

CLUETT PEABOY & CO., INC.	}	IPC NO. 14-2008-00115
<i>Opposer,</i>	}	Case Filed : 08 August 2008
	}	Opposition to:
	}	
-versus-	}	Appl'n Serial No. : 4-2006-008673
	}	Date filed : 08 August 2006
	}	Trademark : "UNITED ARROWS and Device"
	}	
JOSE P. MACADANGDANG,	}	
<i>Respondent-Applicant.</i>	}	
x-----x	}	Decision No. 2009-57

DECISION

This is an opposition to the registration of the mark "UNITED ARROWS AND DEVICE" bearing Application No. 4-2006-008673 covering the goods "*blouses, boots, jackets, jeans, pants*" falling under class 25 of the International Classification of goods which application was published in the Intellectual Property Philippines (IPP) E-Gazette, officially released on January 25, 2008.

The Opposer in the instant case is "CLUETT PEABODY & CO., INC.," a corporation organized and existing under the laws of the State of Delaware, United States of America with principal office address at 200 Madison Avenue, New York, New York, 10016, United States of America.

On the other hand, the Respondent-Applicant is "JOSE P. MACADANGDANG" with given address at 3<sup>rd</sup> Floor No. 205 Jaboneros Street, Binondo, Manila, Philippines.

The grounds of the opposition are as follows:

- "7. The registration of the mark "UNITED ARROWS AND DEVICE" in the name of the Respondent-Applicant will violate and contravene the provision of Sections 123.1 (d), (e), (f) and (g) of the Intellectual Property Code, as amended, because said mark is confusingly similar to Opposer's internationally well-known trademarks "ARROW", "ARROW & DEVICE", "ARROW WITH DEVICE" and their variations, owned, registered in the Philippines, used and not abandoned by the Opposer as to be likely, when applied to or used in connection with the goods of the Respondent-Applicant, to cause confusion or mistake, or to deceive the purchasers thereof as to the origin of the goods.
- "8. The registration of the mark "UNITED ARROWS AND DEVICE" in the name of the Respondent-applicant will cause grave and irreparable injury and damage to the Opposer for which reason it opposes said application based on the grounds set forth hereunder.
  - A. Opposer is the prior adopter, user and owner of the trademarks "ARROW", "ARROW & DEVICE", "ARROW WITH DEVICE" and their variations in the Philippines and elsewhere around the world.
- "9. Opposer is the owner of the internationally well-known trademarks "ARROW", "ARROW & DEVICE", "ARROW WITH DEVICE" and their variations, which are registered with the Intellectual Property Office of the Philippines ("IPOPhil", henceforth), the earliest registration of which goes as far back as 1956.

