

JAGUAR LAND ROVER LIMITED,
Opposer,

-versus-

SLAZENGRS LIMITED,
Respondent- Applicant.

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IPC No. 14-2014-00122
Opposition to:
Appln. No. 4-2013-00012326
Date filed: 11 October 2013
TM: "PANTHER DEVICE"

NOTICE OF DECISION

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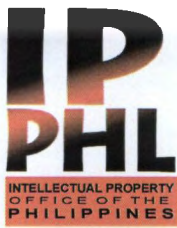
GREETINGS:

Please be informed that Decision No. 2017 - 211 dated June 09, 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHEL 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, June 09, 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



JAGUAR LAND ROVER LIMITED,
Opposer,

IPC No. 14-2014-00122
Opposition to:

- versus -

Application No. 4-2013-00012326
Date Filed: 11 October 2013
Trademark: "PANTHER DEVICE"

SLAZENGRS LIMITED,
Respondent-Applicant.

Decision No. 2017 - 211

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DECISION

JAGUAR LAND ROVER LIMITED ("Opposer")¹, filed a verified opposition to Trademark Application Serial No. 4-2013-00012326. The application, filed by SLAZENGRS LIMITED ("Respondent-Applicant")², covers the mark "PANTHER DEVICE" for use on *"clothing, namely, shorts, shirts, sport shirts, undershirts, swimsuits, pullovers, sweaters, jumpers, smocks, vests, underwear, long underwear, underpants, brassieres, gaiters, garters, stockings, suspenders, socks, braces, waist bands, gloves, pants, jeans, outerwear, waterproof clothing, namely, coats, jackets, anoraks, overcoats, raincoats, thermal clothing, namely, hoodies, sweaters, tops, sweatshirts, pullovers, parkas, jackets, fleece clothing for outdoor wear, namely, fleece pullovers, fleeces jackets; lightweight clothing for outdoor wear namely, tops, blouses, shirts, t-shirts, casual sport shirts; coats, jackets, parkas, anoraks, overcoats, raincoats, rain suits, wind jackets, skirts, dresses, panties, briefs, tracksuits and warm-up suits; martial arts suits and kimonos sportswear, namely, face masks, leg guard for hockey, goal keeping smocks for hockey, absorbent band for wear on the wrists and heads, footwear; sports shoes; trainers, boots, walking boots, football boots, shoes, cycling shoes, and boxing shoes, headgear, namely, headbands, hat and caps; waterproof clothing, namely, thermal socks and thermal underwear; sports clothing, namely, sports coats, sports shirts, sports jackets, sports jerseys, ski trousers, ski pants, ski suits, ski jackets, breeches for sports, sports over uniforms and sports shirts; trousers, shirts; trousers, shirts, t-shirts, cagoules and smocks; gloves; headgear, namely, hats, caps, berets and headbands, belts, expanding bands for holding sleeves; shoulder pads for clothing"* under class 25; and, *"games and playthings, gymnastic articles, sporting articles for use in playing the games of squash, badminton, tennis and table tennis, squash balls, shuttlecocks, tennis balls, table tennis balls, squash, badminton and tennis racket bags (shaped to contain a racket), grip bands for squash, badminton and tennis rackets, head covers for squash, badminton and tennis rackets, squash rackets, badminton rackets, tennis rackets for ball games, squash, badminton and tennis string protectors, strings for squash, badminton and tennis rackets, strings*

¹ A corporation organized and existing under the laws of the United Kingdom, with business address at Abbey Road, Whitley, Coventry CV-3 4LF, England.

