

FITNESS ANYWHERE LLC,
Petitioner,

-versus-

CHRIS T. SPORTS PLAZA, INC.,
Respondent-Registrant.

IPC No. 14-2012-00345
Petition for Cancellation

Reg. No. 4-2009-000871
Date Issued: 15 October 2009

**TM: TRX FITNESS ANYWHERE
AND DEVICE**

NOTICE OF DECISION

JDF LAW OFFICE

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GREETINGS:

Please be informed that Decision No. 2016 - 400 dated 07 November 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 07 November 2016.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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FITNESS ANYWHERE LLC,
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CHRIS T. SPORTS PLAZA, INC.,
Respondent-Registrant.

} **IPC NO. 14-2012-00345**
} Cancellation of :
}
} Registration No. 4-2009-000871
} Date of Registration: 15 October 2009
} Trademark: **"TRX FITNESS**
} **ANYWHERE AND DEVICE"**
}
}
x-----x } Decision No. 2016- 400

DECISION

FITNESS ANYWHERE LLC (Petitioner)¹ filed a Petition for Cancellation of Registration No. 4-2009-000871. The registration, in the name of CHRIS T. SPORTS PLAZA, INC. (Respondent-Registrant)², covers the mark "TRX FITNESS ANYWHERE AND DEVICE", for use on "suspension trainer" under Class 28 of the International Classification of Goods³.

The Petitioner alleges, among others, the following:

"9. The registration of the mark 'TRX FITNESS ANYWHERE AND DEVICE' in the name of the Respondent violates and contravenes the provisions of Section 123.1 (d), (e), and (g) of the IP Code, as amended, because said mark is a combination of and identical to and confusingly similar to Petitioner's internationally well-known 'TRX', 'FITNESS ANYWHERE' and 'X' trademarks and their variants owned, registered in the United States of America and elsewhere in the world, exclusively used and not abandoned by the Petitioner as to be likely, when applied to or used in connection with the goods and services of the Respondent, causes confusion or mistake, or deceives the purchaser s thereof not only as to the goods they are purchasing but also as to the origin or sponsorship of said goods.

"10. Section 123.1, paragraphs (d), (e) and (g) provide:

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

¹ A corporation duly organized and existing under the laws of the state of Delaware, United States of America (U.S.A.), with address at 615 South Dupont Hwy, Dover, DE 19901, U.S.A.

² A corporation duly organized and existing under the laws of the Philippines with address at 3/F K Plaza Building, #18 Kamuning Road, Quezon City

³ 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.

(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 with 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 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 public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

(g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods and services.

"11. The registration of the mark 'TRX FITNESS ANYWHERE AND DEVICE' in the name of Respondent is causing grave and irreparable injury and damage to the Petitioner for which reason it seeks for the cancellation of said registration based on the grounds set forth hereunder:

"A. Petitioner is the prior adopter, user and owner of the marks 'TRX', 'FITNESS ANYWHERE' and 'X' and their variants, in the United States of America, the Republic of the Philippines, and elsewhere in the world.

"12. Fitness Anywhere LLC ('Fitness Anywhere') which does business under the following name and style, 'TRX', 'FITNESS ANYWHERE' and 'X', is a fitness and wellness company with a registered office located in Dover, Delaware. It invented and created the TRX SUSPENSION TRAINING fitness product and services family.

"13. Fitness Anywhere manufactures and sells 'TRX' branded products for suspension trainers and rip trainers. Born in the Navy Seals, TRX^R, Suspension Training^R bodyweight exercise simultaneously develops strength, power, endurance, mobility, durability, balance, flexibility and core stability. TRX Suspension Training requires the use of the TRX Suspension TrainerTM, a highly portable performance training tool that leverages gravity and the user's bodyweight to enable hundreds of exercises that can be instantly scaled for any user to reach any fitness or training goal. The easily scalable nature of TRX Suspension Training makes it a practical solution wherever you are in a fitness continuum. TRX suspension trainer products include the TRX, Pro Kit, TRX Force kit: Tactical and the TRX Training Bundle.

