

E.I. DU PONT DE NEMOURS & CO.,
Opposer,

-versus-

ELTON SIOCO,
Respondent-Applicant.

X-----X

IPC No. 14-2014-00161

Opposition to:

Appln. Serial No. 4-2013-009454

Date Filed: 08 August 2013

TM: KEVLAR

NOTICE OF DECISION

JDF LAW

Counsel for Opposer
1502 One Global Place
5th Avenue corner 25th Street,
Bonifacio Global City, Taguig City

ELTON SIOCO

Respondent- Applicant
No. 41 Kapiligan Street,
Doña Imelda, Quezon City

GREETINGS:

Please be informed that Decision No. 2017 - 64 dated 10 March 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, 13 March 2017.

MARILYN F. RETUAL
IPRS IV

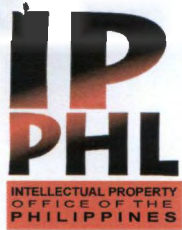
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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Opposer,	}	Opposition to:
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-versus-	}	App. Ser. No. 4-2013-009454
	}	Date Filed: 08 August 2013
ELTON SIOCO,	}	Trademark: KEVLAR
Respondent-Applicant.	}	
x-----x		Decision No. 2017 - <u>64</u>

DECISION

E.I. DU PONT DE NEMOURS & CO. ("Opposer")¹ filed an Opposition to Trademark Application Serial No. 4-2013-009454. The application filed by ELTON SIOCO ("Respondent-Applicant")², covers the mark KEVLAR for use on goods such as " disc brake pads " under class 12 of the International Classification of Goods³.

Opposer alleges the following grounds for opposition:

"a. Opposer's KEVLAR is an internationally well-known mark entitled to protection under the provisions of the IP Code and Articles 6bis of the Paris Convention;

"b. The registration of the mark KEVLAR in the name of Respondent-Applicant will violate and contravene Section 123.1, subparagraph (f) of the Intellectual Property Code of the Philippines (R.A. 8293), as amended.

xxx

"c. Opposer is the owner and prior user of the mark KEVLAR which has long been used to identify its goods and products.

"d. The registration and use of the trademark KEVLAR by Respondent-Applicant will diminish the distinctiveness and dilute the goodwill of the Opposer's trademark KEVLAR.

¹ A corporation organized and existing under the laws of Delaware, U.S.A. with principal office address at 1007 Market Street, Wilmington, Delaware 19898 U.S.A.

² A Filipino citizen with address at No. 41 Kapiligan Street Doña Imelda, Quezon City.

³The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

The Opposer's of evidence consists of the following:

1. Special Power of Attorney;
2. Printout of relevant pages of Opposer's website <http://www.dupont.com>;
3. Certified copy of Opposer's Charter/ Certificate of Incorporation;
4. Certified copy of Philippine Registration No. 61427 issued on 22 August 1995;
5. Certified copy of Philippine Registration No. 60171 issued on 29 March 1995;
6. Authenticated Affidavit-Direct Testimony of Giselle Ruiz Arthur;
7. Certified copy of the trademark registration for KEVLAR issued in Switzerland;
8. List of KEVLAR registrations and pending applications in various jurisdictions;
9. List of authorized licencees of products made of KEVLAR fibers;
10. List of oppositions filed in many jurisdictions;
11. Representative samples of certificates of registration for the mark KEVLAR issued in Australia, Malaysia, Switzerland, Great Britain and Northern Island, Hong Kong, South Africa, Thailand, Canada, Indonesia, Slovenia, China, Japan, OHIM, Brazil and the U.S.A ;
12. Affidavit-Direct Testimony of Jennifer Fajelagutan; and
13. Printouts of relevant pages of various websites containing information about KEVLAR.

This Bureau issued a Notice to Answer on 02 July 2014 and served the same to Respondent-Applicant on 8 July 2014. Despite receipt of the Notice, Respondent-Applicant failed to file the answer. On 12 November 2014, this Bureau issued Order No. 2014-1494 declaring Respondent-Applicant in default. Thus, this case is deemed submitted for resolution.

Should the Respondent-Applicant be allowed to register the mar KEVLAR?

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.⁴

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

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

xxx

(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:

⁴ See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

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- 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;

Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, or to a well-known mark, said mark cannot be registered.

Records will show that at the time the Respondent-Applicant filed its trademark application on 08 August 2013, Opposer has already obtained a registration for its mark KEVLAR on 22 August 1995, almost eighteen (18) years earlier. In fact, it was first registered in 17 April 1973 in Switzerland. As such, pursuant to Section 138 of the IP Code, being a holder of a certificate of registration, such "certificate of registration is a prima facie evidence of the registrant's ownership of the mark, and of the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto."

But are the marks confusingly similar as to likely cause confusion on the part of the public?

The parties marks are herein reproduced:

KEVLAR

Opposer's Mark

KEVLAR

Respondent-Applicant's Mark

Indubitably, the marks of the parties are confusingly similar if not identical because both marks contain the word KEVLAR. Also, the competing marks are mere word marks written in plain uppercase letters. Aside from the slight difference in the font used which is very insignificant, there is no other difference that can be observed between them. Thus, the similarity between the mark would likely cause confusion, mistake or deception on the part of the public that the competing marks are one and the same or that it is owned by one and the same person or entity. A boundless choice of words, phrases and symbols is available to one who wishes a trademark sufficient unto itself to distinguish his product from those of others. When, however, there is no reasonable explanation for the defendant's choice of such a mark though the field for his selection was so broad, the inference is inevitable that it was chosen deliberately to deceive.⁵

As to the goods, Opposer's mark is used on "*man-made fibers for generalized use in industrial arts*" under Class 22 and "*yarns*" under Class 23. On the other hand, Respondent-

⁵ *Converse Rubber Corporation vs. Universal Rubber Products, Inc., G.R. No. L-27906. January 8, 1987.*

Applicant's mark is being applied for use on "disc brake pads" under Class 12. It would seem that the goods of the parties are different and non-competing. However, a further scrutiny of the evidence submitted by Opposer would show that KEVLAR products are used on many industrial products from consumer products, military body armor, fire resistant mattresses, firefighter gears, fiber optics, automotive components and reinforcement and even for *brake pads, clutches and gaskets* which is similar or closely related to Respondent-Applicant's "disc brake pads". Thus, to allow the registration of the Respondent-Applicant's mark KEVLAR would likely cause confusion, mistake or deception, on the part of the public, into believing that Respondent-Applicant's disc brake pads are made of Opposer's KEVLAR fibers or that its goods are made under the sponsorship of Opposer.

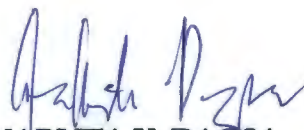
The protection of trademarks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trademark is a merchandising shortcut, which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, due aim is the same – to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trademark owner has something of value. If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress.⁶

Accordingly, the registration of Respondent-Applicant's mark is proscribed by Section 123.1(d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-009454 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, TO MAR 2017.


MARLITA V. DAGOSA
Adjudication Officer
Bureau of Legal Affairs

⁶ *Societe Des Produits Nestle, Et. Al. vs. Court of Appeals. G.R. No. 112012. April 4, 2001*