

OBERON MEDIA (UK) LIMITED  
(formerly DIGITAL BRIDGES LIMITED)  
2008

IPC No. 14-2009-00012  
Case Filed: 12 January

Opposer,

Opposition to:

- versus -

Appl'n Serial No. 4-2008-000521  
Date Filed: 15 January 2008  
TM: "I-PLAY"

IP E-GAME VENTURES, INC.  
Respondent-Applicant  
x-----x

Decision No. 2009-105

## DECISION

Before us is a verified NOTICE OF OPPOSITION filed by opposer Oberon Media (UK) Limited (formerly Digital Bridges Limited) Application Serial No. 4- 2008-000521 filed by respondent-applicant IP E-Game Ventures, Inc. on January 15, 2008 for registration of the mark "I-PLAY" for services under Class 35 namely, "advertising, updating of advertising material, dissemination of advertising matter, communication media (presentation of goods) for retail purposes, computer data bases (compilation of information) consumers (commercial information and advice for) consumer advice shop", and published in the Intellectual Property Philippines Electronic Gazette that was officially released for circulation on September 12, 2008.

Opposer is OBERON MEDIA (UK) LIMITED (formerly DIGITAL BRIDGES LIMITED), a company organized under the laws of England and Wales with principal place of business at 3 Pitreavie Court, Pitreavie Business Park, Dunfermline, United Kingdom KY 11 UU. Respondent-applicant is IP E-GAME VENTURES, INC., a corporation organized and existing under the laws of the Republic of the Philippines with principal place of business at 34/F Tower II, RCBC Plaza, 6819 Ayala Avenue, Makati City, Metro Manila, Philippines.

Opposer preliminary made the following allegations:

"2. The Opposer does business using the name "I-PLAY" and owns and operates a website located at <http://www.i-play.com> which is readily accessible to anyone with an internet connection, including to Filipinos and Philippine-based internet service users, and is a prominent developer and provider of downloadable games. Opposer, using the name and mark "I-PLAY", provides mobile games through a network of more than one hundred twenty (120) cellular and mobile device carriers worldwide. Opposer has been developing mobile games since 1998, and has been offering and selling such games directly to users in the Philippines since as early as the year 2007, through its Philippine distributor, Information Gateway. Each game offered/provided by the Opposer has a splash-screen that shows Opposer's "I-PLAY" mark. In support of the assertion pertaining to the existence of a distributorship arrangement and distribution in the Philippines of products/services bearing the Opposer's "I-PLAY" mark, attached and marked hereto as Opposer's Exhibits "A" to "A-1" respectively to form integral parts hereof, are (a) a notarized and duly legalized certification from Mr. Jordan Goldstein, Company Secretary of the Opposer, attesting that (b) the accompanying Distribution Agreement between Opposer and an entity known as Information Gateway, dated November 29, 2006, is a true and correct copy of the original Agreement.

"4. Respondent Applicant purportedly operates the Philippine-based information technology ("IT") firm known as the IPVG Corp.

"5. Via press release(s) made sometime in December 2007, Respondent-Applicant announced that two Philippine companies, namely GMA Network, Inc. and IPVG Corp., through their respective subsidiaries, would be forming a joint venture company to be named, "I-Play, Inc." which would engage in online gaming starting the year 2008. Marked and attached hereto as Opposer's Exhibit "B" to form an integral part hereof, is a print-out of a news item/story entitled "GMA Network, IPVG announce gaming joint venture" dated December 22, 2007, that was downloaded from the Inquirer.Net website.

The grounds relied for opposition are as follows:

"6. The allowance for registration of the mark "I-PLAY" bearing the aforestated details, contravenes Section 123.1 (d) and (f) of Republic Act No. 8293 ("R.A. No. 8293" or the "IP Code")

"7. The mark "I-PLAY" is identical and so resembles the Opposer's "I-PLAY" mark, as to be likely when applied to or used in connection with the Respondent-Applicant's sought-to-be-covered Class 35 services, to likely deceive or cause confusion with Opposer's goods and/or services bearing its "I-PLAY" mark.

"8. The use by Respondent-Applicant of the mark "I-PLAY" on services that are similar, identical or closely related to the goods/services that are produced by, originate from, offered by, or are under the sponsorship of Opposer bearing the latter's "I-PLAY" mark will greatly mislead the purchasing/consumer public into believing that Respondent-Applicant's services are produced by, originate from, or are under the sponsorship of herein Opposer.

