



MANOLO P. SAMSON,
Opposer,

-versus-

CATERPILLAR, INC.,
Respondent-Applicant.

X-----X

} IPC No. 14-2002-00085
} Opposition to:
} Appln. Serial No. 4-1997-116433
} Date Filed: 07 May 1997
} TM: "CATERPILLAR AND
} DESIGN"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 46 dated March 22, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 22, 2013.

For the Director:

ATTY. PAUSTI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



MANOLO P. SAMSON, Opposer,	}	IPC No. 14-2002-00085
	}	Opposition to:
	}	Appln. Serial No. 4-1997-116433
- versus -	}	Date Filed: 07 May 1997
	}	Trademark: CATERPILLAR AND
CATERPILLAR, INC.,	}	DESIGN
Respondent-Applicant.	}	
x-----x		Decision No. 2013 - <u>46</u>

DECISION

MANOLO P. SAMSON¹ ("Opposer") filed on 11 December 2002 a Verified Notice of Opposition to Trademark Application No. 4-1997-116433. The application, filed by CATERPILLAR, INC.² ("Respondent-Applicant"), covers the mark CATERPILLAR AND DESIGN (Consists of the Word CATERPILLAR With A Triangle Incorporated Under the Letter A) for use on *watches, clocks, cuff links, tie tacks, tie bars, bracelets, pendants, belt buckles, earrings, charms, key chains, stick pins, lapel pins, necklaces, watch, fobs, alarm clocks, wall clocks, watch bands, belt buckles, bracelets, watch cases, jewelry, chains, watch chains, charms, chronographs for use as watches, chronometers, cigarette holders, ear clips, tie clips, costume jewelry, jewelry, lighters, necktie fasteners, ornamental pins, pocket watches, rings, stop watches, watch straps, tie fasteners, tie pins, watch movements, parts for watches*" under Class 14 of the International Classification of goods³.

The Opposer alleges that he is the registered owner of the trademark CATERPILLAR WITH A TRIANGLE BENEATH THE LETTER A under Registration No. 64705 issued on June 16, 1997 for use on shoes, sandals, slippers and boots and has other pending applications for the registration of the same trademark for use on other goods. According to the Opposer, the approval of Respondent-Applicant's Application No. 116433 will violate Section 4 (d) of Republic Act No. 166, as amended, and Section 123.1 (d) and (g) of the new Intellectual Property Code of the Philippines. In support thereof, the Opposer avers the following as facts:

"1. Opposer adopted and has used the trademark CATERPILLAR WITH A TRIANGLE BENEATH THE LETTER A in good faith for shoes, sandals, slippers and boots;

"2. Opposer's trademark CATERPILLAR WITH A TRIANGLE BENEATH THE LETTER A is duly registered in his favor under Registration No. 64705 issued on June 16, 1997. A copy of Registration Certificate No. 64705 is hereto attached as Annex "A" and made an integral part hereof;

¹ Of legal age, Filipino citizen, and a resident of 146 E. Rodriguez Avenue, Concepcion I, Marikina City.

² With address on record at 100 N. E. Adams St., Peoria, Illinois 61629, U.S.A.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral 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.

"3. Respondent-Applicant opposed before Application Serial No. 90614 of Opposer. Said opposition, however, was dismissed. Hence, the issuance in favor of Opposer of Annex "A".

Respondent-Applicant is now, therefore, barred and/or estopped from further questioning the validity of Registration No. 64706;

"4. Opposer has extended the use of the trademark CATERPILLAR WITH A TRIANGLE BENEATH THE LETTER A for other goods. And to protect his rights therefor, be filed and they are now pending this Office, Application Serial No. 123893 and No. 123894. Copies of these pending applications are hereto attached as Annexes "B" and "C", respectively, and made integral parts hereof;

"5. The mark which Respondent-Applicant's seeks to register is identical and/or confusingly similar to Opposer's registered trademark CATERPILLAR WITH A TRIANGLE BENEATH THE LETTER A and therefore, under Section 4(d) of Republic Act No. 166, as amended, the registration of said mark is proscribed;

"6. The mark which Respondent-Applicant seeks to register is identical and/or confusingly similar to Opposer's mark CATERPILLAR WITH A TRIANGLE BENEATH THE LETTER A which is the subject of Application Serial No. 123893 and No. 123894;

"7. The registration and use by Respondent-Applicant of subject trademark for watches, will cause confusion, mistake and deception on the part of the purchasing public;


"8. The registration and use by Respondent-Applicant of subject trademark for watches, clocks, cuff links, tie tacks, tie bars, bracelets, pendants, belt buckles, earrings, charms, stick pins, lapel pins, necklaces, fobs, alarm clocks, wall clocks, watch bands, watch cases, jewelry, lighters, necktie fasteners, ornamental pins, pocket watches, rings, stop watches, watch straps, tie fasteners, tie pins, watch movements, parts for watches, will dilute the distinctiveness and erode the goodwill of Opposer's registered trademark."

