

DC COMICS,
Opposer,

-versus-

ROMMEL CASTILLOS SALES,
Respondent-Applicant.

X-----X

}
}
}
}
}
}
}
}
}
}

IPC No. 14-2011-00297
Opposition to:

Appln. Serial No. 4-2010-010794
Date Filed: 01 October 2010

TM: PLANET KRYPTON

NOTICE OF DECISION


QUISUMBING TORRES
Counsel for Opposer
12th Floor, Net One Center, 26th Street corner
3rd Avenue, Crescent Park West, Bonifacio Global City
Taguig City

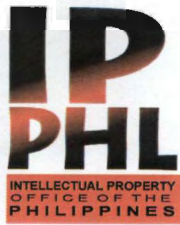
ROMMEL CASTILLO SALES
Respondent- Applicant
28 J. Elizalde Street, BF Homes,
Sucat, Parañaque City

GREETINGS:

Please be informed that Decision No. 2016 - 390 dated 21 October 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 21 October 2016.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



DC COMICS,	}IPC NO. 14-2011-00297
Opposer,	}Opposition to:
	}
-versus-	}Appln. Ser. No. 4-2010-010794
	}Date Filed: 1 October 2010
	}
ROMMEL CASTILLOS SALES,	}Trademark: "PLANET KRYPTON"
Respondent-Applicant.	}
	}
x-----x	}Decision No. 2016- 390

DECISION

DC COMICS, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2010-010794. The application, filed by ROMMEL CASTILLOS SALES, (Respondent-Applicant)², covers the mark "PLANET KRYPTON", for use on "superhero arts, prop replicas, memorabilia" under Class 28 and "statues store" under Class 35 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"a. Opposer is the prior user and first registrant of SUPERMAN, DAILY PLANET, KRYPTO, S IN SHIELD LOGO, SMALLVILLE, SUPERBOY, SUPERGIRL and KRYPTONITE trademarks in numerous countries, and have no doubt attained well-known status worldwide, including the Philippines, as marks belonging to DC Comics, well before the filing date of Respondent's PLANET KRYPTON trademark, which was only filed on 1 October 2010. xxx

"b. The Superman Trademarks, most relevant of which is KRYPTONITE, are well known trademarks, both internationally and in the Philippines. As such, Respondent's PLANET KRYPTON mark is identical and confusingly similar to, or constitutes a translation of, Opposer's Superman Trademarks, and thus runs contrary to Section 123 of the IP Code. Section 123 (e) and (g) of the IP Code provide:

Sec. 123. Registrability. - 123.1. A mark cannot be registered if it:

¹ A general partnership organized under the State of New York, U.S.A., with business address at 1700 Broadway, New York, New York 10019, U.S.A.

² Filipino with address at 28 J. Elizalde St. BF Homes Sucat Paranaque

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the World Intellectual Property Office, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark with 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 public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

(g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;

“c. Furthermore, Opposer is entitled to protection under Philippine law against marks that are liable to create confusion in the minds of the public or used in bad faith under Article 6bis of the Paris Convention, thus:

Article 6bis

Marks: *Well-known Marks*

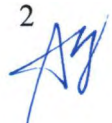
(1) The countries of the Union Undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use of a trademark which constitutes a reproduction, an imitation, or a translation considered by competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used on bad faith.

“d. If allowed to proceed to registration, the consequent use of the PLANET KRYPTON mark by Respondent will amount to unfair competition with and dilution of Opposer’s Superman Trademarks, which has attained valuable goodwill and reputation through years of extensive and exclusive use. This is prohibited under Section 168 of the IP Code.

Opposer’s goodwill is 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. xxx

“e. The registration of Respondent’s mark will work to impede the natural expansion of Opposer’s use of its Superman Trademarks in the Philippines;

“f. The *Superman* story, including planet *Krypton* and *Kryptonite*, popularized through numerous comic books (1938 to present), radio sets and audio books (1940 to 1951, 1955, 2008), television programs (1952 to 1958, 1966-1969, 1975, 1973 to 1984, 1988 to 1992, 1993 to 1997, 1996 to 2000, 2001 to 2011) stage plays (1966), short films (1941 to 1943), movies (1948, 1978, 1980, 1983, 1987, 2006), newspaper strips (1939 to 1966) and video games (1978, 1999), as well as the drawings of an exploding planet *Krypton* appearing on the 1986 issues of *The History of DC Universe No. 1* and *The Man of Steel No. 1*, are from the moment of creation, all protected by copyright. xxx

To support its opposition, the Opposer submitted as evidence the following:

1. Original Verified Notice of Opposition;
2. Affidavit of Pericles R. Casuela dated 22 August 2011;
3. Computer Print-out of screenshots from www.supermanhomepage.com; www.comics.org; store.supermansuperstore.com; www.supermuseum.com; and
4. Table of applications and registrations for Superman trademarks⁴

This Bureau served upon the Respondent-Applicant a “Notice to Answer” on 10 October 2011. The Respondent-Applicant, however, did not file an Answer.