² A corporation organized and existing under the laws of the United Kingdom, with business address at Unit A, Brook Park East, Shirebrook NG20 8RY, United Kingdom.

for rackets for ball games, tennis nets, nets for games, tennis ball throwing machines, tapes for wrapping squash, badminton and tennis racket handle grips, tapes for wrapping racket and bat grips, tables for playing table tennis, table tennis bats, sporting equipment for use in playing games namely, field hockey sticks, ball and pads, ice hockey sticks, pucks, pads and gloves, footballs, lacrosse balls and sticks, balls and nets, netball balls and nets, balls for games and sports balls, lawn tennis rackets and balls, cricket balls and bats, croquet sets, clock golf sets, namely, golf clubs for use in the game of clock golf, quoits, flying discs and putting golf balls and water polo balls, balls for use in sports, balloons, sports bags especially adapted for sports equipment, electronic games, namely, hand-held unit for playing electronic games, modeled miniature plastic toy figurines, protective clothing for use in sport, namely, football knee pads and soccer shin pads, abdominal guards for athletic use, mouth guards for athletic use, floats for bathing and swimming, wheeled carriers for golfing use, namely, non-motorized golf carts, parts and fittings for all the aforesaid goods, playing cards" under class 28 of the International Classification of Goods and Services.³

The Opposer alleges that it is a world-renowned luxury car manufacturer whose use of the JAGUAR trademark dates as far back as 1938. Its core products are cars and automobiles. It expanded the brand to cover clothing, toys, and sporting articles, among others. It is the owner of the JAGUAR brand and trademark which includes its LEAPER Device alone and in combination with JAGUAR. In the Philippines, the Opposer filed and began using its LEAPER DEVICE mark as early as 02 February 1989, and matured into registration on 05 April 1994 under Registration No. 057601. It has also various registrations and/or applications for registration for the marks JAGUAR & LEAPER or LEAPER Device.

Accordingly, Opposer's Registration No. 4-1996-111879 in class 28 lapsed due to non-filing of the Declaration of Actual Use. This is one of the registrations cited by the Bureau of Trademarks against the subject application which was allowed, after the Opposer provided its consent. On 18 October 2012, the Opposer filed a replacement application for the JAGUAR & LEAPER DEVICE mark covering goods in class 28. However, in spite of the relationship of co-existence between the parties by long history of cooperation and co-existence around the world, the Opposer was surprised to be notified of an Opposition to its Application No. 4-2012-12861.

The following are the grounds for this instant opposition: (1) The Respondent-Applicant is in bad faith; (2) The Opposer has the superior right to use and register the "Feline Leaper Device"; (3) The Opposer's trademarks have earlier filing and/or registration dates than the opposed mark; and, (4) The Opposer's Jaguar and Leaper trademark should be recognized as a well-known mark.

The Opposer's evidence consists of the following:

1. Notarized and legalized Certificate and Special Power of Attorney;
2. Certificate of Registration for the Mark LEAPING JAGUAR DEVICE;

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

3. Details of Opposer's application for JAGUAR DEVICE in Class 28;
4. Certified true copy of application for the PANTHER DEVICE with Application No. 4/2010/009667;
5. Certified true copy of Registrability Reports on PANTHER DEVICE with Certificate of Registration No. 4-2010-009667;
6. Certified true copy of the IPO BOT Director of a certification dated 08 April 2014;
7. Certificates of registration in the Philippines, promotional material and print advertisements and printout of images featuring the Leaper Device and the use of the Leaper Device;
8. List of international trademarks under the name of the Opposer; and,
9. Original certified true copies of representative samples of international trademarks registered in the name of the Opposer covering registrations in Vietnam, Hong Kong and Indonesia.⁴

On 17 September 2014, Respondent-Applicant filed an Answer on 17 September 2014. Respondent-Applicant alleges that it has demonstrated continued ownership of the mark PANTHER DEVICE and its variants under the current and lapsed trademark registrations in the Philippines, the earliest of which dates back to 1988 or way ahead of any Jaguar's Philippines trademark registrations.

