

AUDI AG,
Opposer,

-versus-

YONG LIN ZHENG,
Respondent-Applicant.

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IPC No. 14-2014-00293

Opposition to:

Appln. Serial No. 4-2014-004058

Date Filed: 02 April 2014



TM:

NOTICE OF DECISION

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YONG LIN ZHENG

Respondent- Applicant
29 A. Sen. M. Cuenco Sr. Street,
Brgy. Sta. Teresita, Quezon City

GREETINGS:

Please be informed that Decision No. 2017 - 144 dated 25 April 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, 25 April 2017.

MARILYN F. RETUTAL
IPRS IV

Bureau of Legal Affairs

AUDI AG,
Opposer,

-versus-

YONG LIN ZHENG,
Respondent-Applicant.

} **IPC NO. 14-2014-00293**

} Opposition to:

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} Application No. 4-2014-004058

} Date filed : 2 April 2014


} Trademark: 

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x-----x } Decision No. 2017 144

DECISION

AUDI AG, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2014-004058. The application, filed by YONG LIN ZHENG. (Respondent-Applicant)², covers the mark “”, for use on “LCD screen protectors, batteries, battery chargers, universal battery chargers (for cellphones, tablets and I phones), headsets, earphones, power banks (for cellphones, tablets and I phones) USB cables, USB’s, memory cards and bags and cases specifically adapted for holding or carrying cellular phones or pouch” under Class 9 of the International Classification of Goods³.

The Opposer relies on the following grounds in support of its Opposition:

“10. The mark  being applied for by respondent-applicant is identical to opposer’s well-known trademark , registered worldwide, as to likely, when applied to or used in connection with the goods of respondent-applicant, cause confusion, mistake and deception on the part of the purchasing public.

“11. The registration of the trademark  in the name of the responden-applicant will violate is contrary to the provisions of Sections 123.1, subparagraph (d), and (f) of Republic Act No. 8293, as amended, which prohibits the registration of a mark that:

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

¹ A corporation organized and existing under the laws of Germany, with business address at D-85045 Ingolstadt, Bavaria, Germany
Germany



² With address at 29A Sen. M. Cuenco Sr. Street, Barangay Sta. Teresita Quezon City


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.

“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.

(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 and 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;

“12. The registration and use by respondent-applicant of the mark  will diminish the distinctiveness and dilute the goodwill of opposer’s well-known trademark .

“13. The registration of the trademark  in the name of the respondent-applicant is contrary the provisions of the Intellectual Property Code of the Philippines.”

The Opposer, among other things, also alleges that:


“The trademark  of respondent-applicant Yong Lin Zheng is confusingly similar with the world famous and registered trademark  of opposer Audi AG. The published mark  consists of four rings intertwined horizontally in a manner that is very similar to Audi AG  device.

“15. The size of the rings and the manner the rings are looped together to form a ‘four ring device’ is uncannily similar to that of Audi AG’s mark. the marks are confusingly similar with each other in terms of appearance. The potential confusion is therefore real. Xxx


“48. While the opposer’s mark is only registered for goods under classes 36 and 37 in the Philippines, goods under class 9 are still within the opposer’s scope of potential expansion of business. xxx”


The Opposer submitted as evidence the following:

1. List of  trademark registrations worldwide;

2. Copy of Certificate of Registration No. 42005010887 for the trademark  issued by the Intellectual Property Office of the Philippines;
3. Copy of Certificate of Registration No. 41997116471;
4. Copy of Certificate of Registration No. 41997116472;
5. Photographs of AUDI dealer location in Greenhills, Global City and Alabang;
6. Promotional, marketing and advertising materials;
7. CD-ROM of advertisements of the Opposer;
8. Screenshots of <http://www.audi.com>;
9. Audi AG Annual Report for the year 2013;
10. Secretary's Certificate dated 25 August 2014; and
11. Notarized and legalized Affidavit –testimony of witness Annette Krah⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 20 December 2014. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 9 September 2015 Order No. 2015-1407 declaring the Respondent-Applicant in default.

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

The records show that when the Respondent-Applicant filed his application on 2 April 2014, the Opposer already had Certificate of Registration no. 4-2005-010887⁵ for the trademark  issued on 16 October 2006 covering goods under Class 12 namely, "vehicles and their designed parts under Class 12" and Class 37, namely "Repair and maintenance of vehicles".

But are the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

Opposer's mark

Respondent-Applicant's mark



The evidence shows that the Opposer uses the AUDI & FOUR RINGS LOGO, wherein the size of the rings and the manner by which the rings are looped form a "four ring device" which is exactly how the Respondent-Applicant devised his mark. Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur. We observe that the Respondent-Applicant's logo has "broken" rings with the end portions devised as arrows making the over-all look dissimilar. Therefore, there is no likelihood of confusion among the purchasing public.

⁴⁴ Exhibits "A" to "N" with submarkings

⁵ Exhibit "C"

Besides, even if the marks of the parties utilize four rings, the kind, nature or type of goods upon which the marks are to be applied must be considered in determining the likelihood of confusion. The Opposer uses its mark on Class 12 namely, "vehicles and their designed parts" and Class 37, namely "Repair and maintenance of vehicles" while the Respondent-Applicant uses his mark on "LCD screen protectors, batteries, battery chargers, universal battery chargers (for cellphones, tablets and I phones), headsets, earphones, power banks (for cellphones, tablets and I phones) USB cables, USB's, memory cards and bags and cases specifically adapted for holding or carrying cellular phones or pouch" under Class 9. Because the marks are used on products of different nature, confusion and deception is unlikely. There is no likelihood of confusion of business. The goods are unrelated and non-competing. The channels of trade where the goods flow are worlds apart. The target market or consumers are also different, thus it is unlikely that the public would be vulnerable to confusion much less deception.

In Canon Kabushiki Kaisha v. Court of Appeals⁶ the Supreme Court held:


xxx petroleum products on which the petitioner therein used the trademark ESSO, and the product of respondent, cigarettes are "so foreign to each other as to make it unlikely that purchasers would think that petitioner is the manufacturer of respondent's goods". Moreover, the fact that the goods involved therein flow through different channels of trade highlighted their dissimilarity xxx

Thus, the evident disparity of the products of the parties in the case at bar renders unfounded the apprehension of petitioner that confusion of business or origin might occur if private respondent is allowed to use the mark CANON."

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-004058 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, 25 APR 2017


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