"14. On the other hand, originally created to meet the needs of combat sport athletes and physical therapists, Rip Training variable resistance exercise is a multi-faceted approach to strength and cardiovascular conditioning that challenges you in all three planes of motion every rep, every set, every workout. Equally adept as a rehab tool, a strength and conditioning tool, and a regenerative tool, the Rip Trainer is an exceptionally versatile tool for elite athletes, fitness enthusiasts and beginners alike.

"15. Rip Training utilizes a lever bar and resistance cord to provide a unique mix of rotation, core stability, control, power, strength, mobility, metabolic conditioning, balance and coordination challenges. TRX has developed a wide assortment of unique, leverage-variable resistance exercise movements, coaching cues, and programming and educational principles using the Rip Trainer, the collection of which comprises Rip Training. TRX products are sold online and through a network of retail stores and worldwide distributors. The company was founded in 2005 and is based in California, U.S.A. TRX rip trainers include the TRX Rip Trainer Heavy Resistance Cord, TRX Rip Trainer Medium Resistance Cord, TRX Rip Trainer Light Resistance Cord and the TRX Rip Trainer X-Heavy Resistance Cord.

"16. TRX Training was born of necessity in the Navy SEALs. After TRX founder and inventor Randy Hetrick graduated from college at USC, he spent the next 14 years serving as a Navy SEAL commando. His operational career culminated as a Squadron Commander of the SEAL's elite special missions unit where circumstances inspired him to experiment with what would become TRX.

"17. TRX training was the solution discovered by Randy to the nagging problem of how to stay fit on the road. Randy experimented with an old jiu-jitsu belt and some surplus parachute webbing, hung his handmade contraption over a door and discovered the endless versatility of the tool he had just created. Suddenly he was doing rows, pull-ups, presses, curls, shoulder raises, flys, pull-overs, triceps extensions and a host of other exercises. The world of exercise programming opened up and an entirely new modality – TRX Suspension Training bodyweight exercise- was born.

"18. In 2001, Randy hung up his fins to attend Stanford's Graduate School of Business. He purchased a used sewing machine, set up a manufacturing station in his garage, and devoted his summer to prototyping, planning and shopping suppliers. With a seed funding commitment from long-time friend and angel investor Joe DiJulio, Randy launched Travelift, LLC, moved into a tiny office on Taraval St. in San Francisco's foggy Sunset District and hired his first employees.

"19. Randy quickly realized that however versatile and dynamic the TRX Suspension Trainer might be, training gear without great content and education to support it would surely become another fitness gizmo that flashed in the fan. So he set to work building an organization that could create innovate products- and deliver the knowledge about how to use them. During this period, the company moved to new offices in San Francisco's Russian Hill area and introduced a public

training center on the first floor of its building. It changed its operating name from Fitness Anywhere to TRX, then moved again into its current HQ in San Francisco's Financial District and also opened offices in the European Union, Brazil, Japan through its wholly owned subsidiaries.

"20. In the Spring of 2011, the RipTM Trainer joined the TRX team. Created the two-time US National Taekwondo champion Pete Holman, the Rip Trainer uses the assymetrical loading of the resistance cord to constantly challenge the user's balance and enable maximal muscle recruitment. Meanwhile, TRX Suspension Training became a mainstay in the training rooms of champion teams in the NFL, NBA, NHL and MLB including the Denver Nuggets, Pittsburgh Pirates and San Diego Chargers, as well as the four branches of the US Military.

"21. For a seven-year-old company, the growth has been fast. TRX was recently recognized by San Francisco Business Times as the Bay Area's fifth fastest growing private company and has made Outside Magazine's Best Places to Work list three years running.