According to Respondent-Applicant, the present application traces its roots to the lapsed Trademark Registration No. 4-2010-009667 dated 30 June 2011, which originated from the expired Trademark Registration No. 4-1998-007867 dated August 2005. This registration passed the substantive examination conducted by the Intellectual Property Office, facilitated by the consent given by Jaguar when the latter's two registrations for JAGUAR & DEVICE were cited by the examiner, namely: Registration No. 4-1996-109476D dated 17 August 2006, covering Class 25 and Registration No. 4-1996-111879 dated 18 October 2001 covering Class 28. While it is true that Respondent-Applicant has obtained and filed a letter of consent from the Opposer during the substantive examination of Trademark Application No. 4-2010-009667, such consent did not divest Respondent-Applicant's statutory right to oppose its trademark application for grounds under the IP Code. As regards Respondent-Applicant's bad faith, when it opposed the Opposer's application of its core products, the ultimate objective of which is not to maliciously interfere with Opposer's use of JAGUAR & DEVICE but solely to limit the class 28 coverage to prevent possibility of confusion. That objective was achieved when the parties agreed to amend the class 28 product coverage by deleting "golf balls; golf bags; golf divot repair kit," as Respondent-Applicant's core products. This case was issued an Entry of Judgment/Execution of Order dated 12 September 2013.

Finally, Respondent-Applicant avers that it has narrowed its opposition to Opposer's two trademark applications covering class 28 products - and only for the reasons stated above. It is true that Respondent-Applicant obtained Opposer's consent, but the coexistence between the parties should have defined limits as far as product coverage is concerned to avoid the possibility and the actual trademark confusion in the market place.

⁴ Exhibits "A" and "B" inclusive of sub-markings.

The Respondent-Applicant's evidence consists of the following:

1. Copy of Certificate of Registration No. 4-2009-005434 dated 4 December 2009 for SLAZENGER & PANTHER DEVICE covering NICE classes 18, 25 and 28;
2. Computer extract of Certificate No. 4-2011-011574 dated 7 June 2012 for PANTHER DEVICE covering NICE class 18;
3. Certified true copy of Certificate of Registration No. 4-1998-007867 dated 28 August 2005 for PANTHER DEVICE covering NICE class 28;
4. Certified true copy of Certificate of Registration No. 4-2010-009667 dated 30 June 2011 for PANTHER DEVICE covering NICE class 28;
5. Copy of Certificate of Registration No. 41519 dated 17 October 1988 for SLAZENGER & PANTHER PARALLEL LINE DEVICE covering class 28;
6. Copy of Motion to Withdraw dated 18 July 2013 concerning IPC No. 14-2013-00167 entitled SZLAZENGERS LIMITED v. JAGUAR CARS LIMITED;
7. Letter Jaguar Cars Limited dated 15 July 2013 filed with the Bureau of Trademarks limiting the product coverage for Trademark Application No. 4-2012-012861 for the mark JAGUAR & LEAPER;
8. Certified true copy of authenticated Declaration of Mr. David Forsey;
9. Certified true copy of Declaration of Actual Use;
10. Certified true copy of Notice of Acceptance of Declaration of Actual Use of the mark SLAZENGER & PANTHER DEVICE under Registration No. 4-2009-005434;
11. Certified true copy of the duly accepted Affidavit of Use for the mark SLAZENGER & PANTHER PARALLEL DEVICE under Registration No. 41519.⁵

The Preliminary conference was conducted and terminated. Thereafter, the parties submitted their respective position papers⁶. Thus, this case is submitted for decision.

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

The grounds of this instant opposition are anchored on the standpoint that the competing marks are identical or confusingly similar and thus would cause damage or would block their pending trademark applications for JAGUAR & LEAPER. The Opposer claims superior rights to use and register the said marks on the basis of registration/filing date and a claim for being well-known. In fact, it argued that Respondent-Applicant is in bad faith for filing oppositions in spite of acknowledgment from both parties of their coexistence arising from consent agreements both in the Philippines and abroad.

Before discussing the aforementioned issues, it is necessary to re-examine whether the two marks are indeed identical or confusingly similar on the basis of Article 123 of Republic Act No. 8293, also known as the Intellectual Property Code ("IP Code):

⁵ Exhibits "1" to "11" inclusive of sub-markings.

