

**FERRARI S.P.A.,**  
*Opposer,*

**-versus-**

**ANDREW ARQUIZA SY,**  
*Respondent-Applicant.*

X-----X

}	<b>IPC No. 14-2014-00086</b>
}	Opposition to:
}	Appln. Serial No. 4-2013-00007190
}	Date Filed: 06 June 2013
}	
}	
}	<b>TM: KOBBLEIS</b>

**NOTICE OF DECISION**

**CARAG JAMORA SOMERA & VILLAREAL LAW OFFICE**

*Counsel for Opposer*  
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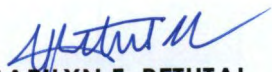
**ANDREW ARQUIZA SY**  
*Respondent- Applicant*  
312-B 10<sup>th</sup> Avenue corner 4<sup>th</sup> Street  
Barangay 108, Caloocan City

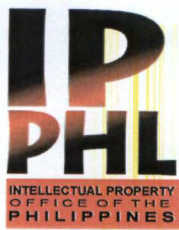
**GREETINGS:**

Please be informed that Decision No. 2017 - 258 dated 28 June 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, 29 June 2017.

  
**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs



FERRARI S.P.A.,  
Opposer,

-versus-

ANDREW ARQUIZA SY,  
Respondent-Applicant.

}IPC NO. 14-2014-00086  
}Opposition to:  
}  
}Appln. Ser. No. 4-2013-00007190  
}Date Filed: 6 June 2013  
}Trademark: "KOBBLEIS"  
}  
}

x-----x}Decision No. 2017- 258

**DECISION**

FERRARI S.P.A., (Opposer)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2013-00007190. The application, filed by ANDREW ARQUIZA SY (Respondent-Applicant)<sup>2</sup>, covers the mark "KOBBLEIS", for use on "connecting rods, pistons, piston rings, air cleansers, heads, valves being engine parts, cam shaft, rocker arms, kick starter, carburetors, fuel filter, mufflers, stators being parts of machines & engine timing components, namely, cam sprockets and chains" under Class 7 and "Motorcycle parts and accessories namely, handle grips, brake levers, disc brakes, disk brake pads, disk brake calipers, throttle cables, brake cables, speedometer cables, brake pedals, shocks, spoke wheels, rims, rios, tire inner tubes, clutch bells, clutch springs, clutch swings arm, headlight mounts, brake shoes sprockets, brake assemblies, brake master cylinders, drive face, body cover kits, slide mirrors, front dash panels, handle bars, forks, luggage console, wheel hubs, shrouds, fuel line hoses, amplified horns, horn or motorcycles, motorcycles, motorcycle chain guide or roller, clutch flyball & plate holder & rear set shifters" under Class 12 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its opposition on the grounds that:

"9. Opposer is the owner of numerous trademark registrations for the 'Prancing/Rearing Horse Device' mark and is the Registrant in the Philippines of the following marks with their respective registration details, to wit:

Mark	Registra tion No.	Registrat ion Date	Classes of Goods/ services	Validi ty of Regist ration
PRANCING HORSE DEVICE	4-2007- 006676	April 28, 2008	3, 12, 14, 16, 18, 24, 25, 26, 28, 35, 37 and 41	Until April 28, 2018

<sup>1</sup> A corporation organized and existing under the laws of Italy with address at Via Emilia Est 1163, Modena, Italy

<sup>2</sup> Philippine resident with address at 312-B7<sup>th</sup> 10<sup>th</sup> Ave., cor. 4<sup>th</sup> St. Barangay 108 Caloocan City

<sup>3</sup> 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.

FERRARI AND PRANCING HORSE DEVICE	4-2007-006675	November 3, 2008	3, 9, 12, 14, 16, 18, 24, 25, 26, 28, 35, 37, 41	Until November 3, 2018
SF AND PRANCING HORSE	4-2007-006674	April 28, 2008	3, 12, 14, 16, 18, 24, 25, 26, 28, 35, 37 and 41	Until April 28, 2018



“11. The Respondent’s application for registration of his Mark chiefly contravenes Section 123.1 sub-paragraph (d) of Republici Act 8293 (‘R.A. 8293 or the ‘IP Code’), that states to wit:

