

MARVEL CHARACTERS, INC.,
Opposer,

-versus-

**INTERNATIONAL CONSUMER PRODUCTS
LIMITED COMPANY,**
Respondent- Applicant.

X-----X

IPC No. 14-2011-00307
Opposition to:
Appln. Serial No. 4-2010-002936
Date Filed: 17 March 2010
TM: "X-MEN & DEVICE"

NOTICE OF DECISION

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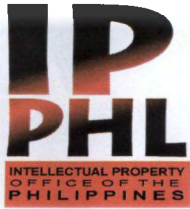
GREETINGS:

Please be informed that Decision No. 2016 - 108 dated April 08, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 08, 2016.

For the Director:

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



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IPC NO. 14-2011-00307

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Appln. Ser. No. 4-2010-002936
Date Filed: 17 March 2010
Trademark: X-MEN & DEVICE

Decision No. 2016 - 108

DECISION

MARVEL CHARACTERS, INC.¹ ("Opposer") filed on a Veried Opposition to Trademark Application Serial No. 4-2010-002936. The application filed by INTERNATIONAL CONSUMER PRODUCTS LIMITED COMPANY² ("Respondent-Applicant") covers the mark X-MEN & DEVICE for use on "shampoos; shower gels; hair conditioner; perfumes; deodorants for body care; skin care products, namely, facial cleanser, facial toner, facial moisturizers; skin toners; anti-wrinkle creams; anti-aging creams" under Class 03 of the International Classification of goods³.

The Opposer alleges the following grounds:

"4.1. Opposer is the true owner and rightful proprietor of the 'X-MEN' mark that is used in various goods which are manufactured and sold by Opposer. Being the sole owner and proprietor, Opposer has caused the registration of the 'X-MEN' mark and variations thereof worldwide.

"4.2. Opposer's 'X-MEN' mark is internationally and locally well-known and is entitled to protection under Section 123.1 (f), in relation to Section 123.1 (e), of the IP Code, Article 6bis of the Paris Convention and Article 16(2) and (3) of the TRIPS Agreement. The protection granted to Opposer's well-known 'X-MEN' mark extends even to non-competing goods.

"4.3. Respondent-Applicant's mark 'X-MEN & DEVICE' is confusingly similar, if not identical in word component, to the Opposer's 'X-MEN' mark, and infringes upon the Opposer's exclusive right to use the 'X-MEN' mark which is protected under Section 147 of the IP Code.

The Petitioner submitted the following evidence:

1. Exhibit "A" - certified true copy of the exhibits submitted in IPC No. 14-2007-00254 which forms part of the records of Appeal No. 14-2010-00013;
2. Exhibit "B" - printout of IPO's online Database showing the registration/application status of various "X-MEN" mark; and
3. Exhibits "C" to "N" - printouts of the USPTO Database showing the registration status of

¹ A corporation duly organized and existing under the laws of U.S.A with business address at 1600 Rosecrans Avenue, Manhattan Beach, California 90266 U.S.A.

² A corporation duly organized and existing under the laws of Vietnam with address at NO. 30, Lam Son, 6 Ward, Binh Thanh District, Ho Chi Minh District., Vietnam.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

Republic of the Philippines

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"X-MEN" marks;

This Bureau issued on 10 November 2011 a Notice to Answer and personally served a copy thereof to the Respondent-Registrant's counsel in the Philippines on 24 November 2011. After several motions for extension of time to file answer, Respondent-Registrant filed the Verified Answer on 22 February 2012. However, on 07 March 2012, Opposer filed a Manifestation and Motion praying that Respondent-Applicant be declared in default as it failed to present proof to show that its counsel Atty. Chito Dimaculangan has been authorized to sign the verification of the Answer. On 08 June 2012, this Bureau issued Order No. 2012-827 declaring Respondent-Applicant deemed to have failed to file the Answer for failure to show proof of authority to sign the verification and consequently declaring Respondent-Applicant in default. Accordingly, pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer

Should the Respondent-Applicant be allowed to register its mark **X-MEN & DEVICE**?

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.⁴

A perusal of the records of this will show that at the time Respondent-Applicant filed its application for registration of its mark **X-MEN & DEVICE** on 17 March 2010, Opposer already has an existing registrations for the mark **X-MEN** issued way back in 1995 for classes 16, 25 and 28.

But, are the competing marks, shown below, resemble each other such that confusion or even deception is likely to occur?

