

**HARMAN INTERNATIONAL
INDUSTRIES INCORPORATED,**
Opposer,

-versus-

**SHENZHEN COSHIP ELECTRONICS
CO., LTD.,**
Respondent- Applicant.

x-----x

IPC No. 14-2011-00550
Opposition to:
Appln. Serial No. 4-2010-003560
Date Filed: 05 April 2010
TM: "RIBBON DEVICE"

NOTICE OF DECISION

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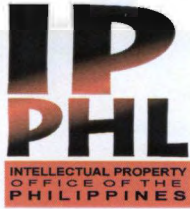
GREETINGS:

Please be informed that Decision No. 2016 - 162 dated June 02, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 02, 2016.

For the Director:

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



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Date Filed: 05 April 2010
Trademark: RIBBON DEVICE

Decision No. 2016 - 162

DECISION

HARMAN INTERNATIONAL INDUSTRIES INCORPORATED¹ ("Opposer") filed on a Verified Notice of Opposition to Trademark Application Serial No. 4-2010-003560 The application filed by SHENZHEN COSHIP ELECTRONICS CO., LTD.² ("Respondent-Applicant") covers the mark RIBBON DEVICE for use on goods under classes 9³, 38⁴ and 42⁵ of the International Classification of goods⁶.

The Opposer alleges the following grounds:

"(a) Opposer is the prior user and first registrant of the STYLIZED INFINITY SYMBOL trademark in the Philippines, well before the filing date of the Respondent's RIBBON DEVICE trademark, which was only filed on 5 April 2010. The registration details of Opposer's STYLIZED INFINITY SYMBOL trademark held by Opposer are as follows:

¹ A corporation duly organized and existing under the laws of U.S.A. with business address at Stamford, Connecticut, U.S.A.

² A corporation duly organized and existing under the laws of China with address at A6/F, Rainbow Technology Building, 5th Industrial District, Hi-Tech Industrial Park Northern Section, Nanshan District, Shenzhen City., Guangdong Province, People's Republic Of China.

³ set-top boxes; computer peripheral devices; computers; processors (central processing units); electronic notice boards; theft prevention installations, electric, electronic tags for goods; navigational instruments; monitors (computer hardware); monitors (computer programs); alarms; computer software, recorded; computer programmes (programs recorded; intercommunication apparatus; camcorders; portable telephones; television apparatus; audio and video receivers; amusement apparatus adapted for use with an external display screen or monitor; antennas; electronic pocket translators; animated cartoons; protection devices for personal use against accidents; smart cards (integrated circuit cards); notebook computers; counters; vending machines; facsimile machines; transmitters of electronic signals; telephone apparatus; monitoring apparatus, electric; radios; video game cartridges; sound recording apparatus; cameras (photography); projection apparatus; measuring instruments; milage recorders for vehicles; audiovisual teaching apparatus; optical lenses; telescopes; microscopes; optical glass; video recorders; wires, electric; semi-conductors; integrated circuits; wafers (silicon slices); conductors, electric; transformers (electricity); remote control apparatus; galvanizing apparatus; extinguishers; welding apparatus, electric; radiological apparatus for industrial purposes; eyeglasses; galvanic cells; battery chargers; door openers, electric; fluorescent screens.

⁴ electronic bulletin board services (telecommunications services); cable television broadcasting; cellular telephone communication; communications by computer terminals; electronic mail; providing telecommunications connections to a global computer network; providing user access to a global computer network (service providers); radio broadcasting; television broadcasting; computer aided transmission of messages and images; telephone services; paging services (radio, telephone or other means of electronic communication); communications by telephone; teleconferencing services; information about telecommunication; facsimile transmission.

⁵ research and development for others; industrial design; computer software design; updating of computer software; consultancy in the field of computer hardware; maintenance of computer software; computer systems analysis; creating and maintaining web sites for others; data conversion of computer programs and data (not physical conversion); computer system design; recovery of computer data; rental of modems; computer rental; hosting computer sites (web sites).

⁶ 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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Moreover, Respondent's RIBBON DEVICE looks like the universal symbol that means 'infinity', and therefore draws closely on the number of INFINITY marks held by the Opposer for the same class of goods. The registration details of these INFINITY marks are as follows:

x x x

"(b) Opposer enjoys the exclusive right to prevent all third parties not having its consent from using in the course of trade *identical or similar signs* for goods which are identical or similar to those in respect of which its trademarks are registered where such use would result in the likelihood of confusion.

