which is left to the imagination of the observer.

The Opposer also alleges that its mark is well-known and famous. According to its witness, Lisa G. Widup<sup>8</sup>, "the 'iPAD' is a 'state of the art tablet computer known for its revolutionary mini-touch screen technology and a capability to run thousands of software applications.'" Having said that, compared to the Respondent-Applicant's mark "X-PAD" marketed as a netbook with keyboards, there is still no likelihood of confusion of goods or business. It is improbable for one who is buying or using "X-PAD" products to be reminded of the mark "iPAD". The buying public should be credited with a modicum of intelligence and discernment in purchasing articles, such as gadgets and mobile phones. Mobile phones are such kind of consumer goods where brand patronage or consciousness is concededly prevalent. Corollarily, the fame and popularity of iPAD in fact makes it improbable for one to confuse "X-PAD" product as an iPAD.

In *Emerald Garment Manufacturing Corporation v. Court of Appeals*<sup>9</sup>, the Supreme Court held:

Finally, in line with the foregoing discussions, more credit should be given to the "ordinary purchaser." Cast in this particular controversy, the ordinary purchaser is not the "completely unwary consumer" but is the "ordinarily intelligent buyer" considering the type of product involved.

The definition laid down in *Dy Buncio v. Tan Tiao Bok*<sup>35</sup> is better suited to the present case. There, the "ordinary purchaser" was defined as one "accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The simulation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

The Bureau also finds merit in the Respondent-Applicant's observation of the prevalence of other companies using the word "PAD" appended to words/letters to describe their products, namely : PLDT MyDSL's "Watchpad"; Lenovo's "IdeaPad"; Redfox's "WizPad", as shown below:

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<sup>8</sup> Exhibit "B"

<sup>9</sup> G.R. 100098, 29 December 1995



Redfox's "WizPad"

ideapad.

Lenovo's "IdeaPad"



PLDT MyDSL's "Watchpad"

(Exhibit "3")

Based on the foregoing, any likelihood of confusion between the mark of the Opposer's, "iPAD" with Respondent-Applicant's "X-PAD" is nil.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2009-990081 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 28 October 2015.

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