Records show that at the time Respondent-Applicant applied for registration of the mark “PLANET KRYPTON”, the Opposer had registered the marks KRYPTONITE and KRYPTO THE SUPERDOG. A global database search yields an image of the mark KRYPTONITE.

The Opposer's mark is depicted below side by side with the Respondent-Applicants’:



Opposer’s mark



Respondent-Applicant’s mark

⁴ Exhibits “A” to “D” inclusive of submarkings

The word KRYPTON in Respondent-Applicant's mark is a play on the word KRYPTONITE. The mark PLANET KRYPTON is described as "a green planet exploding with debris in all directions"... a word planet krypton and a small space ship going out of the planet with a small baby inside". According to the Opposer, the mark is a scene referring to the popular comic series *Superman*. Superman, being a small baby inside a space ship who eventually found his way to earth. The Superman mythology includes *Kryptonite*, an element from Superman's home planet, *Krypton*, famous for the being responsible for the ultimate physical weakness of *Superman* and other *Kryptonians*. "The definition of **kryptonite** is Superman's ultimate weakness, or anything that causes someone's ultimate weakness. An example of **kryptonite** is the one food a person is seriously allergic to" (www.yourdictionary.com/kryptonite)⁵. The Opposer points out that the scenario of a green planet exploding is the interior artwork of the Opposer's *The History of the DC Universe No. 1* published in 1986 and the cover of July 1986 issue of Opposer's "The Man of Steel No. 1" are depicted below:



⁵ <https://www.google.com/search?q=kryptonite+meaning&ie=utf-8&oe=utf-8>



Obviously, the Opposer being the originator proved that it is the originator and creator of the *Superman* story, fictional planet KRYPTON and the element KRYPTONITE, forming essential parts of the story.⁶ The mark KRYPTONITE has been registered worldwide.⁷

Clearly, the Respondent-Applicant has no right to register a mark which he does not own. In *Birkenstock Orthopaedie GmbH & Co. Kg. v. Philippine Shoe Expo Marketing Corporation*,⁸ the Supreme Court held:

"It must be emphasized that registration of a trademark, by itself, is not a mode of acquiring ownership. If the applicant is not the owner of the trademark, he has no right to apply for its registration. Registration merely creates a prima facie presumption of the validity of the registration, of the registrant's ownership of the trademark, and of the exclusive right to the use thereof.xxx

In the instant case, petitioner was able to establish that it is the owner of the mark 'BIRKENSTOCK'. It submitted evidence relating to the origin and history of 'BIRKENSTOCK' and its use in commerce long before respondent was able to register the same here in the Philippines. It has sufficiently proven that 'BIRKENSTOCK' was first adopted in Europe in 1774 by its inventor, Johann Birkenstock, a shoemaker, on his line of quality footwear and thereafter, numerous generations of his kin continuously engaged in the manufacture and sale of shoes and sandals bearing the mark 'BIRKENSTOCK' until it became the entity now known as the petitioner."

This Bureau noticed that the Respondent-Applicant's business name registration is PLANET KRYPTON PROPS & MEMORABILIA STORE and trademark PLANET KRYPTON. It is likely therefore, that the buying public may be confused or misled into

⁶ Exhibit "C"

⁷ Exhibit "D" and "B"

⁸ G.R. No. 194307, 20 November 2013

thinking that the services/goods of the Respondent-Applicant bearing the mark PLANET KRYPTON originate or are sponsored by the Opposer.

Succinctly, because the Respondent-Applicant uses its mark on goods/services that are similar or closely related to the Opposer's goods (16,25,28) it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:


Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.⁹

The public interest, therefore, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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.¹⁰

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-010794 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 21 OCT 2016


Atty. ADORACION U. ZARE, LL.M.
Adjudication Officer
Bureau of Legal Affairs

⁹*Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

¹⁰*Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).