APPLE, INC.,	}	**IPC No. 14-2013-00143**
Opposer,	}	Opposition to:
	}	Appln. Serial No. 4-2011-014926
-versus-	}	Date Filed: 15 December 2011
	}	
	}	
FRANCISCO M. DOMAGOSO,	}	**TM: EPOL T.V. ALL FILIPINO AND DESIGN**
Respondent-Applicant.	}	

x----------x

NOTICE OF DECISION

QUISUMBING TORRES
Counsel for Opposer
12th Floor, Net One Center, 26th Street corner
3rd Avenue, Crescent Park West, Bonifacio Global City
Taguig, Metro Manila

ATTY. EDUARDO P. QUINTOS XIV
Counsel for Respondent- Applicant
No. 521 E. Quintos Sr. Street,
Sampaloc, Manila

GREETINGS:

Please be informed that Decision No. 2017 - 79 dated 15 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, 16 March 2017.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

APPLE INC.,
Opposer,

- versus -

FRANCISCO M. DOMAGOSO,
Respondent-Applicant.
x ---------- x

IPC No. 14-2013-00143
Opposition to:

Appln. No. 4-2011-014926
Date Filed: 15 December 2011
Trademark: **"EPOL T.V. ALL FILIPINO AND DESIGN"**

Decision No. 2017 - 79

DECISION

APPLE INC. ("Opposer")[1], filed a verified opposition to Trademark Application Serial No. 4-2013-00143. The application, filed by FRANCISCO M. DOMAGOSO ("Respondent-Applicant")[2], covers the mark "EPOL T.V. ALL FILIPINO AND DESIGN" for use under the following classes and its respective goods[3] namely: **11:** *disseminate advertisements and advertising materials, create indexes of information, sites and other resources available on computer networks and other electronic communications networks for interested parties; retail stores services in the field of entertainment featuring movies, television programs, sporting events, musical works, and audio and audio visual works via internet and other computer, electronic and communications network; provide subscriptions to text data, image, video and multimedia content via the internet and other electronic and communications networks; advisory and consultancy services relative to the foregoing;* **38:** *retrieval services for text, data, image, audio video and multimedia content; advisory and consultancy services relative to the foregoing with end in view of live streaming via internet;* **39:** *advisory and consultancy services relative to the computerize data storage;* **41:** *entertainment services by providing facility to live concerts and special events with the end in vies of live streaming via internet; provide downloadable pre-recorded text, data, image, audio, video and multimedia content for a fee or pre-paid subscription, provide via the internet and other electronic and communications networks, arrange and conduct commercial, trade and business conferences, shows and exhibition, information, advisory and consultancy services relative to the foregoing;* and, **45:** *personal and social services rendered by others to meet the needs of individuals.*

The Opposer alleged that it is the prior user and first registrant of the APPLE trademarks in the Philippines even before the filing date of Respondent-Applicant's "EPOL TV" mark on 15 December 2011. The Opposer has registered and applied for the registration of the APPLE Trademarks in other countries. It is also the owner of the Apple TV marks, which are registered and used in various countries worldwide. To date, the Opposer continues to use APPLE trademarks in the Philippines and throughout the world.

---

1 A corporation organized under the laws of the State of California, U.S.A., with business address at 1 InfiniteLoop, Cupertino, California 95014, U.S.A..
2 With address at 319 Younger Street, Balut, Tondo, Manila, Metro Manila, Philippines.
3 The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE
Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio, Taguig City 1634 Philippines •www.ipophil.gov.ph
T: +632-2386300 • F: +632-5539480 •mail@ipophil.gov.ph

The Opposer's ground in this instant opposition case is that Respondent-Applicant's mark "EPOL TV" is confusingly similar, if not identical, to Opposer's APPLE Trademarks, and thus runs contrary to Section 123 of the Intellectual Property Code. The Respondent-Applicant's "EPOL TV" mark appropriates the vital elements of the Opposer's APPLE Trademarks that would support a finding of sufficient similarity, if not identity, between the competing marks. The combination of the various elements of the Respondent-Applicant's "EPOL TV" mark cuts too closely to the famous APPLE Trademarks, to escape notice. Moreover, the subject mark is applied for registration, among others, for services in classes 35 and 38, in which classes the Opposer's APPLE Trademarks are used and registered.

According to the Opposer, its APPLE Trademarks were declared as well-known trademarks, both internationally and in the Philippines. In fact, the Bureau of Legal Affairs, in Decision No. 2008-161 dated 03 September 2008 declared the APPLE Trademarks as well-known marks. Further, the recognition that the Opposer's marks are well-known marks was reiterated in IPC No. 14-2011-00275 involving the mark "APPLEWERKZ & DESIGN". Thus, Opposer as owner of a well-known and registered mark in the Philippines, is entitled protection against marks that are liable to create confusion in the minds of the public, whether such marks are used in similar or dissimilar goods or services.

