

NFL PROPERTIES LLC.,	}	IPC No. 14-2006-00082
Opposer,	}	Opposition to:
	}	
	}	Ser No. 4-2003-006510
-versus-	}	Date Filed: 23 July 2003
	}	
	}	TM: "HAWK W/ HAWK'S HEAD"
ROSA KAW,	}	
Respondent-Applicant.	}	Decision No. 2006-137
x-----x	}	

DECISION

This pertains to the VERIFIED NOTICE OF OPPOSITION filed by NFL Properties LLC to the application for registration of the trademark "HAWK W/ HAWK'S HEAD DESIGN" for Class 25 goods, namely, shoes, slippers, and sandals under Application Serial No. 4-2003-006510 lodged by Rosa Kaw and published for opposition in the January 26, 2006 issue of the Intellectual Property Philippines (IPPhil.) e-Gazette, No. 176.

Opposer NFL Properties LLC is a limited liability company organized under the laws of the State of Delaware, the United State of Delaware, the United States with address at 280 Park Avenue, New York, New York 10017 while Rosa Kaw is a Filipino citizen residing at 550 C.M. Recto, Manila.

The grounds for opposition are as follows:

1. Opposer is the merchandising arm of the National Football League ("NFL"), an association of thirty-two (32) member clubs, each of which owns and operates a professional football team that provides entertainment services to the public in the form of competitive and professional American football games in various locations throughout the United States;
2. NFL football is the most popular team sports entertainment in the United States: Million of fans attend NFL games each year, and NFL football receives extensive international coverage in print and electronic media as NFL football games or highlights are broadcast into 235 countries, and in the Philippines is aired or broadcasted via SOLAR, ESPN, Star Sports, and AFN;
3. In addition to the international broadcast of NFL football games, NFL teams routinely play football games outside the United Stated through the NFL's American Bowl Series;
4. The NFL and team names/logos/marks are also popular and favorite subjects and features of numerous international publications;
5. The phenomenal exposure of the brands and trademarks of the NFL has made them the fourth largest licensed brands in the world according to License! Magazine (April 2003);
6. As a result of the NFL's and its teams' significant exposure, the general public is very familiar with the NFL and its member clubs, and clearly associates the NFL with the sport of American football;
7. The Philadelphia Eagles is one of the member clubs;
8. Established in 1993, the Philadelphia Eagles is one of the most storied professional American football clubs in the United States: it won its first NFL championship in 1948,

and has appeared in four (4) NFL championships and two (2) Super Bowl championship games, the most recent of which was in 2005;

9. The Philadelphia Eagles logo has remained virtually unchanged since 1996 and, since its adoption, has represented valuable source significance and an important part of the history of the team;
10. Owing to the popularity and huge following of the Philadelphia Eagles among sports fanatics worldwide, its team name, logo, uniform, designs, colors, and other indicia (collectively the "Eagles Marks") are covered by over 200 applications and registrations in approximately 50 countries, spanning the continents of Asia, Europe, Africa, Australia, and America;
11. Opposer has a pending application for registration of the Philadelphia Eagles logo in the Philippines for Classes 25 and 41;
12. The Eagles Marks are inherently distinctive and instantly recognizable by fans of the NFL worldwide and other members of the public;
13. A wide variety of products, including Class 25 goods, bearing the Eagles Marks are available for sale throughout the globe, including the Philippines, in retail shops as well as in the internet through the NFL's internet sale portal and the Philadelphia Eagles website;
14. NFL has periodically published a Merchandise Catalogue for all NFL merchandise including Class 25 goods bearing the Eagles Marks, and these products are manufactured, distributed, and sold strictly under license pursuant to an Omnibus License Agreement between NFL companies and Reebok International, Ltd.;
15. The Philippines is host to three (3) manufacturing locations for merchandise manufactured for export under the Omnibus License Agreement between NFL companies and Reebok International, Ltd.;
16. The Philadelphia Eagles logo has been extensively used for, among others, Class 25 goods since its adoption in 1996 or long before respondent-applicant's appropriation of a similar mark also for Class 25 goods;
17. The Philadelphia Eagles logo already represents valuable source significance and an important facet of opposer's merchandising activities as shown by its worldwide promotional and licensing efforts;
18. Because the Philadelphia Eagles logo is the type of famous mark which is licensed for use, the consumer will incorrectly assume a connection with opposer or the NFL upon encountering similar products from respondent-applicant bearing a similar mark;
19. Respondent-applicant's use and registration of a confusingly similar mark will give her a profoundly unfair advantage over others in the Philippines who must either rely on the marks which do not have a pre-existing established global reputation or pay significant royalties to brand owners to properly license globally recognized brand names;
20. It is evident that respondent-applicant has appropriated a similar mark solely to capitalize upon the renown of the Philadelphia Eagles logo and thus gain public acceptability by misleading the public into believing that her goods originate from, or are licensed or sponsored by opposer or NFL;

