

IROBOT CORPORATION,
Opposer,

-versus-

CLAUDIA INDIG PAYUSAN,
Respondent- Applicant-Assignee.

x-----x

IPC No. 14-2015-00372
Opposition to:
Appln. Serial No. 4-2012-013479
Date Filed: 06 November 2012
TM: I-ROBOT

NOTICE OF DECISION

VERA LAW
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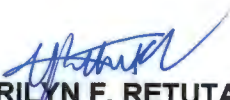
CLAUDIA INDIG PAYUSAN
Respondent-Applicant-Assignee
658 Carlos Palanca Street
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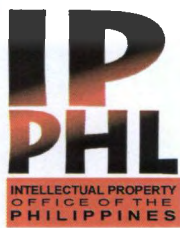
GREETINGS:

Please be informed that Decision No. 2017 - 90 dated March 23, 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOP HL 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, March 24, 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



IROBOT CORPORATION,
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- versus -

CLAUDIA INDIG PAYUSAN
Respondent-Applicant.

x-----x

IPC No. 14-2015-000372

Opposition to:
App. Ser. No. 4-2012-013479
Date Issued: 06 November 2012
Trademark: "I-ROBOT"

Decision No. 2017 - 90

DECISION

IROBOT CORPORATION,¹ ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2012-013479. The application filed by CLAUDIA INDIG PAYUSAN,² ("Respondent-Applicant"), covers the mark "I-ROBOT" for use on "cell phone, mid, led/lcd/crt television, DVD player, microphone, speakers, amplifier, radio, battery, SD card, USB" under Class 09 of the International Classification of Goods.³

Opposer alleges the following grounds:

I. RESPONDENT-APPLICANT'S 'i-Robot' MARK IS A REPRODUCTION OF OPPOSER'S INTERNATIONALLY WELL-KNOWN MARK 'IROBOT' AND ITS FAMILY OF MARKS.

II. RESPONDENT-APPLICANT'S TRADEMARK APPLICATION FOR i-Robot SHOULD BE REJECTED BECAUSE IT IS CONFUSINGLY SIMILAR WITH OPPOSER'S INTERNATIONALLY REGISTERED MARK 'I-ROBOT'.

III. RESPONDENT-APPLICANT'S TRADENAME IS ACCORDED PROTECTION UNDER THE PARIS CONVENTION AND SECTION 165 OF THE INTELLECTUAL PROPERTY CODE."

Opposer's evidence consists of the following:

1. Print-out of the relevant page of IPOPHL E-Gazette showing details of Application Serial No. 4-013479 for the mark i-Robot;
2. Order dated 11 August 2015 in IPC No. 14-2015-00372;
3. Authenticated Special Power of Attorney and Verification and Certification of Non-Forum Shopping;
4. Print-out of search result for IROBOT in Trademark Electronic Search System of the USPTO;
5. Authenticated and legalized Affidavit-Direct Testimony of Ms. Tonya Drake;
6. Certified copy of iRobot's History;
7. Certified copy of iRobot profile in NASDAQ's website;

¹A foreign corporation organized and existing under the laws of the State of Delaware, U.S.A. with principal office at 8 Crosby Drive, Bedford Massachusetts, U.S.A.

²A Filipino citizen with address at 658 Carlos Palanca Sr. Street Quaipe, Manila.

³The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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8. Printout of the iRobot STEM project from the website www.irobot.com;
9. List of products registered under the name iRobot found in their website;
10. List of awards received as shown in the Opposer's website;
11. Reviews of iRobot products found in their website;
12. Relevant pages of magazines and websites where iRobot is advertised;
13. Screenshot of Opposer's website;
14. Copy of iRobot's 2014 Annual Financial Report;
15. iRobot's Annual Income Statement;
16. List of registration for the mark iRobot in the name of Opposer in various countries;
17. Representative samples of certificates of registration for the mark IROBOT in the name of Opposer issued in Argentina, Brazil, Chile, China, Colombia, Costa Rica, Dominican Republic, OHIM, Hong Kong, Japan, Jordan, Kuwait, Macau, Mexico, New Zealand, Norway, Peru, Russia, Saudi Arabia, South Africa, Turkey, U.A.E., U.S.A and Venezuela;
18. Affidavit-Direct Testimony of Cherylette p. Lingao;
19. Printout of iRobot's facebook account

On 01 February 2016, this Bureau issued a Notice to Answer and personally serve to Respondent-Applicant on 22 February 2016. On 18 March 2016, Respondent-Applicant filed the Answer alleging the following Affirmative Defenses:

"1. Respondent-Applicant has filed the application for registration of the 'i-Robot' mark under Class 9 in good faith for lack of sufficient prior knowledge of Opposer's IROBOT mark; and

2. 'i-Robot' mark is not confusingly similar with Opposer's IROBOT mark."