The Respondent-Applicant filed its Answer on 04 February 2003 stating the following affirmative defenses:

"A. Caterpillar Inc., being the owner by prior adoption and use of the mark CATERPILLAR AND DESIGN, has the right to use and register such mark.

"12. Caterpillar Inc. is the owner of the mark CATERPILLAR AND DESIGN, an internationally famous or well-known trademark which Caterpillar Inc. has long used and registered worldwide in many countries;

"13. The mark CATERPILLAR AND DESIGN is a derivative of the mark CATERPILLAR which has been used by Caterpillar Inc. worldwide in its core business of manufacturing heavy machinery and equipment for construction, mining, road building and agricultural industries since 1925. The mark



CATERPILLAR is registered worldwide, including in the Philippines where it has been registered since 1938. The following Philippine registrations for the mark CATERPILLAR are subsisting to date:

a. The trademark CATERPILLAR, first registered on 6 September 1938 for goods under International Class 24, covered by Certificate of Registration No. 575 which registration remains in force up to 7 June 2008;

b. The trademark CATERPILLAR, registered on 26 August 1971 for goods under International Class 20, covered by Certificate of Registration No. 16811 which registration remains in force up to 26 August 2011;

Copies of the Certificates of Registration covering the foregoing CATERPILLAR marks are attached hereto as Annexes "4" and "5";

"14. While maintaining its core machinery business, Caterpillar Inc. expanded into other business activities including Caterpillar Inc. footwear, clothing and accessories, Cat Financial, Cat Logistics and Cat Electric Power;

"15. Beginning 20 October 1988, the mark CATERPILLAR AND DESIGN was introduced and commercially-used by Caterpillar Inc. in its business activities. Such use has been continuous and has not been abandoned. To protect Caterpillar Inc.'s ownership of the mark CATERPILLAR AND DESIGN, it applied for and registered such mark in many countries for various classes of goods, some of which are:

- a. Australia
Registration No. : 502784
Class : 25
Registered On : January 10, 1989
Term : In full force until January 10, 2006,
subject to further renewals
- b. Argentina
Registration No. : 1.594.903
Class : 25
Registered On : March 27, 1996
Term : 10 years
- c. Austria
Registration No. : 139 826
Classes : 7, 12 and 37
Term : January 15, 1992
- d. Bermuda
Registration No. : 27748
Class : 25
Registered On : March 20, 1996
Term : 7 years, renewable for another 14 years
- e. Brazil
Registration No. : 817084690

	Class	:	25
	Registered On	:	May 3, 1994
	Term	:	10 years
f.	Brunei		
	Registration No.	:	20,601
	Class	:	25
	Registered On	:	March 25, 1995
	Term	:	7 years, renewable for 14 years
g.	Canada		
	Registration No.	:	TMA 382,235
	Classes	:	Wares in International Classes 25, 7, 9, 12, 18 21 and Services
	Registered On	:	March 29, 1991
	Term	:	15 years
h.	Denmark		
	Registration No.	:	VA 1995 06629
	Class	:	25
	Registered On	:	June 13, 1997
	Term	:	10 years
i.	Egypt		
	Registration No.	:	100836
	Class	:	25
	Registered On	:	March 2, 1999
	Term	:	10 years
j.	France		
	Registration No.	:	1.499.046
	Classes	:	1, 2, 3, 6, 7, 8, 9, 12, 14, 16, 17, 18, 21, 25, 28, 34, 36, 37
	Registered On	:	November 18, 1988
	Term	:	-
k.	Hong Kong		
	Registration No.	:	01864
	Class	:	25
	Registered On	:	December 23, 1988
	Term	:	valid until December 23, 2009
l.	Indonesia		
	Registration No.	:	265814
	Classes	:	21, 24, 25 and 26
	Registered On	:	February 16, 1991
	Term	:	10 years, subject to renewal
m.	Ireland		
	Registration No.	:	164272
	Class	:	25

