



ELEANOR Y. OCAMPO,
Opposer,

-versus-

RICARDO BRITO,
Respondent- Applicant.

X-----X

} **IPC No. 14-2008-00356**
} Opposition to:
} Appln. Serial No. 4-2008-005606
} Filing Date: 13 May 2008
} **TM: "LOGO (FOOT DEVICE)"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 176 dated August 22, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 22, 2013.

For the Director:

Edwin A. Dating
ATTY. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



ELEANOR Y. OCAMPO,	}	IPC No. 14-2008-00356
Opposer,	}	Opposition to:
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-versus-	}	Appln. Serial No. 4-2008-005606
	}	Date Filed : 13 May 2008
RICARDO BRITO,	}	Trademark: "LOGO (FOOT DEVICE)"
Respondent-Applicant.	}	
x ----- x	x	Decision No. 2013 - <u>176</u>

DECISION

ELEANOR Y. OCAMPO ("Opposer")¹, filed on 12 December 2008 an opposition to Trademark Application No. 4-2008-005606. The application, filed by RICARDO BRITO ("Respondent-Applicant")², covers the mark "LOGO (FOOT DEVICE)" for use on goods under class 25³ for footwear namely shoes, sandals and slippers; clothing namely shirts, pants, jackets and socks.⁴

The Opposer interposes the following grounds for opposition:

"1. The approval of the application in question is contrary to Sections 123.1 (d) and 138 of Republic Act No. 8293;

"2. As registered owner of the trademarks 'REVA' and 'FOOTPRINT DEVICE', the approval of the application in question will violate Opposer's right to the exclusive use of her registered trademarks and cause great and irreparable damage and injury to her.

The alleged facts are as follows:

"1. Opposer is the registered owner of the trademark 'REVA' under Registration No. 4-1997-126241 issued on July 26, 2003 for use on shoes, sandals and slipper; clothing, namely: shirts, pants, jackets and socks falling under Class 25.

Registration No. 4-1997-126241 continues to be in full force and effect. x x x

¹ Filipino, of legal age, with postal address at 497 President Quirino Avenue corner Zulueta Street, Paco, Manila.
² With address at 5006 Sto. Rosario Street, Mapulang Lupa, Valenzuela City.
³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.
⁴ The application was published in the Intellectual Property Office Official Gazette, officially released for circulation on 22 August 2008.

"2. Opposer is likewise the registered owner of the trademark 'FOOTPRINT DEVICE' under Registration No. 4-2007-001813 issued on July 23, 2007 for use on shoes, sandals and slippers; clothing, namely: shirts, pants, jackets and socks falling under Class 25.

Registration No. 4-2007-001813 continues to be in full force and effect. x x x

"3. Opposer, through her corporate vehicle, Unisport Marketing Corporation, has used and continues to use her aforementioned registered trademarks. x x x

"4. Respondent-Applicant's trademark 'LOGO (FOOT DEVICE)' is confusingly similar to Opposer's registered trademarks 'REVA' and 'FOOTPRINT DEVICE'. x x x

"5. The goods covered by Respondent-Applicant's application falling under Class 25, are identical to, and/or related to, the goods covered by Opposer's Registration No. 4-1997-126241 and Registration No. 4-2007-001813, which also fall under Class 25.

"6. Accordingly, the approval of the application in question is contrary to Section 123.1 (d) of Republic Act No. 8293, x x x.

"7. The approval of the application in question violate the right of Opposer to the exclusive use of her registered trademark 'REVA' and "FOOTPRINT DEVICE' on goods listed in the certificates registration issued to her.

The Opposer's evidence consists of the following:

1. Exhibit "A"- Certificate of Registration No. 4-1997-126241;
2. Exhibit "B"- Certificate of Registration No. 4-2007-001813;
3. Exhibit "C"- Declaration of Actual Use;
4. Exhibits "D" to "D-3"- Photographs of representative goods bearing the marks "REVA" and "FOOTPRINT DEVICE";
5. Exhibits "E" to "E-3"- Sales Invoices of Unisport Marketing Corporation;
6. Exhibit "F"- Print-out of Respondent-Applicant's mark "LOGO" as published in the E-Gazette; and,
7. Exhibit "G" – Affidavit of Eleanor Y. Ocampo.