21. Respondent-applicant's use and registration of a similar mark for Class 25 goods will allow her to unfairly benefit from, and ride on, the extensive popularity and goodwill of the subject mark without paying any licensing fee or royalties;
22. Respondent-applicant's unauthorized appropriation and use of a confusingly similar mark will dilute the goodwill and reputation of opposer's Philadelphia Eagles logo: If respondent-applicant will apply a similar mark on merchandise that are of poor quality and styling, consumers and buyers will attribute this negative impression to opposer and NFL to the latter's prejudice and detriment, especially that opposer pays serious attention to quality and style of its merchandise bearing the NFL marks;
23. The mark "HAWK W/ HAWK'S HEAD DESIGN" so resembles opposer's internationally well-known Philadelphia Eagles logo which has been previously used in commerce and registered in the United States and other parts of the world and not abandoned, as to be likely, when applied to or used in connection with respondent-applicant's goods, to cause confusion, mistake, and deception of the purchasing public;
24. Considering that the Philadelphia Eagles logo is well-known internationally and in the Philippines, and is being used extensively by opposer for Class 25 goods, it is clear that respondent-applicant cannot register a confusingly similar mark in the Philippines for identical or similar goods despite the fact that the Philadelphia Eagles mark is not yet registered here; and
25. The registration by respondent-applicant of the mark "HAWK W/ HAWK'S HEAD DESIGN" will violate the Intellectual Property (IP) Code and the Paris Convention to which the Philippines and the U.S. are parties.

On August 18, 2006, respondent-applicant filed a VERIFIED ANSWER denying all the allegations and grounds stated in the OPPOSITION and alleging the following special and affirmative defenses:

1. Respondent-applicant has openly adopted and used the mark "HAWK W/ HAWK'S HEAD DESIGN" since 1985;
2. On November 3, 1989, the Hawk trademark was registered in the name of respondent-applicant with the Bureau of Patents under Registration No. 46817;
3. Respondent-applicant, through Sportrend Manufacturing Corporation, established and popularized the "HAWK W/ HAWK'S HEAD DESIGN" in the Philippines by hiring the services of various models/celebrities such as Aga Muhlach, Alma Concepcion, Daisy Reyes, and Sarah Christopher;
4. Respondent-applicant, through Sportrend Manufacturing Corporation, likewise established and popularized "HAWK W/ HAWK'S HEAD DESIGN" in the Philippines by way of promotional materials such as newspaper and magazine ads, posters, calendars, key chains, radio, and television;
5. The registration of the subject mark will not in any way cause confusion or mistake or will deceive purchasers due to the fact that it is not identical to the opposer's Philadelphia Eagles logo;
6. The registration of the mark "HAWK W/ HAWK'S HEAD DESIGN" is neither contrary to law nor violate the Paris Convention;
7. There is no evidence that opposer uses that mark for its own goods (shoes) in the Philippines; and

8. The registration of the Philadelphia Eagles logo in the United States or in any country has no influence whatsoever in the Filipino buying public in relation to goods (shoes) with the subject mark.

