



OFFICE OF THE DIRECTOR GENERAL

BATA BRANDS, S.A.R.L.,
Appellant,

Appeal No. 04-2010-0001

-versus-

Application No. 04-2006-006347

Date Filed: 15 June 2006

DIRECTOR OF THE BUREAU
OF TRADEMARKS,
Appellee.

Trademark: BATA

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DECISION

BATA BRANDS, S.A.R.L. ("Appellant") appeals the decision, dated 16 November 2009, of the Director of the Bureau of Trademarks ("Director") sustaining the final rejection of the Appellant's application to register the mark "BATA" for goods¹ falling under Class 25 of the Nice Classification.²

Records show that the Appellant filed on 15 June 2006 Trademark Application No. 04-2006-006347. The Examiner-in-Charge ("Examiner") issued an official action³ stating that the mark may not be registered because it nearly resembles a mark with an earlier filing date and the resemblance is likely to deceive or cause confusion. The Appellant submitted a letter, dated 30 March 2007, claiming that there can be no confusing similarity between its mark and the mark cited by the Examiner because the goods are different. The Appellant also stated in the letter that its mark is internationally well-known and is registered in virtually all countries of the world where intellectual property law exists. Subsequently, the Examiner issued a "FINAL REJECTION"⁴ stating that the Appellant's mark cannot be registered because it is identical with the mark "BATA" bearing Reg. No. 026064 covering closely related goods of rubber shoes and casual rubber shoes.

The Appellant filed on 26 March 2008 an "APPEAL TO THE DIRECTOR UNDER RULE 1102" contending that the Examiner erred in

¹Boots, dress shoes, casual shoes, athletic shoes, pumps, overshoes, sandals, flip-flops, slides, mules, clogs, slippers and all other types of footwear made of leather, fabric, wood, plastic or other materials other than rubber, or combinations of such materials.

²The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

³Paper No. 3, mailed on 23 March 2007.

⁴Paper No. 09, mailed on 05 February 2008.

concluding that there is confusing similarity between the two marks considering that the goods are different and the purchasing public could easily distinguish one from the other. The Director denied the appeal and sustained the final rejection.

On 08 February 2010, this Office received a copy of the Appellant's "APPEAL". The Appellant contends that the Director is clothed with sufficient authority to determine whether a mark is well-known for purposes only of allowing a mark to be published for opposition purposes. The Appellant argues that it was an error for the Director to have shied away from what clearly is a legal duty to perform which was even recognized in *Sehwani, Inc. v. In-N-Out Burger, Inc.*⁵ where the Supreme Court ruled that the "competent authority" for purposes of determining whether a mark is well-known refers to the "registering authority". According to the Appellant, the Director is in-charge of overseeing trademark applications. The Appellant maintains that its mark is well-known and is entitled to the protection of the IP Code and the international covenants adhered to by the Philippines. The Appellant claims that it will be more in keeping with sound policy and common justice to allow the trademark application to proceed so that the parties concerned may properly ventilate their respective claims in the appropriate forum.

On 26 March 2010, the Director filed her "COMMENT" alleging that the Examiner or the Bureau of Trademarks is not a competent authority for purposes of determining whether a mark is well-known. She maintains that whether a mark is well-known is factual in nature and is better adjudicated in a litigious action rather than in an *ex parte* proceeding. She avers that the existence of a valid and subsisting certificate of registration in favor of an identical mark used for similar goods bars the Examiner from allowing the Appellant's trademark application even for the purpose of publication.

The issue in this appeal is whether the Director was correct in sustaining the final rejection of the Appellant's application to register the mark BATA.

Sec. 123.1(d) of the IP Code, states that a mark cannot be registered if it:

- (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;

In this regard, below are the illustrations of the Appellant's mark and the mark cited by the Examiner:

⁵ G. R. No. 171053, 15 October 2007.

Bata



Appellant's mark

Mark cited by the Examiner

At a glance, one can see that the marks are similar if not identical as they both refer to the word "Bata". Furthermore, both marks are used on shoes. The Appellant's trademark application was filed on 15 June 2006 and covers the following goods: boots, dress shoes, casual shoes, athletic shoes, pumps, overshoes, sandals, flip-flops, slides, mules, clogs, slippers and all other types of footwear made of leather, fabric, wood, plastic or other materials other than rubber, or combinations of such materials.

On the other hand, the mark BATA cited by the Examiner which became the basis for the final rejection of the Appellant's trademark application is used on similar goods, rubber shoes and casual rubber shoes, and has been registered to another proprietor since 1978. The mark BATA cited by the Examiner has existed since 1978 and for over thirty (30) years has been registered in the name of *New Olympia Rubber Prods., Co., Inc.*

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.⁶

To allow the registration of the Appellant's mark would be contrary to the provisions of the IP Code and defeat the very rationale of trademark registration. Sec. 123.1 (d) of the IP Code bars the registration of BATA in the name of the Appellant because this mark is identical to a registered mark belonging to a different proprietor which is used on the same or related goods.

The Director was, therefore, correct in sustaining the final rejection of the Appellant's mark. Moreover, the allowance of the Appellant's trademark application would also prejudice *New Olympia Rubber Prods., Co., Inc.* which

⁶ *Pribhdas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 November 1999.

has complied with the registration requirements of BATA for the past 30 years.

Furthermore, because of the similarity in the appearance of the marks and the goods to which the marks are used, it is very likely that the purchasing public would be deceived or be confused on the source or origin of the goods. The purchasing public may associate or mistake the Appellant's goods as those of the owner of the mark cited by the Examiner or vice versa.


Regarding the Appellant's claim that its mark is well-known, this is a claim or defense against other trademark applications or registrations involving identical or similar trademarks. This presupposes a contest between two (2) parties both claiming ownership and/or the right to register a trademark. This could be done, not through the *ex parte* proceedings in the Bureau of Trademarks but in an adversarial proceeding, for example, an opposition or a cancellation case, in the Bureau of Legal Affairs of this Office.

WHEREFORE, premises considered, the appeal is hereby DISMISSED. The Trademark Application No. 4-2006-006347 for boots, dress shoes, casual shoes, athletic shoes, pumps, overshoes, sandals, flip-flops, slides, mules, clogs, slippers and all other types of footwear made of leather, fabric, wood, plastic or other materials other than rubber, or combinations of such materials is hereby rejected.

Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Trademarks. Let a copy of this Decision be furnished also the library of the Documentation, Information and Technology Transfer Bureau for its information and records purposes.

SO ORDERED.

SEP 25 2012 Taguig City


RICARDO R. BLANCAFLOR
Director General