

OGIO INTERNATIONAL, INC.,
Opposer,

-versus-

HONG WEN KAI,
Respondent- Applicant.

x-----x

} IPC No. 14-2012-00221
}
} Opposition to:
} Appln. Serial No. 4-2011-012462
} Date Filed: 17 October 2011
} TM: "OGIO AND LOGO"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 272 dated July 28, 2016 (copy enclosed) was promulgated in the above entitled case.

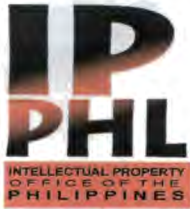
Taguig City, July 28, 2016.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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OGIO INTERNATIONAL, INC.,

Opposer,

-versus-

HONG WEN KAI,

Respondent-Applicant.

x-----x

IPC No. 14-2012-00221

Opposition to:

Application No. 4-2011-012462

Date Filed: 17 October 2011

Trademark: "OGIO AND
LOGO"

Decision No. 2016- 272

DECISION

OGIO INTERNATIONAL, INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-012462. The application, filed by Hong Wen Kai² ("Respondent-Applicant"), covers the mark "OGIO AND LOGO" for use on "*bags and wallets*" under Class 18 and "*blouse, skirts, shorts, t-shirts, polo shirts & polo, jeans, sandals shoes, socks, bras & underwear*" under Class 25 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"Discussions:

"29. There can be no question that the contending trademarks are identical as shown by a side by side comparison:

x x x

"30. Given that these contending trademarks are identical in all aspects and points of design, how will the law now resolve the dispute?

"31. This is answered in the decisions of the Supreme Court which have been applied consistently by this Honorable Office as shown in a very recent decision which it rendered in the case of Q.S. Holdings SARL vs. Ramon Ong, Appeal No. 14-09-56 (May 15, 2012) where he ruled: 'xx if the mark subject of a TM application is exactly the same in appearance as the mark already registered or used by another, then the law will presume that the TM application is filed fraudulently or in bad faith, in that the applicant is deemed to have intended to copy the mark of the latter in order to ride on the goodwill

¹ A foreign corporation duly organized and existing under and the laws of Utah, United States of America, with principal office at 14926 South Pony Express Road Bluffdale Utah 84065 USA.

² With address at 115 Mauban St., Brgy. Manresa, Quezon City.

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

of the copied mark. A trademark application which was filed in bad faith can never mature into a registration.

"32. That is, the applicant has before him a boundless choice of words and designs, and for him to come out with a mark which exactly copies the mark of another, is indication of his intent to copy the latter trademark.

"33. There is no question that the goods covered by the contending trademarks are closely related, if not identical. Respondent-Applicant's trademark application, as published, identified its goods as 'bags and wallets' and 'blouse, skirts, shorts, t-shirts, polo shirts & polo, jeans, sandals, shoes, socks, bras & underwear' in International Classes 18 and 25, while Opposer's goods are 'all purpose athletic bags, daypacks, tote bags, all purpose sports bags, duffel bags, book bags, school bags, shoulder bags, hard-sided and soft-sided carry-on bags and gym bags' and 'clothing, namely, men's and ladies shirts, pants, bathing suits, bathing trunks, beach cover-ups, beachwear, athletic footwear, athletic jerseys, unitards, leotards, coats, jackets, sweatshirts and sweatpants' also covered under Classes 18 and 25.

"34. Because of the relatedness of the parties goods', the source and origin of these goods can easily be confused by the relevant consumers. Both goods flow through the same channels of trade and are directed to the same sector or category of consumers.

"35. If Respondent-Applicant is permitted to use the challenged trademark, Opposer will suffer irreparable damage from association with products that are of inferior quality.

"36. If the trademark is also well-known, then the IP Code expressly grants protection to such a mark against a copycat regardless of whether the contending goods or services are related or similar, or not. Thus, Section 123.1 (e) and (f) state:

x x x

"37. In considering whether a mark is well-known or not within the ambit of protection of Section 123.1 (e) of the IPC, reference to the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers, particularly, Rule 102 thereof, is necessary. Said Rule 102 provides:

x x x

"38. It is immediately apparent that the facts adduced in the Verified Notice of Opposition as well as the Affidavits and documentary exhibits constitute the relevant facts showing that Opposer's OGIO and O DEVICE marks are well-known, following the above-mentioned criteria. These facts, and the corresponding criteria, are as follows:

x x x

"39. Without doubt, the criteria set to guide in determining if a mark is well-known or not, have been met and proven. Opposer's OGIO and O DEVICE are clearly well-known, both internationally and in the Philippines and hence, they can no longer be appropriated by Respondent-Applicant.