On September 4, 2006, opposer filed by registered mail a REPLY alleging that respondent-applicant's prior registration of the "Hawk" word mark on November 3, 1989 under Registration No. 46817 is irrelevant: What opposer is questioning in the present proceedings is respondent-applicant's application to register the "HAWK W/ HAWK'S HEAD DESIGN" which opposer submits is confusingly similar with its well-known Philadelphia Eagles logo, and the allegations that respondent-applicant had registered the word mark "Hawk" does not mean that she also has the right to appropriate a logo mark that is confusingly similar to the Philadelphia Eagles logo of opposer. Opposer puts forth, moreover, the following allegations which essentially reiterates the allegations in its VERIFIED NOTICE OF OPPOSITION:

1. The Philadelphia Eagles logo has been extensively used by opposer for, among others, class 25 goods since its adoption in 1996 or long before respondent-applicant appropriated and filed an application for registration of the subject mark also for Class 25 goods;
2. That the Philadelphia Eagles logo is a world-famous and well-known mark pursuant to Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers is borne by the fact that the Eagles Marks are covered by over 200 applications and registrations in approximately 50 countries and that opposer has a pending application for registration in the Philippines of the Philadelphia Eagles logo for Classes 25 and 41; that the Eagles Marks are favorite features and subject of international sports publications; that a wide variety of products including Class 25 goods bearing the Eagles Marks are available for sale throughout the globe including the Philippines in retail shops and through the internet; that the NFL publishes on an annual basis a Merchandise Catalogue for all NFL merchandise including Class 25 goods bearing the Eagles Marks; that these products are manufactured, distributed, and sold strictly under license pursuant to an Omnibus License Agreement between NFL companies and Reebok International, Ltd.; that the Philippines is host to 3 manufacturing locations for merchandise manufactured for export under the Omnibus License Agreement between NFL companies and Reebok International, Ltd.; that the phenomenal exposure of NFL's brands and trademarks has made them the 4th licensed brands in the worlds according to License! Magazine; and that the NFL brands produce more than \$3 billion in sales annually;
3. Respondent-applicant's defense that she openly adopted and used the subject mark since 1985 and that said mark was promoted by hiring the services of various models is also irrelevant and immaterial as respondent-applicant filed an application for registration of said mark only on July 23, 2003 while opposer's Philadelphia Eagles logo has already been extensively used since its adoption in 1996;
4. Contrary to her assertion that the registration of the subject mark is not contrary to law, respondent-applicant cannot register the subject mark because it is confusingly similar to opposer's mark that is already well-known internationally and in the Philippines;
5. It is not true that the Philadelphia Eagles logo has no influence whatsoever in the Filipino buying public in relation to respondent-applicant's shoes bearing the subject mark: A comparison of the subject mark with the Philadelphia Eagles logo reveals an intention by respondent-applicant to ride on the popularity and fame of the Philadelphia Eagles logo;
6. The subject mark "hawk head" is basically a replica of the Philadelphia Eagles logo from the shape of the beak to the ferocious portrayal of the eye and the depiction of the feathers, and the angle of the hawk head reveals a striking resemblance though may variations would have been available to respondent-applicant;

7. That respondent-applicant had to imitate opposer's Philadelphia Eagles logo as her "hawk head" design out of all possible variations only betrays the intention to ride on the popularity or fame of the Philadelphia Eagles logo;
8. Without the pervading presence of the Philadelphia Eagles logo in print media, television, apparel, and the internet, the probability of a logo designer coming up with a "hawk head" design which is exactly similar to the Philadelphia Eagles logo is very low, if not impossible; and
9. Although the word "HAWK" is juxtaposed to the "hawk head", it is very clear that what dominates the eye is the "hawk head": It is the main feature in the design that attracts attention, and which creates the impression that respondent's goods originate from, or are licensed or sponsored by opposer of the NFL which is particularly true considering that the Philadelphia Eagles logo is also being used extensively by opposer for Class 25 goods.

Preliminary conference was initially set on September 13, 2006 Respondent-applicant filed on September 5, 2005 by registered mail a MOTION FOR POSTPONEMENT, praying for the resetting of the preliminary conference either on September 27, 2006 or October 4, 2006. This Bureau issued on September 12, 2006 Order No. 2006-1309 directing respondent-applicant to pay a filing fee of P 656.50 before it would act on her MOTION but respondent-applicant failed to do so. Notwithstanding respondent-applicant's non-payment of said filing fee, preliminary conference was reset on October 4, 2006. At said hearing, only opposer's counsel appeared. Thus, respondent-applicant was deemed to have waived her right to submit her position paper and/or draft decision, and the preliminary conference was deemed terminated. Per Order No. 2006-1434, opposer was directed to file its position paper and/or draft decision within a non-extendible period of ten (10) days from receipt of said Order. Opposer filed its Position Paper on November 6, 2002. The case is, thus, now deemed submitted for decision.

This Bureau notes that respondent-applicant's documentary evidences attached to her VERIFIED ANSWER are photocopies certified by her lawyer, Atty. Shem A. Yap. This certification does not comply, however, with the requirements of Section 5 in reference to Section 8.1 and 8.2 of Office Order No. 79 which provides the following:

"8.1 Within three (3) working days from receipt of the petition or opposition, the Bureau shall issue an order for the respondent to file an answer together with the affidavits of witnesses and originals of documents, and at the same time shall notify all parties required to be notified in the IP Code and these Regulations, provided, that in case of public documents, certified true copies may be submitted in lieu of the originals. The affidavits and documents shall be marked consecutively as 'Exhibits' beginning with the number '1'". (Underscoring supplied.)

For public documents, thus, either the originals or certified true copies thereof should be submitted. For private documents, the originals thereof should be submitted but in the interest of justice, certified true copies may be submitted.

In case of public documents, the official custodian thereof should make the certification (Rule 130, B (2), Section 7, Rules of Court). In case of private documents, the proper custodian thereof should make the certification.

To be admissible in evidence, a copy of the Certificate of Registration in the Principal Register certified by the records custodian of the Bureau of Trademarks (BOT) should have been submitted by respondent-applicant. Moreover, a copy of the notarized Agreements between Sportrend Manufacturing Corporation, Professional Promotions Group, Inc. on the one hand and Alma Concepcion and Aga Muhlach separately on the other hand, certified by the notary public

should have been submitted to be admissible in evidence if respondent-applicant cannot submit the originals thereof. The rest of the documents submitted by respondent-applicant, being private documents, are not admissible: The originals thereof should have been submitted but in case this cannot be done, copies thereof certified by the proper officer of Sportrend Manufacturing Corporation, if these are ad flyers; or by the proper officer of the newspaper and/or magazine in which these are advertised, if these are ads in newspaper and/or magazines, should have been submitted. Likewise, the check vouchers should have been certified by the proper officer of Sportrend Manufacturing Corporation.

There is no showing that respondent-applicant's counsel is a proper officer of Sportrend Manufacturing Corporation for purposes of certifying the private documents submitted by respondent-applicant. His certification, thus, cannot be taken as one within the meaning of the law. Moreover, there is no showing that the originals of the private documents submitted by respondent-applicant have been lost; destroyed; cannot be produced without respondent-applicant's fault; or are in the custody or control of the adverse party who fails to produce them after notice and satisfactorily proof that these exist, in which case said copies may be admissible (Rule 130, B (2), Section 5 and 6).

The documents attached to respondent-applicant's VERIFIED ANSWER, then, are not admissible in evidence.

The issues to be resolved are as follows:

1. Whether the subject mark "HAWK W/ HAWK'S HEAD DESIGN" is confusingly similar to opposer's Philadelphia Eagles logo;
2. Whether opposer's and respondent-applicant's goods are similar and/or related;
3. Whether opposer's Philadelphia Eagles logo is a well-known mark; and
4. Whether respondent-applicant is entitled to the registration of the mark "HAWK W/ HAWK'S HEAD DESIGN".

As to the first issue, this Bureau rules in the affirmative.

Notwithstanding the shadings on the beak and on the feathers on the lower part of the head of opposer's eagle device and the absence of such shadings on respondent-applicant's hawk device; and the presence of the word "HAWK" under respondent-applicant's hawk device, opposer's eagle device and respondent-applicant's hawk device are substantially and confusingly similar" The fierce expression of the eyes, the curve of the break; and the spread of the feathers on the neck of opposer's eagle device and respondent-applicant's hawk device are confusingly similar or almost the same:

HAWK W/ HAWK HEAD'S DESIGN



PHILADELPHIA EAGLES LOGO



There is similarity in the essential features of both marks which might create confusion (Emerald Garment Manufacturing Corporation v. Court of Appeals, et. al., G.R. No. 100098, December 29, 1995). It could be reasonably supposed that a purchaser of one party's products

under Class 25 bearing its mark might confuse said product with that of the other party's product under the same class. On other words, it could be reasonably supposed that confusion may arise especially since the purchasers of such goods are the average or ordinary purchasers, and the goods flow through the same channels or trade.

As to the second issue, this Bureau rules likewise in the affirmative.

Respondent-applicant's application for registration of the mark "HAWK W/ HAWK'S HEAD DESIGN" filed on July 23, 2003, denominated as Application Serial No. 4-2003-006510, is for Class 25 goods, specially, shoes, slippers, and sandals; and opposer's application for registration of its Philadelphia Eagles logo filed on April 21, 2006, denominated as Application Serial No. 4-2006-004236, is also for Class 25 goods which includes, as mentioned, footwear and, among others, shirts, gloves, and jackets (Exhibit "C").

Opposer's and respondent-applicant's respective goods are, thus, both similar and related: Footwear is included in the respective applications for registration, while opposer's items of clothing such as shirts, pants, gloves, and jackets which bear the Philadelphia Eagles logo are related to respondent-applicant's shoes, slippers and sandals bearing the mark "HAWK W/ HAWK'S HEAD DESIGN" not only because they belong to the same class but also because: 1) they essentially serve the same or complementary purpose; and 2) it might reasonably be assumed that they originate from one manufacturer. Goods are related when, among other factors, they serve the same purpose (*ESSO Standard Eastern, Inc. v. Court of Appeals, et al.*, G.R. No. L-29971, August 31, 1982). Moreover, although goods may be non-competing because they have different descriptive properties, they may still be considered as related if the simultaneous use on them of identical or closely similar trademarks would be likely to cause confusion as to the origin, or personal source, of the second user's goods (*Ang. V. Teodoro*, G.R. No. 48226, December 14, 1942).

Footwear and clothing complement each other: Matching footwear with clothing apparel is commonly done but out of necessity, practical considerations, or aesthetic values. For instance, sweatpants are necessarily matched with rubber shoes because these items are purposely for sporting activities such as running/jogging and exercising. Certain kinds of shirts may be matched with certain kinds of footwear for practical considerations: A sleeveless T-shirt may be matched with slippers on warm days while a turtleneck shirt may be matched with boots on humid days. A lightweight jacket with a particular design may be matched with some fancy footwear for aesthetic purposes.

As to the third issue, this Bureau rules in the affirmative.

One criterion for determining whether a mark is well-known is the duration. Extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising pr publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies (*Rules On Trademarks, Service Marks, Trade Names and Marked Or Stamped Containers*).

This Bureau holds that the extent and geographical area of the promotion of opposer's Philadelphia Eagles logo, such as the advertising and publicity of goods under different classes which bear said mark through broadcast media and the internet is such that said mark may be considered as well-known. Practically all countries in the world, in continents from Europe to the Asia/Pacific Rim and from North and South America to Antarctica receive NFL programming (Exhibit "A"). Such programming of team sports entertainment through cable and broadcast network inevitably results to products bearing the Philadelphia Eagles logo being shown to a vast world audience of different cultures. The Philadelphia is one country where such programming exists. Moreover, advertisements in a detailed manner of a vast array of products bearing the Philadelphia Eagles logo appear on the internet which is practically without boundaries. These products bearing said mark may be accessed by anyone from anywhere.

Further, the Philadelphia Eagles logo has been registered in practically all countries not only in North America but in Europe as well and in some parts of Asia (Exhibit "E").

Lastly, the Philadelphia Eagles logo has become a common fixture in sports culture that is particularly associated with opposer as part of American culture, acquiring a distinctiveness that is all its own.

Section 123.1 (e) of the IP Code provides:

"A mark cannot be registered if it:

(e) Is identical with or confusingly similar to . . . 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 . . ."

In view of Section 123.1 (e) of the IP Code, this Bureau holds that respondent-applicant is not entitled to the registration of the mark "HAWK W/ HAWK'S HEAD DESIGN".

WHEREFORE, in vie of the foregoing, the VERIFIED NOTICE OF OPPOSITION filed by opposer NFL PROPERTIES L.L.C. is hereby SUSTAINED. Consequently, Application Serial No. 4-2003-006510 for the mark "HAWK W/ HAWK'S HEAD DESIGN" on goods under Class 25 filed on July 23, 2003 by Rosa Kaw is, as it is hereby, REJECTED.

Let the filewrapper of HAWK with Hawk's Head be forwarded to the Bureau of Trademarks (BOT) together with a copy of this Decision for appropriate action.

SO ORDERED.

Makati City, December 15, 2006.

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