	Registered On	:	March 23, 1995
	Term	:	-
n.	Italy		
	Registration No.	:	567874
	Classes	:	1, 2, 4, 6, 7, 8, 9, 12, 14, 16, 17, 18, 21, 25, 26, 28, 34, 35, 36, 37, 41, 42
	Registered On	:	January 10, 1989
	Renewed On	:	December 12, 1998
o.	Jamaica		
	Registration No.	:	30,143
	Class	:	25
	Registered On	:	June 27, 1995
	Term	:	-
p.	Japan		
	Registration No.	:	4076665
	Class	:	25
	Registered On	:	October 31, 1997
	Term	:	10 years
q.	Korea		
	Registration No.	:	0198854
	Classes	:	18 and 25
	Registered On	:	July 28, 1990
	Renewed On	:	August 7, 2000
	Term	:	Effective until August 24, 2010
r.	Laos		
	Registration No.	:	6213
	Class	:	25
	Registered On	:	February 18, 1998
	Term	:	10 years
s.	Malaysia		
	Registration No.	:	89/00466
	Class	:	25
	Registered On	:	January 25, 1989
	Term	:	-
t.	Mexico		
	Registration No.	:	362012
	Class	:	-
	Registered On	:	January 18, 1989
	Term	:	-
u.	New Zealand		
	Registration No.	:	190103
	Class	:	25
	Registered On	:	January 5, 1989
	Term	:	Effective until January 5, 2010;

renewable for 14 years

- v. Panama
Registration No. : 79519
Class : 25
Registered On : February 9, 1996
Term : 10 years
- w. Peru
Registration No. : 017429
Class : 25
Registered On : July 21, 1995
Term : -
- x. Saudi Arabia
Registration No. : 367/74
Class : 25
Registered On : September 15, 1996
Term : 9 years, eight months
- y. Singapore
Registration No. : 184/89
Class : 25
Registered On : January 12, 1989
Renewed On : January 12, 1996
Term : 10 years from renewal
- z. South Africa
Registration No. : 88/11729
Class : 36
Registered On : December 29, 1988
Term : Effective until December 29, 2008
- aa. Spain
Registration No. : 1.296.693/2
Class : 25
Registered On : April 20, 1990
Term : -
- bb. Vietnam
Registration No. : 27/406
Class : 25
Registered On : June 26, 1998
Term : Effective until February 24, 1997
- cc. Taiwan
Registration No. : 444690
Class : 25 (boots and shoes)
Registered On : June 1, 1989
Renewed On : June 1, 2009
Term : Effective until May 31, 2009

Copies of consularized and/or legalized certificates of registrations covering the above-enumerated registrations are attached hereto as Annexes "6-series";

"16. Opposer cites his Philippine Registration No. 64705 (Annex "A" of the Opposition) as a bar to the registration of Caterpillar Inc.'s subject trademark. Under said registration, Opposer's claimed date of first use of the mark CATERPILLAR WITH A TRIANGLE BENEATH THE LETTER "A", which is identical to Caterpillar Inc.'s CATERPILLAR AND DESIGN trademark, is 2 March 1992. However, Caterpillar Inc. is the prior user and registrant of the trademark CATERPILLAR AND DESIGN. As can be gleaned from the foregoing representative samples of certificates of registrations covering Caterpillar Inc.'s CATERPILLAR AND DESIGN trademark, fourteen (14) registrations, namely, Australia, Canada, France, Hong Kong, Indonesia, Italy, Korea, Malaysia, Mexico, New Zealand, Singapore, South Africa, Spain and Taiwan, pre-date by as much as three years, Opposer's claimed date of first use of the mark identical to CATERPILLAR AND DESIGN. These prior registrations worldwide prove Caterpillar Inc.'s ownership and prior appropriation of the CATERPILLAR AND DESIGN, and Opposer's unlawful act of appropriating the same as his own;


"17. The right to register a trademark is based on ownership. Being the owner by prior adoption and use of the mark CATERPILLAR AND DESIGN, Caterpillar Inc. is entitled to register the same;