"9. Opposer has not abandoned the use in other countries around the world, including here in the Philippines, of its "I-PLAY" mark.

"10. Opposer submits that its "I-PLAY" mark is a well-known mark which is entitled to broad protection under Article 6bis of the Paris Convention for the Protection of Industrial Property (the "Paris Convention") and Article 16 of the Trade Related Aspects of Intellectual Property (the "TRIPS Agreement"), to which the Philippines and the United Kingdom are signatories.

"11. The registration of Respondent-Applicant's "I-PLAY" mark contravenes the provisions of R.A. No. 8293, the Paris Convention and the TRIPS Agreement, hence is subject to non-allowance for registration under the pertinent provisions of said laws.

Opposer relies upon and shall prove, among others, the following:

(a) The Opposer is the true owner of the "I-PLAY" mark which has been registered in the Opposer's name and/or is the subject of applications for registration, to wit:

| Country Registration/ Application No. | Registration No./ Application           | Date of Registration/ Application | Classes/Goods/ Services Covered   |
|---------------------------------------|---|-----------------------------------|---|
| 1. United States of America (U.S.A.)  | U.S. Federal Registration No. 2,643,125 | October 29, 2002                  | 41- "providing online interactive computer games that may be accessed via a global computer network"  |
| 2. U.S.A.                             | Serial/ Application No. 78/ 751, 932    | November 11, 2005                 | 9. "Electric publications, publications provided on-line; computer hardware; computer software; computer hardware and software for entertainment content for use on and |

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|  |  |  | <p>with wireless communication devices; computer hardware, programs and software downloadable from a global communications network; computer software and telecommunications apparatus to enable connection to a computer database or a global communications network; computer games and entertainment software; computer games and devices and wireless communications devices; computer games and entertainment software downloadable from a global communication network; computer programs, CDs, CDROMs; electronic and optical and magnetic data recording means; sound video and data recordings; records, discs, tapes, cassettes, cartridges and cards, all bearing or for use in bearing data, sound, images, graphics, text programs or information; mobile telephones enabled to operate using Wireless Application Protocols; computer apparatus and programs for use in connection with wireless communications means; computer network apparatus and installations for the communication of data; security apparatus for computer hardware and software”</p> <p>38- “Telecommunications services; mobile and wireless telephone communication services; provision of electronic mail and messaging services; provision of user access and telecommunications connections to global communication networks; telecommunication of information via a global computer network; computer network communication services; leasing of telecommunications lines; leasing of telecommunication lines for access to computer networks; consultancy services relating to all the aforesaid services”</p> <p>41- “Entertainment services; provision of entertainment, by means of wireless communication devices, apparatus and instruments; provision of entertainment by means of a</p> |
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|  |  |  | communication network or a computer-based system; provision of information relating to entertainment; provision of information relating to entertainment and entertainment by means of wireless communication devices, apparatus and instruments and by means of a global communications network or a computer database” |
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| 3. Office for Harmonization in the Internal Market (“OHIM)/ Community Trade Mark Registration (for the mark “dbi-play”) | 4163572 | 03/02/06 | 9- “Electronic publications, publications provided on-line; computer hardware; computer software; computer hardware and software for entertainment content; computer hardware and software for entertainment content for use on and with wire-less communication devices; computer software supplied from a computer database or a global communications network; computer software and telecommunication apparatus to enable connection to a computer database or a global communications network; computer games entertainment software; games entertainment software for use in conjunction with wireless communication means; computer games programs and software downloadable from a global communications network; computer programs; CDs, CDROMs, interactive CD-ROMs; electronic, optical and magnetic data recording means; sound video and data recordings; records, disc, tapes, cassettes, cartridges and cards all bearing or for use in bearing data, sound, images, games, graphics, text, programs or information; mobile telephones; mobile telephones enabled to operate Wireless Application Protocols; computer apparatus and programs for use in connection with wireless communications means; computer network apparatus and installations for communication of data, security apparatus for computer software and hardware” |
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|  |         |            |  |
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|  |         |            | <p>38- "Telecommunications services; mobile and wireless telephone communication services; provision of electronic mail and messaging services; provision of user access and telecommunications connections to global communication networks; telecommunication of information via a global communication network; telecommunication of information via a global communications network; computer network communication services; leasing of telecommunications lines; leasing of telecommunications lines for access to computer networks; consultancy services relating to all of the aforesaid services"</p> <p>41- "Entertainment services; provision of entertainment by means of wireless communication devices, apparatus, and instruments; electronic games services; electronic games services provided by means of a communications network or a computer-based system; provision of information relating to entertainment and electronic games; provision of information relating to entertainment, entertainment by means of wireless communication devices, apparatus and instruments and electronic games services via a global communications network or a computer database"</p> |
| OHIM/<br>Community<br>Trademark<br>Application | 4513057 | 28/06/2005 | <p>9- "Electronic publications, publications provided on-line; computer hardware; computer software; computer hardware and software for entertainment content; computer hardware and software for entertainment content for use on and with wire-less communication devices; computer hardware, programs and software downloadable from a global communications network; computer software supplied from a computer database or a global communications network;</p>   |

