

ROLEX SA,
Opposer,

-versus-

THE POLO RALPH LAUREN, L.P.,
Respondent- Applicant.

X-----X

}
} **IPC No. 14-2011-00006**
} Opposition to:
} Appln. Serial No. 4-2010-001145
} Date Filed: 02 February 2010
} **TM: "RLX RALPH LAUREN"**
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}
}

NOTICE OF DECISION

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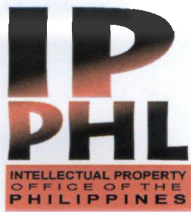
GREETINGS:

Please be informed that Decision No. 2016 - 74 dated March 08, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 08, 2016.

For the Director:


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



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- versus -

THE POLO RALPH LAUREN, L.P.,
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IPC No. 14-2011-00006

Opposition to:

Appln. Serial No. 4-2010-001145

Date filed: 02 February 2010

Trademark: "RLX RALPH LAUREN"

Decision No. 2016 - 74

DECISION

ROLEX SA ("Opposer")¹, filed a verified opposition to Trademark Application Serial No. 4-2010-001145. The application, filed by THE POLO RALPH LAUREN, L.P. ("Respondent-Applicant")², covers the mark "RLX RALPH LAUREN" for use on goods under the following classes³: **08** namely, *hand tools and implements (hand operated), cutlery, side arms, razors;* **09** namely, *binoculars, eyeglass cases, eyeglass chains, eyeglass cords, eyeglass frames, eyeglasses, spectacle glasses, spectacle (optics), telescopes;* **14** namely, *alarm clocks, amulets, ashtrays, or precious metal, for smokers, badges, boxes (cigar), boxes of precious metal, bracelets, brooches, buckles, cases (cigarette), cases for clocks, cases for watches, chains (watches), clips (tie), clocks, clocks and watches (electric), cuff links, flasks, goblets, gold objects, gold and silver ware (cutlery, forks, spoons), jewel cases, jewellery, ornamental pins, ornaments (hat), pearls, rings, silver ornaments, straps for wrist watches, watch bands, watch cases, watch chains, watch crystals, watch glasses, watch springs, watch straps, watches, wrist-watches;* **16** namely, *hang tags, catalogues, stationery, shopping bags, patterns for dressmaking and making cloths, and wrapping paper;* **18** namely, *attache cases, backpacks, bags (garments, bags for campers, bags for climbers, beach bags, belts, briefcases, card cases, cases of leather or leather board, handbags, key cases, parasols, pocket wallets, satchel (school) school bags, school satchels, suitcases, travelling bags, umbrella sticks, umbrellas;* **20** namely, *bed fittings, bedding, furniture, picture frames, jewellery cases, statuettes and wickerwork;* **21** namely, *houseware and kitchen utensils, ceramics, glassware, porcelain, earthenware, perfume sprayers and vaporizers and vases;* **24** namely, *bedspreads, bed linen, blankets, coasters, coverlets, curtain holders, curtains, eiderdowns, face towels, furniture coverings, handkerchiefs, household linen, mats, napkins, pillow shams, pillowcases, place mats, quilts, serviettes, travelling rugs, table runners, table cloths, table mats, table linen, towels, tapestries and wall hangings;* **25** namely, *men's, women's & children's clothing, namely, sweater, shirts, including knitshirts, dress shirts, sport shirts, sweatshirts, and t-shirts, jackets, ties, suits, slacks, ascots, bathing suits, belts, blouses, skirts, dresses, coats, hats, caps, tuxedos, pants, jeans, shorts, tops, vests, robes, hosiery, scarves, pajamas, underwear, kilts, mufflers, squares, shawls, footwear, namely, shoes, boots, slippers, and athletic shoes, blazers, headbands, wristbands, coveralls, overalls, sweat pants and sleepwear;* **27** namely, *carpets, rugs, mats and matting, linoleum and other materials for covering existing floors, wall hangings (non-textile);* **28** namely, *sporting articles, namely, baseballs, baseball bats, baseball gloves, boxing gloves, cricket bats, cricket balls, cricket bags, dumb bells, exercise bicycles, frisbees, golf clubs, golf balls, golf*

¹ A corporation organized and existing under the laws of Japan, with principal office at 12-1 Yurakucho 1- Chome, Chiyoda-ku, Tokyo, Japan.