Respondent-Applicant's evidence consists of the following:

1. Copy of Certificate of Copyright Registration and Deposit in the name of Respondent-Applicant;
2. Copy of Manifestation filed on 09 December 2015 regarding the Assignment of Application of Trademark i-Robot;
3. Copy of the Notice of Recordal for the mark iRobot together with the copy of the Assignment of Trademark Application;
4. Copy of Notice to Answer in IPC No. 14-2015-00372;
5. Copy of representative sample of Sales Invoice issued by Chaison Trading Corp.;
6. Copy of the General Information Sheet of Chaison Trading Corp. filed with the Securities and Exchange Commission;
7. Photocopy of Statement of Account issued by Pilipino Star Ngayon, Inc. to IROBOT for its advertising contract;
8. Original copy of Pilipino Star Ngayon issue dated July 5, 12, 19, and 26 where i-Robot mobile phones are advertised in the front page;
9. Photocopy of photos of i-Robot stalls located in SM Sangandaan, SM Fairview and SM Bicutan;
10. Printout of pages from website www.irobotmobile.com; and
11. Advertising materials for iRobot mobile phones.

Pursuant to Office Order No. 154, s. 2010, the case was referred to the Alternative Dispute Resolution ("ADR") for mediation on 30 March 2016. However, the parties refused to mediate. After the termination of the preliminary conference, the parties were directed to file their position papers. On 21 September 2016, Opposer filed its Position Paper. Respondent-Applicant did not file its position paper.

Should the trademark **i-Robot** be allowed registration?

Section 123.1 (d) and (e) of Republic Act No. 8293, otherwise 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:

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;

x x x

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

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 resembles a well-known mark, said mark cannot be registered.

The marks of the parties are herein reproduced for comparison:

iRobot[®]

Opposer's Marks

i-Robot

Respondent-Applicant's Mark

There is no doubt that the Respondent-Applicant's mark is similar to the Opposer's mark because they both use the word "iRobot". Although they are presented differently, that is, Opposer's mark is written in plain italicized letter in green color and as a single word while that of Respondent-Applicant is written in plain black letters with the letter "i" and the word "robot" separated by a hyphen, such difference is very trivial compared to the glaring similarities between the marks.

However, the similarity in the appearance of the applied mark to another mark does not automatically bar its registration. A similar mark may be registered when the goods, upon which the applied mark will be used, is different or non-competing to the goods of another such that it cannot be said that the goods of the latter is manufactured or sourced from the former or that there is a connection between them.

In *Philippine Refining Co., Inc. vs. Ng Sam and The Director of Patents*⁴, the Court ruled:

A rudimentary precept in trademark protection is that "the right to a trademark is a limited one, in the sense that others may use the same mark on unrelated goods." Thus, as pronounced by the United States Supreme Court in the case of *American Foundries vs. Robertson*, "the mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description."

Such restricted right over a trademark is likewise reflected in our Trademark Law. Under Section 4(d) of the law, registration of a trademark which so resembles another already registered or in use should be denied, where to allow such registration could likely result in confusion, mistake or deception to the consumers. Conversely, where no confusion is likely to arise, as in this case, registration of a similar or even identical mark may be allowed.

In this case, Respondent-Applicant's mark is used on "cell phone, mid, led/lcd/crt television, DVD player, microphone, speakers, amplifier, radio, battery, SD card, USB" under Class 9. On the other hand, Opposer's mark is used on goods such as "remote controls for vacuum cleaners and automatic floor scrubbers and industrial robots; parts and fittings for automatic floor scrubbers, vacuum cleaners and industrial robots for use in the fields of interior maintenance of households and commercial buildings, military operations, law enforcement, scientific research and search and rescue, namely, brushes and air filters; sensors for detecting the presence or absence of chemicals; biological organisms; laser spectrums, sound, light and movement; computer hardware and software for control of automatic machines, namely, automatic floor scrubbers, vacuum cleaners and industrial robots in the fields of interior maintenance of households and commercial buildings, military operations, law enforcement, scientific research and search and rescue" also under Class 9. Nevertheless, even if they goods of the parties belong to the same class, they are not automatically considered similar, related or competing goods.