"18. Opposer's Registration No. 64705 is not a bar to the registration of the subject mark. Such registration was obtained fraudulently and/or contrary to the provisions of the old Trademark Law, particularly, Sections 2 and 2-A, which allows the registration of trademarks owned by persons or entities, meaning, a trademark appropriated to his exclusive use not so appropriated by another. Opposer obtained Registration No. 64705 despite Caterpillar Inc.'s prior use and ownership of the mark CATERPILLAR AND DESIGN. For this reason, Registration No. 64705 is subject of a petition for cancellation docketed as Civil Case No. Q-00-41446 which is pending before the Regional Trial Court of Quezon City;

x x x

"20. Caterpillar Inc.'s prior use and registration worldwide of the CATERPILLAR AND DESIGN trademark for different classes of goods in relation to its various business activities controverts the validity of Opposer's Registration No. 64705. Caterpillar Inc. is therefore entitled to the registration of its subject trademark. To allow Opposer's Registration No. 64705 to bar the registration of the subject mark which Caterpillar Inc. actually owns would bring about the situation which greatly concerned the Supreme Court in the 1984 case of La Chemise Lacoste, S. A. v. Fernandez, that is, for the Philippines to acquire an unbecoming reputation among the manufacturing and trading centers of the world as a haven for intellectual pirates imitating and illegally profiting from trademarks and tradenames which have established themselves in international and foreign trade;

"B. Assuming, without conceding, the validity of Opposer's Registration No.



64705, such registration is only for shoes, slippers and boots in Class 25, Opposer's exclusive right under said registration is limited to such goods.

"21. As stated above, the validity of Opposer's Registration No. 64705 has been assailed by Caterpillar Inc. and Caterpillar Asia Ltd. in its petition for cancellation docketed as Civil Case No. Q-00-41446 which is pending before the Regional Trial Court of Quezon City. Without conceding the validity of Registration No. 64705, Caterpillar Inc. submits that such registration does not preclude the allowance of the subject trademark;

"22. Registration No. 64705, a copy of which is attached as Annex "A" of the Opposition, enumerates only three goods under Class 25 as part of its coverage, these are shoes, sandals and boots. Under Section 20 of the old Trademark Law prevailing at the time of the issuance of said registration, which is likewise the law under which this application is being pursued, a certificate of registration of a mark shall be prima facie evidence x x x of the registrant's exclusive right to use the mark in connection with the goods, business or specified services specified in the certificate;

x x x

"24. And in Canon Kabushiki Kaisha v. Court of Appeals, the Supreme Court reiterated that principle that the certificate of registration confers upon the trademark owner the exclusive right to use its own symbol only to those specified in the certificate, subject to the conditions and limitations stated therein. Hence, it was held in said case that the exclusive right of the petitioner therein to use the trademark CANON is limited to the products covered by its certificate of registration, that is, paints, chemical products, toner and dyestuff. Private respondent in said case was allowed to register the trademark CANON for Class 25 goods, specifically, sandals;

"25. The subject trademark application is for goods under Class 14, namely:

"Watches, clocks, cuff links, tie tacks, tie bars, bracelets, pendants, belt buckles, earring, charms key chains, stick pins, lapel pins, necklaces, watch fobs, alarm clock, wall clocks, watch bands, belt buckles, bracelets, watch cases, jewelry chains, watch chains, charms, chronographs for use as watches, chronometers, cigarette holders, ear clips, tie clips, costume jewelry, jewelry, lighters, necktie fasteners, ornamental pins, pocket watches, rings, stop watches, watches, watch straps, tie fasteners, tie pins, watch movements, parts for watches."

"26. The aforesaid goods are in a different class and totally unrelated to shoes, slippers, sandals and boots covered by Registration No. 64705. They are also sold in different channels of trade;

"27. Equally important, while Caterpillar Inc. has long been using its CATERPILLAR AND DESIGN trademark for goods under Class 14, particular watches, watch bands, watch chains, chronometers and chronograms for watches, which are sold worldwide including in authorized jewelry stores in the

Philippines, Opposer has not ventured into the production of such goods. Therefore, pursuant to Section 20 of the old Trademark Law and settled jurisprudence quoted above, Opposer cannot claim exclusivity of use to his mark which is brazen imitation of CATERPILLAR AND DESIGN beyond that accorded by Registration No. 64705, which is limited to shoes, slippers, sandals and boots; and

"28. Finally, without again conceding the validity of Opposer's Registration No. 64705, it should be noted that even under the IP Code, registration of a mark identical with a registered mark belonging to a different proprietor with an earlier filing or priority date is proscribed only in respect of, among others, the same goods or services or closely related goods or services. As discussed above, the goods subject of Caterpillar Inc.'s present application is totally unrelated to the goods specified in Registration No. 64705."