² With address at 471 Elcano Street, San Nicolas, Manila.

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.

bags, golf gloves, hockey sticks, ice skates, roller skates, skateboards, soccer balls, soccer boots, ski's, surf boards, tennis balls, tennis rackets, bears and clothing therefore in international class 28; and, 35 namely, retail store services.

The Opposer alleges that it is the originator, prior user and prior registrant of the well-known trademark ROLEX which is used worldwide in relation with the prestigious ROLEX watches. Opposer is also the owner of a variety of other trademarks containing ROLEX, such as ROLEX & CROWN DEVICE, ROLEX ROYAL WHITE, ROLEX PRINCE, ROLEX DEEPSEA, THE ROLEX MENTOR AND PROTEGE ARTS INITIATIVE & DESIGN, ROLEX GLIDELock, ROLEX IN GREEN & GOLD CROWN DEVICE, ROLEX PRESIDENT, ROLEX OYSTER QUARTZ & CROWN, ROLEX DAYTONA & CROWN DEVICE, THE ROLEX AWARDS FOR ENTERPRISES AND DEVICE, ROLEX & CROWN & ARABESQUE (DEVICE), ROLEX DEEPSEA, ROLEX GLIDELock, SQUARE WITH ROLEX LETTERS, MACROLEX and others ROLEX variant marks (collectively, the "ROLEX trademarks"). Opposer's first use and registration of the ROLEX mark, both around the world (since 1908) and in the Philippines (since 1965), predate the filing of Respondent's application by more than 100 years, or ten decades. In the Philippines, it covers watches, clocks, chronometric and horological instruments, their parts and accessories in Class 14 and other related products and services. It is also the registered owner of over 1,500 trademark registrations for the ROLEX trademarks in respect of watches, clocks, chronometric and horological instruments, their parts and accessories in Class 14 and other related products and services in more than 200 countries worldwide. Opposer obtained its first registration for ROLEX as early as 1908 in Switzerland under Reg. No. 24001 and has widely used, promoted and registered its marks worldwide since then, long before the filing of Respondent's local application in February, 2010.

Opposer further alleged that the Respondent-Applicant is known for being in the business of clothes, one of its sportswear line commercialized under the trademark RLX. Since more than 10 years, the Respondent-Applicant has been trying also to register the trademark with RLX for watches (class 14) in several countries. ROLEX has opposed these applications considering the obvious risk of confusion, for which the Respondent-Applicant has very often withdrawn its trademark applications in international class 14. ROLEX has also obtained favourable decisions from various Trademark Offices. In the Philippines, herein Opposer has previously opposed Application No. 4-2008-005148 for RLX POLO SPORT in international class 14 under IPC No. 14-2009-00200, resulting in the withdrawal of said application and dismissal of the case under Order 2010-06(D) of the Director of Bureau of Legal Affairs.

Accordingly, Respondent-Applicant's trademark RLX RALPH LAUREN in class 14 goods are identical to the products and services covered by the ROLEX trademarks, and closely resembles Opposer's ROLEX trademarks, as to be likely, when applied to or used in connection with these goods of Applicant, to cause confusion, mistake and deception on the part of the purchasing public by creating a false connection between Respondent-Applicant's products and those of Opposer.

Opposer argued to have widely used, promoted, advertised its registered ROLEX trademarks as internationally well-known, protected against appropriation and use by other parties in a confusingly similar manner without Opposer's consent. It has strengthened the reputation and goodwill of its ROLEX trademarks and product as of superior quality and reliability among the public. Opposer has also vigorously protected its mark against unauthorized use and registration by other parties around the world.

Finally, the registration and use of RLX RALPH LAUREN in respect of Class 14 goods in the name of the Respondent-Applicant is contrary to, and infringes upon Opposer's exclusive right to use the ROLEX trademarks under Sections 123.1 (e), (f) and Section 147 of the IP Code, Article 6bis and Article 8 of the Paris Convention for the Protection of Industrial Property and Article 16 of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), to which the Philippines, Switzerland and

the United States are parties. The word ROLEX, being the dominant and distinctive element of the Opposer's famous trade name and corporate name Rolex SA as registered in Switzerland and used as a name to identify the 26 affiliated ROLEX Companies and service centers around the world for more than six decades, is also protected under Section 165(2) of the IP Code and Article 8 of the Paris Convention. Respondent's unauthorized use of the confusingly similar RLX RALPH LAUREN mark therefore infringes upon the Opposer's ROLEX trade name and business name.