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|  |  | <p>computer software and telecommunications apparatus to enable connection to a computer database or a global communications network; computer programs; CDs, CD-ROMs, interactive CD-ROMs; electronic, optical and magnetic recording means; sound, video, and data recordings; records, discs, tapes, cassettes, cartridges and cards, all bearing or for use in bearing data, sound, images, graphics, text, programs or information; mobile telephones; mobile telephones enabled to operate using Wireless Application Protocols; computer apparatus and programs for use in connection with wireless communications means; computer network apparatus and installation for the communication of data; security apparatus for computer software and hardware”</p> <p>41- ““Entertainment services; provision of entertainment by means of wireless communications devices, apparatus, and instruments; provision of entertainment by means of a communications network, or a computer-based system; provision of information relating to entertainment; provision of information relating to entertainment and entertainment by means of wireless communication devices, apparatus and instruments and by means of a global communications network or a computer database”</p> |
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Certified true copies of the afore-enumerated registration certificate(s)/ applications are marked and attached hereto as Opposer’s Exhibits “C” to “F”, to form integral parts hereof.

- (b) Opposer has been commercially using its “I-PLAY” mark in the United States and elsewhere around the world since 2005, and in the Philippines since 2007, which use antedates the use, if any, made of Respondent-Applicant of its “I-PLAY” mark.
- (c) In support of Opposer’s claims that [i] it is the originator of the “I-PLAY” mark; [ii] the date/period of first use thereof; [iii] products/services bearing said mark have been distributed, offered for sale, sold in many jurisdictions around the world, by virtue of which the Opposer has made extensive use worldwide of its “I-PLAY” mark, Opposer

manifests that for the fiscal years 2005-2007, it had made over UK £41,999,000.00 in worldwide sales of various products/services bearing said mark. Marked and attached hereto as Opposers Exhibit "G" to form an integral part hereof, is a duly executed, notarized and legalized Affidavit of Tomer Ben-Kiki, one of Opposer's Directors, attesting to the foregoing matters/sales figures.

- (d) In further support of Opposer's claim that its aforementioned mark has gained international notoriety, it asserts that it has undertaken and made extensive publicity and promotions of said mark in internationally-circulated publications and/or its websites such as The Guardian, Mobile Entertainment, MCV, Mobile Games Analyst, What Mobile, DMEurope and GamesIndustry.biz. The earliest example of an advertisement taken out/posted by the Opposer is one that appeared in ME: Mobile Entertainment on or around April 4, 2005. A certified true copy of this advertisement, is marked and attached herewith as Opposer's Exhibit "V", to form an integral part hereof. The duly executed, notarized and legalized Affidavit of Opposer's witness that is identified as Opposer's Exhibit "G" in subparagraph (c) *supra*, includes copies/webpage print-out of sample advertisements featured in various publications/Opposer's website made around the world.
- (e) By spelling, representation and appearance, the mark "1-PLAY" is identical to and/or confusingly similar to the Opposer's mark, "I-PLAY".
- (f) Opposer continues to use its "I-PLAY" mark worldwide, including here in the Philippines.
- (g) By virtue of the prior and continued use of the "I-PLAY" mark in the Philippines and other countries around the globe made by herein Opposer, said mark has become popular and internationally well-known and has established valuable goodwill for the Opposer with the general purchasing/consumer Public, which has identified Opposer as the owner and the source of goods bearing said mark.
- (h) In connection with the Opposer's policy to protect its rights over its "I-PLAY" mark, Opposer was able to have successfully prevailed before this very Honorable Office, in relation to the Opposer's Opposition filed in relation to the application for registration of the mark "I-PLAY" bearing Application No. 4-2007-0006546 for Class 41 services, that was also filed by the same Respondent-Applicant that is party to the instant Opposition Case. In support of this assertion, attached and marked hereto as Opposer's Exhibit "W", is a duplicate original of this Honorable Office's Decision No. 4-2008-195 dated November 5,2008.