"22. Fitness Anywhere and TRX maintain a website <http://www.trxtraining.com> where information on its company history, products and stores worldwide are seen. xxx

"23. 'TRX' has been aggressive in building and maintaining a deep and diverse intellectual property portfolio. Fitness Anywhere owns trademark registrations and pending trademark applications worldwide for the internationally well-known 'TRX', 'FITNESS ANYWHERE' and 'X' trademarks and its variants, xxx

"24. Certified true copies of representative samples of certificates of registrations for 'TRX', 'FITNESS ANYWHERE' and 'X' trademarks and its variants and pending applications worldwide mentioned are attached xxx

"25. Likewise, Fitness Anywhere has been granted registrations and has pending applications for the marks 'TRX', 'FITNESS ANYWHERE' and 'X' trademarks and its variants in the Philippines, xxx

"26. Certified true copies of the representative samples of certificates of registrations for 'FITNESS ANYWHERE' and 'SUSPENSION TRAINING' trademarks, as issued by the Intellectual Property Office of the Philippines (IPOPHL) and pending applications for 'FITNESS ANYWHERE' and 'TRX' in the Philippines as downloaded from the IPOPHL website are attached xxx

"27. Fitness Anywhere likewise has been granted patent registrations and has pending patent applications in the United States and internationally xxx

"32. Fitness Anywhere has invested millions of dollars in promoting and advertising its products worldwide under the 'TRX', 'FITNESS ANYWHERE' and 'X' trademarks and their variants. Since 2008, Fitness Anywhere products have been advertised, offered for sale and in fact sold in the following nations

across the globe: xxx For the years 2010-2012, Fitness Anywhere's local distributor in the Philippines, Finix Corporation ('Finix'), has spent a total of PHP2,800,000 in advertising and marketing in the Philippines alone.

"33. As the exclusive distributor of TRX products in the Philippines, Finix Corporation undertakes aggressive marketing and promotions of the TRX products in the Philippines by regularly sponsoring athletic events and functions and also providing media outfits and TV shows with fitness equipment to keep its local media correspondents, production staffs and celebrities in tip-top shape. The company participates in trade shows and conducts training seminars.

"34. As a result of such advertising and promotions in the Philippines and worldwide, global sales of TRX branded equipment exclusively manufactured and sold by Fitness Anywhere exceed US\$80,000,000. On the other hand, sales for Fitness Anywhere products sold or shipped to the Philippines directly by Fitness Anywhere amount to US\$326,498.06 from 2008 to 2011. xxx

"35. 'TRX', 'FITNESS ANYWHERE' and 'X' branded products and their variants are being sold around the world through its trusted distributors worldwide as well as its website www.trxtraining.com. xxx

"B. Respondent's 'TRX ANYWHERE AND DEVICE' is a combination of the Petitioner's well-known 'TRX', 'FITNESS ANYWHERE' and 'X' marks and their variants, and is identical and confusingly similar with 'TRX', 'FITNESS ANYWHERE' and 'X' marks and their variants. xxx

"D. Petitioner's 'TRX', 'FITNESS ANYWHERE' and 'X' marks and their variants are internationally well-known. xxx

"E. Since petitioner's 'TRX', 'FITNESS ANYWHERE' and 'X' marks and their variants are internationally well-known, they are entitled to protection against identical and confusingly similar marks covering similar or related goods and/or services. xxx

"F. Respondent's act of registering the 'TRX FITNESS ANYWHERE AND DEVICE' mark is done in bad faith and with the intention of making its counterfeit TRX-branded products seem legitimate.

"60. Chris T. Sports Plaza, Inc. herein Respondent, was a former client of Petitioner who used to order TRX fitness products from its Philippine distributor, Finix Corp. Attached to the Affidavit of Mr. Tom Shaw, Chief Financial Officer of Fitness Anywhere, as Annexes 'B' and 'C' which Affidavit form an integral part of this Petition for Cancellation as Exhibits 'H-8' to 'H-18' are the extracts of Internal Fitness Anywhere correspondence and order details as maintained in the ordinary course business pertaining to Order No. 29738. The said extracts show that Mr. Engelbert Tang ordered a total of US\$488.40 worth of various TRX-branded products, including the TRX Professional Bundle and the TRX Force Kit exercises devices, as well as several other TRX branded DVDs providing exercise

instructions, on behalf of Chris T. Sports Plaza, Inc. Exhibit 'C' of Mr. Shaw's Affidavit show the shipment made by Fitness Anywhere's exclusive contract manufacturer, Tochanda Limited, of products exclusive contract manufacturer, Tochanda Limited, of products ordered by Mr. Tang on Order No. 29736.