The Opposer's evidence consists of the following:

1. Verified, notarized and legalized notice of opposition;
2. Notarized and legalized power of attorney;
3. Legalized certified translation attesting to the capacity of Stewart Wicht and Catherine O'Rourke;
4. Certified true copies of Certificates of Registration of the following trademarks in the Philippines: ROLEX+CROWN DEVICE, ROLEX CROWN & DEVICE, ROLEX DEEPSEA, ROLEX PRINCE, ROLEX GLIDELock, ROLEX (WORD), ROLEX SA, ROLEX OSTERQUARTZ AND CROWN, ROLEX +CROWN DEVICE, ROLEX & DEVICE, ROLEX DAYTONA & CROWN DEVICE, ROLEX IN GREEN AND GOLD CROWN DEVICE;
5. Certificates of Registration of ROLEX in various countries such as Argentina, Canada, China, European Community, Hong Kong, Japan, Madrid Union, South Africa,
6. Sample of advertisements in local newspapers and magazines in the Philippines; and
7. Sample of advertisements in local newspapers and magazines in various countries.

On 28 July 2011, Respondent-Applicant filed its Answer alleging that its affiliate, PRL USA Holdings, Inc. is the registered owner in the United States of the trademarks POLO RALPH LAUREN & DESIGN, POLO BY RALPH LAUREN, RALPH LAUREN AND DEVICE, for men's suits, slacks, ties, sweaters, shoes, shirts, hats, belts, socks, and ladies' blouses, skirts, suits and dresses (U.S. Reg. No. 978,166 issued February 5, 1974); for suits, overcoats, sweaters, ties, shirts and pants (U.S. Reg. No. 984,005 issued May 14, 1974); for after shave lotion and toilet water (U.S. Reg. No. 1,021,368 issued September 30, 1975); for women's clothing, namely, top coats, raincoats, jackets, suit jackets, suit coats, sport coats, sport jackets, blazers, blouses, shirts, shirt jackets, pants, skirts, dresses, sweaters, t-shirts, hats and scarves (U.S. Reg. No. 1,050,722 issued October 19, 1976); for belts (U.S. Reg. No. 1,067,743 issued June 14, 1977).

Likewise, Respondent-Applicant, The Polo/Lauren Company, L.P. is the registered owner of the marks "POLO BY RALPH LAUREN", "POLO PLAYER SYMBOL", "POLO RALPH LAUREN & DESIGN", for clothing, fabrics, jewelry, leather goods, etc., in various countries. It also holds two registrations for the mark RLX in Japan Reg. No. 4639200 and in the US. Reg. No. 2,276,536 and also holds two pending trademark applications for the marks RLX RALPH LAUREN RLX in the Philippines. Thus, the trademark Ralph Lauren from which the first two letters of the trademark RLX are taken is a well-known mark.

As affirmative defense, Respondent-Applicant stated that its mark is completely distinguishable from Opposer's mark. Respondent-Applicant's mark consists of the letters RLX in one line followed by the words Ralph Lauren. On the other hand, Opposer's marks consist of the word ROLEX, either alone or accompanied by a crown device and/or word describing the style of the watch. Considering that RLX RALPH LAUREN and ROLEX do not have a single word in common, it is preposterous to conclude that confusing similarity exists on the sole basis of three common consonants. To do so would be tantamount to granting opposer an exclusive monopoly of all marks which contain such consonants, a highly unjust and unreasonable consequence.

Moreover, the nature of the goods involved precludes any likelihood of confusion. Rolex watches are usually sold to persons who have considerable financial stability and who are in the higher echelons, at least economically. And due to this generally higher than average price, its purchasers are necessarily more discriminating and sophisticated. The watches involved herein are unlike articles of everyday use, freely obtainable by anyone, anytime, anywhere. Since the buyers of these products are necessarily more cautious and discriminating, any likelihood of confusion between the goods is far-fetched.

