



**BUILD-A-BEAR WORKSHOP, INC.,**  
Opposer,

**-versus-**

**TOASTER BRAINWORKS LAB, INC.,**  
Respondent- Applicant.

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IPC No. 14-2010-00109  
Opposition to:  
Appl. Serial No. 4-2009-500417  
Date Filed: July 7, 2009  
TM: "STUFF-ME BEAR STUFFED  
WHEN LOVE"

### NOTICE OF DECISION

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#### GREETINGS:

Please be informed that Decision No. 2014 - 146 dated May 29, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 29, 2014.

For the Director:

  
Atty. EDWIN DANILO A. DATING  
Director III  
Bureau of Legal Affairs



<b>BUILD-A-BEAR WORKSHOP, INC.,</b>	} <b>IPC NO. 14-2010-00109</b>
Opposer,	} Opposition to:
	} Appln. Ser. No. 4-2009-500417
	} Date Filed: 7 July 2009
-versus-	}
	} Trademark: <b>“STUFF-ME-BEAR</b>
	} <b>STUFFED</b>
<b>TOASTER BRAINWORKS LAB, INC.,</b>	} <b>WHEN LOVE”</b>
Respondent-Applicant.	}
	}
x-----x	} Decision No. 2014- 146

**DECISION**

**BUILD-A-BEAR WORKSHOP, INC.** (Opposer)<sup>1</sup> filed on 26 May 2010 an opposition to Trademark Application Serial No. 4-2009-500417. The application, filed by **TOASTER BRAINWORKS LAB, INC.** (Respondent-Applicant)<sup>2</sup>, covers the mark “STUFF-ME-BEAR STUFFED WHEN LOVE”, for use as “importer of toys, as stuff toys” under Class 35 of the International Classification of Goods<sup>3</sup>.

The Opposer alleges, among other things, that the registration by the Respondent –Applicant will violate its rights and interests over its internationally well-known “BUILD-A-BEAR WORKSHOP” marks registered in the Philippines and will cause great and irreparable damage to the Opposer. It invokes Sec. 134 in relation to 123.1 (f) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”) which provides:

Sec. 123. Registrability. - 123.1. A mark cannot be registered if it:

(f) is identical with, or confusingly similar to, or constitutes a translation of, a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services, would indicate a connection between those goods and services, and the owner of the registered mark; Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use;

<sup>1</sup> A corporation duly registered and existing under the laws of Delaware, U.S.A. with principal address at 1954 Innerbelt Business Center Drive, Saint Louis, Missouri 63114, U.S.A.

<sup>2</sup> A Philippine corporation with address at 16 D Strata 100 Building F. Ortigas Jr. Road, Ortigas Center, Pasig City

<sup>3</sup> The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

According to the Opposer:

"1. It previously applied for and registered the with the Intellectual Property Office of the Philippines (IPOPhil) the following marks:

- (i) 'BUILD A BEAR WORKSHOP WHERE BEST FRIENDS ARE MADE AND DESIGN' under Registration No. 4-2000-008214 issued on 17 January 2005;
- (ii) 'CHOOSE ME, HEAR ME, STUFF ME, STITCH ME, FLUFF ME, NAME ME, DRESS ME, TAKE ME HOME' under Registration No. 4-2005-008373 issued on 1 December 2008;
- (iii) 'BUILD A BEAR WORKSHOP &DESIGN' under Application No. 4-2005-008366 filed on 26 August 2005, the registration proceedings are pending before the IPO Phil;
- (iv) 'HEART IN A BEAR TRADE DRESS' under Application No. 4-2005-008371 filed on 26 August 2005, the registration proceedings are pending before the IPO Phil.

"2. The Opposer likewise applied for and/or registered its trademarks, collectively referred to as the 'BUILD-A-BEAR WORKSHOP' marks, in various foreign trademark registries including the United States Patent and Trademark Office (USPTO) Registration No. 2,553,748 and issued prior to the filing of Respondent-Applicant's registration.

"3. The goods and services of Opposer carrying its 'BUILD-A-BEAR WORKSHOP' marks have acquired international recognition due to the long use of, and the large amounts spent by Opposer for advertisement, promotion and publicity worldwide, together with the volume of sales of said goods and services.

"4. The Opposer's 'BUILD A BEAR WORKSHOP' marks have become firmly and widely identified with the goods and services of Build-A-Bear Workshop, Inc. and/or its distributors, dealers, licensees, agents such that the buying public, here and abroad, have come to regard Build-A-Bear Workshop, Inc. as the true source o the goods and services bearing said marks."

The Opposer submitted as evidence the following:

1. Legalized and authenticated Amended and Restated By-laws of Build-A-Bear Workshop, Inc.;
2. Copy of Certificate of Registration No. 4-2008-007229 dated 29 December 2008 for the mark 'A FRIEND FUR ALL SEASONS';
3. Copy of Certificate of Registration No. 4-2005-008364 dated 15 December 2008 for the mark 'BEARARMOIRE';
4. Copy of Certificate of Registration No. 4-2000-008214 dated 17 December 2005 for the mark 'BUILD-A-BEAR WORKSHOP WHERE BEST FRIENDS ARE MADE AND DESIGN';

5. Copy of Certificate of Registration No. 4-2005-008373 dated 1 December 2008 for the mark 'CHOOSE ME, HEAR ME, STUFF ME, STITCH ME, FLUFF ME, NAME ME, DRESS ME, TAKE ME HOME';
6. Copy of Certificate of Registration No. 4-2005-008370 dated 16 February 2009 for the mark 'CUB CONDO DESIGN';
7. Copy of Certificate of Registration No. 4-2008-007489 dated 3 November 2008 for the mark 'HOMECATION';
8. Copy of Certificate of Registration No. 4-2005-008372 dated 23 February 2009 for the mark 'STORE FRONT DESIGN'
9. Copy of USPTO Reg. No. 2,553,748 for the mark BUID-A-BEAR WORKSHOP;
10. Worldwide trademark portfolio of BUILD-A-BEAR marks;
11. Copies of trademark registrations for the mark BUILD-A-BEAR WORKSHOP in countries such as Brazil, United States of America, Canada, Office of Harmonization of Internal Markets (OHIM), Indonesia, Japan;
12. Print-out of Respondent-Applicant's print advertising on interactive retail experience of STUFF-ME-BEAR; and
13. Print-out of advertisements of BUILD -A-BEAR in the Philippine Daily Inquirer.<sup>4</sup>

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 11 June 2010. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 22 November 2010 Order No. 2010-1351 declaring the Respondent-Applicant in default.

Should the Respondent-Applicant be allowed to register the trademark STUFF-ME-BEAR STUFFED WHEN LOVE?

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>5</sup> Thus, Sec. 123.1 (d) of R. A. No. 8293, also known as The Intellectual Property Code of the Philippines ("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.

Records show that while at the time Respondent-Applicant applied for registration of the mark STUFF-ME-BEAR STUFFED WHEN LOVE, the Opposer already has existing trademark registrations in the Philippines, particularly, BUILD-A-BEAR WORKSHOP WHERE BEST FRIENDS ARE MADE AND DESIGN under Certificate

<sup>4</sup> Exhibits "A" to "I" inclusive of submarkings

<sup>5</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.

of Registration No. 4-2000-008214 dated 17 December 2005 and CHOOSE ME, HEAR ME, STUFF ME, STITCH ME, FLUFF ME, NAME ME, DRESS ME, TAKE ME HOME under Certificate of Registration No. 4-2005-008373 dated 1 December 2008 for the mark. The goods covered by the Opposer's trademark registration are also under Class 35, same as indicated in the Respondent-Applicant's trademark application and Class 28 covering, among others, the following goods/services: "plush toy animals and stuffed toy animals and accessories, retail store services in the field of stuffed toy animals and plush toy animals and accessories, CDs and audio cassettes relating to or regarding teddy bears and other stuffed toy animals and plush toy animals, jewelry, newsletters, and brochures for children, retail stores services, mail order services."

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

The competing marks, depicted below, are identical :

Opposer's marks

Respondent-Applicant's mark



The words STUFF-ME-BEAR sounds like a variation of the Opposer's mark BUILD-A-BEAR. In fact, STUFF-ME-BEAR is a "composite" mark, derived from the different registered marks of the Opposer particularly, BUILD-A-BEAR and STUFF ME. Other fanciful marks of the Opposer convey similar messages, such as CHOOSE ME, HEAR ME, STITCH ME, FLUFF ME, NAME ME, DRESS ME, TAKE ME HOME. The Respondent-Applicant's device is characterized by a teddy bear device depicting a small bear inserting a heart into a large bear (heart in heart) and a stylized text of the mark written around the teddy bear device. In the same manner, the Opposer's registered trademark constitutes worker bears (inserting a heart into a large bear and a stylized phrase BUILD A BEAR at the top of the large bear and WORKSHOP at the bottom of the large bear and a stylized phrase "HERE BEST FRIENDS ARE MADE". The stylized word component of the Respondent-Applicant's mark are similarly placed on top and beneath the representation of a big bear. A smaller bear also appears to be fixing or stuffing the larger bear which is the same concept as the Opposer's trademark showing small worker bears inserting hearts into the large bear. The Opposer asserts that in the past thirteen years, Build-A-Bear Workshop, Inc. has evolved from the simple idea of making stuffed animals for mall-based retailing to an interactive "make-your-own-

entertainment experience. Its stores offer an extensive coordination of merchandise, including thirty different styles of animals to be stuffed and a wide variety of clothing, shoes and accessories for the stuffed animals.<sup>6</sup> It is likely that the consumers will associate and confuse the Respondent-Applicant's mark with the Opposer's registered marks because the marks are used on similar and/or closely related goods.

Succinctly, because the Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.<sup>7</sup>

The public interest, therefore, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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>8</sup>

It is emphasized that the Respondent-Applicant despite the opportunity given, did not file an Answer to defend his trademark application and to explain how he arrived at using the mark STUFF-ME-BEAR STUFFED WHEN LOVE. It is incredible for the Respondent-Applicant to have come up with exactly the same mark for use on similar goods by pure coincidence.

Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why of the millions of terms and combinations of letters and designs available, the Respondent-

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<sup>6</sup> Notarized and legalized Affidavit of Maxine Clark dated 12 May 2010.

<sup>7</sup> *Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

<sup>8</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

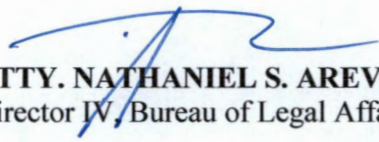
Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.<sup>9</sup>

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

**WHEREFORE**, premises considered, the instant opposition to Trademark Application Serial No. 4-2009-500417 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 29 May 2014.



**ATTY. NATHANIEL S. AREVALO**  
Director IV, Bureau of Legal Affairs

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<sup>9</sup> *American Wire & Cable Company v. Director of Patents*, G.R. No.L-26557, 18 February 1970.