DKH RETAIL LIMITED, *Opposer,*	}	**IPC No. 14-2015-00207** Opposition to:
-versus-	}	Appln. Serial No. 4-2014-014274 Date Filed: 18 November 2014
DAVIES PAINTS PHILIPPINES, INC., *Respondent-Applicant.*	}	**TM: SUPERDRY**

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 83 dated 17 March 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 20 March 2017.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

DKH RETAIL LIMITED,	}	**IPC NO. 14-2015-00207**
Opposer,	}	
	}	Opposition to:
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DAVIES PAINTS PHILIPPINES, INC.	}	TM: **SUPERDRY**
Respondent-Applicant.	}	
x----------x		**Decision No. 2017-** 83

DECISION

DKH RETAIL LIMITED ("Opposer")[1] filed an opposition to Trademark Application Serial No. 4-2014-014274. The application filed by DAVIES PAINTS PHILIPPINES, INC.[2] ("Respondent-Applicant"), covers the mark SUPERDRY for use on "paints" under Class 2 of the International Classification of Goods.

The Opposer alleges the following grounds:

"A Opposer is the prior adopter, user and true owner of the trademark SUPERDRY in the Philippines and elsewhere around the world.

"B. Respondent-Applicant's SUPERDRY mark is exactly the same as Opposer's internationally well-known SUPERDRY trademark and its variations. Thus, registration of the same will only give rise to confusion of business.

"C. Opposer's SUPERDRY trademark and its variations are internationally well-known.

D. Being internationally well-known, Opposer's SUPERDRY trademark and its variations are entitled to protection against the registration and use of identical and confusingly similar marks covering related and unrelated goods; and

"E. The registration and use of the trademark SUPERDRY by Respondent-Applicant will diminish the distinctiveness and dilute the goodwill of Opposer's SUPERDRY mark.

Opposer's evidence consists of the following:

1. Certified true copy of the Affidavit-Direct Testimony of Mr. Shaun Simon Wills;
2. Authenticated and legalized Supplemental Affidavit of Euan Sutherland;

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[1] *A corporation duly established and existing in accordance with the laws of United Kingdom with principal office at Unit 60 The Runnings Cheltenham, Gloucestershire GI51 9NW, United Kingdom*

[2] *A domestic corporation with address at Unit 1707 Antel Global Corporate Center, Julia Vargas Avenue, Ortigas, San Antonio, Pasig City*

3. Affidavit of Atty. Joy Marie R. Gabor-Tolentino;
4. Certified true copies of Opposer's various registration of the mark SUPERDRY in the Philippines;
5. List of Opposer's registrations and applications for the mark SUPERDRY in other jurisdictions;
6. Representative samples of certificates of registration issued in other countries such as Morocco, United Kingdom, Turkey, Benelux, Mexico, Norway, Australia, Canada, United States and OHIM;
7. Screen captures of relevant pages of Opposer's website http://www.superdry.com;
8. Copies of photographs of famous celebrities wearing SUPERDRY products;
9. Copies of articles published about the brand and its history;
10. Representative samples of advertising and promotional materials for the products bearing the mark SUPERDRY;
11. Annual Report and Financial Statements from 2011-2013 of SuperGroup;
12. Certification for the Total Sales for SUPERDRY-branded products for 2013-2015;
13. Printout of the Facebook page of Opposer in the Philippines; and
14. Promotional materials used in the Philippines for SUPERDRY brand.

This Bureau issued on 08 July 2015 a Notice to Answer and served a copy thereof to Respondent-Applicant's representative on 29 July 2015. After two motions for extension of time, Respondent-Applicant filed its Answer on 27 October 2015, alleging the following Special and Affirmative Defenses:

"The Notice of Opposition is not verified by a duly authorized agent of the Opposer and thus should be dismissed outright;

"Section 123.1 (f) of the Intellectual Property Code of the Philippines is not applicable in the instant case.

"Opposer failed to prove that the cited mark is well-known in the Philippines;

"There is no likelihood of confusion between the goods of the cited mark and that of Respondent-Applicant.

"Respondent-Applicant's mark is not descriptive and poses no danger of confusion of origin; and

"Opposer will not be damaged by the registration of Respondent-Applicant's mark."

Respondent-Applicant's evidence consists of the following:

1. Affidavit of Johnlee Garcia, President of Respondent-Applicant;
2. Secretary's Certificate executed by Ms. Zaneta Gan;
3. IPO's acknowledgment receipt of the application;
4. Printout of page 7 of IPO E-Gazette on 06 April 2015; and
5. Special Power of Attorney.

Pursuant to Office Order No. 154, s. 2010, the case was referred to the Alternative Dispute Resolution ("ADR") for mediation. However, the parties failed to settle their dispute. The preliminary conference was terminated on 05 July 2015 and the parties were directed to submit position papers. On 25 July 2015, the parties filed their respective Position Papers.