Opposer prays, thus, for a declaration that respondent-applicant's mark "I-PLAY" is identical or confusingly similar to opposer's mark "I-PLAY" and that opposer's mark "I-PLAY" is an internationally well-known mark. Opposer prays, too, that the subject Application Serial No. 4-2008-000521 filed in respondent-applicant's name be disallowed.

Opposer submitted the following evidence in support of the verified NOTICE OF OPPOSITION:

| Documentary Exhibit | Description/ Nature of Document  |
|---------------------|--|
| "A" to "A-1"        | Certified true copy of a duly executed Wireless games Agreement entered into by and between the Opposer and its Philippine distributor, Information Gateway, Inc. (a/so marked as Exhibit "5" of the Affidavit of Opposer's witness, Tomer Ben-Kiki). This document bears the duly signed and notarized Certification made by Mr. Jordan Goldstein, the Opposer's Company Secretary, declaring that the attached Wireless Games Agreement is a true and correct co of the original Agreement |

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| "B"   | Print-out of a news item/story entitled "GMA Network, IPVG announce gaming joint venture" dated December 22, 2007 that was downloaded from the Inquirer.net website  |
| "C"   | Certified true copy of U.S. Federal Registration No.2, 643, 124 for the mark "I-PLAY" issued by the United States Patent and Trademark office ("USPTO") in the Opposer's name covering services falling under International Class 41   |
| "D"   | Certified true copy of U.S. Trademark Application bearing Serial/Application No. EC004513057 for the mark "I-PLAY" filed with the USPTO in the Opposer's name seeking to cover goods falling under International Class 9 and services falling under International Classes 38 and 41  |
| "E"   | Certified true copy of CTM Reg. No. 4163572 for the mark "I-PLAY" issued by the Office for Harmonization in the Internal Market (OHIM) in the European Union in the Opposer's name for goods falling under International Class 9 and for services falling under International Classes 38 and 41  |
| "F"   | Certified true copy of Community trade Mark ("CTM") Serial/Application No. RC004513057 for the mark "I-PLAY" filed with the Office for Harmonization in the Internal Market (OHIM) in the European Union in the Opposer's name for goods falling under International Class 9 and for services falling under International Classes 38 and 41                                    |
| "G"   | Duly executed, notarized and legalized Affidavit of Tomer Ben-Kiki, a director of Opposer Company, who serves as Opposer's witness in the case   |
| "H"   | Certificate of Good Standing stating that Tomer Ben-Kiki was appointed on June 29, 2007 as a Director of Opposer Company ( <i>the original of which is attached and marked as Annex "A" of the Verification and Certification of Non-Forum Shopping page of the Notice of Opposition, as well as a copy thereof marked as Exhibit "1" of the affidavit of Tomer Ben-Kiki</i> ) |
| "H-1" | Duly executed, notarized and legalized Certification on the authority of Tomer Ben-Kiki to act on the Opposer's behalf, as well as serving as a Power of Attorney granted to undersigned counsel to act an Opposer's behalf in respect of the instant Opposition case  |
| "I"   | Print-out of the Opposer's website <a href="http://www.iplay.com">http://www.iplay.com</a> ( <i>attached and marked as Exhibit "3" of the Affidavit of Tomer Ben-Kiki</i> )  |
| "J"   | Print-out of a Google Analytics webpage showing that the Opposer's website received 3,647 visits from individuals based in various cities within the Philippine ( <i>attached and marked as exhibit "4" of the Affidavit of Tomer Ben-Kiki</i> )   |
| "K"   | Depiction of the "I-Play" brand which is displayed when each game from the Opposer's website is downloaded ( <i>attached and marked as Exhibit "6" of the Affidavit of Tomer Ben-Kiki</i> )  |
| "L"   | Screen shot of Information gateway's promotion(2) In the Philippines in connection with Netopia of the Opposer's games bearing it's "I-Play" name and brand ( <i>attached and marked as Exhibit "7" of the Affidavit of Tomer Ben-Kiki</i> )   |
| "M"   | Opposer's notes to financial statements for year that ended December 31, 2006 ( <i>attached and marked as Exhibit "8" of the Affidavit of Tomer Ben-Kiki</i> )   |
| "N"   | M: Metrics charts for Opposer ( <i>attached and marked as Exhibit "9" of the Affidavit of Tomer Ben-Kiki</i> )   |
| "O"   | Copies of announcements of various awards won by the Opposed ( <i>attached and marked as Exhibit "10" of Tomer Ben-Kiki</i> )  |
| "P"   | Copies of announcements of various awards won by the Opposer ( <i>attached and marked as Exhibit "11" of Tomer Ben-Kiki's Affidavit</i> )  |



