

PUMA SE,
Opposer,

-versus-

OCEAN HARVEST TRADING LIMITED,
Respondent-Applicant.

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IPC No. 14-2013-00043
Opposition to:
Appl. Serial No. 4-2012-009783
Date Filed: 09 August 2012

TM: KROOBERG LOGO

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 521 dated 23 December 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 06 January 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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| Opposer, | } Opposition to: |
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| -versus- | } Appln. Ser. No. 4-2012-009783 |
| | } Date Filed: 9 August 2012 |
| | } |
| OCEAN HARVEST TRADING LIMITED, | } Trademark: "KROOBERG LOGO" |
| Respondent-Applicant. | } |
| x-----x | } Decision No. 2016- 521 |

DECISION

PUMA SE, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2012-009783. The application, filed by OCEAN HARVEST TRADING LIMITED (Respondent-Applicant)², covers the mark "KROOBERG LOGO", for use on "Clothing goods, namely: pants, shirts, polo shirts, t-shirts, tank tops, vests, suits, night shirts, night gowns, pullovers, undershirts, jackets, shorts, pajamas, blouses, sportswear, jogging suits, blazers, swimsuits, babywear, underpants, gloves, scarves, belts, money, belt, socks, suspenders, coats, cyclists' clothing, hoods, overalls, jumper, wristbands, footwear namely: shoes, sports shoes, casual shoes, slippers, sandals, shoes for children, boots, footwear, footwear accessories (uppers, fittings, topees, heelpieces, welts, non-slipping devices); and headgear namely: caps, headbands, visors, hairbands; and berets" under Class 25 of the International Classification of Goods³.

The Opposer anchors its opposition on the ground that Puma will be damaged by the registration of Ocean Harvest's "Krooberg Logo". According to the Opposer the registration of "Krooberg Logo" is prohibited under Sections 123.1 (d), (e) and (f) of Republic Act 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code") which provides that:

Sec. 123.1. Registrability. 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

¹ A corporation organized under European law, German law with address at office at Puma Way 1, Herzogenaurach.

² A corporation organized in Hong Kong with address at Flat/Rm 1508 Hing Yip Commercial Centre, 272-284 Des Voeux Road, Central, Hong Kong

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

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(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 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;

(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 and services which are not similar to those with respect to which registration is applied for: *Provided*, that the use of the mark in relation to the 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.”

The Opposer submitted as evidence the Affidavit of Mr. Jochen Lederhilger and Dietmar Knoess; List of locations of stores selling Puma goods; Samples of advertising of Puma in magazines and articles.⁴

The Respondent-Applicant filed its Answer on 17 July 2013, alleging among other things, the following defenses:

“Opposer’s Formstrip Device is not similar/confusingly similar or substantially similar to Respondent’s KROOBERG LOGO. xxx

“15. For emphasis, Opposer’s Formstrip Device is simply a stylized sideway ascending band, narrow on the upper portion and wider at the bottom part; much like a shortened boomerang ascending wider on one end.

“16. On the other hand, Respondent’s KROOBERG LOGO resembles the silhouette of a pointed beak with a wide base and a bard pointing upward to the right tip of the nose; depicting a belting Kingfisher symbolizing agility and grace. xxx

“18. In the above ‘false representation’, Opposer deliberately stretched the upper portion of Respondent’s mark and rendered hidden the beak portion to suit the alleged similarity/confusing and/or substantial similarity to its Formstrip Devices. xxx

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

“Respondent is promoting, marketing and building the KROOBERG LOGO using its own resources and pool of brand ambassadors, without any association with and/or connection with the Opposer.xxx”

The Respondent-Applicant submitted as evidence the following: Affidavit – testimony of Jose Raul S. Limpo; Certificate of Incorporation No. 894867; Trademark Application for the KROOBERG LOGO; pictures of shoe products with the KROOBERG LOGO; pictures of stores 7-16 wherein products bearing KROOBERG LOGO is used; photos of events 17-29 involving KROOBERG LOGO; representative photos of brand ambassadors; 30-34 and File of trademark application for KROOBERG LOGO.

The Preliminary Conference was held on 29 June 2016 wherein the parties were directed to file their respective position papers. The Opposer submitted its position paper on 18 July 2016 and its Supplemental Position paper on 16 October 2016. The Respondent-Applicant filed its position paper on 19 July 2016.

Should the Respondent-Applicant be allowed to register the trademark KROOBERG LOGO?

The records show that at the time Respondent-Applicant applied for registration of the mark “KROOBERG LOGO” on 9 August 2012, the Opposer already has existing registrations⁵ for the marks “PLAIN FORMSTRIP” under Reg. No. 042074 issued on 28 November 1988; “FORMSTRIP” under Reg. No. 026702 issued on 15 February 1979; and “FORMSTRIP” under Reg. No. issued on 20 December 2012.

The question is: Are the competing marks, depicted below, identical or closely resembling each other such that confusion or mistake is likely to occur?

Opposer’s marks



Respondent-Applicant’s mark



As seen, the marks are not the same. The Respondent-Applicant’s mark looks like the silhouette of a Kingfisher bird, while the Opposer’s mark is described as a strip being narrower at the upper parts and gradually widens at the bottom. Because of the appearance of a wide base and a tapering upper part, the Opposer insists on the confusing similarity between the two marks. In this regard, the Bureau lends credence to Respondent-Applicant’s explanation that the characterization by a stylized and ascending band is ‘artistically common’ in shoes and footwear brands, such as Brooks, Li Nng,

⁵ Exhibit “A”

Onitsuka Tiger and Mizuno. We reproduce a portion of Respondent-Applicant's Answer on page 8:



As seen, other marks applied on footwear use as their logo, the representation of strips with varied combinations or degrees of a wider base, tapering to the top or slanting upwards. Each of the marks appearing above is unique.

Records also show that both parties' actual marks applied to their respective goods, convey different commercial impressions, as seen below:

Opposer's goods (par.31. of the Opposition)



Respondent-Applicant's goods (Exhibit "6")




Visually, the marks are distinguishable from each other. Thus, the likelihood that confusion or deception may result in the contemporaneous use of the marks is remote.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-009783 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, 23 DEC 2016


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