Accordingly, if allowed to proceed to registration, the use of Respondent-Applicant's "EPOL TV" mark will amount to unfair competition with and dilution of the Opposer's APPLE Trademarks, which have attained valuable goodwill and reputation through the years of extensive and exclusive use. The Opposer's goodwill is a property right separately protected under the Philippine law. The violation thereof amounts to downright unfair competition.

The Opposer submitted the following evidence:

1. Original Verified Notice of Opposition;
2. Original notarized and legalized Affidavit of Thomas R. La Perle;
3. Listing of a sampling of trademark registrations for the Apple Logo, APPLE word mark, APPLE TV word mark and the APPLE Logo and TV trademarks in variety of jurisdictions;
4. Photocopy of the Opposer's external use policy, published as "Guidelines for Using Apple Trade Marks and Copyright";
5. Photocopies of materials featuring Opposer's APPLE trademarks in Mac OS products;
6. Screenshot of the homepage of the iTunes Store services website in Philippines showing Apple Logo;
7. Screenshots of Apple Store service website for the United States, France, Japan, the Philippines and the United Kingdom;
8. List of current Apple Retail Store worldwide;
9. Collection of images illustrating the use of Opposer's APPLE trademarks, specifically the Apple Logo as to the Apple Retail Stores;
10. Samples of Opposer's print and outdoor advertising distributed in the Asia Pacific region;
11. True copies of article from the PC World magazine entitled "Apple tops in Consumer Satisfaction" and the Business Week Magazine entitled "The World's Most Innovative Companies;
12. Photocopies of the brandchannel.com 2008 and 2009, Fortune Magazine's "Most Admired Company" for the years 2008 to 2012, worldwide decisions of the fame and recognition of the APPLE and/or APPLE Logo marks;
13. True copy of relevant pages from Apple's 2011 Annual Report;
14. Examples of Opposer's advertisements in the Philippines;
15. Pictures of stores and signages depicting the APPLE Name and Marks used in the Philippines;

16. Photocopies of IPO Decision No. 2008-161 dated 3 September 2008 and Resolution No. 2009-30 dated 18 May 2009 docketed as IPC No. 14-2007-00193, declaring APPLE Trade Marks as well-known;
17. Photocopy of IPO's Decision docketed as IPC No. 14-2011-00275;
18. Certified True Copy of Philippine Trademark Registration Nos. 4-1990-51466, 4-1997-125379, 4-2002-001523, 4-2002-003950, 040035 for APPLE in classes 16, 9, 38 and 42;
19. Certified True Copy of Philippine Trademark Registration Nos. 4-2002-002618, 4-2002-004056, 4-2011-006624, 040034 and 4-2008-015163 for the logo APPLE in classes 9, 38, 42 and 35; and,
20. Original legalized and notarized Certificate and Power of Attorney showing Opposer's counsel's authority to execute the Verification and Certification of Non-Forum Shopping.

On 23 September 2013, Respondent-Applicant filed his Answer. By way of Special and Affirmative Defenses, Respondent-Applicant affirmed that Opposer's Affidavit states that the mark "APPLE TV" was not among those which are registered in its family of Apple marks in the Philippines. The application date for "APPLE TV" does not precede that of the Respondent-Applicant's filing date for the subject mark.

Respondent-Applicant strongly disputed that the subject mark is entirely different from, and that its mark is not confusingly similar to the Opposer's registered trademarks. As previously described, Respondent-Applicant's mark or logo is an apple with a side view silhouette of a person's face on the right side as bite mark together with an image of a television inside the apple plus a television antenna on top of it, with inscriptions "epol t.v. all filipino". According to Respondent-Applicant, the application of the Holistic Test reveals great discrepancies between the two (2) marks and the inevitable conclusion that said marks are dissimilar.

Moreover, Respondent-Applicant would be dealing with live streaming services via the internet, contrary to Opposer's registered marks' goods. Thus, the identity, confusion, similarity or deception would be highly remote under the competing marks as no ordinary purchaser would be mistaken as passing off something that belongs to another. Besides, Opposer's marks belong to high-end article categories that are classified as expensive and valuable items which are not purchased for everyday consumption. The goods are bought only after deliberate, comparative, curious and analytical investigation, unlike Respondent-Applicant's service/s which are offered free of charge. Accordingly, Respondent-Applicant's mark should be considered as a whole and not piecemeal. The dissimilarities between the two marks become conspicuous, noticeable and substantial.

Thus, Respondent-Applicant's mark is not contrary to any of Section 23 of the IP Code non-registrability provisions, more specifically, paragraphs (d), (e), (f), and (g) as cited by the Opposer.