The pre-trial conference was conducted and terminated on 04 July 2005. Then after, the trial on the merits ensued.

The Opposer presented its witnesses and offered the following evidence consisting of Exhibits "A" to "Y" inclusive of submarkings, which were duly admitted by this Bureau in an Order No. 2008-1614 dated 16 October 2008:


1. Duly notarized affidavit of Opposer's counsel and first witness, Florencio Z. Sioson, dated August 16, 2005 and page 2 thereof showing the signature of Florencio Z. Sioson;
2. Certification of documents taken from the records of Registration No. 64705 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
3. Opposer's Certificate of Registration No. 64705 issued on June 16, 1997 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A for use on shoes, slippers, sandals and boots and the dorsal portion thereof indicating Opposer's filing of the affidavit of use following its 5th anniversary;
4. Duly accepted Affidavit of Use submitted last June 17, 2002 following the 5th anniversary of Registration No. 64705 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
5. Certification of true copies of Order No. 96-518 and Order No. 97-34 taken from the file of IPC No. 4227 entitled Caterpillar, Inc. v. Manolo P. Samson;
6. Order No. 97-34 issued on January 17, 1997 denying Caterpillar Inc.'s Motion to Admit Verified Notice of Opposition for having been filed beyond the reglementary period and the page 2 thereof;
7. Order No. 96-518 issued on September 10, 1996 giving due course to Manolo P. Samson's Application Serial No. 90614 for the registration of the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A filed on January 24, 1994 and page 2 thereof;
8. Duly accepted Affidavit of Use filed July 5, 2007 following the 10th anniversary of Registration No. 64705 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
9. Certification of documents taken from the file wrapper of Application Serial No. 4-1997-123893 filed August 22, 1997 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
10. Trademark Application Serial No. 4-1997-123893 filed on August 22, 1997 by Manolo P. Samson for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A for use on coin purse, wallet, handbags, overnight bags, travel bags,

- school bags, attache case, luggage;
11. Drawing and facsimiles of the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
 12. Acknowledgment of Filing of Application Serial No. 4-1997-123893 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
 13. Letter to the IPO Director General dated June 1, 1998 announcing Manolo P. Samson's desire to have his Application Serial No. 4-1997-123893 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A examined and approved under R. A. No. 166, as amended;
 14. Examiner's action, marked Paper No. 5, bearing mailing date of July 18, 2000;
 15. Manolo P. Samson's response dated September 11, 2000 to the Examiner's action, Paper No. 5;
 16. Examiner's action, marked Paper No. 7, bearing mailing date of March 15, 2001;
 17. Manolo P. Samson's response dated May 7, 2001 to the Examiner's action, Paper No. 7 and page 2 thereof;
 18. Letter dated November 27, 2001, submitting the required Declaration of Actual Use together with supporting documents for Application Serial No. 123893;
 19. Declaration of Actual Use for Application Serial No. 4-1997-123893 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A filed on December 3, 2001, together with cash invoices and labels and page 2 thereof;
 20. Cash Invoice Nos. 8766 and 8784 of Caterpillar Boutique dated November 16 and 17, 2001, respectively;
 21. Labels bearing the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
 22. Certification of documents taken from the file wrapper of Application Serial No. 4-1997-123894 filed by Manolo P. Samson on August 22, 1997 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
 23. Trademark Application Serial No. 4-1997-123894 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A for use on jeans, pants, polo, t-shirts, polo shirts, briefs, shorts, sandos, socks, belts, jogging pants, sweatshirts, suits, coats, overcoats, topcoats, jackets, neckties, caps, vests, dresses, skirts;
 24. Drawing and facsimiles of the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
 25. Acknowledgment of Filing of Application Serial No. 4-1997-123894 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
 26. Letter to the IPO Director General dated June 1, 1998 announcing Manolo P. Samson's desire to have his Application Serial No. 4-1997-123894 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A examined and approved under R.A. No. 166, as amended;
 27. Examiner's action, marked Paper No. 5, bearing mailing date of July 18, 2000;
 28. Manolo P. Samson's response dated September 11, 2000 to the Examiner's action, Paper No. 5;
 29. Examiner's action, marked Paper No. 7, bearing mailing date of March 15, 2001;
 30. Manolo P. Samson's response dated May 7, 2001 to the Examiner's action, Paper No. 7 and page 2 thereof;
 31. Letter dated November 27, 2001, submitting the required Declaration of Actual Use together with supporting documents for Application Serial No. 4-1997-123894;
 32. Declaration of Actual Use for Application Serial No. 4-1997-123894 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A filed on December 3, 2001, together with cash invoices and labels and page 2 thereof;
 33. Cash Invoice Nos. 7365 and 8759 of Caterpillar Boutique dated November 7 and 14, 2001, respectively;