"40. Under a similar situation as depicted in the case of Sehwhani vs. In-N-Out Burder, Inc., the Supreme Court found the evidence of world-wide registration and extensive Internet postings as sufficient to declare the trademark well-known internationally and in the Philippines.

"41. The Sehwanī doctrine should be applied because this Honorable Office has issued recent decisions affirming the Sehwanī tenet, as follows:

x x x

"42. For being extensively promoted and for being registered in numerous countries, Opposer's OGIO and O DEVICE have the status of well-known marks pursuant to the Sehwanī doctrine. Hence, it should be protected as against the challenged application to give effect to said Sections 123.1(f) and 147.2.

"43. And there is another legal effect of the well-known status of Opposer's OGIO and O Device marks.

"44. In the December 22, 2009 Decision in Appeal No. 14-09-19 in the case entitled Paul Frank Industries, Inc. vs. Alan Sia Yu, the Office of the Director General held as follows:

x x x

"45. Verily, with OGIO and O Device of Opposer having the status of a well-known marks for being prominently posted in the internet, then under the Paul Frank ruling, the conclusion is inescapable that Respondent-Applicant should be deemed to have prior knowledge of Opposer's OGIO and O Device, and that it therefore copied the said marks solely to take advantage of the goodwill and well-known status of Opposer's OGIO and O Device.

"46. As afore-discussed, this effectively degrades the challenged OGIO AND LOGO as nothing more but a fraudulent or bad faith copycat of Opposer's OGIO and O DEVICE, and thus should be slain on sight pursuant to Section 151 of the IP Code.

"47. Section 151 of the IP code proscribes registrations 'obtained fraudulently or contrary to the provisions of this Act.' In this regard, the law will presume that a mark is fraudulent if it is identical to a mark belonging to another, and the copycat cannot explain the similarity.

"48. In the case of Converse Rubber Corporation vs. Universal Rubber Products, Inc., the Supreme Court ruled:

x x x

"49. And in the subsequent case of Shangri-La International Hotel Management, Ltd. vs. Developers Group of Companies, Inc., the Supreme Court again held that:

x x x

"50. What is more, the Supreme Court in the same case recognized that:

x x x

"51. As could be gleaned from these decisions, the applicant or junior entrant is at the very least required to explain the origins of his trademark in order to successfully explain away the similarity as merely coincidental. That is, the explanation must be 'reasonable' without which the presumption of bad faith copying arises.

"52. A consistent position was adopted by the Supreme Court in a much later case of Fredco Manufacturing Corporation vs. President Fellows of Harvard College (Harvard University) decided in June 2011 when it upheld the right of Harvard University to register HARVARD in connection with goods in Class 25 because the records failed to disclose any explanation for the adverse party's use of the name and mark "HARVARD' and the words 'USA', 'Established in 1936' abd 'Cambridge, Massachusetts' within an oblong device, 'US Legend' and 'Europe's No. 1 Brand.'

"53. And the Honorable Director General has unequivocally ruled in many cases affirming the good faith requirement when applying for registration. In Harbour Footwear Group Ltd. versus Nelson Chan [ODG Appeal No. 14-08-18, Inter Partes Case No. 14-2001-00053 and in Original Appalachian Artworks, Inc. versus Didi Chan, [ODG Appeal No 1-25, Inter Partes Case No. 3785, the Honorable Director General ruled thus:

x x x

"54. And in the case of Quinns Marketing Services Limited versus Anil Kapahi and Sura Kapahi [ODG Appeal No. 14-07-53, Inter Partes Case No. 14-2007-00071 the Director General ruled thus:

x x x

"55. And most significantly, in the case of Paul Frank Industries, Inc. versus Alan Sia Yu [ODG Appeal No. 14-09-19, Inter Partes Case No. 14-2007-00247, it was ruled that:

x x x

"56. There is thus no more doubt that jurisprudence prescribes that there be a clear nexus between the trademark and the circumstances of the person or entity claiming protection for the same. That if there is nothing in any of the circumstances of a party that would connect it to the mark that he adopts and thus merit his coinage of such mark, the inference is that the coinage is a bad faith one designed to ride on the goodwill of the copied mark. The Supreme Court in McDonald's Corporation vs. MacJoy Fastfood Corporation, held:

x x x

"57. Applying the foregoing rules, it is evident that the challenged registration is obviously a fraudulent or bad faith adoption of Opposer's OGIO and O DEVICE trademarks. There is simply nothing that can be seen from the personal circumstances of Respondent-Applicant that would merit his coinage of the OGIO AND LOGO trademark. Obviously, his Chinese name cannot point to a connection with his OGIO AND LOGO trademark to merit his coinage of this mark.

