

**INTERNATIONAL GAMING  
PROJECTS LIMITED,**  
Opposer,

**-versus-**

**XYLOMEN PARTICIPATIONS S.A.R.L.,**  
Respondent- Applicant.

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} **IPC No. 14-2015-00362**  
} Opposition to:  
} Appln. No. 4-2014-001271  
} Date Filed: 30 January 2014  
} **TM: "VIKING JOURNEY"**  
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**NOTICE OF DECISION**

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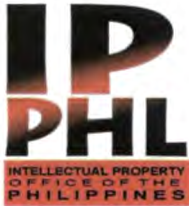
**GREETINGS:**

Please be informed that Decision No. 2016 - 266 dated July 28, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 28, 2016.

For the Director:

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



**INTERNATIONAL GAMING PROJECTS LTD.,**

Opposer,

-versus-

**XYLOMEN PARTICIPATIONS, S.A.R.L.,**

Respondent-Applicant.

X ----- X

IPC No. 14-2015-00362

Opposition to Trademark

Appln. No. 4-2014-001271

Date Filed: 30 January 2014

TM: **"VIKING JOURNEY"**

Decision No. 2016- 266

### DECISION

International Gaming Projects Limited<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2014-001271. The contested application, filed by Xylomen Participations S.a.r.l.<sup>2</sup> ("Respondent-Applicant"), covers the mark "VIKING JOURNEY" for use on *"gaming devices, namely, gaming machines, slot machines, bingo machines, with or without video output, computer software and firmware for games of chance on any computerized platform, including dedicated gaming consoles, video based slot machines, reel based slot machines and video lottery terminals, components for gaming machines that generate or display wager outcomes, namely, controllers, displays, button panels, bolsters, electrical wiring and computer hardware and software associated therewith, gaming machines, namely, devices which accept a wager, gaming software that generates or displays wager outcomes of gaming machines"* and *"bingo game playing equipment, spin reel game playing equipment games, namely, reel games, board games, card games, stand alone video game machines"* under Classes 09 and 28, respectively, of the International Classification of Goods<sup>3</sup>.

According to the Opposer, it is engaged in the business of developing and manufacturing various gaming platforms for its customers, which include actual development of games and gaming systems/infrastructure. It aims to deliver "Bingo in Action" with a mission to provide entertainment and happiness to people through its products and to add to the business growth of its clients. For over two decades, it has been developing "Electronic Slot", "Bingo" and "Amusement with Prizes" (AWP) gaming machines, samples of which can be found in the website [www.ortizgaming.com](http://www.ortizgaming.com). To achieve its goals of producing fun and full of adventure gaming titles, it developed and registered its trademarks all over the world.

<sup>1</sup> A corporation organized under the laws of Malta with principal place of business at Palazzo Pitro Stiges, 90 Strait Street, Valleta VLT 1436, Malta.

<sup>2</sup> With known address at 16, e Jean L' Aveugle, L-1148, Luxembourg.

<sup>3</sup> 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.

One of the Opposer's marks is "VIKING'S GOLD", which it claims to have used the since July 2012. It now contends that the Respondent-Applicant's applied mark is confusingly similar thereto. In support of its opposition, the Opposer submitted the affidavit of Mr. Carlo E. Abarquez, with annexes.<sup>4</sup>

A Notice to Answer was issued and served upon the Respondent-Applicant on 24 November 2015. The latter, however, did not file Answer. Thus, the Hearing Officer issued Order No. 2016-640 on 19 April 2016 declaring the Respondent-Applicant in default and the case submitted for resolution.

The issue to be resolved is whether the Respondent-Applicant should be allowed to register the mark "VIKING JOURNEY" in its favor.

Section 123.1 (d) of Republic Act 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; xxx"***

Records reveal that at the time the Respondent-Applicant filed the contested application on 30 January 2014, the Opposer has a valid and existing registration of the mark "VIKING'S GOLD" under Certificate of Registration No. 4-2013-000609 issued on 17 October 2013.

To determine whether the competing marks are confusingly similar, the two are reproduced below:



*Opposer's mark*



*Respondent-Applicant's mark*

<sup>4</sup> Marked as Exhibits "C" to "H".

A perusal of the marks will readily show that they similarly appropriate the word "VIKING". The Respondent-Applicant replacement of the word "GOLD" in the Opposer's mark with "JOURNEY" notwithstanding, the marks are still confusingly similar. They give the same impression or connotation that the goods involved has a relation to the word "VIKING". 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 purchaser as to cause him to purchase the one supposing it to be the other.<sup>5</sup>

Moreover, it is noteworthy that the Opposer's mark "VIKING'S GOLD" similarly cover "*computer programs, software; electronic components*" and "*automatic slot machines; amusement and gaming machines; amusement and gaming electric and/or electronic machines, apparatus and installations; video game machines and apparatus; parts and fittings for the said goods not included in other classes*" also for Classes 09 and 28, which are the similar and/or related to the goods covered by the Respondent-Applicant's mark. Thus, it is highly likely that the consumers will be lead to believe that Respondent-Applicant's services is connected to or sponsored by the Opposer.

Time and again, it has been held in our jurisdiction that the law does not require that the competing trademarks must be so identical as to produce actual error or mistake. It would be sufficient, for the purposes of the law that similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the new brand for it.<sup>6</sup> Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.<sup>7</sup>

Succinctly, 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."<sup>8</sup>

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

<sup>6</sup> American Wire & Cable Co. vs. Director of Patents, G.R. No. L-26557, 18 February 1970.

<sup>7</sup> Philips Export B.V. vs. Court of Appeals, G.R. No. 96161, 21 February 1992.

<sup>8</sup> Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

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.<sup>9</sup> It is found that the Respondent-Applicant's mark sufficiently met this function.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application No. 4-2014-001271 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 28 JUL 2016

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

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<sup>9</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.