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| “Q” | Copy of the advertisement for the Official Mobile Phone Game based in the 2006 Olympic Winter Games in Torino, Italy and the resulting game Torino 2006, for which the Opposer had the exclusive license to develop <i>(attached and marked as Exhibit “12” of Tomer Ben-Kiki’s Affidavit)</i>                                      |
| “R” | Representative copies of articles that appeared In the publications The Guardian, Mobile Entertainment, MCV, Mobile Games Analyst, What Mobile, Dmeurope.com and GameIndustry.biz pertaining to Opposer’s game bearing its “I- Play” name and brand <i>(attached and marked as Exhibit “13” of the Affidavit of Tomer Ben-Kiki)</i> |
| “S” | Copies of representative samples of advertisements bearing the Opposer’s “I-Play” mark posted/published in various publications released in different countries <i>(attached and marked as Exhibit “14” of the Affidavit of Tomer Ben-Kiki)</i>   |
| “T” | Copies of print-outs from various websites featuring sponsorships and promotions made by the Opposer of its “I-Play” mark <i>(attached and marked as Exhibit “15” of the Affidavit of Tomer Ben-Kiki)</i>   |
| “U” | Displays of pictures of I-Play POP signages made at the Mobile Gaming Championship <i>(attached and marked as Exhibit “16” of the Affidavit of Tomer Ben-Kiki)</i>  |
| “V” | Copy of advertisement which appeared In ME: Mobile Entertainment on or around April 4, 2005, accompanied by duly signed and notarized Certification of Ms. Jennifer Susan Atwood, Opposer’s Company Secretary that this advertisement is a true and correct copy of the original advertisement                                      |
| “W” | Duplicate original of BLA Decision No. 4-2008-195 dated November 5, 2008 in relation to IPC No. 14-2008-00102 entitled “Digital Bridges Limited vs. IP E-Games Ventures, Inc.” - Opposition to Application No. 4-2007-006546 for the mark “I-PLAY” with filing date of June 25, 2007  |

Records show that a Notice to Answer was issued on February 09, 2009 and personally served on February 20, 2009 to respondent-applicant’s agent/representative, Ms. Sheilah Mae W. Famador, who received it on said date. Pursuant to Subsection 8.1, Section 8 of Office Order No. 79 Series of 2005, respondent-applicant had until March 22, 2009 to file its verified answer together with the affidavit of its witness and other documents in due form in support of its application, but failed to do so. This constitutes a waiver for respondent-applicant to file said verified answer and documents pursuant to Section 11 of the same Office Order which provides:

Section 11. Effect of failure to file an answer. - In case the Respondent-Applicant fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the Petition or Opposition, the affidavit of the witness and documentary evidence submitted by Petitioner or Opposer.

The issues to be resolved are as follows:

1. Whether respondent-applicant’s mark “I-PLAY” is confusingly similar to opposer’s mark “I-PLAY”; and
2. Who between opposer and respondent-applicant is the owner of the mark “I-PLAY”.

