

HEAD SPORT GMBH,  
Opposer,

-versus-

KARL LAGERFELD B. V.,  
Respondent-Applicant.

x-----x

IPC No. 14-2013-00048

Opposition to:

Application No. 4-2012-500670

Date Filed: 20 March 2012

Trademark: **HEAD DEVICE**

Order No. 2015 - 1698

## ORDER

The records show that this Bureau issued Decision No. 2015-244 dated 04 November 2015. This Bureau finds no merit in the opposition that, as discussed in the decision, the mark HEAD DEVICE of the Respondent-Applicant is highly distinguishable from that of the Opposer's. However, the dispositive portion of the decision inadvertently stated that the opposition is "SUSTAINED", when in fact the opposition is DISMISSED.

Accordingly, to correct the records and in the interest of justice, Decision No. 2015-244 dated 04 November 2015 is hereby **AMENDED**, the dispositive portion of which, to read as follows:

"WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-500670 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action."

SO ORDERED."

SO ORDERED.

Taguig City, 01 December 2015.

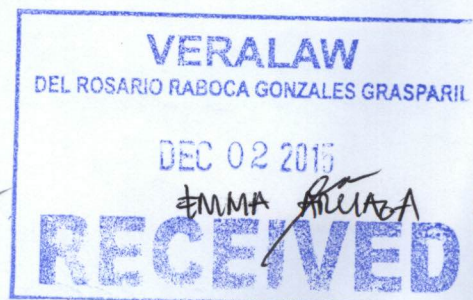
Atty. NATHANIEL S. AREVALO  
Director IV, Bureau of Legal Affairs

Copy furnished:

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Received By: Rebecca B. Virkhar





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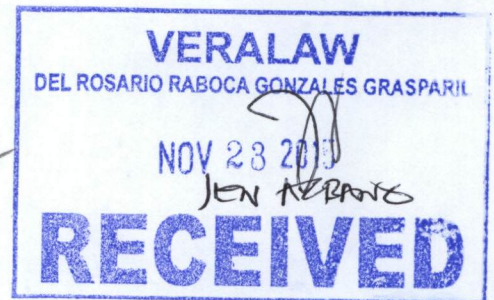
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}  
} IPC No. 14-2013-00048  
} Opposition to:  
} Appln. No. 4-2012-500670  
} Date Filed: 20 March 2012  
} TM: HEAD DEVICE (2012)  
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### NOTICE OF DECISION

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### GREETINGS:

Please be informed that Decision No. 2015 - 244 dated November 04, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 04, 2015.

For the Director:

*Edwin O. Dating*  
**Atty. EDWIN DANILO A. DATING**  
Director III  
Bureau of Legal Affairs



HEAD SPORT GMBH,  
Opposer,

-versus-

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Respondent-Applicant.

X-----X

IPC No. 14-2013-00048  
Opposition to:  
Appln. No. 4-2012-500670  
Date Filed: 20 March 2012  
TM: HEAD DEVICE (2012)

**NOTICE OF DECISION**

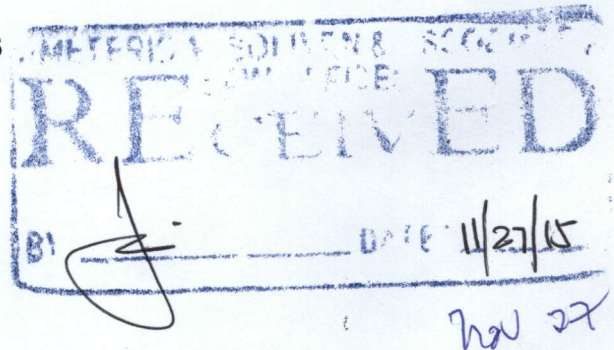
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**X VERALAW**

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**GREETINGS:**

Please be informed that Decision No. 2015 - 244 dated November 04, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 04, 2015.