- “12. The ARROW brand, introduced in 1851, is one of the oldest and most trusted apparel brands. ARROW is a symbol of authentic American Style in clothing for men, women and children. A detailed account of the history and heritage of Opposer’s ARROW brand and products, from its humble beginnings in the town of Troy, NY, where the originators of the business of the Opposer started their small business, to its current status as an American lifestyle brand, can be found on the official web site maintained by the Opposer specifically to feature its ARROW brand of products (<http://www.arrowshirt.com>), printouts of which are hereto attached as Exhibits “E-7” to “E-18”.
- “13. Opposer, together with its parent corporation Philips-Van Heusen Corporation, is the true bona fide proprietor of the ARROW trademark, which has extensively been use of since its launch in the year 1851 in the USA. They have authorized the use of its ARROW products mark in more than 120 countries worldwide and ARROW products are currently being sold in more than 55 countries, including the Philippines.
- “14. Opposer first used the “ARROW WITH DEVICE” trademark in the United States on December 01, 1903 for articles of clothing, namely; shirts and has been continuously and extensively used since then. Opposer first used the “ARROW” trademark in the United States on May 01, 1922 for handkerchief, and has been continuously used and extensively used since then. Attached herewith as Exhibits “C” to “C-4” is an Affidavit executed by Mr. Joseph A. Rosato, an employee of Opposer, attesting to the fact of Opposer’s prior use and adoption of the marks “ARROW WITH DEVICE” and “ARROW”, among others.
- “15. ARROW products, which bear Opposer’s well-known trademarks “ARROW”, “ARROW & DEVICE”, “ARROW WITH DEVICE” and their variations, are made available in the Philippines through the efforts of Corporate Apparel, Inc., (“Corporate Apparel”, hereinafter), the authorized distributor of Opposer’s ARROW products. In an affidavit herewith attached as Exhibits “F” to “F-62”, Ms. Aileesa G. Lim, the Vice President of Corporate Apparel, attests to the nationwide sale, distribution and marketing of Opposer’s ARROW products in the Philippines. As proof of the foregoing, attached to said Affidavit are copies of representative sales invoices dating from 2001 to the present. Also attached to said Affidavit is a list of the establishments in the Philippines where stores selling Opposer’s ARROW products are located, which include well-known malls and department stores such as SM Megamall, Robinson Galleria, The Landmark and Rustan’s Alabang, among others. Likewise, attached to the Affidavit of Ms. Lim among other evidence, are various promotional and sample packaging materials featuring Opposer’s ARROW products, and bear Opposer’s well-known marks “ARROW”, “ARROW & DEVICE”, “ARROW WITH DEVICE” and their variations.

The Opposer submitted the following in support of its opposition.

Exhibit	Description
“A”	Authenticated Special Power of Attorney
“B”	Certified true copy of Certificate of Registration No. 4-1999-007332 for the mark “ARROW”
“B-1”	Certified true copy of Certificate of Registration No. 4-2000-001879 for the mark “ARROW”
“B-2”	Certified true copy of Certificate of Registration No. R-1639 for the mark “ARROW with ARROW

	Device”
“B-3”	Certified true copy of Certificate of Registration No. 4-2002-008854 for the mark “ARROW with Device Below the Word”
“B-4”	Certified true copy of Certificate of Registration No. 4-2004-005345 for the mark “ARROW with Device”
“B-5”	Certified true copy of Certificate of Registration No. 28833 for the mark “ARROW & Device”
“B-6”	Certified true copy of Certificate of Registration No. 4-2002-007304 for the mark “ARROW with Device Below the Word”
“B-7”	Certified true copy of Certificate of Registration No. 4-2000-001878 for the mark “ARROW with Device”
“B-8”	Copy of trademark Application No. 4-2001-005585 for the mark “ARROW with Device Below the Word”
“B-9”	Copy of trademark Application No. 4-1999-007332 for the mark “ARROW”
“B-10”	Copy of trademark Application No. 4-1995-103062 for the mark “ARROW with Device”
“B-11”	Copy of trademark Application No. 4-2004-003456 for the mark “ARROW with Device”
“C”	Certification issued by the Intellectual Property Office of the Philippines (IPP)
“C-1”	Authentication issued by the New York Counsel
“C-2”	Affidavit of Mr. Joseph A. Rosato
“C-3”	Pat of the Affidavit of Joseph A. Rosato
“C-4”	Authentication of the State of New York
“D” to “D-104”	Affidavit of Joseph A. Rosato and its attachments
“E”	Affidavit of Chrissie Ann L. Barredo
“E-1” to “F-58”	Attachments to the Affidavit of Chrissie Ann L. Barredo
“G” to “G-293”	Affidavit of Mark D. Fisher and attachments

On the part of the Respondent-Applicant, he failed to file his verified answer to the Notice of Opposition despite receipt of the Notice to Answer on June 19, 2008.

Section 11 of the Summary Rules (Office Order No. 79, Series of 2005), provides:

Section 11. *Effect of failure to file an Answer.* – In case the Respondent-applicant fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the Petition or Opposition, the affidavit of the witnesses and documentary evidence submitted by the Petitioner or Opposer.