Opposer’s mark us depicted below:



Meanwhile, respondent-applicant's mark is depicted below:



There is no question that the competing marks are confusingly similar: Except for the letter "P" in opposer's mark which is in lower case and that in respondent-applicant's mark which is in upper case, both marks consist of the word "I-PLAY" spelled and pronounced in the same manner. Further, both appear to be written with serifs, or in Times Roman-like font. The difference in the case of the letter "P" is very minor.

Thus, the word "I-PLAY" gives the same visual and aural impressions to the public's mind in the light of the goods to which they are used respectively by petitioner and respondent-registrant (*McDonald's Corporation v. MacJoy Fastfood Corporation*, G. R. No. G.R. No. 166115, February 2, 2007; *McDonalds Corporation v. L. C. Big Mak, Inc.*, G. R. No. 143993, August 18, 2004). Similarity in size, form and color, while relevant, is not conclusive. Neither duplication/imitation, or the fact that the infringing label suggests an effort to emulate, is necessary. The competing marks need only contain the main, essential or dominant features of another; and that confusion and deception are likely (*Sterling Products International, Inc. v. Farbenfabriken Bayer Aktiengesellschaft*, G.R. No. L-19906, April 30, 1969; *Urn Hoa v. Director of Patents*, G. R. No. L-8072, October 31, 1956; *Co Tiong Sa v. Director of Patents, et al.*, G. R. No. L-5378, May 24, 1954).

In the case at bench, the likelihood of confusion is heightened by the fact that the respective goods and/or services of the parties, though under different classes, are not only related but similar. Respondent-applicant's computer data bases (compilation of information) are a general category that could refer to electronic publications; computer hardware and software for entertainment content; computer programs in general; or computer games, and all of these are some of opposer's goods. Respondent-applicant's services for advertising/dissemination of advertising matter; communication media (presentation of goods) for retail purposes; and commercial information and advice for consumers/consumer advice shop could refer to electric publications or publications provided on-line; computer programs; sound video and data recordings; records, discs, tapes, cassettes, cartridges and cards bearing data, sound, images, graphics, texts, programs, or information; telecommunications services; and electronic mail and messaging, all of which may be used for advertising, and these are some of opposer's services.

In view of the confusing similarity of opposer's and respondent-applicant's respective marks, and of the similarity / relatedness of their goods and services, even the relevant sector of the public that patronizes such goods and / or services to which the respective "I-PLAY" marks of opposer and respondent-applicant are attached might likely be induced to believe that the goods of one party are those of the other party and/or that, at the least, there is some connection between opposer and respondent-applicant which, in fact, does not exist. There is likelihood not only of confusion of goods but also confusion of business as the marks are practically one and the same.

As to the first issue, thus, this Bureau rules in the affirmative.

Opposer submitted in evidence a legalized copy of a Wireless Games Agreement showing that it entered into a contract with Information Gateway, Incorporated for the latter to distribute opposer's games (Exhibit "A" and "A-1"). The games are downloaded on mobile phone devices through a server of Information Gateway, Incorporated that is, in turn, made possible by

portals such as the wireless application protocol (WAP) or other web sites. In essence, opposer's goods and / or services are coursed through the use of the internet.

The following question now arises: Is there use of opposer's "I-PLAY" mark in the Philippines through the sale and / or distribution of its goods and / or services to which said mark is attached subsequent to the distribution agreement with Information Gateway, Incorporated; and if so, when was the first use thereof?

Opposer submitted in evidence a legalized affidavit of its Director, Tomer Ben-Kiki, testifying that its website was visited by individuals in the Philippines between January 10, 2007 to January 10, 2008 (Exhibit "G"). This testimony refers to and is buttressed by a downloaded copy of the list of "hits" in specific cities in the Philippines received by opposer in its website (Exhibit "J"). Moreover, a downloaded copy of a page in opposer's website in partnership with Netopia shows that opposer's games "The Fast and The Furious" and "Jewel Quest" are among the most downloaded mobile games in the Philippines (Exhibit "L"). This downloaded copy is also referred to in Ben-Kiki's affidavit. To "download" is "to transfer data or programs from a server or host computer to one's own computer or digital device" (Dictionary.Com). All these are relevant evidences which a reasonable mind may accept as adequate to support the statement that opposer's mark "I-PLAY" is being used in the Philippines through the downloading of games to which it is attached, used, or associated. In view hereof, there is reasonable ground to believe that opposer is offering for sale and / or selling mobile games using the mark "I-PLAY" to individuals in the Philippines, albeit starting in 2007.