"61. There was also a request from Mr. Tang to act as a distributor of TRX-branded products made and sold exclusively by Fitness Anywhere in the Philippines. However, the request was turned down by Fitness Anywhere.

"62. Due to the fact that Respondent through Mr. Tang, has previously ordered, and indeed obtained TRX-branded products from Petitioner, importing same into the Philippines, it is clear that the Respondent had knowledge of the fact that Petitioner is the legitimate, true and lawful owner of 'TRX', 'FITNESS ANYWHERE' and 'X' trademarks and their variants, which trademarks were maliciously copied by the Respondent and combined to form a single mark which it later registered as 'TRX FITNESS ANYWHERE AND DEVICE', the subject of herein Petition for Cancellation.

"63. Petitioner later found out through its local distributor in the Philippines, Finix Corp., that Respondent is selling counterfeit TRX-branded products in its branches in the Philippines. Finix Corp. was informed by its customer Toby's Sports that it received a letter dated 8 March 2011 from Respondent informing that latter that Respondent claims the exclusive rights over TRX brands by virtue of the Intellectual Property Office (IPOPHL) Trademark Registration No. 4-2009-000871 for the mark 'TRX FITNESS ANYWHERE AND DEVICE'. Respondent sought to enter into an exclusivity arrangement with Toby's Sports for the TRX brands. Xxx

"64. Toby's Sports, knowing fully well that Finix Corp. is the exclusive distributor of TRX-branded products in the Philippines, sought the help of the latter with regard to this letter. It also reported to Finix Corp. one incident wherein a certain buyer brought TRX products from Toby's Sports in SM Megamall and the identical item displayed at Chris Sports' shop in SM Megamall also. When the buyer found out that TRX products being sold at Chris Sports for the identical items which they bought at Toby's Sports cost less at Chris Sports, particularly the following: xxx

	Toby's Sports	Chris Sports
TRX Force Training Kit	PHP 12,500 (USD 284)	PHP 9,895 (USD 225)
TRX Pro Pack	PHP 10,000 (USD 228)	PHP 8,995 (USD 205)

"65. As a result of the discrepancy in the price, the buyer returned the items brought at Toby's and instead bought the same items from Chirs Sports. The large discrepancy in the pricing made the buyer decide to buy the TRX products from Chris Sports. The large discrepancy in the pricing made the buyer decide to buy the

TRX products from Chris Sports instead of those from Toby's Sports since he has no knowledge of the proliferation of counterfeit TRX products. xxx

"66. In February of 2011, Mr. Legarde, together with Mr. Cresencio Raneses, Sales Consultant of Finix Corp. and Ms. Feilia Jia, the then representative of TRX in the Asia Pacific Region, went to SM Megamall to check out Chris Sports branches. They saw the TRX products on display at Chris Sports SM Megamall and upon seeing the same, they went in to inquire on the TRX products that they saw on display. The same were identified by Ms. Felia Jia as counterfeit TRX products. Xxx

"68. Mr. Legarda and Mr. Teston of Finix Corp. visited Fitness Anywhere in the United States of America (USA) and brought the samples purchased on 11 March 2011. The same were declared counterfeit by Fitness Anywhere.