34. Labels bearing the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
35. Duly notarized affidavit of Opposer's Marketing Officer and second witness, Rudy Ong Cortan, dated January 29, 2008;
36. Certified machine copy of the Certificate of Incorporation together with the Articles of Incorporation of Mano Shoes Manufacturing Corporation issued by the Securities and Exchange Commission on January 15, 1993;
37. Certification of the registration of the business name Caterpillar Boutique & General Merchandise issued by the Department of Trade and Industry on August 8, 2002 in favor of Manolo P. Samson;
38. Certificate of Renewal of the registration of the business name Caterpillar Boutique & General Merchandise issued by the Department of Trade and Industry last September 5, 2007;
39. Photographs of Opposer's shoes, shoe box for low-cut shoes, sandals, current box for sandals, jeans, skirt, polo shirt, t-shirt, socks, cap, visor, labels, hangtags and cloth labels, plastic wrapper, paper bag and plastic packaging bearing the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A in lieu of the actual products;
40. Various Cash Invoices of Itti Shoes and Caterpillar Boutique evidencing sales of Opposer's products bearing the trademarks CATERPILLAR and CAT;
41. Photographs of Opposer's coin purse, traveling bag, belt, and slippers bearing the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A in lieu of the actual products; and
42. Certified machine copy of the Certificate of Incorporation together with the Articles of Incorporation of Itti Shoes Corporation issued by the Securities and Exchange Commission on September 29, 1992.

The Respondent-Applicant's formal offer of documentary evidence consists of the following:

1. Affidavit dated 6 January 2009 of Pericles R. Casuela together with his signature;
2. Special Power of Attorney issued by Caterpillar, Inc. in favor of Quisumbing Torres on 27 February 2006 and authenticated by the Consul General of the Philippine Embassy in Washington D. C. on 24 April 2006;
3. Certified true copy of Certificate of Registration No. 575 for CATERPILLAR issued by the Intellectual Property Office on 7 June 1968 and renewed for another 20 years from 7 June 1988;
4. Certified true copy of Certificate of Registration No. 1609 for CAT issued by the IPO on 16 July 1975 and renewed for another 20 years from 16 July 1995;
5. Certified true copy of Certificate of Registration No. 16811 for CATERPILLAR issued by the IPO on 16 July 1975 and renewed for another 20 years from 16 July 1995;
6. Certified true copies of various trademark registrations issued by the IPO in favor of Caterpillar, such as: Certificate of Registration No. 4-1999-001830 for CAT IN BOLD LETTERS WITH A SOLID TRIANGLE UNDER THE LETTER "A"; Registration No. 4-1998-005057 for CATERPILLAR AND DESIGN; Registration No. 4-1998-005059 for CATERPILLAR AND DESIGN; Registration No. 4-1998-005058 for CAT AND DESIGN; Registration No. 4-1998-005060 for CAT AND DESIGN; Registration No. 4-1999-006389 for CAT; Registration No. 4-2001-002533 for THE CAT RENTAL STORE LOGO; Registration No. 4-2003-009565 for CATERPILLAR AND DESIGN; Registration No. 4-2003-009564 for CAT AND DESIGN; Registration No. 4-1999-001831 for CATERPILLAR AND DESIGN; Registration No. 4-1999-006388 for CAT AND DESIGN; Registration No. 4-1999-006387 for CATERPILLAR AND DESIGN; Registration No. 4-2006-009671 for

