

**BAYERISCHE MOTOREN WERKE
AKTIENGESELLSCHAFT,**
Opposer,

-versus-

MICHELLE S. DY,
Respondent- Applicant.

X-----X

} **IPC No. 14-2014-00183**
}
} Opposition to:
} Appln. Serial No. 4-2013-000691
} Date Filed: 22 January 2013
} **TM: "BMV"**
}
}
}
}
}

NOTICE OF DECISION

BETITA CABILAO CASUELA SARMIENTO
Counsel for the Opposer
Suite 1104, Page One Building
1215 Acacia Avenue, Madrigal Business Park
Ayala Alabang, Muntinlupa City

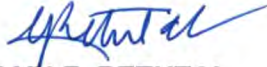
MICHELLE S. DY
Respondent-Applicant
Unit 14-F City Plaza Condominium
439 Plaza Del Conde Street
Binondo, Manila

GREETINGS:

Please be informed that Decision No. 2016 - 213 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 30, 2016.

For the Director:


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

BAYERISCHE MOTOREN WERKE
AKTIENGESELLSCHAFT

Opposer,

-versus-

MICHELLE S. DY,

Respondent-Applicant.

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IPC No. 14-2014-00183

Opposition to:

Application No. 4-2013-000691

Date Filed: 22 January 2013

Trademark: BMV

Decision No. 2016- 213

DECISION

BAYERISCHE MOTOREN WERKE AKTIENGESELLSCHAFT¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-000691. The application, filed by Michelle S. Dy² ("Respondent-Applicant"), covers the mark "BMV" for use on "*riders helmet for motorcycle, bicycle; protective helmets for sports*" under Class 09 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"I. The grounds for opposition are as follows:

"1. The registration of the BMV mark is contrary to the provisions of Section 123.1 (d), (e) and (f) of Republic Act No. 8293, as amended, which prohibit the registration of a mark that:

x x x

"2. The Opposer is the owner of the BMW and BMW formative trademarks which are registered with the Philippine Intellectual Property Office (IPO) in several classes, including classes 9 and 12. The details of these registrations appear below:

x x x

"3. The Opposer is entitled to the benefits granted to foreign nationals under Section 3 of Republic Act No. 8293, which provides:

x x x

"4. The Opposer's BMW mark is well-known and world famous. Hence, the registration of the Respondent-Applicant's BMV mark will constitute a violation of

¹A foreign corporation organized and existing under the laws of Germany, with business address at BMW Building, Petuelring 130, D-80809 Munich, Germany.

²With address at Unit 14-F CityPlaza Condominium, 439 Plaza Del Conde Street, Binondo, Manila, Metro Manila, Philippines.

³The 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.

Articles 6bis and 10bis of the Paris Convention in conjunction with Sections 3, 123.1 (e), and 123.1 (f) of Republic Act No. 8293.

"5. Opposer has used the BMW mark prior to the filing date of the Respondent-Applicant's BMV mark subject of this opposition. The Opposer continues to use the BMW mark in numerous countries worldwide, including the Philippines.

"6. Opposer has also extensively promoted the BMW mark worldwide. Over the years, the Opposer has obtained significant exposure for its products and services on which the BMW mark is used in various media, including television commercials, outdoor and online advertisements, internationally well-known print publications, and other promotional events.

"7. Opposer has not consented to the Respondent-Applicant's use and registration of the BMV mark or any other mark identical or similar to the Opposer's BMW mark.

"8. The use by Respondent-Applicant of the BMV mark in connection with 'riders helmet for motorcycle, bicycle; protective helmets for sports' in class 9, which is identical or closely-related to the goods or services upon which the trademark BMW is used and registered by the Opposer in connection with its business, will mislead the purchasing public into believing that the Respondent-Applicant's goods are produced by, originate from, or are under the sponsorship of the Opposer. Potential damage to the Opposer will also be caused as a result of its inability to control the quality of the products offered or put on the market by the Respondent-Applicant under the BMV mark. This is particularly true because the Opposer also manufactures/distributes helmets under the BMW mark. A screenshot of one of the websites of the Opposer at www.bmw-motorrad.com is shown below:

x x x

"8. The use by the Respondent-Applicant of the BMW mark in relation to its goods in class 9, being identical or closely-related to the Opposer's goods will take unfair advantage of, dilute and diminish the distinctive character or reputation of the Opposer's well-known BMW mark.

"9. The denial of the application for the BMV mark is authorized under other provisions of Republic Act No. 8293.