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

- (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

“12. Respondent-Applicant’s mark, particularly the Horse’s Head Device portion thereof, appearing as a prominent portion of said composite mark, so resembles the Opposer’s ‘Prancing Horse/Rearing Horse Device’ mark as to be likely when applied or used in connection with the Respondent-Applicant’s goods to deceive or cause confusion with those of Opposer’s goods/ lines of business bearing the Opposer’s ‘Prancing Horse/Rearing Horse Device’ mark. Said Horse’s Device appearing alongside a racing car pennant further adds to the confusion that will be engendered in the market, as these both convey a relation to racing car sports events which are participated in/supported by the Opposer, using its ‘Prancing Horse/Rearing Horse Device’ mark, particularly in connection with the Formula 1 or F1 car racing events.



“13. The use by Respondent-Applicant of the mark on goods that are similar, identical or closely related to the Opposer’s goods that are produced by, originate from, offered by, or under the sponsorship of herein Opposer bearing the latter’s ‘Prancing Horse/Rearing

*Handwritten signature or initials.*

Horse Device' mark, will greatly mislead the purchasing public into believing that Respondent-Applicant's goods are produced by or originate from, or are under the sponsorship of the Opposer.

"14. Opposer has not abandoned the use in other countries around the world, including the Philippines, of its 'Prancing Horse/Rearing Horse Device' mark.

"15. By virtue of the prior and continued use of the Opposer's 'Prancing Horse/Rearing Horse Device' mark in many countries around the globe made by herein Opposer, said mark has become popular and an internationally well-known one, including here in the Philippines, and has established valuable goodwill for the Opposer with the purchasing /consumer public , which has identified Opposer as the owner and the source of the goods and/or products bearing the Opposer's 'Prancing Horse/Rearing Horse Device' mark.

"16. In view of the foregoing, the Respondent's mark may also be considered in contravention of Section 123.1 (f) of our IP Code, which states to wit:

(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 and services which are not similar to those with respect to which registration is applied for: Provided, that the use of the mark in relation to the goods or services would indicate a connection between those goods or 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."

Opposer also claims to be the true owner of the 'Prancing Horse/Rearing Horse Device' mark, which mark has been registered in its name and is the subject of registrations and applications in many jurisdictions around the world, including here in the Philippines. Opposer states that it has been commercially using the mark in Italy as early as 1946 and elsewhere in the world. Apart from being the originator of the 'Prancing Horse/Rearing Horse Device' mark, which have been marketed, promoted, distributed, offered for sale and sold in many jurisdictions around the world, including here in the Philippines, it manifests to have sold millions worth of products bearing the said mark.

To support its opposition, the Opposer submitted as evidence the following:

1. Affidavit of Sabina Fasciolo;
2. List of registration and applications for the Opposer's mark;
3. True copies of Certificates of Registration of the Opposer's 'Prancing Horse/Rearing Horse Device' and other FERRARI marks; and

4. Copies of articles featuring the Opposer.<sup>4</sup>

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 20 May 2014. However, the Respondent-Applicant did not file an answer. Thus, the Hearing Officer issued Order No. 2014-1074, on 14 August 2014, declaring the Respondent-Applicant in default.

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

Records show that at the time Respondent-Applicant applied for registration of the mark KOBBLEIS on 6 June 2013, the Opposer already registered the marks PRANCING HORSE DEVICE<sup>5</sup>; FERRARI AND PRANCING HORSE DEVICE<sup>6</sup> and SF PRANCING HORSE DEVICE for goods under Classes 3, 9, 12, 14, 16, 18, 24, 25, 26, 28, 35, 37 and 41. Respondent-Applicant's trademark application is applied on goods under Classes 12.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?



Opposer's mark



Respondent-Applicant's mark

The marks identical with respect to their use of the image of a horse. This similarity does not automatically result to a finding of confusing similarity. In Opposer's mark, the image is the whole body of a black horse in a prancing position, standing on its hind legs. On the other hand, the Respondent-Applicant's mark is an image of a horse's head in red/gray in a rectangular device, behind the horse's head is black background and a black and white racing flag/pennant. Beneath it are the words, KOBBLEIS. These peculiarities distinguish one from the other. The over-all commercial impression of the marks are different.