"58. In contrast, the OGIO and O trademarks of Opposer has an easily explained origin and coinage: it is Opposer's corporate name, and the well-known brand for its popular racquets.

"59. The foregoing principle has guided this Hon. Office in resolving cases before it involving identical trademarks.

"60. The Office of the Director General has reiterated the definition of bad faith filing or registration in the case of Mustang-Bekleidungswerke GMBH+Co. KG. vs. Hung Chiu Ming, which was decided on August 29, 2007, as follows -

x x x

"61. Since a trademark or trade name or other mark of ownership is acquired by adoption and use thereof in commerce, it belongs to the person who first used and gave it value. The person who has established prior adoption and use of the mark or trade name acquires ownership thereof on goods upon which it is used or affixed or on goods and articles related thereto. He is entitled to use it to the exclusion of others, to register, and to perpetually enjoin others from using as explained in the cases of Chung Te vs. Ng Kian Giab, Ed A. Keller & Co. vs. Kinkua Marijasu Co., Parke Davis & Co., vs. Kiu Foo & Co.

"62. OGIO being the Opposer's corporate, business or trade name, it enjoys separate protection under the law and jurisprudence.

"63. The rule is, even if Opposer's corporate name is not yet registered as such in the Philippines, still, it is a protected trade name and/or business name under the contemplation of the Paris Convention and the IPC.

"64. Article 6 and 8 of the Paris Convention states:

x x x

"65. And Section 165 of the IPC provides:

x x x

"66. There should therefore be no quibbling that from the outset, the instant TM Application is unregistrable, because it encroaches upon the corporate name of Opposer.

"67. Foreign corporations, such as Opposer herein, are particularly entitled to the protection of this prohibition, based on well-settled jurisprudence.

"68. Thus, in General Garments Corporation vs. The Director of Patents and Puritan Sportswear, it was held that:

x x x

"69. Similarly, in Western Equipment and Supply Co. v. Reyes and Red Line Transportation Co. v. Rural Transit Co., it was uniformly held as follows:

x x x

"70. In Western, it was particularly ruled as follows:

x x x

"71. This basic doctrine was reiterated in recent years, particularly in Philips Export B.V. et al. vs. Court of Appeals, et al.

"72. In the recently decided case of Coffee Partners, Inc. vs. San Francisco Coffee & Roastery, Inc., the Supreme Court held

x x x

"73. There is thus no quibbling about the application of this prohibition in the case at hand, OGIO is the trade name, more accurately, the corporate name, of Opposer, and hence, Respondent-Applicant is barred from filing a trademark application for the registration of OGIO AND LOGO.

"74. The Civil Code of the Philippines identifies the goodwill of a business as property. And the protection of goodwill involving intellectual property is enshrined in Section 168 of the IP Code, thus:

x x x

"75. Goodwill involving intellectual property is acquired by a trademark through continued use, quality of goods or services, and ingenuity of the business. As held in *Dela Rama Steamship Co. vs. National Dev. Co.*:

x x x

"76. And goodwill of intellectual property is proven by evidence of continuous use, promotions and advertising, as confirmed in *Levi Strauss (Phils.), Inc. vs. Vogue Traders Clothing Company*, thus:

x x x

"77. Under the law, a person will be deemed to be riding on the goodwill of a trademark belonging to another if he comes out with an identical copy of substantially similar version of such trademark, as taught in *Levi's*, thus:

x x x

"78. Otherwise stated, for choosing an exact copy of a mark belonging to another for use on the same goods, the copycat will be treated by law as out to ride on the goodwill, or to take advantage of such goodwill, residing in the copied mark.

"79. As held in the afore-cited *Shangri-La International Hotel Management, Ltd. vs. Developers Group of Companies, Inc.*:

x x x

"80. Applying the foregoing rule, it is undeniable that in the instant case, the goodwill of the OGIO brand of Opposer is amply proven by evidence of long and extensive use, through Opposer's flourishing world sales of its OGIO products, and extensive promotions and advertising campaigns.