"69. On 19 June 2011, a separate test buy was conducted by an employee of the local counsel of Fitness Anywhere by the name of Eric D. Bilbao on the Chris Sports branches in SM Mall of Asia and Glorietta. xxx

"70. The sample TRX products yielded from said test purchase were brought to the office of Finiz Corp. for comparison and verification. Based on Finix's verification and comparison of the sample TRX products with the original ones, it confirmed that it was counterfeit.xxx"

To support its opposition, the following evidence were submitted:

1. Special Power of Attorney dated 15 July 2011 ;
2. Affidavit of Jennifer D. Fajelagutan;
3. Affidavit of Ms. Norene Lew dated 12 March 2012;
4. Samples of Certificates of Registrations for "FITNESS ANYWHERE" and "SUSPENSION TRAINING" trademarks;
5. Samples of Certificates of Patent Registrations;
6. Samples of Certificates Copyright Registrations;
7. Affidavit of Van Raymond Legarde dated 5 June 2012 ;
8. Affidavit of Tom Shaw 12 March 2012;
9. Affidavit of Cresencio Raneses dated 5 June 2012;
10. Affidavit of Eric D. Bilbao dated 8 August 2011; and
11. Affidavit of Norene Lew dated 12 March 2012
12. Affidavit of Ms. Tina Richards 6 March 2012
13. Copy of letter dated 23 June 2011;
14. Copy of Reply-letter dated 5 August 2011;
15. Copy of letter dated 18 November 2011; and
16. Print-out of excerpts from IPOPHL website of trademarks of respondent.⁴

⁴ Exhibits "A" to "O" inclusive of submarkings

This Bureau served upon the Respondent-Registrant a "Notice to Answer" on 5 August 2012. The Respondent-Registrant, however did not file an Answer. Thus, on 21 October 2016 Order No. 2016-1727 was issued declaring the Respondent-Registrant in default.

Should the Respondent-Registrant's trademark registration "TRX FITNESS ANYWHERE and DEVICE" be cancelled?

Section 151 of the IP Code provides:

Section 151. Cancellation – 151.1. A petition to cancel a registration of a mark under this Act may be filed with the Bureau of Legal Affairs by any person who believes that he is or will be damaged by the registration of a mark under this Act as follows:

- (a) Within five (5) years from the date of registration of the mark under this Act.
- (b) At any time if the registered mark becomes the generic name for the goods or services or a portion thereof, for which it is registered or has been abandoned, or its registration obtained fraudulently, or contrary to the provisions of this Act, or if the registered mark is used by, or with the permission of the registrant so as to misrepresent the source of the goods or services or in connection with which the mark is used.

Records show that the Respondent-Registrant was granted Certificate of Registration No. 4-2009-000871 for the mark "TRX FITNESS ANYWHERE and DEVICE" on 15 October 2009 for goods under Class 23, namely: "suspension trainer".

The competing marks, depicted below, are identical

Petitioner's Marks

TRX FITNESS ANYWHERE

Respondent-Registrant's Mark



Petitioner claims to be the prior adopter, owner and user of the marks "TRX", "FITNESS ANYWHERE" and "X" trademarks. The Petitioner manufactures "TRX" products for suspension trainers and rip trainers and sells these goods through its Philippine distributor Finix Corp. Its witness, Van Raymond Legarde⁵ attests to the sales and promotional activities to brand the "TRX", "FITNESS ANYWHERE" and "X" trademarks. In the Philippines, the Petitioner registered the marks: "FITNESS ANYWHERE" under Certificate of Registration No. 4-2010-013994⁶ on 1 September 2011 for goods/services under class 9, namely: "digital materials, namely: online streaming and downloadable media files namely online, streaming and downloading media files featuring physical education, exercise, fitness information and instruction: DVDs featuring physical education, exercise, fitness information and instructional pre-recorded DVDs featuring physical education, exercise, fitness information and

⁵ Exhibit "G"

⁶ Exhibit "D"-2

instruction”; and “SUSPENSION TRAINING” under Certificate of Registration No. 4-2010-013996⁷ on 1 October 2011 for goods/services under class 9, namely: “digital materials, namely: online streaming and downloadable media files namely online, streaming and downloading media files featuring physical education, exercise, fitness information and instruction: DVDs featuring physical education, exercise, fitness information and instructional pre-recorded DVDs featuring physical education, exercise, fitness information and instruction”.

