

CALVIN KLEIN TRADEMARK TRUST,
Opposer,

-versus-

**ERCAN SAAT SANAYYI VE TICARET
LIMITED SIRKETI,**
Respondent-Applicant.

X-----X

IPC No. 14-2014-00417

Opposition to:

Appln. Serial No. 1180660

Date Filed: 19 March 2013

TM: dk DANIEL KLEIN

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 50 dated 24 February 2017 (copy enclosed) was promulgated in the above entitled case.

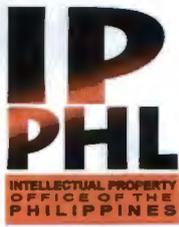
Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 24 February 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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CALVIN KLEIN TRADEMARK TRUST, }
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 ERCAN SAAT SANAYYI VE TICARET }
 LIMITED SIRKETI, }
 Respondent-Applicant. }

IPC No. 14-2014-00417
 Opposition to:
 Application No. 1180660
 Date Filed: 19 March 2013
 Trademark: "dk DANIEL KLEIN"

Decision No. 2017- 50

DECISION

CALVIN KLEIN TRADEMARK TRUST¹ ("Opposer") filed an opposition to Trademark Application Serial No. 1180660. The application, filed by Ercan Saat Sanayyi Ticaret Limited Sirketi² ("Respondent-Applicant"), covers the mark "dk DANIEL KLEIN" for use on *"apparatus and instruments for recording, transmission or reproduction of sound, data and images, computer programs for data processing, magnetic and optical data carriers; antennas, satellite antennas, component parts for antennas; coin-operated mechanisms for vending machines, ticket dispensers, automated banking machines, connectors for electronic circuits, counters and electronic timers, clothing for protection against accidents, lifesaving apparatus and equipment, eyeglasses, sunglasses, contact lenses, contact lens cases, containers for contact lenses; access control and alarm monitoring systems, alarm bells, electric, traffic-light apparatus (signalling devices), fire extinguishers; fire hose nozzles; sprinkler systems for fire protection; fire alarms; radar apparatus, radars sonars, night vision goggles, electro-dynamic apparatus for the remote control of signals; electrolyzers, galvanometers, anodes, cathodes; magnets, decorative magnets"* under Class 09, *"precious metals and their alloys, namely, gold, silver, platinum; precious stones, jewelry made of precious metal or coated therewith, namely, bracelets, rings, charms, necklaces, ear clips, cuff-links, earrings, ornamental pins, tie pins, pendants, rings being jewelry, medallions, brooches, personal ornaments jewellery, trinkets, namely, key rings, statues of precious metal, busts of precious metal; horological and chronometric instruments and parts and accessories thereof, namely, chronometers, wrist watches, pocket watches, jewelry watches, wall clocks, table clocks, watch bands, watch straps, watch bracelets, watch chains, cases for watches and clocks, and replacement parts for watches and clocks"* under Class 14, *"non-electronic cleaning utensils (including brushes except for painting brushes, steel chips, sponges, steel wool, cleaning wool, cleaning and wiping clothes made of textile, dish washing gloves, non-electric polishing machines, carpet brooms, mops); toothbrushes, electrical toothbrushes, dental floss, shaving brushes, hair brushes, combs; non-electrical devices for household and kitchen use included in this class; ironing boards, ironing board covers, laundry drying mechanisms, cloth hangers; cages and materials for pets, plant and*

¹A foreign corporation duly organized and existing under the laws of Italy with principal offices at Via Goldoni, 10-20129 Milano, Italy.
²With address at 11 Galaxy St., Concorde Village, Tambo Paranaque City, Philippines.

