

PUMA SE,
Opposer,

-versus-

BANGKOK ATHLETIC COMPANY LTD.,
Respondent-Applicant.

}	IPC No. 14-2012-00378
}	Opposition to:
}	Appln. No. 4-2012-500519
}	Date Filed: 01 March 2012
}	TM: "PAN AND DEVICE"
}	
}	
}	
}	
}	

X-----X

NOTICE OF DECISION

ESCAÑO SARMIENTO & PARTNERS LAW OFFICES
Counsel for the Opposer
Suite 1605, The Taipan Place
F. Ortigas Jr. Road, Ortigas Business District
Pasig City

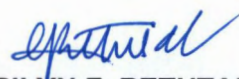
BENZON NEGRE UNTALAN
INTELLECTUAL PROPERTY ATTORNEYS
Counsel for Respondent- Applicant
2nd Floor SEDCCO Bldg.
Rada cor. Legaspi St.
Legaspi Village, Makati City

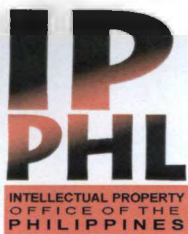
GREETINGS:

Please be informed that Decision No. 2016 - 151 - dated May 19, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 19, 2016.

For the Director:


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



PUMA SE,

Opposer,

-versus-

BANGKOK ATHLETIC COMPANY LTD.,
Respondent-Applicant.

X ----- X

IPC No. 14-2012-00378

Opposition to Trademark
Application No. 4-2012-500519
Date Filed: 01 March 2012

Trademark: **"PAN AND DEVICE"**

Decision No. 2016- 151

DECISION

Puma SE¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-500519. The contested application, filed by Bangkok Athletic Company Ltd.² ("Respondent-Applicant"), covers the mark "PAN AND DEVICE" for use on "*shoes; sport shoes; sandals; sport wears; t-shirts; shirts; pants; shorts; jackets; socks; hats; caps; sneakers; scarves and underwear*" under Class 25 of the International Classification of Goods³.

The facts, according to the Opposer, are as follows:

"3. Since 1948, Puma is engaged in the business of manufacturing and distributing athletic shoes, apparel and accessories.

4. As part of its international business development and marketing strategy, Puma has developed and is using the internationally well-known trademarks 'Puma', 'Jumping Cat Device' and 'Puma and Jumping Cat Device' (collectively referred to as 'Puma Trademarks'). x x x

5. The Puma Trademarks have been recognized globally and have been accorded international trademark protection for goods under Nice Class 25.

x x x

6. In *Puma Sportsschufabriken Rudolf Dassler v. Intermediate Appellate Court*, the Philippine Supreme Court has recognized that the Puma Trademarks are internationally well-known:

x x x

¹A corporation duly organized and existing under and by virtue of the laws of Germany with address Puma Way 1, Herzogenaurach.

² A limited company organized and registered under the laws of the Kingdom of Thailand with business address at 61/210-213 Soi Watchan Nai (Rat Uthit 2), Charoenkrung Road, Bangklo, Bangkoraem, Bangkok, 10120, Thailand.

³The 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.

8. In 1964, Puma started doing business in the Philippines. The Puma Trademarks are accorded trademark protection from the Philippines Intellectual Property Office ('IPO') for goods under Nice Class 25: x x x

9. Currently, Puma has twelve (12) concept stores located nationwide. Puma's goods are also being sold in SM department stores. x x x

10. With an annual estimated advertising budget of Sixteen Million Pesos (PhP16,000,000.00), Puma regularly conducts exhaustive local advertising marketing and advertising campaigns. Product advertisements are contained in leading magazines and newspapers, such as Clavel, Preview, Men's Health, Total Fitness, Football Philippines, FHM Status, OK! Philippines, Runner's World and the Philippine Star. x x x

11. Puma also employs the services of well-known local artists and athletes to endorse its brand. x x x

12. Recently, Puma has agreed to support and sponsor the Philippine National Football team, more popularly known as the Azkals."

In support of its Opposition, the Opposer submitted the following:

1. affidavit executed by Mr. Jochen Lederhilger and Micahel Lammermann;
2. copies of certificates of registration for "PUMA", "JUMPING CAT DEVICE" and "PUMA AND JUMPING CAT DEVICE" from different countries;
3. summary of international trademark registrations of "PUMA", "JUMPING CAT DEVICE" and "PUMA AND JUMPING CAT DEVICE";
4. list of locations where its goods are being sold;
5. samples of the advertising collateral found in magazines and newspapers;
6. advertising collateral featuring local artists and athletes; and
7. pictures comparing its products with that of the Respondent-Applicant's.⁴

The Respondent-Applicant filed its Answer on 14 May 2013 alleging, among others:

"3. As attached to in the *Joint Affidavit* of Respondent-Applicant's directors, Mrs. Songsri Sattapiam and Mr. Wichian Simarirut, Respondent-Applicant is an affiliate and licensee of Bangkok Rubber Public Company Limited ('BRC'). x x x

4. In 1974, BRC began manufacturing sports shoes, casual shoes, school shoes, and other apparel under the brand 'PAN'. The products bearing the 'PAN' brand were initially marketed in its domestic market of Thailand. However, the operations of the company rapidly grew in geographical scope as the 'PAN' brand quickly gained considerable goodwill. With such growth in operations, the Respondent-Applicant was formed. Respondent-Applicant, a licensee of BRC, served as the distributor of goods such as shoes, sports clothes, socks, hats and jackets all marketed under the 'PAN' trademark.