- CAT AND DESIGN; Registration No. 4-2006-009670 for CATERPILLAR & DESIGN; Registration No. 4-1998-009050 for CATERPILLAR & TRIANGULAR DESIGN; Registration No. 4-1998-009051 for CAT AND TRIANGULAR DESIGN; Registration No. 4-2007-005211 for CAT; Registration No. 4-2007-005212 for CAT AND DESIGN; Registration No. 4-2007-007839 for CATERPILLAR; Registration No. 4-2007-011171 for MACHINE BODY HORIZONTAL (WITH CAT IN BLACK AND WHITE); Registration No. 4-2006-009672 for CATERPILLAR & DESIGN; and Registration No. 4-2006-009673 for CAT & DESIGN, for various classes of goods and services, such as classes 1, 2, 4, 6, 7, 8, 9, 11, 12, 16, 17, 19, 20, 24, 28, 35, 36, 37, 39 and 42;
7. Certified true copies of various trademark applications filed in the name of Caterpillar with the IPO, such as: Trademark Application No. 4-2007-001774 and 4-2007-005210 for CATERPILLAR; Application Nos. 4-1997-116433, 4-1997-121938, 4-2007-001760, 4-2007-001764 and 4-2007-005209 for CATERPILLAR AND DESIGN; Application No. 4-2007-001763 for CAT; and Application Nos. 4-1997-116432, 4-1997-121936, 4-1997-121937, 4-2007-001762 and 4-2007-001765 for CAT AND DESIGN, for various classes of goods and services, such as classes 4, 7, 9, 12, 14, 18, 25, 35, 36, 37 and 42;
 8. Original computer print out of the search report generated as of 13 November 2008 by the IPO's Trademark Online Search System disclosed on the IPO's official website, www.ipophil.gov.ph for all the trademark applications and registrations under the name of Caterpillar, Inc.;
 9. Original computer print out of the search report generated as of 13 November 2008 by the IPO's Trademark Online Search System disclosed on the IPO's official website, www.ipophil.gov.ph for all the trademark applications and registrations that use or incorporate the word CATERPILLAR in the mark;
 10. Certified true copy of Decision No. 728, rendered by the Director of the Philippine Patent Office on 8 August 1973 in a trademark opposition case entitled *Caterpillar Tractor Co. v. Ceferino L. Benedicto* docketed as Inter Partes Case No. 573;
 11. Affidavit dated 21 July 2009 of Peter L. Calimag and his signature thereto;
 12. Certificate of Authenticity issued by the Honorable Office's Records Officer IV, Marilyn F. Retual on 10 July 2009, attesting to the fact that "the Affidavit of J. Michael Hurst with Annexes... are copies from the original on file with the records of this Office which forms part of the records of IPC No. 14-2006-00030...";
 13. Affidavit of J. Michael Hurst dated 13 July 2006 and authenticated before the Consul General of the Philippine Embassy in Washington, D. C. on 27 July 2006, along with an envelope containing the Annexes referred to in Mr. Hurst's Affidavit;
 14. Annex 1 of Mr. Hurst's Affidavit which is an original computer print out of a table generated from Caterpillar's corporate database that lists in detail the various registrations secured by Caterpillar for its CATERPILLAR mark around the world as of 7 July 2006;
 15. Annex 2 of Mr. Hurst's Affidavit which is an original computer print out of a table generated from Caterpillar's corporate database that lists in detail the various registrations secured by Caterpillar for its CAT mark around the world as of 7 July 2006;
 16. Annex 3 of Mr. Hurst's Affidavit which is an original computer print out of a table generated from Caterpillar's corporate database that lists in detail the various registrations secured by Caterpillar for its CATERPILLAR & DESIGN mark around the world as of 7 July 2006;
 17. Annex 4 of Mr. Hurst's Affidavit which is an original computer print out of a table generated from Caterpillar's corporate database that lists in detail the various registrations secured by Caterpillar for its CAT & DESIGN mark around the world as of 7 July 2006;
 18. Annex 5 of Mr. Hurst's Affidavit which is a compilation of various promotional
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materials, product catalogues, retail support materials, price lists and order forms used by Caterpillar for its various products, such as bags, beltbags, wallets, coin purses, belts, caps, shirts, jackets, socks, stuffed toys, juggling balls, colored pencils, pencil cases, watches, gloves, pocket knives, multi-tools, ear plugs, high-visibility vests, sunglasses, golf balls and tees, umbrellas, pins, soccer balls, baseballs, pumps, stationery, pens, flash drives, portfolios, calculators, lanyards, rings, playing cards, mugs, keychains, sports bottles, scale models and footwear;