Opposer likewise submitted in evidence, as follows, documents to show its history as a limited company that conceived, or came up with the mark and concept of "I-PLAY" before respondent-applicant applied for registration of its confusingly similar "I-PLAY" mark.

Opposer was incorporated as a limited company on April 29, 1998 under the United Kingdom's The Companies Act 1985 (Exhibit "H"). Since its incorporation, opposer has been in continuous and unbroken existence; is not in liquidation or subject to an administration order; and has not been appointed a receiver or manager at least by April 25, 2008 (Exhibit "H"). Opposer applied with the United States Patent and Trademark Office (USPTO) for, and was granted, registration on October 29, 2002 of the mark "I-PLAY" for Class 41 services (Exhibit "C"). It also applied with the USPTO for registration on November 11, 2005 of the same mark for Classes 09, 38, and 41 goods and / or services (Exhibit "O"). Further, it applied with the Office for Harmonization in the International Market (OHIM) for, and was granted, registration on March 02, 2006 of the same mark likewise for said Classes 09, 28, and 41 (Exhibit "E"). Per its evidences, opposer's "I-PLAY" games have been offered online since 2005 (Exhibits "N", "P", and "R"). There are various articles issued in 2005 by foreign media referring to the mark "I-PLAY" as a mark and concept that is the brain Child of opposer in respect to opposer's goods and / or services to which said mark is attached (Exhibits "R").

With all the foregoing evidences, there is reasonable ground to believe that opposer is the entity that indeed conceived, or came up with the mark "I-PLAY" before respondent-applicant applied for registration of its confusingly similar mark. Meanwhile, respondent-applicant failed to file its Answer and present evidence to rebut opposer's foregoing evidences; and failed to show by its failure to file a Declaration of Actual Use that, for goods and / or services similar and / or related to opposer's goods and / or services, it is the originator of the mark "I-PLAY" or, at least, that it conceived and used the mark prior to January 10, 2007 when opposer was already appearing online in the Philippines and was receiving "hits" for its mobile games. Moreover, opposer used the mark in the Philippines not long after the series of acts it undertook as a logical outcome of its having conceived said mark- registrations with the USPTO and the OHIM- and of the series of events that happened as a result of the recognition abroad of its ownership over its mark- the newspaper and electronic articles and the awards; and before respondent-applicant applied for its registration for similar and / or related goods and / or services.

Opposer was able to show by the evidences it submitted that it is the originator of the mark "I-PLAY" and it used said mark in the Philippines prior to the application for registration by respondent-applicant of a confusingly similar mark for the same and / or related goods and / or services. This Bureau is aware that use of a mark by a person or entity other than the applicant prior to the use or filing of an application of a confusingly similar mark by the applicant for the same and / or related goods and / or services will not necessarily defeat the grant of the application, as- regardless of such situation- the IP Code now only requires that the applicant proves his / its use of the mark within three (3) years from the filing of the application through a declaration of actual use (DAU). Thus, priority in use of the mark is not the gauge per se.

But having proved that it conceived, concretized, and thereafter, used in the Philippines its mark "I-PLAY" prior to respondent-applicant's application for registration of the subject mark, opposer must be declared the owner of the mark "I-PLAY". As mentioned earlier, respondent-applicant failed to prove, by failing to file an Answer and attach evidences thereto, especially to attach a Declaration of Actual Use that it conceived and used its mark prior to opposer's use of its own mark in the Philippines.

As to the second issue, thus, this Bureau rules that opposer is the owner of the mark "I-PLAY".

WHEREFORE, with the NOTICE OF OPPOSITION is, as it is, hereby SUSTAINED. Consequently, Application Serial No. 4-2008-000521 for the mark "I-PLAY" filed by respondent-applicant IP E-Game Ventures, Inc. on January 15, 2008 for services under Class 35 namely, "advertising, updating of advertising material, dissemination of advertising matter, communication media (presentation of goods) for retail purposes, computer data bases (compilation of information) consumers (commercial information and advice for) consumer advice shop" is, as it is hereby, REJECTED.

Let the filewrapper of this case together with this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, July 29, 2009.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs  
Intellectual Property Office