This Bureau served upon the Respondent-Applicant a Notice to Answer on 23 January 2009. The Respondent-Applicant filed its Verified Answer on 22 May 2009. In the Answer, he denied paragraphs 1, 2 and 3 under the facts relied upon to support the Opposition for lack of knowledge or information sufficient to form a belief as to the truth or falsity thereof. He likewise denied paragraphs 4, 5, 6, 7 and 8, and paragraphs 1 and 2 of the enumerated grounds for being mere conclusions of law and for reasons more specifically stated under the special and affirmative defences. The following are presented as specific denials:

"3.01 Respondent-Applicant specifically denies paragraphs 1, 2 and 3 under the facts relied upon to support the Opposition for lack of knowledge or information sufficient to form a belief as to the truth or falsity thereof.

‘3.02 Respondent-Applicant denies paragraphs 4,5,6,7 and 8 under the facts relied upon to support the Opposition and paragraphs 1 and 2 of the enumerated grounds for being mere conclusions of law and for reasons more specifically stated under the special and affirmative defenses and raised in its Answer the following Special and Affirmative Defenses, to wit:

“3.03 Opposer has neither legal nor factual basis of its claim that it will be damaged by the approval of the application or registration of the mark LOGO (FOOT DEVICE) bearing Application Serial No. 42008005606 filed on 13 May 2008.

“3.04 On 12 May 2005, IPO issued Trademark Certificate of Registration No. 4-2003-005476 for the trademark LOGO (FOOT DEVICE) in favor of herein Respondent-Applicant, Ricardo Brito, covering clothing and footwear under Class 25 specifically for shirts, t-shirts, pants, jackets, jeans, underwear, socks, shoes, sandals and slippers, belts, caps, hats, shorts, sweatpants and sweatshirts. x x x

“3.05 Opposer on the other hand, applied with IPO for the registration of the mark REVA on 04 November 1987 under Application No. 4-1997-126241. x x x

Although a foot device can be found in both trademarks, there are glaring and striking differences between them to that prospective consumers of clothing or footwear cannot distinguish one from the other. The subject mark, LOGO (FOOT DEVICE), sought to be registered by Respondent-Applicant is not identical nor is it confusingly similar to Opposer’s REVA trademark. Very dominant in Opposer’s trademark REVA is the word REVA, not the foot logo, there is no similarity in the dominant feature of Opposer’s REVA trademark, as compared to Respondent-Applicant’s LOGO (FOOT DEVICE). Opposer’s REVA trademark is a composite mark while Respondent-Applicant’s mark LOGO (FOOT DEVICE) is a device mark. x x x

To prohibit or disallow registration of a mark, section 123.1 of the Intellectual Property Code (R.A. 8293) requires that a mark subject of any action for opposition should be identical or confusingly similar with any prior or registered trademarks, but as happened in this opposition, there is no infringement or confusingly similarity between these marks. Hence, Opposer can not assert exclusivity of use of the foot device as trademark as applied to goods under Class 25.

“3.06 In the use of the foot device alone as trademark, Respondent’s LOGO (FOOT DEVICE) was applied and registered earlier than Opposer’s FOOTPRINT DEVICE. Opposer applied for the registration of the LOGO (FOOT DEVICE) with Application Serial No. 42003005476 on 20 June 2003 while Opposer’s FOOTPRINT DEVICE was applied for registration on 21 February 2007. Respondent’s LOGO (FOOT DEVICE) was registered 12 May 2005, more than two years earlier than Opposer’s FOOTPRINT DEVICE on 23 July 2007.

x x x

There is no denying that Respondent-Applicant is the prior adopter and registrant of the FOOT DEVICE as trademark. x x x

“3.07 It is not Opposer but Respondent-Applicant therefore who will suffer irreparable damage with the existence of both trademarks adopting a FOOT DEVICE alone, as applied to identical goods in the clothing and footwear business.