"(c) Respondent's RIBBON DEVICE mark is confusingly similar, if not identical, to Opposer's INFINITY marks, and thus runs contrary to Section 123 of the IP Code. Section 123 (d), (e), (f) and (g) of the IP Code provides:

x x x

Respondent's RIBBON DEVICE mark appropriates the vital elements of Opposer's INFINITY mark, particularly the STYLIZED INFINITY SYMBOL, that would support a finding of sufficient similarity, if not identity, between the competing marks in terms of appearance. A cursory examination of Respondent's mark would show a studied attempt to copy Opposer's mark, by making its mark a mirror image of the STYLIZED INFINITY SYMBOL for which Opposer's goods have been known to bear, thus:

x x x

The fact that Respondent intends to use its mark for identical and similar goods under class 9 cuts too closely to the famous INFINITY mark owned by Opposer, particularly the STYLIZED INFINITY SYMBOL, to escape notice. Respondent's trademark application would show that the same is intended for:

x x x

On the other hand, Opposer's STYLIZED INFINITY SYMBOL is registered in for the following goods:

**HIGH FIDELITY SPEAKERS, SWITCHING AMPLIFIERS, PREAMPLIFIERS, HEAD-
PHONES AND TONE ARMS**

Hence, the registration of Respondent's RIBBON DEVICE mark in connection with the said goods under Class 9 will confuse consumers into believing that RIBBON DEVICE originates from Opposer, or are otherwise sponsored by or associated with Opposer.

Opposer is the worldwide leader in audio and info-entertainment products. Famous for its HARMAN KARDON, AKG, INFINITY, JBL, MARK LEVINSON and LEXICON brands, Opposer has continuously been a leading source of high quality products. Opposer began using HARMAN as its trade name as early as 1953, and the INFINITY brand as early as 1968. Opposer's use of the trade name and the INFINITY brand has been uninterrupted since then.

All of the foregoing support a finding of sufficient similarity between the competing marks, if not identity with the INFINITY marks. There appears to be a studied attempt to copy Opposer's well-known INFINITY marks, and ride on the goodwill it has created through 43 years of continuous use.

By suggesting a connection, association or affiliation with Opposer, when there is none, Respondent will no doubt cause confusion among the minds of the general public and substantial damage to the goodwill and reputation associated with the INFINITY marks, particularly the STYLIZED INFINITY SYMBOL, as well as the Opposer's business reputation.

"(d) Respondent's RIBBON DEVICE mark appropriates not only the dominant feature of Opposer's

STYLIZED INFINITY SYMBOL, but its entirety.

x x x

The dominance test is based on Section 155.1 of the IP Code which expressly recognizes the right of the owner of a registered mark to protection against:

x x x

The protection granted to trademark owners extends not only to the goods stated on the registration certificate but also to the goods related thereto. As early as 1968, in the case of *Sta. Ana v. Maliwat*, the Supreme Court declared:

x x x

The foregoing principle is embodied in Section 138 of the IP Code which expressly states that:

x x x

"(e) The competing marks are mirror images of each other, to a striking degree, which alone constitutes sufficient ground for the Honorable Office to rule that the marks are confusingly similar, more so as the marks involve the same class of goods. The fact that the Respondent's mark mimics the 3-dimensional portrayal of Opposer's STYLIZED INFINITY SYMBOL demonstrates Respondent's intentional, studied attempt to colorably imitate Opposer's famous mark.

"(f) The Opposer has also used and registered the INFINITY marks in other countries, which thereby classifies the INFINITY marks as registered and well-known trademarks, both internationally and in the Philippines.

As such, the Opposer is entitled to a wider scope of protection under Philippine law and to protect its INFINITY marks against marks that are liable to create confusion on the minds of the public or used in bad faith under Article 6bis of the Paris Convention, thus:

x x x

As the owner of the mark that it is well-known and registered in the Philippines, Opposer is entitled to protect its INFINITY marks, particularly the STYLIZED INFINITY SYMBOL, against the mark that are liable to create confusion in the minds of the public, whether such mark are used on similar or dissimilar goods or services.

"(g) If allowed to proceed registration, the consequent use of the RIBBON DEVICE mark by the Respondent will amount to unfair competition with and dilution of Opposer's INFINITY marks, particularly the STYLIZED INFINITY SYMBOL, which have all attained valuable goodwill and reputation through the years of extensive and exclusive use. This is prohibited under Section 168 of the IP Code.

Opposer's goodwill is a property right separately protected under Philippine law, and violation thereof amounts to downright unfair competition proscribed under Article 10bis of the Paris Convention, Article 28 of the Civil Code and Section 168 of the IP Code:

x x x

On the other hand, Article 28 of the Civil Code and Section 168 of the IP Code provides:

x x x

"(h) The registration of the Respondent's mark will work to impede the natural expansion of Opposer's use of its INFINITY marks in the Philippines.