The lone issue to be resolved in this particular case is:

“WHETHER OR NOT THE APPLICATION FOR REGISTRATION OF THE MARK “UNITED ARROWS AND DEVICE” IN THE NAME OF RESPONDENT-APPLICANT SHOULD BE DENIED?”

The applicable provisions of law is Section 123.1 (d) of Republic Act No. 8293, which provides:

“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 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;

The contending trademarks are reproduced below for comparison and scrutiny.



Opposer's mark



Respondent-Applicant's mark

The Opposer's mark consists of the word "ARROW and ARROW DEVICE" while that of the Respondent-Applicant's mark consists of the words "UNITED ARROWS and DEVICE OF ARROWS".

The two contending trademarks contained the word "ARROW" and "DEVICE OF ARROW". Their only distinction is the presence of the word "UNITED" in the Respondent-Applicant's mark, however, this slight distinction does not avoid nor negate confusing similarity between the two trademarks.

Considering therefore, that the two trademarks are confusingly similar to each other, then the issue to be resolved is:

“WHO BETWEEN THE OPPOSER AND THE RESPONDENT-  
APPLICAN HAS A BETTER RIGHT OVER THE TRADEMARK “ARROW  
AND DEVICE OF ARROW”.

Records show that Opposer's trademark "ARROW and Device" has been registered with the Intellectual Property Office of the Philippines (IPP), the earliest registration of which goes as far back as 1956, to wit:

Mark	Class	Registration No.	Date of Registration
ARROW	25	14-2000-001879	June 08, 2006
ARROW	24, 25	4-1999-007332	December 19, 2005
ARROW & DEVICE	25	028833	December 29, 1980
ARROW WITH DEVICE	25	4-2000-001878	January 15, 2007
ARROW WITH DEVICE BELOW THE WORD	03	4-2001-005585	November 07, 2005
ARROW WITH DEVICE BELOW THE WORD	14	4-2002-008854	July 30, 2005
ARROW WITH DEVICE BELOW THE WORD	18	4-2002-007304	March 05, 2007
ARROW WITH ARROW DEVICE	25	001639	November 20, 1956

ARROW WITH DEVICE	25	4-2004-005345	September 25, 2006
ARROW WITH DEVICE BELOW THE WORD	25	4-2002-006072	February 24, 2005

Certified true copies of the above-stated certificate of registrations are duly marked (Exhibits "B" to "B-7").

Considering therefore that the Opposer's trademarks are registered with the Intellectual Property Philippines (IPP), the *use* and *adoption* by the Respondent-Applicant of substantially the same mark as *subsequent user* can only mean that the applicant wishes to reap the goodwill, benefit from the advertising value and reputation of the Opposer's mark. It is further observed that the goods covered by the competing marks fall under Class 25 of the International Classification of goods.

Approval of Respondent-Applicant's trademark application in question is a clear violation of Section 123.1 (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines.

It is unthinkable and truly difficult to understand why of the millions of terms and combination of letters and designs available, the Respondent-Applicant had to choose the mark "ARROW" and "ARROW DESIGNS" as part of its mark which is exactly the same of the Opposer's mark which is a registered mark and deserve protection, if there was no intent to take advantage of the goodwill of the Opposer's mark.

The right to registered trademarks, trade-names and service marks is based on ownership. Only the owner of the mark may apply for its registration (*Bert R. Bagano vs. Director of Patents, et.al., G.R. No. L-20170, August 10, 1965*).

WHEREFORE, view in the light of all the foregoing, the Bureau of Legal Affairs finds and so holds that Respondent-Applicant's mark is confusingly similar to Opposer's marks and as such, the opposition is, as it is, hereby SUSTAINED. Consequently, Application No. 4-2006-008673 filed on August 08, 2006 for the registration of the mark "UNITED ARROWS AND DEVICE" is, as it is hereby REJECTED.

Let the filewrapper of the trademark "UNITED ARROWS AND DEVICE" subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 28 April 2009.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs  
Intellectual Property Office