“3.08 Clearly, it is Respondent-Applicant who can assert exclusive use of the FOOT DEVICE as applied to goods under Class 25 for having applied the trademark and issued registration ahead of Opposer’s FOOTPRINT DEVICE, hence, this instant Opposition should be dismissed.”

The Respondent-Applicant’s submitted its lone evidence consisting of Certificate of Registration No. 4-02003-005476 marked as Exhibit “1”.

On 09 June 2011, the Opposer filed her Reply re-stating her documentary evidence proving that the subject trademark application is proscribed by Section 123.1 (d) of Republic act No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”), and alleging that the lone evidence of Respondent-Applicant has no evidentiary value because the same have been ordered removed from the Register.

Should the Respondent-Applicant be allowed to register the trademark LOGO (Foot Device)?

It is emphasized that 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 out 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

The Opposer anchors its opposition on Sec. 123.1 (d) of the IP Code which provides that a mark shall not 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;

⁵ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91, of the Trade related Aspect of Intellectual Property (TRIPS Agreement).

Records show that at the time the Respondent-Applicant filed its trademark application on 13 May 2008, the Opposer has existing trademark registrations which are used in goods similar and/or closely related to the goods indicated in the Respondent-Applicant's application, The Opposer has Registration No. 4-1997-126241 for the mark REVA⁶ which was issued on 26 July 2003 with a term of twenty (20) years, covering "shoes, slippers, boots, sandals, t-shirts, polo, poloshirts, pants, jeans, slacks, socks, belts, sweatshirts, shorts, jackets, caps, suspender, blouses, sandos and jogging pants under Class 25. In addition, the Opposer has Registration No. 4-2007-001813 for mark FOOTPRINT DEVICE⁷ which was issued on 23 July 2007 with a term of ten (10) years, covering the same goods under Class 25.

The foregoing trademarks were used and continuously used in the Philippines, evidenced by the Declaration of Actual Use⁸ and the sales invoices to various clients⁹ which showed its first use in the year 1996 and onwards.

The competing marks are reproduced below for comparison:



Trademark Reg. No. 4-1997-126241



Trademark Reg. No. 4-2007-001813

Opposer's Trademarks



Respondent-Applicant's Trademark

-
- ⁶ Exhibit "A" of the Opposer.
 - ⁷ Exhibit "B" of the Opposer.
 - ⁸ Exhibit "C" of the Opposer.
 - ⁹ Exhibits "E" to "E-3" of the Opposer.

The Opposer has two registered trademarks. Registration No. 4-1997-126241 is a composite mark consisting of the word mark REVA and the footprint design. It displays the word mark REVA as the more prevalent feature than the footprint design. However, the footprint design on the left portion of the word REVA is an integral component of the composite mark, particularly because it shapes the straight wall line of the letter R. Registration No. 4-2007-001813 on the other hand, has only the footprint design of the right foot. Comparing the Respondent-Applicant's mark with the Opposer's registered marks, one can easily see the similarity between these marks. What render these marks distinctive are the visual and conceptual properties of a foot device.

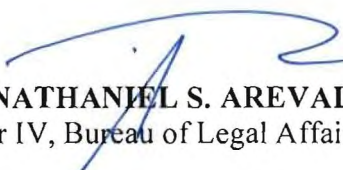
Thus, this Bureau finds that confusion, or even deception, is likely to occur. The competing marks need not be identical or similar in all details. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.¹⁰

The field from which a person may select a trademark is practically unlimited. As in all cases of colourable imitation, the answer riddle is why, of the millions of terms and combination of letters and available, the Respondent-Applicant had come up with a mark identical or so clearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.¹¹

WHEREFORE, the instant Opposition is hereby **SUSTAINED** on the grounds stated above. Let the file wrapper of Trademark Application No. 4-2008-005606 be returned together with a copy of this Decision to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 22 August 2013.


NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs

¹⁰ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 4 April 2001, 356 SCRA 207, 217.

¹¹ American Wire and Cable Co. v. Director of Patents et. al. (SCRA 544), G.R. No. L-26557, 18 Feb. 1970.