In the case of *Great White Shark v. Danilo Caralde*<sup>7</sup>, the Supreme Court upheld the finding that no confusing similarity existed in spite of the use of by the competing marks of the image of a shark on the same type of goods, it held:

<sup>4</sup> Exhibits "A" to "K" inclusive of submarkings

<sup>5</sup> Exhibit "H"

<sup>6</sup> Exhibit "I"

<sup>7</sup> G.R. No. 192294, 12 November 2012

In Great White Shark's 'GREG NORMAN LOGO', there is an outline of a shark formed with the use of green, yellow, blue and red lines/strokes. In contrast, the shark in Caralde's 'SHARK & LOGO' mark is illustrated in letters outlined in the form of a shark with the letter 'S' forming the head, the letter 'H' forming the fins, the letters 'A' and 'R' forming the body, and the letter 'K' forming the tail. In addition, the latter mark includes several more elements such as the word 'SHARK' in a different font underneath the shark outline, layers of waves, and a tree on the right side, and liberally used the color blue, with some parts in red, yellow, green and white. The whole design is enclosed in an elliptical shape with two linings, thus xxx

As may be gleaned from the foregoing, the visual dissimilarities between the (2) two marks are evident and significant, negating the possibility or confusion in the minds of the ordinary purchaser, especially considering the distinct aural difference between the marks. xxx"

Therefore, when the images of the marks are juxtaposed beside each other, bearing in mind the difference in the goods they represent, mistake, confusion as to source or even deception is not likely. Aside from the visual dissimilarities of the marks, it is evident that the marks of Respondent-Applicant are also applied on different goods under Class 12, namely: "Motorcycle parts and accessories namely, handle grips, brake levers, disc brakes, disk brake pads, disk brake calipers, throttle cables, brake cables, speedometer cables, brake pedals, shocks, spoke wheels, rims, rios, tire inner tubes, clutch bells, clutch springs, clutch swings arm, headlight mounts, brake shoes sprockets, brake assemblies, brake master cylinders, drive face, body cover kits, slide mirrors, front dash panels, handle bars, forks, luggage console, wheel hubs, shrouds, fuel line hoses, amplified horns, horn or motorcycles, motorcycles, motorcycle chain guide or roller, clutch flyball & plate holder & rear set shifters" while Opposer's Reg. No. 4-2007-006676<sup>8</sup> are for "automobile bodies, automobile chassis, gearboxes for or being parts of land vehicles, horns (buttons) for automobiles, hubs for automobiles wheels, automobile bumpers, automobile seat cushions, automobile sunroof, seat belts for use on vehicles, spoilers for vehicles, steering wheels for vehicles, suspension springs, lower suspension arms for vehicles, suspension shock absorbers for vehicles, windshields, rear view mirrors for vehicles, transmissions for vehicles, suspensions for vehicles, transmissions, suspensions, body work for motor cars" under Class 12. Even if the products are under Class 12, no confusion will result because the marks are of different commercial presentation. Besides, the goods are motorcycle parts and accessories that are not mere household items of minimal value. These are used in automobiles or motorcycles where the typical consumer is more careful and circumspect in purchasing. In the case of Taiwan Kolin Corporation, Ltd. v. Kolin Electronics, Co., Inc.<sup>9</sup>, the Supreme Court held:

While both marks refer to the word 'KOLIN' written in upper case letters and in bold font, the Court at once notes the distinct visual and aural differences between them: Kolin Electronics' mark is italicized and

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<sup>8</sup> Exhibit "H"

<sup>9</sup> G.R. No. 209843, March 25, 2015

colored black while that of Taiwan Kolin is white in pantone red color background. The differing features between the two, though they may appear minimal, are sufficient to distinguish one brand from the other.


It cannot be stressed enough that the products involved in the case at bar are, generally speaking, various kinds of electronic products. These are not ordinary household items, catsup, soy sauce or soap which are of minimal cost. The products of the contending parties are relatively luxury items not easily considered affordable. Accordingly, the casual buyer is predisposed to be more cautious and discriminating in and would prefer to mull over his purchase. Confusion and deception, then, is less likely. xxx”

In the instant case, a customer intending to buy Respondent-Applicant’s goods, would mull over their purchase. They would not immediately form a connection that the goods are that of the Opposer’s simply because the mark of Respondent-Applicant has an image of a horse’s head.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2013-00007190 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 28 JUN 2017

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