Prior to Respondent-Registrant’s registration, the Petitioner already registered in the United States of America, the marks “FITNESS ANYWHERE” under Reg. No. 2, 975,844⁸ on 26 July 2005 for “manually operated exercise equipment, and instructional material sold together therewith as a unit in class 28 (US CLS 22, 23, 38 and 50) and “TRX” under Reg. No. 3,202,696⁹ on 23 January 2007 for “manually operated multi-purpose exercise, fitness and sporting equipment, and instructional material sold together therewith as unit in class 28 (US CLS 22, 23, 38 and 50). The Petitioner also registered the service mark¹⁰ under Reg. No. 3,329,136 which consists of “the color tallow appearing throughout the entirety of the background circle design in the mark. The color white appears in the stylized “X”/Human Design element in the mark.”

The Petitioner asserts that the Respondent-Registrant had the intention of obtaining registration of the marks to legitimize its sale of counterfeit products bearing the “TRX”, “FITNESS ANYWHERE” and “X” trademarks of the Petitioner. In fact, the Respondent-Registrant was aware and familiar with the trademarks of Petitioner. The Respondent-Registrant used to order TRX fitness products from Finnix Corp., the local distributor of the Petitioner in the Philippines. As attested to by Petitioner’s witness, Tom Shaw¹¹, the Respondent, through Mr. Engelbert Tang used to order items bearing the “TRX”, “FITNESS ANYWHERE” and “X” trademarks from the Petitioner. According to Petitioner, on some occasion, Respondent-Registrant negotiated to be the exclusive Philippine distributor of the TRX marks. It cannot be denied that Respondent-Registrant had knowledge and was familiar with the marks of Petitioner. These marks have been misappropriated by Respondent, as its mark “TRX ANYWHERE AND DEVICE” is but a mere combination of the Petitioner’s “TRX”, “FITNESS ANYWHERE” and “X” marks. The “humanized X”, which is unique and distinctive, was blatantly copied in Respondent-Registrant’s composite mark. As a result, “TRX ANYWHERE AND DEVICE”, is identical and confusingly similar with ‘TRX’, ‘FITNESS ANYWHERE’ and ‘X’ marks of the Petitioner. It is incredible for the Respondent-Applicant to have come up with exactly the same mark for use on similar goods by pure coincidence.

Succinctly, because the Respondent-Registrant uses its mark on goods that are similar or closely related to the Petitioner’s it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or

⁷ Exhibit “D-3” to “D-5”

⁸ Exhibit “C-11”

⁹ Exhibit “C-14”

¹⁰ Exhibit “C-16”

¹¹ Exhibit “H”

mistake would subsist not only 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.¹²

The 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 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.¹³

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 to registration. The Philippines implemented the World Trade Organization Agreement "TRPS Agreement" when the IP Code took into force and effect on 1 January 1998.¹⁴

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.

Significantly, Sec. 121.1 of the IP Code adopted the definition of the mark under the old law on Trademarks (Rep. Act. No. 166), to wit:

¹²*Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

¹³*Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha 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).

¹⁴ See Sec. 2: Trademarks, Art. 15 (Protectable Subject Matter)

121.1 "Mark" means any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods; (Sec. 38, R.A. No. 166a)

Sec. 122 of the IP Code also states:

Sec.122. How Marks Are acquired.- The rights in a mark shall be acquired through registration made validly in accordance with the provision of this law.

There is nothing in Sec.122 which says that registration confers ownership of the mark. What the provision speaks of is that the rights in the mark shall be acquired through registration, which must be made validly in accordance with the provision of the law.

Corollarily, Sec. 138 of the IP Code states:


A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of 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.

Aptly, even if a mark is already registered, the registration may still be cancelled pursuant to Sec. 151 of the IP Code.

WHEREFORE, premises considered, the instant Petition for Cancellation of Trademark Registration No. 4-2009-000871 is hereby **GRANTED**. Let the filewrapper of the subject trademark registration be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 07 NOV 2016


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