X-MEN

Opposer's Mark



Respondent-Applicant's Mark

It is very clear that the competing marks are similar as they both contain the word "X-MEN" consisting of the uppercase letters "X," "M," "E," and "N" with a hyphen between the letters "X" and "M". Albeit the differences in the font used and the presence of a stylized letter "X" in a circle device in Respondent-Applicant's mark, such difference is inconsequential. The similarity between the mark would likely cause confusion, mistake or deception on the part of the public that the latter is a variation of the former or vice versa and that it is owned by one and the same person. A

⁴See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

boundless choice of words, phrases and symbols is available to one who wishes a trademark sufficient unto itself to distinguish his product from those of others. When, however, there is no reasonable explanation for the defendant's choice of such a mark though the field for his selection was so broad, the inference is inevitable that it was chosen deliberately to deceive.⁵

Also, this Bureau takes judicial notice of the Decision of the Office of the Director General⁶ in upholding the confusing similarity of the "X-MEN" marks of the parties, the very same marks involved in this case. In finding confusing similarity between Opposer's "X-MEN" and Respondent-Applicant's "X-MEN & DEVICE", the Director General held:

A scrutiny of these marks shows their evident similarity. They both have the term "X-MEN" containing the capital letters "X," "M," "E," and "N" and a hyphen ("-") between the letters "X" and "M". "X-MEN" is the dominant feature in these marks. Notwithstanding the differences in the font and style of "X-MEN" as shown in both marks, and the presence of the stylized "X" inside a circle in the Appellee's mark, it is not unlikely that these marks may be considered a variation of one over the other and are owned by the same person.

The registration of X-MEN & DEVICE may, therefore, prejudice the interests of the Appellant. Even if the Appellee's mark is used on goods different from those covered by the Appellant's certificate of registration for X-MEN, the Appellant's products may be assumed to originate with the Appellant. The public would, thus, be misled into believing that there is some connection with the Appellant and Appellee, which, in fact, does not exist. The likelihood of confusion would subsist not on the purchaser's perception of goods but on the origins thereof.

x x x

In addition, the registration of X-MEN & DEVICE in favor of the Appellee would prevent the Appellant from using the X-MEN on products that are related to the goods of the Appellee. A certificate of registration of a mark shall be *prima facie* evidence of the validity of the registration, the registrant's ownership of the mark and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate. In this instance, the Appellant has already embarked on expanding the use of X-MEN in goods that are similar to the Appellee's goods.

It is also worth to note that in the same decision, the Director General has declared Opposer's X-MEN mark as a well-known mark, to wit:

Significantly, the Appellant's X-MEN is a well-known mark. Rule 102 of the Trademark Regulations sets forth the following criteria in determining whether a mark is well-known:

x x x

In this regard, any combination of the above-mentioned criteria may be taken into account to determine whether X-MEN is a well-known mark. In this case, the Appellant adduced pieces of evidence showing the registration of X-MEN in its name in several countries including the Philippines. The Appellant submitted copies of the certificates of registration for X-MEN issued in its favor, in the Philippines and in other countries and a list of countries that issued the certificates of registration for X-MEN. Moreover, the Appellee did not contradict the following allegations of the Appellant regarding the worldwide licensing agreements and popularity of X-MEN in comic books and motion pictures:

x x x

The foregoing shows the extent to which the Appellant has used, registered and promoted X-MEN not only in the Philippines but also in other countries. These are sufficient enough to consider X-MEN as a well-known mark under the criteria provided in the Trademark Regulations. Sec. 123.1 (e) and (f) of the IP Code provides that a mark cannot be registered if:

x x x

⁵ *Converse Rubber Corporation vs. Universal Rubber Products, Inc.*, G.R. No. L-27906. January 8, 1987.

⁶ See IPOPPL Office of the Director General Decision in Appeal No. 14-2010-0013 (IPC No. 14-2007-00254) promulgated on 11 June 2012.

X-MEN & DEVICE being confusingly similar to the internationally well-known mark X-MEN, it cannot, therefore, be registered.

Prescinding from the above-findings of this Bureau and the earlier ruling of the Director General that the marks of the parties are confusingly similar and in accordance with the declaration that Opposer's X-MEN is an internationally well-known mark, the registration of Respondent-Applicant's mark is proscribed under Section 123.1 (e) and (f) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-002936, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 08 April 2016.


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