

COLUMBIA SPORTWEAR COMPANY,
Opposer,

-versus-

SIM HEE PANG,
Respondent-Applicant.

x-----x

IPC No. 14-2012-00460
Opposition to:
Appln. Serial No.4-2011-012999
Date filed: 27 October 2011
**TM: "CINDIRESS
SPORTWEAR OUTDOOR"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 01 dated January 07, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 07, 2016.

For the Director:


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

COLUMBIA SPORTWEAR COMPANY,

Opposer,

-versus-

SIM HEE PANG,

Respondent-Applicant.

x ----- x

IPC No. 14-2012-00460

Opposition to Trademark

Application No. 4-2011-012999

Date Filed: 27 October 2011

Trademark: "**CINDIRESS
SPORTSWEAR OUTDOOR**"

Decision No. 2016- 01

DECISION

Columbia Sportswear Company¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-012999. The contested application, filed by Sim Hee Pang² ("Respondent-Applicant"), covers the mark "CINDIRESS SPORTSWEAR OUTDOOR" for use on "*clothing namely jeans, slacks, pants, trousers, suits, briefs, panties, tank tops, overalls, jumpers, underwear, sportswear, formal wear namely shoes, slippers, sandals, casual footwear, boots, socks, stockings, high heels, flats sports shoes, trainers, headgear namely caps, hat*" under Class 25 of the International Classification of Goods³.

The Opposer maintains ownership of the mark "COLUMBIA SPORTSWEAR COMPANY & DESIGN", "COLUMBIA & DEVICE" and "COLUMBIA" ("COLUMBIA marks"), which were issued registration on 18 December 2006, 04 June 2007 and 30 September 2002, respectively, for Classes 18 and 25. It asserts the Respondent-Applicant's mark is confusingly similar to its own well-known and famous "COLUMBIA marks", which it has used in the Philippines and elsewhere prior to and long before the filing date of the former's mark. It also claims to have obtained significant exposure for the goods and services upon which the "COLUMBIA marks" are used in various media and that it also maintains a website at the domain name www.columbia.com, which is accessible to internet users worldwide.

The Opposer alleges that the Respondent-Applicant blatantly copies the font, lettering, placement, style logo and other dominant elements of its "COLUMBIA marks". According to the Opposer, the website www.cindiress.com, which appears to be affiliated or operated under the authority or in association with the Respondent-Applicant, the latter's mark is similarly used on sportswear, footwear and outdoor products and depicted in a manner imitating the use of its own marks. The said

¹ A company organized and existing under the laws of Oregon, United States of America (USA), with offices at 14375 NW Science Park Drive, Portland, Oregon 97229, USA.

² With known address at 4/F Wisma Hopo, Jalan P. Ramlee 93400 Kuching Sarawak, Malaysia.

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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website also mentions "Columbia (USA) International Group Co., Ltd. Producer" twice. In support of its Opposition, the Opposer submitted the original notarized and legalized affidavit of Mr. Peter J. Bragdon, its Senior Vice President of Legal and Corporate Affairs and computer printouts of the trademark details report for the marks "COLUMBIA SPORTSWEAR COMPANY & DESIGN", "COLUMBIA & DEVICE" and "COLUMBIA".⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 18 September 2013. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued Order No. 2013-1545 on 11 November 2013 declaring the Respondent-Applicant in default and the case submitted for decision.

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

Section 123.1 (d) and (e) and (f) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("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;

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark 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 knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

(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 or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those 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; xxx"

⁴ Marked as Exhibits "B" to "F", inclusive.

In this regard, with respect to the Opposer's claim that its mark is a well-known mark, the Opposer's evidence, however, does not show that all or a combination of the criteria under Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Tradenames and Marked or Stamped Containers concur.

Nevertheless, records reveal that at the time Respondent-Applicant filed for an application of registration of its mark "CINDIRESS SPORTSWEAR OUTDOOR" on 27 October 2011, the Opposer has registrations of its trademarks "COLUMBIA SPORTSWEAR COMPANY & DESIGN", "COLUMBIA & DEVICE" and "COLUMBIA" under Registration Nos. 4-2003-009461, 4-2005-011468, 4-1997-114682 and 4-1997-114683 issued respectively on 18 December 2006, 04 June 2007 and 30 September 2002.

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the competing marks are shown below for comparison:

Opposer's Marks:

COLUMBIA



Respondent-Applicant's Mark:



"COLUMBIA" and "CINDIRESS" per se are distinguishable aurally and/or visually. This notwithstanding, the competing marks, based on their configuration of

the components or features or presentations, are confusingly similar. Both incorporate a diamond shaped device composed of four identical patterns. It appears that the Respondent-Applicant merely substituted the two parallel lines in the Opposer's marks for the U-shaped pattern. Also, these devices similarly precede their respective brand names. The Respondent-Applicant's applied mark closely resembles the pattern and presentation of the Opposer's mark especially the "COLUMBIA SPORTSWEAR COMPANY & DESIGN". After all, 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.⁵

Succinctly, since the Respondent-Applicant will use or uses the mark "CINDIRESS" to goods that are similar and/or closely related to that of Opposer's registered mark "COLUMBIA marks", the differences will not diminish the likelihood of the occurrence of confusion, mistake and/or deception. It is highly probable that the purchasers will be led to believe that Respondent-Applicant's mark is a mere variation of Opposer's mark. Withal, the protection of trademarks as intellectual property is intended not only to preserve the goodwill and reputation of the business established on the goods bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods.⁶

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."⁷

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

⁵ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁶ Skechers, USA, Inc. vs. Inter Pacific Industrial Trading Corp., G.R. No. 164321, 23 March 2011.

⁷ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

manufacturer against substitution and sale of an inferior and different article as his product.⁸ 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 failed 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.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-012999 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 07 January 2016.



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

⁸ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.