⁶ Opposer submitted its Position Paper on 06 April 2016; Respondent-Applicant submitted its Position Paper on 06 April 2016.

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;** (Emphasis supplied)

The competing marks are shown below for comparison:



Opposer's Trademark



Respondent-Applicant's Trademarks

A comparison of the marks show that they make use of a device/logo consisting of a "large feline"⁷. The adoption of these do not make the marks confusingly similar. The mark JAGUAR makes use of a **mere outline of a large feline** or a jaguar facing **left** but its dominant feature is the word "JAGUAR" in a large distinct font - something which largely sets the two marks apart. In contrast, the PANTHER DEVICE makes use of a **shaded large feline** or a panther facing **right** and has no verbal elements. Clearly the two marks are different.

⁷ These are covered under Category 3.1.4. of the Vienna Classification, under the Vienna Agreement Establishing an International Classification of Figurative Marks administered by WIPO and concluded in 1973.

"[T]he test of confusing similarity that would preclude registration" does not require that the marks be identical and that it is sufficient that there will be a likelihood of a purchaser of one brand to mistake it for another.⁸ But here, the only similarity between the two marks is that they belong to the same Vienna Classification for "*tigers and other large felines*".⁹ As discussed, their aural representation or dominant feature are clearly distinct from each other. Further, this Bureau is not unmindful of the fact that an ordinary intelligent buyer of sporting articles/gear and apparel will be familiar with the goods in question and are not likely to confuse the two marks for the other.

Corollarily, the enunciation of the Supreme Court in the case of *Mighty Corporation vs. E. & J. Gallo Winery*¹⁰ aptly states that:

"A very important circumstance though is whether there exists likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the source of the goods in question. The 'purchaser' is not the 'completely unwary consumer' but is the 'ordinarily intelligent buyer' considering the type of product involved. he is 'accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The situation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

The Bureau likewise finds sufficient the documentary evidence presented by Respondent-Applicant to show the long continuous use of the symbol of the large shaded feline as a dominant feature of their marks and finds that the present application involves a mere variant of their existing trademark registration¹¹. More importantly, there were no citations of confusing similarity for their existing registration in spite of the fact that the marks of both parties both involved a symbol of a large feline facing to the left directly above their brand names. It is further noted that the variant has existing registrations under the same classifications (25 and 28) in other countries for a considerable amount of time.

Having established that the marks are in fact distinct and will not cause confusion; and likewise, because such finding should rectify any fear that the present application will be a hindrance to Opposer's registrations, it is therefore unnecessary to rule on the other issues raised. But it can be readily ascertained based on the records and the acts of both parties that no bad faith is involved in the present case. The Supreme Court, on occasion has ruled that:

"Bad faith, under the law, does not simply connote bad judgment or negligence. It imports a dishonest purpose or some moral obliquity and conscious doing of a wrong, a breach of a known duty through some motive or interest or ill will that partakes of the nature of fraud."¹²

⁸ *Faberge Inc. v. IAC*, G.R. No. 71189, 1992.

⁹ *Supra* note 6.

¹⁰ G.R. No. 154342, 14 July 2004.

¹¹ Exhibits "8-FF" to "8-HHH" of Respondent-Applicant.

¹² *Nazareno v. City of Dumaguete*, G.R. No. 177795, 2009.

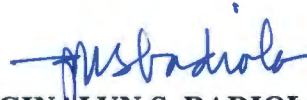
No willful doing of a wrong that amounts to fraud exists in this case. As argued and as seen in the eventual amicable resolution of one of the related cases involving the parties, the Respondent-Applicant was merely acting to protect its own rights. While both parties acknowledge a co-existence, no actual agreement was formed to preclude each other from raising oppositions to each other's applications on valid grounds. But even if a formal agreement was constituted, private contracts or agreements do not overcome the interest of the public in the proper administration of such applications.

Finally, it is emphasized that 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.¹³ This Bureau finds that the Respondent-Applicant's mark meets this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-00012326 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 09 JUN 2017



Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs

¹³ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.