Thereafter, the Preliminary Conference was held and terminated on 17 July 2014. The Opposer and the Respondent-Applicant submitted their position papers on 30 and 28 July 2014, respectively.

Should the Respondent-Applicant be allowed to register the trademark EPOL T.V. ALL FILIPINO AND DESIGN?

It is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing out into the market a superior genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and

sale of an inferior and different article as his products.[4] In this regard, Sec. 123.1 (d) R.A. No. 8293, also known as the Intellectual Property Code ("IP Code") provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date in respect of the same goods or services or closely related goods or services, or if it nearly resembles such as mark as to be likely to deceive or cause confusion.

While the competing marks, as shown below, are not exactly identical:

Opposer's Trademarks

Respondent-Applicant's Trademark

the differences, like the presence of the word "EPOL" in the Respondent-Applicant's mark, and the deviation in the specifics of the apple design are inconsequential and would not avoid a conclusion that the marks convey the same idea or concept to the senses, which is still the "apple" fruit.

Significantly, confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.[5] Colourable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colourable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark with that of the other mark or trade name in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.[6]

In this regard, records show that at the time the Respondent-Applicant filed his trademark application on 15 December 2011, the Opposer has several trademark registrations for the mark APPLE and its variations for various classes: 16, 09, 35, 37, 38, 41, and 42. These registrations reveal to have been filed prior to that of Respondent-Applicant's subject mark[7]. Moreover, this Bureau had already declared the Opposer's APPLE trademarks well-known marks[8].

But, on whether a mark utilized by one party for the purpose of presentation of goods for retail purposes is confusingly similar to a registered mark belonging to another, it is important to determine or establish the goods involved.

---

4 Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91
of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

5 Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 200, 356 SCRA 207, 217.

6 Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.

7 Exhibits "C" to "L" of Opposer.

8 Annexes "20" and "21" of Exhibit "B" of Opposer.

In this instance, the Opposer's trademark registration covers a wide range of goods that include personal computing products, mobile communication and media devices, and portable digital music players, as well as a variety of related software, services, peripherals, networking solutions and various third-party hardware and software products. The Respondent-Applicant's trademark application, on the other hand, covers services which are related in nature, covering classes 35, 38, 39, 41 and 45.

Hence, without explicit limitation in respect of goods, the Respondent-Applicant, if allowed to register EPOL T.V. ALL FILIPINO AND DESIGN will be able to use the mark on any goods. If it uses the mark on goods covered by the Opposer's trademark registrations, the likelihood of confusion therefore arises. This Bureau finds merit in the Opposer's assertions:

> "As a mark that is confusingly similar to the well-known and registered Apple Logo trademarks, the Respondent's 'EPOL TV' mark is likely to deceive consumers by suggesting a connection, association or affiliation with the Opposer, when none exists. There appears to be a deliberate, studied attempt to copy the Opposer's well-known APPLE Logo trademarks, and ride on the goodwill it has created through decades of continuous use.
>
> Moreover, the Respondent's EPOL TV mark is applied for registration for, among others, services in classes 35 and 38, in which classes the Opposer's APPLE Trademarks are used and registered for.
>
> x x x
>
> By suggesting a connection, association or affiliation with the Opposer, when there is none, the Respondent will no doubt cause confusion among the minds of the general public and substantial damage to the goodwill and reputation associated with the APPLE Trademarks, as well as the Opposer's business reputation."

The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:

> "Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily 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. Hence, 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."

Succinctly, because the Respondent-Applicant will use or uses the mark EPOL T.V. ALL FILIPINO AND DESIGN in services that are similar and/or closely related to those covered by the Opposer's registered trademarks, there is the likelihood that information, assessment, perception or impression, whether good or positive, on the services offered by the Respondent-Applicant may unfairly be cast upon or attributed to the Opposer. It is very difficult to understand and highly improbable if the circumstance was purely coincidence. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of letters are unavailable, the Respondent-Applicant had come up with a mark identical or so nearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.[9]

---

[9] American Wire and Cable Co. v. Director of Patents, et al. (SCRA 544) G.R. No. L-26557, 18 Feb. 1970.

Accordingly, this Bureau finds and concludes that the registration of the mark EPOL T.V. ALL FILIPINO AND DESIGN in favor of the Respondent-Applicant is within the prohibition imposed not only by paragraph (d) of Sec. 123.1 of the Code, but also by paragraph (e) thereof which provides that a mark cannot be registered if it:

> (e) Is identical with, or confusingly similar to, or constitutes a translation of 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 the 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."
> (Emphasis supplied)

WHEREFORE, premises considered, the instant opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2011-014926 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 15 MAR 2017

Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs