



AM GENERAL LLC,	}	IPC No. 14-2011-00011
Opposer,	}	Opposition to:
	}	App. Serial No. 4-2010-005165
-versus-	}	Date filed: 17 May 2010
	}	
	}	
SPORTEUM PHILIPPINES, INC.,	}	Trademark: "HUMVEE"
Respondent-Applicant.	}	
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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 – 101 dated June 6, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 7 June 2013.

For the Director:

Edwin Danilo A. Dating
Atty. EDWIN DANILO A. DATING
 Director III, Bureau of Legal Affairs

CERTIFIED TRUE COPY
Sharon S. Alcantara
SHARON S. ALCANTARA
 Records Officer II
 Bureau of Legal Affairs, IPO



AM GENERAL LLC,
Opposer,

-versus-

SPORTEUM PHILIPPINES, INC.,
Respondent-Applicant.

IPC NO. 14-2011-00011

Opposition to:
App.Serial No. 4-2010-005165
Date Filed: 17 May 2010
TM: "HUMVEE"

DECISION NO. 2013- 101

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DECISION

Opposer, AM GENERAL LLC ("Opposer")¹, filed an opposition to Trademark Application Serial No. 4-2010-005165.² The application filed by SPORTEUM PHILIPPINES, INC. ("Respondent-Applicant"),³ covers the mark "HUMVEE" for use on "shoes and sandals" under Class 25 of the International Classification of Goods.⁴

The Opposer alleges the following:

"4. The Opposer is the owner of the internationally well-known HUMVEE mark by prior actual use in commerce and prior registration in the Philippines xxx.

x x x

"4.2. The Opposer has been using its internationally well-known HUMVEE mark for the sale of its vehicles since April 1, 1983.

"5. The Opposer has extensively been promoting and selling its vehicles bearing its internationally well-known HUMVEE mark worldwide and has been doing so prior to the filing of Respondent-Applicant's trademark application for HUMVEE with this Honorable Office.

"6. As a result of its extensive promotion, sales and excellence of the Opposer's vehicles, the Opposer has built and now enjoys valuable goodwill in its business as represented by its internationally well-known HUMVEE mark and the said mark has become distinctive for the Opposer's vehicle sold in commerce.

"7. Notwithstanding the prior use and prior registration of the Opposer's internationally well-known HUMVEE mark, the Respondent-Applicant filed with this Honorable Office Trademark Application No. 4-2010-005156 for HUMVEE on May 17, 2010 xxx.

¹ A corporation organized and existing under the laws of the United States of America, with address at 105 North Niles Avenue, South Bend, IN 46617, U.S.A.

² The application was published in the Intellectual Property E-Gazette on 20 September 2010.

³ A domestic corporation with address at No. 1 Guijo Street corner Octagon Avenue, Octagon State Subdivision, Pasig City.

⁴ The 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 Registration of Marks concluded in 1957.

"8. The Opposer has not consented to the Respondent-Applicant's use and registration of the internationally well-known HUMVEE mark, or any other mark confusingly similar to the said mark.

x x x

"9. The Respondent-Applicant's application for registration of the mark HUMVEE should not be given due course by this Honorable Office because its registration is contrary to Section 123.1 (d) and Section 123.1 (f) of the Intellectual Property Code xxx.

"10. In determining whether a mark is internationally well-known, the following criteria or any combination thereof may be taken into account by the competent authority in the Philippines xxx.

"11. The Opposer's HUMVEE mark is an internationally well-known mark xxx;

"11.1. The Opposer's internationally well-known HUMVEE mark has been registered and has pending applications for registration in numerous countries around the world. xxx

"11.2. The Opposer is extensively and continuously promoting its vehicles bearing its internationally well-known HUMVEE mark through various media. There is a website being maintained by the Opposer to advertise and market its vehicle bearing its internationally well-known HUMVEE mark which is easily accessible to consumers from the Philippines.

"11.3. The Opposer is marketing its vehicles bearing its internationally well-known HUMVEE mark in various countries xxx.

"12. A juxtaposition of Respondent-Applicant's mark HUMVEE which is applied for registration with this Honorable Office and the Opposer's internationally well-known HUMVEE mark reveals that indeed the Respondent-Applicant's mark is **IDENTICAL** to the Opposer's internationally well-known HUMVEE mark.

x x x

"12.1 Evidently, not only did the Respondent-Applicant appropriated all the letters in the Opposer's internationally well-known HUMVEE mark, the Respondent-Applicant also adopted and copied the exact same style of lettering of the Opposer's mark.

"13. The word HUMVEE is a fanciful and coined term, with no meaning in the English language. It cannot therefore be said that the same coined word was coincidentally adopted by the Respondent-Applicant. No other conclusion can be derived from the Respondent-Applicant's act of applying for registration of a mark that is identical to the Opposer's internationally well-known HUMVEE mark.

"14. By Respondent-Applicant's attempt to register and use the internationally well-known HUMVEE mark for its goods, the Respondent-Applicant seeks to take advantage of the worldwide and nationwide reputation of the Opposer gained by ingenious and persistent marketing and expenditure of large sums of money therefore by confusing and misleading the trade and members of the public in suggesting to the that the Respondent-Applicant's product are those being sold or is approved by the Opposer.

"15. If the products of the Respondent-Applicant are inferior in quality, there will be irreparable injury to the Opposer's valuable goodwill and its internationally well-known HUMVEE mark will have unfavorable connotation. Furthermore, the use and registration of the

Opposer's internationally well-known mark HUMVEE by the Respondent-Applicant will dilute the distinctive character of the Opposer's internationally well-known HUMVEE mark.

"16. The Respondent-Applicant seeks to register the mark HUMVEE which is confusingly similar to Opposer's HUMVEE, as to be likely, when applied to the goods of Respondent-Applicant, to cause confusion, mistake or deception of the public as to source of the goods and will inevitably suggest falsely a trade connection between the Opposer and the Respondent-Applicant."

Opposer's evidence consists of the following:

1. Exhibit "A" - Special Power of Attorney executed by the Opposer in favor of Cesar C. Cruz and Partners Law Office;
2. Exhibit "B"- copy of the Certificate of Registration No. 4-2003-001566 for the mark HUMVEE in the name of Opposer;
3. Exhibit "C"- printout of the pages of Opposer's website, Google and other marketing materials used by Opposer to promote its vehicles bearing the HUMVEE mark; and
4. Exhibit "D"- legalized and authenticated Affidavit of Lee Woodward.

This Bureau issued on 10 February 2011 a Notice to Answer and personally served a copy thereof upon the Respondent-Applicant's counsel on 29 February 2011. Despite the notice, the Respondent-Applicant did not file an Answer. Accordingly, pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark HUMVEE?

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.⁵ Thus, Sec. 123.1 (d) of the IP Code provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its application for the mark HUMVEE on 17 May 2010, the Opposer already has an existing registration for the trademark HUMVEE issued on 26 February 2006, covering goods falling under Class 12, namely, "*vehicles, namely, trucks*".

⁵See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.



As shown below, the marks of the Opposer and Respondent-Applicant are identical. Respondent-Applicant copied Opposer's mark with only a very slight variation because it is written in bold letters. But such difference pales into insignificance because of the identicalness or similarity of the marks.

HUMVEE

Opposer's Mark

HUMVEE

Respondent-Applicant's Mark

As to the goods upon which the competing marks are used, it may appear that the competing marks are used on different goods/services, that is, Opposer's mark is used on trucks under Class 12 while Respondent's mark is being applied for shoes and sandals under Class 25. However, an examination of the Opposer's evidence would show that while its HUMVEE mark is used on trucks as per its registration, the Opposer's HUMVEE mark is also being used on merchandise like shirts, jackets, caps and similar items that are being sold to Opposer's customers.⁶ As such, to allow the registration of Respondent-Applicant's HUMVEE mark will likely cause confusion, mistake or deception on the public into believing that Respondent-Applicant's goods originated or is sourced from the Opposer or would give the impression that Respondent-Applicant has been authorized by the Opposer to use its HUMVEE mark in its shoes and sandals.

The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof. The Court distinguished the two types of confusion:

Callman notes two types of confusion. The first is the *confusion of goods* "in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other." In which case, "defendant's goods are then bought as the plaintiff's, and the poorer quality of the former reflects adversely on the plaintiff's reputation." The other is the *confusion of business*: "Here though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff, and the public would then be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."⁷

Moreover, nothing in the records of this case particularly the filewrapper would show or explain how Respondent-Applicant came up with an identical mark as that of Opposer's. As such, the unexplained use by Respondent-Applicant of an identical mark lends itself open to the suspicion of fraudulent motive to trade upon Opposer's goodwill and reputation, thus:

A boundless choice of words, phrases and symbols is available to one who wishes a trademark sufficient unto itself to distinguish his product from those of others. When, however, there is no

⁶ See Exhibit "C".

⁷ Societe des Produits Nestle S.A. v. Martin Dy, G.R. No. 172276, August 8, 2010.


reasonable explanation for the defendant's choice of such a mark though the field for his selection was so broad, the inference is inevitable that it was chosen deliberately to deceive.⁸

As Sec. 123.1 (d) of the IP Code provides, a mark cannot be registered "xxx (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion."

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-005165, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 06 June 2013.



Atty. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

⁸ *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.