"81. Opposer's goodwill has long been established in the Philippines as it has been selling its sporting goods and related products under the OGIO and O DEVICE trademarks through Pacsports Philippines, Inc. for years now.

"82. Resultantly, the challenged registration will permit the Respondent-Applicant to ride on the goodwill of Opposer's OGIO and O DEVICE. Since the contending marks are used on identical and/or similar goods and products, relevant customers will be deceived and misled into believing that Respondent-Applicant's products are sourced from, sponsored by or somehow associated with Opposer herein.

"83. Indeed, Respondent-Applicant has a boundless choice of words to identify its goods from the Opposer, and therefore, there is no reason why it would choose the same mark for its 'bags and wallets' and 'blouse, skirts, shorts, t-shirts, polo shirts & polo, jeans, sandals, shoes, socks, bras & underwear' except to ride on the goodwill of Opposer's OGIO and O DEVICE marks and products.

"84. Supporting Affidavits are concurrently submitted herewith pursuant to the Rules.

The Opposer's evidence consists of the Certificate of Existence and Articles of Ogio International, Inc.; copy of the Articles of Incorporation proving the corporate existence of the Ogio International, Inc.; copies of the certificates of trademark registration for OGIO and variations thereof and for the "O" logo issued in the USA, the European Community, Argentina, Australia, Brazil, Canada, India, Japan, Republic of Korea, Malaysia, Mexico, New Zealand, Singapore and South Africa; representative samples of advertising materials promoting the OGIO trademark and products; excerpts of published brochures featuring golfers advertising the OGIO products; printout of Ogio International Inc.'s website showing athletes with whom Ogio currently has a sponsorship relationship; affidavit of David Wunderli President of Ogio International, Inc.; affidavit of Jan Abigail Ponce; Special Power of Attorney; printout of Opposer's websites www.ogio.com; printouts of websites www.pacsports.com, Pacsports Philippines, Inc.'s official website, wherein Opposer's OGIO and O DEVICE products are distributed; printout of websites <http://www.facebook.com/pages/Pacsports-Philippines-Inc/103236623054703>, Pacsports Philippines, Inc. facebook page; and printout of websites featuring, discussing and reviewing OGIO products accessible to all Internet users worldwide including those coming from the Philippines.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 13 July 2012. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark OGIO AND LOGO?

The Opposer anchors its opposition on Sections 123.1, paragraphs (d), (e) and (f), Section 147.1 and 147.2, Section 165 and Section 168.1 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

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

x xx

(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;"

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered

⁴ Marked as Exhibits "A" to "L", inclusive.

here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

- (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 or service which are not similar to those with respect to which registration is applied for: *Provided*, That use of the mark in relation to those 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;

Sec. 147. *Rights Conferred.* - 147.1. The owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use, of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

147.2. The exclusive right of the owner of the well-known mark defined in Subsection 123.1 (e) which is registered in the Philippines, shall extend to goods and services which are not similar to those in respect of which the mark is registered: *Provided*, That use of that mark in relation to those 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.

Sec. 165. *Trade Names or Business Names.* - 165.1. A name or designation may not be used as a trade name if by its nature or the use to which such name or designation may be put, it is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

165.2. (a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

Records show that at the time the Respondent-Applicant filed its trademark application on 17 October 2011, the Opposer already owns trademark registrations for "OGIO" trademark and variations thereof in numerous countries around the world. In USA alone, it registered the "O" logo under Reg. No. 3242,983 issued on 15 May 2007. The USA registration covers "all purpose athletic bags, day-packs, backpacks, tote bags, all purpose sports bags, duffel bags, book bags, school bags, shoulder bags, hard-sided and soft-sided carry-on bags and gym bags" in Class 18 and "clothing; namely, men's and ladies' shirts, shorts, pants, bathing suits, bathing trunks, beachcoverups,

beachwear, athletic footwear, athletic jerseys, unitards, leotards, coats, jackets, sweatshirts, and sweatpants" in Class 25. This Bureau noticed that the goods covered by Respondent-Applicant's trademark application for the mark OGIO AND LOGO are similar and/or closely-related to Opposer's.

A comparison of the competing marks reproduced below:



OGIO



Opposer's trademarks

Respondent-Applicant's mark

shows that the marks are obviously identical and used on similar and/or closely related goods, particularly, wearing apparel. Thus, it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.⁵

Public interest therefore requires, that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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

⁵ Converse Rubber Corp. v. Universal Rubber Products, Inc. et. al., G.R. No. L-27906, 08 Jan. 1987.