For the Director:

*Edwin O. Dating*  
**Atty. EDWIN DANILO A. DATING**  
Director III  
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**CERTIFIED TRUE COPY**  
DATE **NOV 10 2015**  
*Sharon S. Alcantara*  
**SHARON S. ALCANTARA**  
Administrative Officer III  
Bureau of Legal Affairs



**HEAD SPORT GMBH,**

Opposer,

-versus-

**KARL LAGERFELD B.V.,**

Respondent-Applicant.

X ----- X

IPC No. 14-2013-00048

Opposition to Trademark

Application No. 4-2012-500670

Date Filed: 20 March 2012

Trademark: **"HEAD DEVICE"**

Decision No. 2015- 244

### DECISION

Head Sport GMBH<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-500670. The contested application, filed by Karl Lagerfeld B.V.<sup>2</sup> ("Respondent-Applicant"), covers the mark "HEAD DEVICE" for use on *"photographic, cinematographic and optical apparatus and instruments; optical goods namely spectacles, protective spectacles, spectacle glasses, contact lenses, sunglasses; sunglass products, namely headstraps, sunglass retainers, eyeglass cases and sunglass cases, spectacles presentation boxes, spectacles chains and spectacles cords, parts for all aforesaid goods; cameras cases; cases and holders for portable computers and mobile phones; blank audio tapes, blank audio cassettes, blank video tapes, video cameras; blank video cassettes, blank compact discs, compact discs featuring music, blank laser discs, video discs and magnetic optical discs featuring topics in the fields of fashion, modeling, cosmetics and lifestyles; blank magnetic data carriers, blank recording discs; pre-recording discs featuring topics in the fields of fashion, modeling, cosmetics and lifestyles; computers; computer peripheral equipment; recorded computer programs featuring topics in the fields of fashion, modeling, cosmetics and lifestyles; mouse pads, magnetic coded cards featuring topics in the fields of fashion, modeling, cosmetic and lifestyles; compact discs (audio-video) featuring topics in the fields of fashion, modeling, cosmetics and lifestyles; optical compact discs featuring topics in the fields of fashion, modeling, cosmetics and lifestyles; compact disc players; downloadable electronic publications in the nature of books, magazines, newsletters, brochures and catalogs in the fields of fashion, modeling, cosmetics and lifestyles; pocket calculators; video game cartridges; headphones; loudspeakers", "jewellery namely, bracelets, necklaces, brochures, rings, earrings, charms, tie tacks, hat ornaments, badges of precious metals, belt ornaments of precious metals, pins being jewellery, cuff links, key rings; jewellery and precious stones; horological and chronometric instruments namely, watches, wrist-watches, straps for wrist-watches and watch cases, clocks, chronographs (wrist watches), chronometers, alarm clocks; watches cases; jewellery cases; shoe and hat ornaments of precious metal", "leather and imitations of leather; animal skins; full line of bags, namely, all purpose sports and*

<sup>1</sup> A limited liability company organized and existing under the laws of the Republic of Austria, with principal address at 7000 Portage Road, Kalamazoo, Michigan 49001, USA.

<sup>2</sup> With known address at Looiersgracht 43 1016 VR Amsterdam, The Netherlands.

**Republic of the Philippines**  
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*athletic bags; overnight bags; book bags; tote bags; travelling bags; backpacks; handbags; luggage; suitcases; purses; brief cases; travel bags; duffel bags; and cloth shopping bags; beach bags; wheeled shopping bags, school bags; garment bgs for travel; straps for luggage; overnight cases; clutch bags; travel kit bags sold empty; suit cases with wheels attached; billfolds; wallets, pocket wallets, change purses, coin purses, key cases, credit card cases; credit card money folds; card cases, cosmetic cases sold empty, cases and holders for cosmetic articles; cases for manicure sets; beauty-cases for storing cosmetics; jewelry rolls for travel and storage, umbrellas, parasols and walking sticks; whips, harness and saddler, collars for animals; harness for animals", "fabrics and textile goods not included in other classes, namely, household linen, bed linen, bed sheets, pillow shams, pillow cases, blankets, comforters, quilts, bedspreads, bed covers, coasters, duvet covers, duvet, dust ruffles, mattress covers, table linen, table covers, table cloths, fabric table runners, table napkins of textile, place mat of textile material, curtains, draperies, unfitted fabric furniture covers, fabric flags, handkerchiefs; cloth labels; floor towels; curtain tie-backs in the nature of textile curtain holders; net curtains; upholstery fabrics, wall hanging of textiles" and "clothing for men, women and children and infants namely, shirts, golf shirts, t-shirts, polo shirts, knit tops, woven tops, sweatshirts, tank tops, sweaters, blouses, jerseys, turtle-necks, shorts, sweatpants, warm-up suits, blazers, sport coats, trousers, jeans, skirts, dresses, wedding dresses, suits, overalls, jumpers, vests, jackets, coats, raincoats, parkas, ponchos, swimwear, bikinis, swim trunks, overcoats, rainwear, wind resistant jackets, clothing for dancing namely leotards and ballet suits, sleepwear, pajamas, bathrobes, shower caps, chasubles, underwear, lingerie, boxer shorts, belts made of leather, ties; headgear namely, hats, wool hats, caps, visors, headbands, ear muffs; scarves, shawls, wristbands, cloth bibs; footwear, gym shoes, sneakers, socks, stockings, hosiery, shoes, bibs; foortwear, gym shoes, sneakers, socks, stockings, hosiery, shoes, boots, beach shoes, sandals, slippers, gloves, suspenders; layette; sashes for wear" under Classes 09, 14, 18, 24 and 25, respectively, of the International Classification of Goods<sup>3</sup>.*

The Opposer alleges that it is the owner and originator of the mark "HEAD" as the same has been a major part of its corporate name. It maintains that it is the prior user of the mark "HEAD", which it claims to be deceptively and confusingly similar to the Respondent-Applicant's mark. It avers that it applied for registration on 18 April 1978 under its predecessor, AMF Incorporated, and has spent much for advertisement and promotion of the said mark. According to the Opposer, it deserves protection under Sections 123, 124 and 147 of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code").

<sup>3</sup> 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.



This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 30 April 2013. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued on 16 October 2013 Order No. 2013-1412 declaring the Respondent-Applicant in default and the case submitted for decision.

The question is whether the mark "HEAD DEVICE" should be allowed registration.

The Opposer claims that its predecessor applied an application for registration of the mark "HEAD" before the Respondent-Applicant filed the contested application. However, it did not attach and/or present evidence in support thereto or to any of its allegations for that matter.

Also, this Bureau finds that while the Respondent-Applicant's mark is entitled "HEAD DEVICE", the same does not include the word "HEAD", as shown below:



The applied mark is only given the title "HEAD DEVICE" as it consists of a profile of a man's head and part of his shoulders. When one looks at the applied mark, however, the idea that it is a representation of a "head" will not immediately come to mind. The "HEAD DEVICE" has other distinctive features as described in the application to wit: "THE MARK CONSISTS OF A PROFILE OF A MAN'S HEAD AND SHOULDERS. THE MAN HAS A PONYTAIL, IS WEARING GLASSES AND IS WEARING A COLLAR (CLOTHING) AROUND HIS NECK". These features make the "HEAD DEVICE" mark highly distinguishable. On the other hand, the prevalent feature in the Opposer's tradename is the word "HEAD" itself, which does not appear in the Respondent-Applicant's mark. Hence, it is highly unlikely for purchasers to confuse or even associate one with the other.

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.<sup>4</sup> Respondent-Applicant's trademark sufficiently met this function.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-500670 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 04 November 2015.

  
**ATTY. NATHANIEL S. AREVALO**  
Director IV  
Bureau of Legal Affairs

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<sup>4</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.