animal raising areas used in the household (terrariums); ornamental and decorative articles made of glass, porcelain, ceramic, clay; mouse traps, insect traps, fly catchers, fly rackets, covers for toilet holes; perfume burners (burners giving off scents when lit), perfume sprays and vaporizers (atomizers); non-electric devices for removing make-up, powder puffs, boxes for toilet articles; spraying hose heads, heads for water sprinklers, watering apparatus, garden-watering sprinklers, tips connected to faucets; unprocessed glass, semi-processed glass, glass mosaics and glass powder for decorative purposes (except for construction), glass wool (not for insulation and textile purposes) under Class 21 and "clothing, footwear, headgear" under Class 25 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"The grounds for the opposition to the registration of the respondent-applicant's trademark are as follows:

"1. A trademark 'dk DANIEL KLEIN' of the Respondent-Applicant resembles the trademarks 'CALVIN KLEIN', 'CK LOGO', 'CK ONE' and 'CK CALVIN KLEIN' of opposer and that the use of 'dk DANIEL KLEIN' to the goods and/or services of the respondent-applicant would indicate a connection between opposer's goods and those of respondent-applicant to the damage and prejudice of the opposer's goodwill and interest. There is very close similarity of the respondent-applicant's mark to that of opposer specifically when used in the same classes of goods. In other words, the use of respondent-applicant's mark 'dk DANIEL KLEIN' will cause confusion or mistake upon and/or deceive purchasers or customers in that they will tend to believe that respondent-applicant's goods come from the opposer. Hence, under the trademark law or rules the trademark 'dk DANIEL KLEIN' cannot be registered in favor of respondent-applicant for being deceptive and likely to cause confusion.

"2. With a history or more than twenty years, opposer is operating its business in many countries of the world and its products are marketed almost all over the world.

"3. Opposer has registered and commercially used the trademarks 'CALVIN KLEIN', 'CK LOGO', 'CK ONE' and 'CK CALVIN KLEIN' and their variations in different countries of the world including the Philippines under Certificates of Registration Nos. 46542 issued on September 27, 1989; 4-1994-433376, 66144 both issued on July 28, 1998; 4-1996-110657 issued on August 28, 2000; 4-1996-110656 issued on February 16, 2001; 4-1996-110658 issued on March 1, 2001; 4-1997-119613 issued on July 14, 2001; 4-1996-111158d, 4-1996-111165, 4-1996-111166 all issued on July 1, 2004; 4-1996-107278, 4-1996-189448 both issued on February 24, 2005; 4-1996-107279 issued on July 1, 2005; 4-1996-191155 issued on January 21, 2006; 4-1994-90400 issued on March 18, 2006; 4-1996-90399 issued on April 28, 2006; 4-2006-000968 issued on December 24, 2009; and 4-2012-010298 issued on May 9, 2013.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

"4. Opposer is likewise the prior user of the marks 'CALVIN KLEIN', 'CK LOGO', 'CK ONE' and 'CK CALVIN KLEIN' since said marks had been used much earlier than respondent-applicant as opposer has been organized and existing many years ago while respondent-applicant has only applied for registration only on March 19, 2013.

"5. The trademark 'dk DANIEL KLEIN' is deceptively and confusingly similar to opposer's marks 'CALVIN KLEIN', 'CK LOGO', 'CK ONE' and 'CK CALVIN KLEIN' that when used to the same classes, the latter will be damaged and prejudiced and/or may cause dilution by blurring.

"6. Opposer has already spent much for the advertisements and promotions of their marks. Hence, its business and goodwill will clearly be damaged and will suffer irreparable injury by the registration of the confusingly similar mark 'dk DANIEL KLEIN' by the Respondent-Applicant.

"Opposer relies on the following facts to support its opposition explicitly reserving the right to present other evidence to prove these facts and others as may appear necessary in the course of the proceedings.

"a. The trademark 'dk DANIEL KLEIN' of Respondent-Applicant is very similar to 'CALVIN KLEIN', 'CK LOGO', 'CK ONE' and 'CK CALVIN KLEIN' of Opposer and similar also with respect to the goods (Classes 9, 14 and 25) to which they are being used.