In *Taiwan Kolin Corporation Ltd. v. Kolin Electronics Co., Inc.*⁵, the Supreme Court held:

In resolving one of the pivotal issues in this case—whether or not the products of the parties involved are related—the doctrine in *Mighty Corporation* is authoritative. There, the Court held that the goods should be tested against several factors before arriving at sound conclusion on the question of relatedness. Among these are:

- (a) the business (and its location) to which the goods belong;
- (b) the class of product to which the goods belong;
- (c) the product's quality, quantity, or size, including the nature of the package, wrapper or container;
- (d) the nature and cost of the articles;
- (e) the descriptive properties, physical attributes or essential characteristics with reference to their form, composition, texture or quality;
- (f) the purpose of the goods;
- (g) whether the article is bought for immediate consumption, that is, day-to-day household items;
- (h) the fields of manufacture;
- (i) the conditions under which the article is usually purchased; and
- (j) the channels of trade through which the goods flow, how they are distributed, marketed, displayed and sold.

As mentioned, the classification of the products under the NCL is merely part and parcel of the factors to be considered in ascertaining whether the goods are related. It is not sufficient to state that

⁴ G.R. No. L-26676, July 30, 1982

⁵ G.R. No. 209843, 25 March 2015

the goods involved herein are electronic products under Class in order to establish relatedness between the goods, for this only accounts for one of many considerations enumerated in Mighty Corporation. In this case, credence is accorded to petitioner's assertions that:

- a. Taiwan Kolin's goods are classified as home appliances as opposed to Kolin Electronics' goods which are power supply and audio equipment accessories;
- b. Taiwan Kolin's television sets and DVD players perform distinct function and purpose from Kolin Electronics' power supply and audio equipment; and
- c. Taiwan Kolin sells and distributes its various home appliance products on wholesale and to accredited dealers, whereas Kolin Electronics' goods are sold and flow through electrical and hardware stores.

Clearly then, it was erroneous for respondent to assume over the CA to conclude that all electronic products are related and that the coverage of one electronic product necessarily precludes the registration of similar mark over another. In this digital age wherein electronic products have not only diversified by leaps and bounds, and are geared towards interoperability, it is difficult to assert readily, as respondent simplistically did, that all devices that require plugging into sockets are necessarily related goods.

It bears to stress at this point that the list of products included in Class can be sub-categorized into five (5) classifications, namely: (1) apparatus and instruments for scientific or research purposes, (2) information technology and audiovisual equipment, (3) apparatus and devices for controlling the distribution and use of electricity, (4) optical apparatus and instruments, and (5) safety equipment. From this sub-classification, it becomes apparent that petitioner's products, i.e., televisions and DVD players, belong to audio-visual equipment, while that of respondent, consisting of automatic voltage regulator, converter, recharger, stereo booster, AC-DC regulated power supply, step-down transformer, and PA amplified AC-DC, generally fall under devices for controlling the distribution and use of electricity.

Clearly, even if the goods are classified under the same class, when the goods belong to different sub-classification, they are considered as different goods or unrelated goods. In this case, Respondent-Applicant's goods can be considered as information technology and audiovisual devices which Opposer's goods do not belong to.

What is more, records will also show that at the time Respondent-Applicant filed its trademark application on 06 November 2012, Opposer has no registration or pending application for registration of the mark *i-Robot*. Thus, there is no bar to the registration of Respondent-Applicant's mark.

Furthermore, Opposer's mark cannot also be considered as a well-known mark which can bar registration of Respondent-Applicant even if it is not registered in the Philippines. In order to consider a mark well-known, it must be well-known not only internationally but in the Philippines as well. Also, in order to be declared a well-known mark, account shall be taken of the knowledge of the relevant sector of the public which has been obtained as a result of the promotion of the mark. There is no evidence to support that Opposer's mark is well-known in the Philippines as such Opposer's opposition of the registration of Respondent-Applicant's mark on the basis that it is confusingly similar to its well-known mark has no leg to stand on.

Lastly, Opposer's argument that Respondent-Applicant's mark is similar to its trade name which is entitled to protection even without registration is also untenable. In *Kabushiki Kaisha Isetan vs. The Intermediate Appellate Court, et. al.*⁶, the Supreme Court held that there is no

⁶ G.R. No. 75420, 15 November 1991

automatic protection afforded to an entity whose trade name is alleged to have been infringed through the use of that name as a trademark. It stressed that:

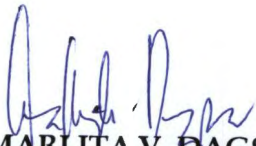
The Paris Convention for the Protection of Industrial Property does not automatically exclude all countries of the world from which have signed it from using a trade name which happen to be used in one country. To illustrate - if a taxicab or bus company in a town in the United Kingdom or India happens to use the trade name "Rapid Transportation", it does not necessarily follow that "Rapid" can no longer be registered in Uganda, Fiji, or the Philippines.

Accordingly, since Respondent-Applicant has shown that it has complied with the provisions of Section 123.1 (d) of the IP Code, hence, it is entitled to the registration of its mark.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-013479, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 MAR 2017.


MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs