

NOLANGROUP SPA,
Opposer,

-versus-

NEW VANHAWK COMPANY,
Respondent-Applicant.

X-----X

}	IPC No. 14-2015-00441
}	Opposition to:
}	
}	Appln. Serial No. 4-2014-505281
}	Date Filed: 06 November 2014
}	
}	TM: X-LITE
}	
}	
}	

NOTICE OF DECISION

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Counsel for Opposer
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8741 Paseo de Roxas, Makati City


NEW VANHAWK COMPANY
Respondent- Applicant
#6400 Tatalon Street, Brgy, Ugong,
Valenzuela City 1448

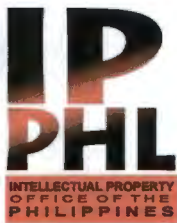
GREETINGS:

Please be informed that Decision No. 2017 - 128 dated 19 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, 20 April 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



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x-----x		Decision No. 2017- <u>128</u>

DECISION

NOLANGROUP SPA¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2014-505281. The application, filed by NEW VANHAWK COMPANY² ("Respondent-Applicant"), covers the mark "X-LITE" for use on "motorcycle parts" under Class 12 of the International Classification of Goods.³

The Opposer alleges, among others, the following:

"10. The mark X-LITE 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 X-LITE in the name of respondent-applicant will violate Section 123.1, subparagraph (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines (IP Code).

"12. Opposer's trademark X-LITE is 'well-known' in accordance with both international conventions and with Philippine laws. The registration of respondent-applicant's nearly-identical trademark to opposer's "well-known" mark is proscribed under the IP Code of the Philippines.

"13. The registration of the trademark X-LITE in the name of respondent-applicant violates Section 123.1, subparagraph (f) of the IP Code.

"14. The registration and use by respondent-applicant of the mark X-LITE will

¹ A foreign corporation organized and existing under the laws of Italy, with business address at Via G. Terzi di S. Agata, 2 - 24030 Brembate di Sopra - BG- Italy.

² A domestic corporation with address at 6400 Tatalon Street, Barangay Ugong, Valenzuela City 1448.

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.

diminish the distinctiveness and dilute the goodwill of opposer's well-known trademark

"15. The registration of the trademark X-LITE in the name of respondent-applicant is contrary to other provisions of the Intellectual Property Code of the Philippines."

The Opposer's of evidence consists of the following:

1. A printout from the IPO Phil Trademark Database showing the details of Trademark Registration No. 4-2008-003542 for the trademark X-LITE under International Class 9;
2. Printouts from Motoworld's website (www.motoworld.com.ph) showing opposer's X-LITE products sold in the Philippines;
3. Copies of promotional materials for opposer's mark Copies of promotional materials for opposer's mark X-LITE in the Philippines;
4. Copies of foreign trademark registrations owned by the Opposer;
5. Print-outs from the opposer's website listing the distributors for products bearing opposer's mark X-LITE around the world;
6. A CD compiling Opposer's brochures and promotional paraphernalia prominently displaying opposer's mark X-LITE;
7. A list of riders sponsored by the opposer for worldwide motorbike competitions in the years 2008, 2009, 2010, 2012, 2014, and 2015;
8. Photographs of some of Opposer's sponsored motorcycle racers in their racing gear prominently displaying Opposer's mark X-LITE;
9. Corporate Secretary's Certificate dated November 5, 2015; and
10. Notarized and legalized Affidavit-Testimony of witness Marco Taschini.

This Bureau issued a Notice to Answer on 07 December 2015 and served the same to Respondent-Applicant on 11 March 2016. Despite the receipt of the Notice, Respondent-Applicant did not file the answer. On 31 January 2017, the Respondent-Applicant was declared in default for failure to answer. Accordingly, this case is submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended.

Should the Respondent-Applicant be allowed to register the mark X-LITE?

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.

To determine the registrability of a mark, Section 123. 1 (d) of R.A. 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:

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 will show that at the time Opposer applied for registration of its X-LITE mark on 06 November 2014, Opposer already has an existing registration for its mark X-LITE issued way back in 08 September 2008. 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 of the parties confusingly similar as to likely cause confusion, mistake or deception on the part of the buying public?

The parties marks are herein reproduced:



Opposer's Mark



Respondent-Applicant's Mark

Indubitably, the marks of the parties are identical in the use of the word X-LITE as well as the other elements in the mark. Aside from that, the goods of the parties are also closely related. Opposer's mark is used on "helmets, protective helmets, sportive helmets, helmets for motorcyclists, helmets for cyclist, helmets for motorists, protective gloves, protective gloves for sport, protective masks, protective clothing, namely protective reinforcements for elbows, knees, legs and arms against accidents" under Class 9. On the other hand, Respondent-Applicant's mark is used on "motorcycle parts" belonging to Class 12. Although, the respective goods of the parties are classified under different class, their goods relates to motorcycles, Opposer's goods being motorcycle accessories and protective gears while that of Respondent-Applicant's cover all kinds of motorcycle parts. As such, the consumers will likely be mistaken, confused or deceived into believing that the goods of the Respondent-Applicant comes from, originated or sourced from Opposer or that there is a connection between them when in fact there is none. Also, any impression or information of Respondent-Applicant's goods may be unfairly attributed to Opposer's.

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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.⁴

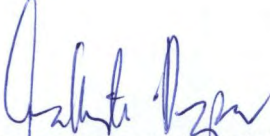
The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.⁵

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-505281, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 19 APR 2017.


MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs

⁴ *Converse Rubber Corporation vs. Universal Rubber Products, Inc.*, G.R. No. L-27906. January 8, 1987.

⁵ *Supra*.