



OFFICE OF THE DIRECTOR GENERAL

KING G. ONG,

Appellant,

-versus-

DIRECTOR OF THE BUREAU OF  
TRADEMARKS

Appellee.

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Appeal No. 04-2011-0023

Application No. 4-2009-010225

Date Filed: 09 October 2009

Trademark: HAVANA SANDALS

DECISION

KING G. ONG (“Appellant”) appeals the decision<sup>1</sup> of the Director of the Bureau of Trademarks (“Director”) sustaining the final rejection of the Appellant’s application to register the mark “HAVANA SANDALS”.

Records show that the Appellant filed on 09 October 2009 Trademark Application No. 4-2009-010225 for HAVANA SANDALS for use on shoes, slippers, sandals and boots. Subsequently, the Examiner-in-Charge (“Examiner”) issued a “REGISTRABILITY REPORT”<sup>2</sup> stating that the mark may not be registered because it nearly resembles a mark with an earlier filing or priority date and the resemblance is likely to deceive or cause confusion.

On 27 April 2010, the Appellant filed a response to the registrability report claiming that the marks are sufficiently dissimilar and may be distinguished by ordinary purchasers. The Appellant claimed that it filed opposition to the two (2) marks cited by the Examiner and that the other mark cited by the Examiner has been declared abandoned.

The Examiner issued an official action<sup>3</sup> stating that the Appellant’s mark nearly resembles the registered marks “HAVAIANAS” and “HAVAIANAS SOUL COLLECTION” and the resemblance is likely to deceive or cause confusion, hence, registration of the Appellant’s mark is proscribed under Sec. 123.1 (d) of the Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines (“IP Code”).

On 16 July 2010, the Appellant filed a response disagreeing with the Examiner and maintaining that its mark is visually and phonetically different from the marks cited by the Examiner and that it has used HAVANA for over 14 years in the

<sup>1</sup> DECISION dated 17 October 2011.

<sup>2</sup> Paper No. 02 with mailing date of 17 March 2010.

<sup>3</sup> Paper No. 04 with mailing date of 26 May 2010.

Philippines and will defend this mark against any opposition/cancellation actions to be filed by third parties.

The Examiner issued a "FINAL REJECTION"<sup>4</sup> stating that the Appellant's mark nearly resembles the registered marks and the only difference is the missing letters "IA" and that it is more likely that the purchaser will be confused and will expect product bearing that word to come from the same proprietor.

The Appellant appealed<sup>5</sup> to the Director who denied the appeal and sustained the final rejection. Not satisfied, the Appellant filed on 22 November 2011 a "NOTICE OF APPEAL" with "APPEAL MEMORANDUM" seeking the reversal of the decision by the Director. The Appellant maintains that there cannot be any confusion or mistakes in the public regarding HAVANA SANDALS and HAVAIANAS. The Appellant contends that the marks are visually and phonetically different and convey different concepts that the average consumers can easily distinguish between these marks. The Appellant claims that the label designs of the marks can be distinguished and that its mark is used with the Filipino tagline "TSINELAS NG BAYAN" which makes it distinct from the marks cited by the Examiner. The Appellant further contends that the prices of goods covered by its mark are different from those covered by the marks cited by the Examiner.

In her comment to the appeal, the Director maintains that the Appellant's mark is confusingly similar with the marks cited by the Examiner and that a scrutiny of these marks shows that visual and aural similarities exist in their overall commercial impression. According to the Director, the six letters of the word "HAVANA" in the Appellant's mark are spelled the same way as those found in the marks cited by the Examiner. The Director argues that these marks have the same stylized font which can be gleaned from the fact that the letter "a", which precedes the letter "n", has a tail which reaches the middle part of the letter "n". The Director avers that the argument that the market of both marks is different does not preclude the fact that the Appellant's mark is confusingly similar to the marks cited by the Examiner and that the goods covered by these marks are exactly the same which may lead to confusion as to the goods and source or origin.

The issue in this case is whether the Director was correct in sustaining the final rejection of the Appellant's application to register HAVANA SANDALS.

Below are the illustrations of the Appellant's mark and the marks cited by the Examiner.

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<sup>4</sup> Paper No. 06 with mailing date of 27 August 2010.

<sup>5</sup> NOTICE OF APPEAL (From Final Rejection marked Paper No. 6) dated 24 September 2010.



*Appellant's mark*



*Marks cited by the Examiner*

At a glance, one can see the similarity in the presentation of the Appellant's mark and the mark "havaianas" cited by the Examiner. These marks both contain all the letters in the word "havana". The only difference in "havana" and "havaianas" is the presence of the letters "i" and "a" inserted between the second letter "a" and the letter "n". Moreover, in the Appellant's mark, the way the second letter "a" which precedes the letter "n" is written is similar to the way this letter is written in the mark "havaianas". In this regard, 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;

The Appellant, however, maintains the position that that there cannot be any confusion or mistakes in the public regarding HAVANA SANDALS.

The appeal is not meritorious.

The Appellant itself pointed out that:

1) The mark HAVANA for slippers was adopted from the beautiful Cuban City named HAVANA. It was Applicant-Appellant Ong's friend who took a vacation and fell in love with Havana, Cuba who inspired the Applicant-Appellant to use the name HAVANA for one of his slipper designs in 1994.<sup>6</sup>

<sup>6</sup> NOTICE OF APPEAL with APPEAL MEMORANDUM, dated 18 November 2011.

HAVANA, therefore, is a place in Cuba and to allow the Appellant to register it as a mark for use on shoes, slippers, sandals and boots would give the impression that these goods originated from Havana, Cuba. Sec. 123.1 (g) and (j) of the IP Code states that:

SEC. 123. Registrability.- A mark cannot be registered if it:

(g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;

(j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services;

In this regard, the purchasing public may associate the goods of the Appellant as originating from Havana, Cuba, thereby misleading them as to the geographical origin of these goods. Moreover, Havana, as a geographical name is not subject to exclusive appropriation. Mere geographical names are ordinarily regarded as common property, and it is a general rule that the same cannot be appropriated as the subject of an exclusive trademark or trade name.<sup>7</sup>

A certificate of registration of a mark gives the registrant the exclusive right to use this mark in connection with the goods or services and those that are related thereto specified in the certificate.<sup>8</sup> To allow the Appellant to use HAVANA would give it the exclusive right to use this mark which is a geographical name of a city in Cuba.

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.<sup>9</sup>

Accordingly, it would be contrary to the rationale of trademark registration if the Appellant is allowed to register HAVANA. Not only would there be a likelihood that the purchasing public would be deceived as to the origin of the goods of the Appellant, but other persons who may want to use this mark which is a "common property" available for use to anybody, may be prevented from using it because of a trademark registration issued to the Appellant.

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<sup>7</sup> Ang Si Heng v. Wellington Department Store, Inc., G. R. No. L-4531, 10 January 1953.


<sup>8</sup> IP Code, Sec. 138.

<sup>9</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant appeal is hereby dismissed. Let a copy of this decision and the records of this case be furnished and returned to the Director of the Bureau of Trademarks for appropriate action. Further, let a copy of this decision be furnished also to the library of the Documentation, Information and Technology Transfer Bureau for information and records purposes.

SO ORDERED.

17 FEB 2014 Taguig City.

  
RICARDO R. BLANCAFLOR  
Director General