The Opposer's evidence consists of the Notice of Opposition; the Affidavit of Dr. Jochen Volkmer, the Head of Trademark Department of Opposer; samples of the materials used in the promotions of the BMW mark; tables showing the details of the applications and registrations for the BMW mark worldwide; copies of the trademark registration certificates and excerpts from the official databases for the BMW mark in various countries around the world; screenshot of the details of the BMW mark under Registration No. 061648 as viewable from the Intellectual Property Office website; printout of the trademark details report for the BMQ mark under Registration No. 4-2009-009101 downloaded from the Intellectual Property Office website; printout of the trademark details report of the BMW mark under Registration No. 4-2003-001247 downloaded from the Intellectual Property Office website; screenshot of the details of

the BMW mark under Registration No. 061644 as viewable from the Intellectual Property Office website; printout of the trademark details report for the BMW X1 mark under Registration No. 4-2009-011875 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW X2 mark under Registration No. 4-2011-011492 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW X3 mark under Registration No. 4-2009-011871 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW X4 mark under Registration No. 4-2011-0111493 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW X5 mark under Registration No. 4-2009-011219 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW X6 mark under Registration No. 4-2009-011218 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW X9 mark under Registration No. 4-2011-014158 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW i1 mark under Registration No. 4-2011-001028 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW i2 mark under Registration No. 4-2011-001027 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW i3 mark under Registration No. 4-2011-001034 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW i4 mark under Registration No. 4-2011-001032 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW i5 mark under Registration No. 4-2011-000881 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW i6 mark under Registration No. 4-2011-000884 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW i7 mark under Registration No. 4-2011-000451 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW i8 mark under Registration No. 4-2011-000452 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW i9 mark under Registration No. 4-2011-000453 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW M1 mark under Registration No. 4-2011-011494 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW M2 mark under Registration No. 4-2011-011495 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW M3 mark under Registration No. 4-2009-011320 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW M5 mark under Registration No. 4-2009-011225 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW M6 mark under Registration No. 4-2009-011223 downloaded from the Intellectual Property Office



website; printout of the trademark details report for the BMW M7 mark under Registration No. 4-2011-011496 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW M10 mark under Registration No. 4-2011-011497 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW Z4 mark under Registration No. 4-2011-012824 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW Z8 mark under Registration No. 4-2011-011511 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW Live mark under Registration No. 4-2011-005579 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW Efficient Dynamics mark under Registration No. 4-2008-008010 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW Gran Coupe mark under Registration No. 4-2010-011512 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW Performance Parts mark under Registration No. 4-2006-004202 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW CERTIFIED PRE-OWNED mark under Registration No. 4-2003-009692 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW PREMIUM SELECTION mark under Registration No. 4-2005-001395 downloaded from the Intellectual Property Office website; screenshot of the details of the BMW and Device mark under Registration No. 16398 as viewable from the Intellectual Property Office website; screenshot of the details of the BMW and Device under Registration No. 03338 as viewable from the Intellectual Property Office website; printout of the trademark details report for the BMW Logo 1 mark under Registration No. 4-2011-012235 downloaded from the Intellectual Property Office website; printout of the trademark details report for the BMW Logo 1 mark under Registration No. 4-2003-001245 downloaded from the Intellectual Property Office website; screenshot of the details of the BMW and Device mark under Registration No. 062637 as viewable from the Intellectual Property Office website; and Certificate and Power of Attorney signed by Dr. Jurgen Reul and Dr. Jochen Volkmer, the General Counsel and Head of Trademark Department of Opposer.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 23 July 2014. Said Respondent-Applicant, however, did not file an Answer.

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

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

The Opposer anchors its opposition on Section 123.1, paragraphs (d), (e) and (f) 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 x x

- (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 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;

Records show that at the time the Respondent-Applicant filed its trademark application on 22 January 2013, the Opposer has existing trademark registrations for BMW, BMW Efficient Dynamics and BMW Live under Trademark Registration Nos. 4-2009-009101, 2011-005579 and 4-2008-008010 issued on 01 April 2010, 09 May 2013 and 05 January 2009 respectively. The registrations cover headgear, caps, components for motor vehicles, automobiles and structural parts under Classes 25, 09 and 12. This Bureau noticed that the goods indicated in the Respondent-Applicant's trademark application, i.e. riders helmets for motorcycle and bicycle and protective helmets for sports under Class 09, are similar or closely-related to the Opposer's.

A comparison of the competing marks reproduced below:

BMW Live

BMW

BMW EfficientDynamics

Opposer's trademarks

BMV

Respondent-Applicant's mark

shows that confusion is likely to occur. An examination and comparison of the competing marks shows that both marks have three (3) letters. Two (2) letters of both marks are the same. The third letter "V" in Respondent-Applicant's mark when doubled equals letter "W", hence, Respondent-Applicant's BMV appears almost the same as Opposer's BMW. Because the Respondent-Applicant's trademark application covers goods that are similar or closely-related to the Opposer's, i.e. helmets for motorcycle and bicycle, protective helmets for sports under Class 09, 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/services 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 or services, but

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

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.⁶

The Respondent-Applicant despite the opportunity given, did not file an Answer to defend their trademark application and to explain how they arrived at using the mark BMV which closely-resembles that of the Opposer's.


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.⁷

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. 4-2013-000691 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, 30 JUN 2016.


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

⁶ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepa 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 *American Wire & Cable Company v. Director of Patents*, G.R. No. L-26557, 18 Feb. 1970.