"b. The trademarks 'CALVIN KLEIN', 'CK LOGO', 'CK ONE' and 'CK CALVIN KLEIN' of Opposer had been used and applied for registration much ahead than Respondent-Applicant.

"c. The trademarks 'CALVIN KLEIN', 'CK LOGO', 'CK ONE' and 'CK CALVIN KLEIN' of Opposer are recognized and well known marks in many countries of the world that are members of the Paris Convention and the World Trade Organization. Hence, entitled to the protection of said organizations.

"d. Considering that Opposer's trademarks 'CALVIN KLEIN', 'CK LOGO', 'CK ONE' and 'CK CLAVIN KLEIN' are known locally and internationally, they deserve protection under the Intellectual Property Code of the Philippines particularly Section 123, 134, and 147 and other relevant Sections thereof.

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 03 February 2015. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark dk DANIEL KLEIN?

Sec. 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides:

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



x x x

- (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;”

Records show that at the time the Respondent-Applicant filed its trademark application on 19 March 2013, the Opposer already owns trademark registrations in the Philippines for “CALVIN KLEIN”, “CK LOGO”, “CK ONE” and “CK CALVIN KLEIN” covering goods in classes 3, 9, 14, 16, 18, 25, 35, 42, among others.

Hence, the question, does dk DANIEL KLEIN resemble CK CALVIN KLEIN such that confusion or deception is likely to occur? The marks are shown below:

Calvin Klein



Opposer's trademarks

dk DANIEL KLEIN

Respondent-Applicant's mark

Confusion is likely in this instance because of the close resemblance between the marks and that the goods covered by the competing marks are similar or that the goods are intimately-related. Respondent-Applicant's mark “dk DANIEL KLEIN” adopted the dominant features of Opposer's trademarks “CALVIN KLEIN” and “CK CALVIN KLEIN”. “dk DANIEL KLEIN” appears almost the same as Opposer's trademark CK CALVIN KLEIN. Both “dk DANIEL KLEIN” and “CK CALVIN KLEIN” marks contain the dominant word or name “KLEIN” with a male first name before it and both marks are composed of CK or DK before the first and last names. Respondent-Applicant merely changed the male first name to DANIEL to come up with the mark “dk DANIEL KLEIN”. Also, the Respondent-Applicant uses or will use the mark on goods that are exactly the same as or closely-related to the goods the Opposer deals in, i.e., goods under Classes 3, 9, 14, 16, 18 and 25. As such, there is likelihood that the public will be confused or mistaken into believing that Respondent-Applicant's mark is just a variation of Opposer's mark or that their goods come from the same source or manufacturer.

The confusion or mistake would subsist not only on 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.⁴

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.⁵

Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why of the millions of terms and combinations of letters and designs available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁶

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

In conclusion, the subject trademark application is covered by the proscription under Sec. 123.1 (d) (iii) of the IP Code.

⁴ *Converse Rubber Corp. v. Universal Rubber Products, Inc. et. al.*, G.R. No. L-27906, 08 Jan. 1987.

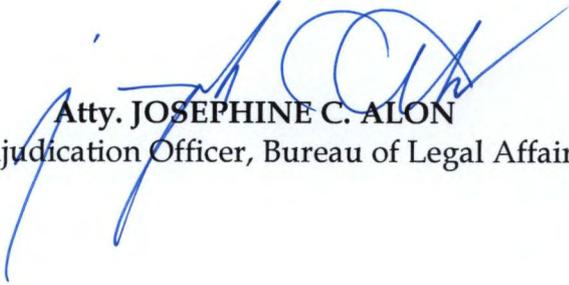
⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Eithepa v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

⁶ *American Wire & Cable Company v. Director of Patents*, G.R. No. L-26557, 18 Feb. 1970.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 01180660 is hereby SUSTAINED. 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, 24 FEB 2017.


Atty. JOSEPHINE C. ALON
Adjudication Officer, Bureau of Legal Affairs