⁴ Marked as Exhibits "A" to "H", inclusive.

5. BRC and Respondent-Applicant quickly expanded their operations and the 'PAN' brand became an international brand. The companies engaged in various advertisements and public relations under the 'PAN' trademark until it became widely well-known not only in Thailand but also in many countries where the 'PAN' brand was able to break ground. At present, the 'PAN' brand is readily associated with high quality sports and casual wear. x x x

6. It was in 1985 when BRC first filed for registration of the 'PAN' brand in Thailand. Given the international scope of its marketing, sale, advertisement and distribution, BRC and Respondent-Applicant likewise registered the 'PAN' trademark in many countries such as Korea, State of Kuwait, United Arab Emirates, Singapore, Myanmar, Laos, India, Cambodia, Norway, Sweden, Finland, Australia, Malaysia, Indonesia, England (Great Britain and Northern Island), Belgium, Netherland and Luxembourg. x x x

7. To protect its rights and interests in the internationally well-known mark 'PAN AND DEVICE' that was being applied to the products distributed by Respondent-Applicant bearing the said mark, Respondent-Applicant applied for registration of the said mark in the Philippines. On 1 March 2012, Respondent-Applicant filed with the Bureau of Trademarks ('BOT') of the Intellectual Property Office Philippines ('IPOPHL') Trademark Application No. 4-2012-500519 under Class 25 for 'shoes, sports shoes, sandals, sport wears, t-shirts, shirts, pants, shorts, jackets, socks, hats, sneakers, scarves and underwear'. x x x"

The Respondent-Applicant's evidence consists of the Joint Affidavit of its directors, Mrs. Songsri Sattapiam and Mr. Wichian Simarirut, with annexes.⁵

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. This Bureau's Alternative Dispute Resolution Services submitted a report that the parties refused to mediate. Accordingly, the Hearing Officer conducted and terminated the preliminary conference on 18 August 2015 wherein the parties were directed to submit their respective position papers. After which, the case is deemed submitted for decision.

The issue to be resolved is whether the Respondent-Applicant's mark "PAN AND DEVICE" should be registered.

Section 123.1 paragraphs (d), (e) and (f) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), provides that 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

⁵ Marked as Exhibits "1" to "10", inclusive.

(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"

Records reveal that at the time the Respondent-Applicant filed an application for registration of the contested mark on 01 March 2012, the Opposer already has valid and existing registrations of its "PUMA" marks issued on 20 January 2003 under Certificate of Registration Nos. 4-1991-075843 and 4-1991-077447; "JUMPING CAT DEVICE" issued on 29 December 1977 and 01 July 2004 under Certificate of Registration Nos. 025562 and 4-1991-075842, respectively; and, "PUMA AND JUMPING CAT DEVICE" issued on 14 November 1988 under Certificate of Registration No. 0141861.

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

Opposer's marks:



Respondent-Applicant's mark:



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.⁶ 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 Opposer's registered marks consist of a jumping cat device, the word "PUMA" and/or the combination of the two. The Respondent-Applicant's mark, on the other hand, consists of a head of a feline with open mouth above the word "PAN". The competing marks are clearly distinguishable. There is no question that the "PUMA" mark is different from "PAN AND DEVICE". As to the "JUMPING CAT DEVICE" trademark, the same is also distinct and different from the applied mark. The Opposer's "JUMPING CAT DEVICE" mark features the whole body of a cat animal leaping towards the left direction whereas the applied mark features a head of a growling panther. While both marks feature felines, the presentations thereof are distinct from each other. More importantly, the word "PAN" accompanies the feline device in the Respondent-Applicant's mark thereby making confusion, mistake, much more deception, highly unlikely.

Moreover, the Trademark Registry of this Office reveals several other trademarks involving vehicles and/or automobiles that likewise employ wings in their trademarks, belonging to different proprietors, including:

⁶ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.



Registration No. 4-2009-011310



Registration No. 4-2014—007925



Registration No. 4-2008-012739

Hence, similarity in this aspect alone is not enough to prevent a junior user registration of its mark provided that the later mark is endowed with other distinguishing features and characteristics such as that of the Respondent-Applicant's.

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.⁷ The Respondent-Applicant's mark sufficiently met this function.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-500519 is hereby **DISMISSED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **19 MAY 2016**


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

⁷ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.