The Respondent-Applicant's evidence consists of the following:

1. Authenticated and notarized Affidavit of Avery S. Fischer, Senior Vice President and General Counsel of Polo Ralph Lauren Corporation;
2. Registration No. 2,276,536 of RLX in United States Patent and Trademark Office, including Declaration and Renewal dated 02 September 2009;
3. Certificate of Trademark Registration No. 4639200 for RLX in the Register of the Japan Patent Office;
4. Status List of RALPH LAUREN RLX in the Philippines;
5. Certificates of Registration for the marks from various countries (without English translation);
6. Certificates of Registration No. 217100 of RALPH LAUREN in The Kingdom of Nicaragua;
7. Country list of Trademarks owned by THE POLO/LAUREN COMPANY, L.P.;
8. RLX Sales Division Summaries;
9. RLX Advertising and Direct Mail Spend; and,
10. RLX Advertising and Direct Mail and Website downloads.

Thereafter, the preliminary conference was held and terminated on 11 April 2012. Hence, this decision.

Should the Respondent-Applicant be allowed to register the trademark RLX RALPH LAUREN?

As culled from the records and evidence, the Opposer has valid and existing registrations for its ROLEX trademarks as early as 1965⁴, both local and foreign, which are still active and subsisting to date. On the other hand, Respondent-Applicant has shown several foreign registrations of its mark RLX, RALPH LAUREN, and POLO BY RALPH LAUREN⁵, and have filed its application for the mark RLX RALPH LAUREN only on 02 February 2010⁶ in the Philippines.

But are the competing marks, as shown below, confusingly similar?



Opposer's Trademark

⁴ Exhibit "B" and series & "C" and series of Opposer.

⁵ Exhibit "A" of Respondent-Applicant.

⁶ Filewrapper records.

RLX RALPH LAUREN

Respondent-Applicant's Trademark

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear" may be considered.⁷ Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

The eyes can see that the marks are different. The similarity between the marks manifests only in the use of the identical letters "R" and "X". Such resemblance, however, is not sufficient to conclude that confusion is likely to occur. The appearance of Respondent-Applicant's mark "RLX RALPH LAUREN" obviously has visual focus on the name component "RALPH LAUREN", as it was shown to be the name of a fashion designer and such name mark is known⁸ and is registered for various products worldwide.⁹ On the other hand, the Opposer's "ROLEX Trademarks", also impressed with an equal popularity, spells out the entire word mark "ROLEX" or with variances such as the device of a crown, clearly manifest a distinguishable and independent character of trademarks.

Moreover, confusion or mistake, much less deception, is unlikely in this instance because the goods or service covered by Opposer's trademark registration are distinguishable from that of the Respondent-Applicant's. While they both cover watches, this Bureau finds merit in the argument of the Respondent-Applicant that Rolex watches are usually or likely to be sold to those who have considerable financial stability and who are in the higher echelons, at least economically.¹⁰ Thus, the likelihood of public deception is very remote because its purchasers are supposed to be more discriminating and sophisticated. In addition, the parties' respective goods/service neither flow in the same store or sales booth as to result to any confusion. The competing goods have their own specialty stores with its brand names visibly displayed. A consumer could easily discern that there is no connection between the two marks where the Opposer's goods with its brands are substantially different to Respondent-Applicant's specialized products. Buyers of branded and particular products are highly aware of the channels of trade either to make a purchase, or for the repair and maintenance of the same.

⁷ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

⁸ Ralph Lauren biography, available at <http://www.biography.com/people/ralph-lauren-9374814> (last access 08 March 2016).

⁹ par. 19, Verified Answer, quoting PRL USA Holdings v. Elyn Latta, D2002-0314 (WIPO May 31, 2002); Ralph Lauren, available at http://www.ralphlauren.com/home/index.jsp?ab=Geo_iPH_rUS_dUS (last access 08 March 2016).

¹⁰ par. 30, Verified Answer.

Corollarily, the enunciation of the Supreme Court in the case of Mighty Corporation vs. E. & J. Gallo Winery¹¹ aptly states that:


"A very important circumstance though is whether there exists likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the source of the goods in question. The 'purchaser' is not the 'completely unwary consumer' but is the 'ordinarily intelligent buyer' considering the type of product involved. he is '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 situation, 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."

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 manufacturer against substitution and sale of an inferior and different article as his product.¹² This Bureau finds that the Respondent-Applicant's mark meets this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-001145 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 08 March 2016.


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

¹¹ G.R. No. 154342, 14 July 2004.

¹² Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.