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.⁶

The Respondent-Applicant's filing of their trademark application in the Philippines may be earlier than the Opposer's, but the latter raises the issues of trademark ownership, fraud and bad faith on the part of the Respondent-Applicant.

In this regard, this Bureau emphasizes that it is not the application or the registration that confers ownership of a mark, but it is ownership of the mark that confers the right of registration. The Philippines implemented the World Trade Organization Agreement "TRIPS Agreement" when the IP Code took into force and effect on 01 January 1998. Art 16(1) of the TRIPS Agreement states:

1. The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.

Clearly, it is not the application or the registration that confers ownership of a mark, but it is ownership of the mark that confers the right to registration. While the country's legal regime on trademarks shifted to a registration system, it is not the intention of the legislators not to recognize the preservation of existing rights of trademark owners at the time the IP Code took into effect.⁷ The registration system is not to be used in committing or perpetrating an unjust and unfair claim. A trademark is an industrial property and the owner thereof has property rights over it. The privilege of being issued a registration for its exclusive use, therefore, should be based on the concept of ownership. The IP Code implements the TRIPS Agreement and therefore, the idea of "registered owner" does not mean that ownership is established by mere registration but that registration establishes merely a presumptive right of ownership. That presumption of ownership yields to superior evidence of actual and real ownership of the trademark and to the TRIPS Agreement requirement that no existing prior rights shall be prejudiced. In *Berris v. Norvy Abyadang*⁸, the Supreme Court held:

⁶ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepe v. Director of Patents*, *supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

⁷ See Sec. 236 of the IP Code.

⁸ G.R. No. 183404, 13 Oct. 2010.

The ownership of a trademark is acquired by its registration and its actual use by the manufacturer or distributor of the goods made available to the purchasing public. Section 122 of the R.A. 8293 provides that the rights in a mark shall be acquired by means of its valid registration with the IPO. A certificate of registration of a mark, once issued, constitutes *prima facie* evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate. R.A. 8293, however, requires the applicant for registration or the registrant to file a declaration of actual use (DAU) of the mark, with evidence to that effect, within three (3) years from the filing of the application for registration; otherwise, the application shall be refused or the mark shall be removed from the register. In other words, the *prima facie* presumption brought about by the registration of a mark may be challenged and overcome, in an appropriate action, by proof of the nullity of the registration or of non-use of the mark, except when excused. Moreover, the presumption may likewise be defeated by evidence of prior use by another person, i.e., it will controvert a claim of legal appropriation or of ownership based on registration by a subsequent user. This is because a trademark is a creation of use and belongs to one who first used it in trade or commerce.

In this instance, the Opposer proved that he is the originator and owner of the contested mark. As stated, "Opposer was founded in 1987 by Mike Pratt after he designed the LockerBag gym bag. The current stylized versions of the marks were first used on the relevant goods sometime in September 2005. Ogio first began using other stylized versions of OGIO sometime in 1987. On March 10, 1987, Ogio International Inc. was incorporated".⁹ In contrast, the Respondent-Applicant despite the opportunity given, did not file an Answer to defend his trademark application and to explain how he arrived at using the mark OGIO AND LOGO which is exactly the same as the Opposer's. It is incredible for the Respondent-Applicant to have come up with exactly the same mark for use on similar goods by pure coincidence.

Also, Opposer has been using OGIO not only as a trademark but also as trade name or business name. As a trade name, OGIO is protected under Section 165 of the IP Code, to wit:

Sec. 165. *Trade Names or Business Names.* - 165.1. A name or designation may not be used as a trade name if by its nature or the use to which such name or designation may be put, it is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

165.2.(a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

165.3. The remedies provided for in Sections 153 to 156 and Sections 166 and 167 shall apply *mutatis mutandis*.

⁹ Pars. 14-16 of the Notice of Opposition.

165.4. Any change in the ownership of a trade name shall be made with the transfer of the enterprise or part thereof identified by that name. The provisions of Subsections 149.2 to 149.4 shall apply mutatis mutandis.

Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why of the millions of terms and combinations of letters and designs available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.¹⁰

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.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-012462 is hereby SUSTAINED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 28 JUL 2018.


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

¹⁰ *American Wire & Cable Company v. Director of Patents*, G.R. No. L-26557, 18 Feb. 1970.