19. Copy of the article entitled "*There's no business like shoe business*" written by Ching M. Alano and published in the Philippine Star on 8 November 1998;
20. Official Receipt No. 0245380 dated 7 July 2009 issued by the IPO in payment for securing certified true copies of Mr. Hurst's Affidavit; and
21. Certified true copy of the article entitled "*There's no business like shoe business*" written by Ching M. Alano and published in the Philippine Star on 8 November 1998.⁴

The Opposer filed its Memorandum on 08 December 2010 while the Respondent-Applicant did so on 13 December 2010.

Should the Respondent-Applicant be allowed to register the trademark CATERPILLAR AND DESIGN?

The Opposer anchors its opposition on Section 4(d) of Republic Act No. 166, as amended, the law in force at the time the subject application was filed, which provides that:

Section 4. *Registration of trademarks, trade names and service marks.* - The owner of a trademark, trade name or service mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same, unless it:


x x x

(d) Consists of or comprises a mark or trade name which so resembles a mark or trade name registered in the Philippines or a mark or trade name previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers.

The above-quoted provision, however, must be taken in the light of the other provisions of the said Act. In this regard, Section 20 of R.A. 166, as amended, provides:

Section 20. *Certificate of registration prima facie evidence of validity.* - A certificate of registration of a mark or trade name shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark or trade name, and of the registrant's exclusive right to use the same in connection with the goods, business or services specified in the certificate, subject to any conditions and limitations stated therein.

⁴ Marked as Exhibits "1" to "9" inclusive of submarkings.



The force and effect of Section 4(d) of R. A. 166, as amended, thus, is subject to the conditions under Section 20. Hence, Section 4(d) will apply only if the goods bearing the mark of the subsequent applicant for registration are covered by the Certificate of Registration of the prior registrant. In the same manner, said provision applies only if the goods bearing the mark of the subsequent applicant is the same as, or similar to, the goods of the prior user of the identical mark.

In this regard, the competing marks are reproduced below for purposes of comparison, to wit:



Opposer's mark



Respondent-Applicant's mark

There is no doubt that the marks are identical in spelling and style, and if pronounced, would produce the same sound effect. The Opposer's Certificate of Registration, however, covers "*shoes, slippers, sandals and boots*" under Class 25 while the goods indicated in the Respondent-Applicant's trademark application include "*watches, clocks, cuff links, tie tacks, tie bars, bracelets, pendants, belt buckles, earrings, charms, key chains, stick pins, lapel pins, necklaces, watch, fobs, alarm clocks, wall clocks, watch bands, belt buckles, bracelets, watch cases, jewelry, chains, watch chains, charms, chronographs for use as watches, chronometers, cigarette holders, ear clips, tie clips, costume jewelry, jewelry, lighters, necktie fasteners, ornamental pins, pocket watches, rings, stop watches, watch straps, tie fasteners, tie pins, watch movements, parts for watches*" under Class 14. The goods covered by the Opposer's marks on one hand, and those of the Respondent-Applicant's on the other are different and unrelated, belonging to different classes of goods, possessing different physical attributes or essential characteristics, and serving different purposes.

Also, while it is true that the mark CATERPILLAR has been previously registered and used in the Philippines, such prior use and registration pertains to the Respondent-Applicant itself. In fact, the Respondent-Applicant was able to present evidence of use which pre-dates the claimed date of first use (year 1992) of the mark by the Opposer. The Respondent-Applicant even obtained registration in Hong Kong⁵ for CATERPILLAR AND DESIGN as early as 1988 for goods under Class 25, including clothing, footwear and headgear. The prohibition under Section 4 (d) of R. A. 166 applies only if the prior registrant or user is a party other than the Applicant.

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 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

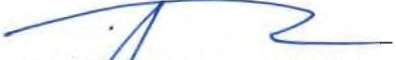
⁵ Annex "6-j".

prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁶ The Respondent-Applicant, in this case, has properly satisfied this test.

WHEREFORE, premises considered, the opposition to Trademark Application No. 4-1997-116433 is hereby **DISMISSED**. 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, 22 March 2013.



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

⁶ *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).