"(i) The registration and consequent use of the RIBBON DEVICE mark by the Respondent will result in a confusion of source or reputation, which is proscribed under the IP Code and applicable precedents; and

"(j) Other provisions of the IP Code and related international agreements or conventions on the subject of intellectual property rights warrant the denial by this Honorable Office of Respondent's trademark application."

The Opposer's evidence consists of the following:

Exhibit "B" - legalized Certificate and Special Power of Attorney;

Exhibit "C" - authenticated Affidavit of Beverly Shin;

Exhibit "D" - table showing the details of the registration and applications for the mark INFINITY worldwide;

Exhibit "E" - copies of some of the trademark registration certificates for the INFINITY marks from various jurisdictions;

Annex "C-Series" - copies of Opposer's Annual Reports from 2002-2010;

Annex "D" - representative list of Opposer's various recognition and awards for its products and services;

Annex "E-Series" - samples of promotional materials, catalogues, articles, advertisements, studies, letters, list, screen shot, awards and other evidence of the extensive promotion and reputation of the INFINITY marks around the world; and

Annex "F" - Decision from the court of Brazil finding the INFINITY trademark as internationally well-known and a chart listing trademark oppositions filed by Opposer worldwide to defend its INFINITY trademark.

This Bureau issued on 16 February 2012 a Notice to Answer and personally served a copy thereof to the Respondent-Registrant's counsel in the Philippines on 20 February 2012. Respondent filed a Motion for Extension of Time to File Answer. Despite the grant of the motion for extension, Respondent-Applicant failed to file the Answer. On 10 December 2012, this Bureau issued an Order 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 Respondent-Applicant be allowed to register the mark RIBBON 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.⁷

Sec. 123.1 (d) of the IP Code provides:

SECTION 123. Registrability. — 123.1. A mark cannot be registered if it:

x x x

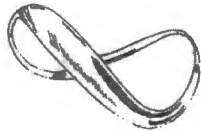
⁷See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

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;

A perusal of the records of this will show that at the time Respondent-Applicant filed its application for registration of its mark RIBBON DEVICE on 5 April 2011, Opposer already has an existing registration for the mark STYLIZED INFINITY SYMBOL issued on 14 April 2005. Opposer's STYLIZED INFINITY SYMBOL mark is used on "*high fidelity speakers, switching amplifiers, preamplifiers, head-phones and tone arms*" under Class 9. On the other hand, Respondent-Applicant's mark will be used for goods under Classes 9, 38 and 42.

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



Opposer's Mark



Respondent-Applicant's Mark

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademark pictured in their manner of display. Inspection should be undertaken from the viewpoint of the 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.⁸ Thus, confusion is likely between marks only if their overall presentation as to sound, appearance or meaning would make it possible for consumers to believe that the goods or products, to which the marks are attached, comes from the same source or are connected or associated with each other.

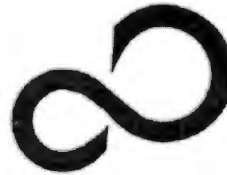
Respondent-Applicant's mark is different and distinct from Opposer's mark. Opposer's mark consists of a stylized infinity mark while that of Respondent-Applicant's consists of a blended blue ribbon device. Opposer's mark is presented in black color while that of Respondent-Applicant in blue. Though it may seem that both mark appears as a stylized number "8", the manner in which they are presented or depicted are different. Visually, it is very apparent that the marks are different from each other. As such, the likelihood of confusing similarity between the two marks are remote.

Further, Opposer's mark STYLIZED INFINITY LOGO is a commonly used mark. Based on the Trademark Database, there are more than one hundred "Infinity" marks which is composed of the word "INFINITY", the "INFINITY DEVICE" or a combination of the word "INFINITY" and "INFINITY DEVICE". Among these INFINITY DEVICE registered as a mark other than the

⁸ *Etepha A.G. v. Director of Patents, G.R. No. L-20635, 31 March 1966.*

registered mark of Opposer and used in Class 9, are as follows :

pc tools



Thus, Opposer's mark is considered a weak mark. A weak trademark has no capacity to identify strongly a single original or source of goods or services. In this case, when we see the INFINITY DEVICE it does not exclusively suggest that it comes from Opposer or it refers only to Opposer's products only.


What is more, the goods/services which Respondent-Applicant deals is not covered by the goods of Opposer. In view thereof, it is farfetched that consumers or the public in general will likely be confused or mistaken or be deceived that the product of Respondent-Applicant comes from, originated or sourced from or manufactured by Opposer.

Accordingly, this Bureau cannot sustain the instant opposition.

WHEREFORE, premises considered, the instant opposition is hereby DENIED. Let the filewrapper of Trademark Application Serial No. 4-2010-003560, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 02 JUN 2016


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