Should Respondent-Applicant's mark **SUPERDRY** be registered?

Opposer anchors its opposition on Section 123.1 (d) and (f) of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines", as amended, which provides:

> **Section 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;
>
> x x x
>
> (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 services 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.

Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, or resembles a well-known mark, said mark cannot be registered.

Records will show that at the time Respondent-Applicant filed its trademark application on 18 November 2014, Opposer has already obtained a registration of its mark SUPERDRY on 19 November 2009 for Classes 9, 14, 18 and 25. Opposer also has existing registration for other variants of its SUPERDRY mark for Classes 3 and 25 issued in 2012 and 2014. As such, pursuant to Section 138 of the IP Code, being a holder of a certificate of registration, such "certificate of registration is a prima facie evidence of the registrant's ownership of the mark, and of the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto."

But are the marks of the parties confusingly similar as to likely cause confusion, mistake or deception on the part of the buying public?

The marks of the parties are herein reproduced for comparison:

極度乾燥(しなさい)
Superdry.

SuperDry

SUPERDRY

Opposer's Marks

SUPERDRY

Respondent-Applicant's Mark

There is no doubt that the Respondent-Applicant's mark is similar to the Opposer's mark because of the presence of the word "superdry" which is also the mark of Opposer. Both marks are word marks written in plain uppercase letters. Although Respondent-Applicant's mark is italicized, such difference is very trivial compared to the glaring similarities between the marks.

However, the similarity in the appearance of the applied mark to a registered mark does not automatically makes it unregisterable. A similar mark may be registered when the goods, upon which the applied mark will be used, is different or non-competing with each other such that it cannot be said that the goods of the latter is manufactured or sourced from the former or that there is a connection between them.

In *Philippine Refining Co., Inc. vs. Ng Sam and The Director of Patents*[3], the Court ruled:

> A rudimentary precept in trademark protection is that "the right to a trademark is a limited one, in the sense that others may use the same mark on unrelated goods." Thus, as pronounced by the United States Supreme Court in the case of American Foundries vs. Robertson , "the mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description."
>
> Such restricted right over a trademark is likewise reflected in our Trademark Law. Under Section 4(d) of the law, registration of a trademark which so resembles another already registered or in use should be denied, where to allow such registration could likely result in confusion, mistake or deception to the consumers. Conversely, where no confusion is likely to arise, as in this case, registration of a similar or even identical mark may be allowed.

[3] *G.R. No. L-26676, July 30, 1982*

In *Faberge, Incorporated v. Intermediate Appellate Court*[4], the Supreme Court sustained the Director of Patents which allowed the junior user to use the trademark of the senior user on the ground that the briefs manufactured by the junior user, the product for which the trademark "BRUTE" was sought to be registered, was unrelated and non-competing with the products of the senior user consisting of after shave, lotion, shaving cream, deodorant, talcum powder and toilet soap.

In this case, Opposer's mark is used on clothing; casual clothing; formal clothing; sportswear; leisurewear; under garments; footwear; optical apparatus; precious metals, bags and other leather products. On the other hand, Respondent-Applicant's mark is used on paints. As such, the parties' goods are non-competing and not related that no confusion is likely to arise.

Moreover, Opposer's reliance on Section 123.1 (f) is also unmeritorious as it failed to present sufficient evidence for it to be declared an internationally well-known mark.

Nonetheless, this Bureau still cannot allow the registration of Respondent-Applicant's mark pursuant to Section 123.1 (j) of the IP Code which provides:

> 123.1 A mark cannot be registered if it:
>
> x x x
>
> (j) Consists exclusively of signs or of indications that may serve in trade to designate the kind , quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of services, or other characteristics of the goods or services.

Pursuant to the above-cited provisions, a mark which is descriptive cannot be registered. "Descriptive marks convey the characteristics, functions, qualities or ingredients of a product to one who has never seen it or does not know it exists."[5] In this regard, the word "superdry" connotes a characteristic or quality of the paint. To allow the registration of the word "superdry" for paints would unfairly exclude other paint manufacturers from using the word "superdry" for their quick-drying paints.

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.

Accordingly, the mark applied for registration by Respondent-Applicant does meet this function.

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[4] *G.R. No. 71189. November 4, 1992, 215 SCRA 326*
[5] *McDonald's Corporation et. Al. v. L.C. Big Mak Burger, Inc., G.R. No. 143993. August 18, 2004.*

WHEREFORE, premises considered, the instant opposition is hereby ***SUSTAINED***. Let the filewrapper of Trademark Application Serial No. 4-2014-014274, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 17 MAR 2017.

MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs