

VISION SPORTS HOLDING CORP.	}	IPC No. 14-2002-00024
Opposer	}	Opposition to:
	}	
-versus-	}	Serial No. : 87837
	}	Date Filed : Sept. 1, 1993
ANGEL STAR INVESTMENT LTD.,	}	Trademark : "VISION"
Respondent-Applicant,	}	
x-----x	}	Decision No. 2005-06

DECISION

This is an Opposition filed by herein Opposer VISION SPORTS HOLDING CORP., a corporation organized by virtue of the laws of the State of California, United States of America, with offices at 1763 Placentia Avenue, Costa Mesa, California 92627, United States of America against the application for registration of the mark "VISION" used for jackets, sweaters, t-shirts, skirts, dresses, blazers, coats, trousers, jeans, jogging suits, shorts, slacks, rainwear, swimming suits, tract suit, socks, stockings, neckwear, ties, scarfs, shoes, sandals, slippers, boots, heels, socks, stockings and hosiery, caps, hats, berets, headbands and hoods under Application Serial No. 87837 and filed on September 1, 1993 by the herein Respondent-Applicant ANGEL STAR INVESTMENT LIMITED, a Hong Kong company with address at New Territories, Hong Kong.

The trademark application was published for opposition on page 71, Volume II, No. 5 issue of the Intellectual Property Office Official Gazette, officially released for circulation on March 30, 2000.

Opposer filed the Verified Notice of Opposition on July 31, 2000, alleging among others, that:

"1. The registration of the trademark "VISION" in the name of the Respondent-Applicant will violate and contravene the following provisions of RA 8293, otherwise known as the Intellectual Property Code (hereinafter, the IP code):

- 1.1 Section 123(d)(i) and 123(d)(iii), because Respondent-Applicant's mark "VISION" is confusingly similar to the trademark "VISION STREET WEAR" owned and unabandoned by the Opposer for identical and/or similar goods, as to be likely, when applied to or used in connection with the goods of Respondent-Applicant, to cause confusion or mistake or deceive the purchasers thereof;
- 1.2 Section 123(e), because Opposer's mark "VISION STREET WEAR" is known all over the world to be exclusively owned by the Opposer as used on clothing, headwear and footwear, among others. Hence, registration of the confusingly similar trademark "VISION" for identical and/or similar goods will not only violate the IP Code but is also a clear breach of Article 6bis of the Paris Convention for the Protection of Industrial Property enforced in the Philippines by virtue of Memoranda of then Minister of Trade dated November 20, 1980 and October 25, 1983 directing the Director of Patents to cancel and/or reject of refuse all unauthorized registrations that are identical with or confusingly similar to internationally well-known marks;

"2. The registration of Respondent-Applicant's trademark "VISION" will cause grave and irreparable injury and damage to the business reputation and goodwill of the Opposer within the meaning of Section 134 of the IP Code."

In support of its opposition, Opposer relied on the following facts:

“1. The Opposer and its predecessors are the exclusive owners and users of the internationally well-known mark “VISION STREET WEAR” as used on clothing, headwear and footwear, including casual, leisure and beach clothing, sportswear, for surfing, swimming, skateboarding, bicycling, BMX racing, shirts, t-shirts, sweat shirts, tank tops, vests, blouses, coats, jackets, sweaters, pullovers, skirts, dresses, pants, sweatpants, shirts, shoes, athletic shoes, boots, slippers, sandals, socks, belts, hats, caps, visors, swimwear, wetsuits, as well as skateboards, snowboards and others.

“2. Opposers and its predecessors have obtained worldwide registrations and/or applications for registration of the trademark “VISION STREET WEAR” or “VISION” in almost all of the countries around the world, including Australia, Austria, Brazil, Canada, Chile, Denmark, Finland, France, Guatemala, Greece, Hong Kong, Iceland, Israel, Italy, Japan, Mexico, New Zealand, Panama, Peru, Philippines, Portugal, Singapore, South Korea, Spain, Sweden, Switzerland, Taiwan, Thailand, United Kingdom, Uruguay, Venezuela, among others. In the Philippines, Opposer has filed its application with the Intellectual Property Office for the registration of the mark “VISION STREET WEAR” under Trademark Application No. 4-2000-03490 filed on April 28, 2000.

“3. Opposer and its predecessors have been using the trademark “VISION STREET WEAR” extensively and continuously in several countries worldwide since 1985, and in the Philippines since 1987, long before the Respondent-Applicant filed the instant application is clearly the senior user of the trademark in question.

“4. The trademark “VISION STEET WEAR” has earned an immense and valuable goodwill as a result of the enormous sales generated by the products bearing said mark, the vastly superior quality of said products and the large sums of money spent worldwide in advertising and promoting said products bearing the “VISION STREET WEAR” mark.”

“5. It is obvious that Respondent-Applicant, in adopting and using the confusingly similar trademark “VISION” for identical and/or similar goods, is riding on and/or intending to ride on and cash in on the international and local popularity of Opposer’s trademark “VISION STREET WEAR”, and to deceive and confuse the buying public as to the original of its goods.”

A Notice to Answer dated October 25, 2000 was issued by this Office requiring the Respondent-Applicant to file Answer within fifteen (15) days from receipt thereof. On December 7, 2000, Opposer filed a Motion to Declare Respondent-Applicant As In Default for failure to file an Answer within the reglementary period, which was GRANTED by this Office under Order No. 2000-666 dated 14 December 2000.

Pursuant to the Order of Default, Opposer presented its evidence ex-parte consisting of exhibits “A” to “L” inclusive of sub-markings which was duly admitted by this Office together with the Supplemental Formal Offer of Evidence consisting of Exhibits “M” to “M-119”.

THE MAIN ISSUE TO BE RESOLVED IN THIS CASE IS WHETHER OR NOT RESPONDENT-APPLICANT’S “VISION” TRADEMARK IS CONFUSINGLY SIMILAR TO OPPOSER’S “VISION” AND “VISION STREET WEAR” TRADEMARKS AS TO CAUSE CONFUSION UPON THE CONSUMING PUBLIC.

It should be noted that the trademark application being opposed was filed on September 1, 1993 or during the effectivity of the old Trademark Law (R.A. 166, as amended). Thus, the applicable provision of law in resolving the issue involved is Section 4 (d) of R.A. No. 166, as amended which provides:

“Sec. 4. Registration of trademarks, tradenames and service marks on the principal register. There is hereby established a register of trademarks, tradenames and service marks which shall be known as the principal register.

The owner of the trademark, tradename, or service mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register, unless it:

x x x

(d) Consist of or comprises a mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business, or services of the applicant, to cause confusion or mistake or to deceive purchasers.”

The Supreme Court in the case of Philippine Nut Industry, Inc. vs. Standard Brands Incorporated, et.al., G.R. No. L-23035, July 31, 1975 has stated that:

“In cases involving infringement of trademarks, it has been held that there is infringement when the use of the mark involved would be likely to cause confusion or mistake in the mind of the public or to deceive purchasers as to the origin or source of the commodity; that whether or not a trademark causes confusion and likely to deceive the public is a question of fact which is to be resolved by applying the “test of dominancy,” meaning, if the competing trademark contains the main or essential or dominant features of another by reason of which confusion and deception are likely to result, then infringement takes place; and that duplication or imitation is not necessary, a similarity of the dominant features of the trademark would be sufficient.”

In the instant case, a visual comparison of the parties’ trademarks reveal that the Opposer’s mark consists of the words “VISION” and “STREET WEAR” while the Respondent-Applicant’s mark consists of the word “VISION” alone.

Although the Opposer’s trademark registration in the Philippines consists of a composite mark “VISION STREET WEAR” while the Respondent-Applicant’s mark consists of only one (1) word “VISION”, it is still likely to cause confusion since the word “VISION” is a prominent or dominant feature in Opposer’s trademark “VISION STREET WEAR”. Opposer intent to use the word “VISION” as its dominant mark as evidenced by its prior application for registration of the word “VISION” alone in many countries of the world, the earliest of which is in Australia in year 1986 (Exhibit “I”). Moreover, both the Opposer and Respondent-Applicant’s trademark cover similar or related goods falling under Class 25.

It is further observed that Opposer’s mark “VISION STREET WEAR” which was likewise registered and applied for its registration in various countries of the world including the Philippines consists of the words “VISION” and “STREET WEAR”, the earliest registration of which was in France in year 1987 (Exhibits “I-15” to “I-16”).

It should also be emphasized that Opposer has used the mark “VISION STREET WEAR” continuously and extensively since 1985 worldwide and in the Philippines since 1987 as evidences by the Affidavit-Direct Testimony of Louis B. Dorfman, President of Vision Sports

Holding Corp. (Exhibit "A"), long before the Respondent-Applicant filed the application for registration of the trademark "VISION".

In this regard, the Supreme Court held that:

"When one applied for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark. This is not only to avoid confusion on the part of the public, but also to protect an already used and registered mark and an established goodwill. (Chuan Chow Soy and Canning Co. vs. Director of Patents and Villapanta, 108 Phil. 833, 836)"

Particularly, the Opposer's mark "VISION" and that of the Respondent-Applicant "VISION" is identical to each other both in spelling, pronunciation and meaning as well.

Furthermore, it must be noted that Respondent-Applicant was declared in default in accordance with the Rules and Regulation on Inter Partes Proceedings and the Rules of Court for failure to file an Answer within the reglementary period under Order No. 666 dated December 14, 2000.

It was held by the Supreme Court in the case of Del Bros Hotel Corporation vs. Intermediate Appellate Court, 159 SCRA 533, 543, that:

"Fundamentally, default orders are taken on the legal presumption that in falling to file an Answer, the defendant does not oppose the allegations and relief demanded in the complaint."

Indeed, this Office cannot but notice the lack of concern the Respondent-Applicant had shown in protecting its mark which is contrary to the norm that: A person takes ordinary care of his concern. (Sec. 3 (d), Rules 131 of the Rules of Court)

WHEREFORE, premises considered, the Opposition is hereby SUSTAINED. Consequently, trademark application Serial No. 87837 filed on September 1, 1993 by ANGEL STAR INVESTMENT LIMITED for the mark "VISION" is, as it is hereby, REJECTED.

Let the filewrapper of the trademark "VISION" subject matter under consideration forwarded to the Administrative, Financial and Human Resources Development Services Bureau (AFHRDSB) for appropriate action in accordance with this Order with a copy to be furnished the Bureau of Trademarks (BOT) for information and to update its records.

SO ORDERED.

Makati City, 22 February 2005.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs