



MANOLO P. SAMSON,
Opposer,

-versus-

CATERPILLAR, INC.,
Respondent-Applicant.

X-----X

} IPC No. 14-2004-00015

} Opposition to:

} Appln. Serial No. 4-1997-121937

} TM: "CAT AND DESIGN

} (CAT with a Triangle Incorporated
} Beneath the Letter A)"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 191 dated October 01, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 01, 2013.

For the Director:


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



MANOLO P. SAMSON,
Opposer,

- versus -

CATERPILLAR, INC.,
Respondent-Applicant.

x-----x

IPC No. 14-2004-00015
Opposition to:

Appln. Serial No. 4-1997-121937
Date Filed:
Trademark: **CAT AND DESIGN**
(CAT with a Triangle Incorporated
Beneath the Letter A)

Decision No. 2013 - 191

DECISION

MANOLO P. SAMSON¹ ("Opposer") filed on 12 December 2002 a Verified Notice of Opposition to Trademark Application No. 4-1997-116432. The application, filed by CATERPILLAR, INC.² ("Respondent-Applicant"), covers the mark CAT AND DESIGN (Consists of the Word "CAT" With A Triangle Incorporated Beneath the Letter "A") for use on *"work, sport and casual clothing namely, caps, belts, ties, scarves, t-shirts, shorts, sweat pants, sweat shirts, wrist bands, jackets, vests, gloves, mittens, rain wear, one-piece jump suit and socks, caps, hats, and garments made to cover and protect the head; shoes, boots, and protective coverings for the feet"* under Class 25 of the International Classification of goods³.

The Opposer alleges that he is the owner of the trademarks CATT'S WITH A TRIANGLE BENEATH THE LETTER A and CAT WITH A TRIANGLE BENEATH THE LETTER A and that the approval of Respondent-Applicant's Application Serial No. 116432 violates 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 CATT'S WITH A TRIANGLE BENEATH THE LETTER A in good faith for shoes, slippers, sandals and boots;

"2. Opposer's trademark CATT'S WITH A TRIANGLE BENEATH THE LETTER A covered by Application Serial No. 90613 filed on January 24, 1994 was duly examined and approved for publication. A copy of Application Serial No. 90613 is hereto attached as Annex "A" and made an integral part hereof;

"3. Respondent-Applicant filed a Notice of Opposition to Application Serial No. 90613 of Opposer which was docketed as Inter Partes No. 14-1999-00049;

"4. Opposer also adopted and has used the trademark CAT WITH A TRIANGLE BENEATH THE LETTER A in good faith for other goods. And to protect his rights therefor, be

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.

filed and they are now pending before this Office, Application Serial No. 123895 and No. 123896. Copies of these pending application are hereto attached as Annexes "B" and "C", respectively, and made integral parts hereof;

"5. The mark which Respondent-Applicant seeks to register is identical and/or confusingly similar to Opposer's trademark CATT'S 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 CAT WITH A TRIANGLE BENEATH THE LETTER A which is the subject of Application Serial No. 123895 and No. 123896 and therefore, under Section 4 (d) of Republic Act No. 166, as amended, the registration of Respondent-Applicant's mark is proscribed;

"7. 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 cause confusion, mistake and deception on the part of the purchasing public; and

"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 13 March 2003 stating the following affirmative defenses:

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

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

"13. The mark CAT AND DESIGN is a derivative of the marks "CATERPILLAR" and "CAT" which have 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 marks CATERPILLAR and CAT are registered worldwide, including in the Philippines, where they have been registered beginning 1938. The following Philippine registrations for the marks CATERPILLAR and CAT 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 until 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 until 26 August 2011;
- c. The trademark CAT, registered on 16 July 1955 for goods under International

Classes 20 and 24, covered by Certificate of Registration No. 1609 which registration remains in force until 16 July 2015;

Copies of the Certificates of Registration covering the foregoing marks are attached hereto as Annexes "3" to "5". These marks have been used in the Philippines continuously to date;

"14. While maintaining its core machinery business, Caterpillar Inc. has 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 CAT 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 CAT AND DESIGN, it applied for and registered such mark in many countries for various classes of goods, some of which are:

- | | | | |
|----|------------------|---|--|
| a. | United States | | |
| | Registration No. | : | 1,908,556 |
| | Class | : | 25 |
| | Registered On | : | August 1, 1995 |
| | Term | : | Ten years, or until August 1, 2005 |
| b. | Argentina | | |
| | Registration No. | : | 1.648.566 |
| | Class | : | 25 |
| | Registered On | : | October 23, 1997 |
| | Term | : | Ten years, or until October 23, 2007 |
| c. | Australia | | |
| | Registration No. | : | 502762 |
| | Class | : | 25 |
| | Registered On | : | January 10, 1989 |
| | Term | : | In full force until January 10, 2006,
subject to further renewals |
| d. | Bermuda | | |
| | Registration No. | : | 27747 |
| | Class | : | 25 |
| | Registered On | : | March 20, 1996 |
| | Term | : | Seven years, renewable for another 14
years |
| e. | Brunei | | |
| | Registration No. | : | 20,600 |
| | Class | : | 25 |
| | Registered On | : | March 25, 1995 |
| | Term | : | Seven years, renewable for fourteen
years |
| f. | Canada | | |
| | Registration No. | : | TMA 382,234 |
| | Classes | : | Wares in International Classes 25, 7, 9,
12, 18, 21
and Services |
| | Registered On | : | March 29, 1991 |

	Term	:	Fifteen years, subject to renewal
g.	Egypt		
	Registration No.	:	100835
	Class	:	25
	Registered On	:	March 2, 1999
	Term	:	Ten years, subject to renewal
h.	France		
	Registration No.	:	1.499.047
	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	:	-
i.	Hong Kong		
	Registration No.	:	06722 of 1999
	Class	:	25
	Registered On	:	December 23, 1988
	Term	:	valid until December 23, 2009
j.	Indonesia		
	Registration No.	:	261482
	Classes	:	21, 25 and 26
	Registered On	:	July 21, 1990
	Term	:	Ten years, subject to renewal
k.	Italy		
	Registration No.	:	567873
	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 28, 1998
l.	Jamaica		
	Registration No.	:	31,135
	Class	:	25
	Registered On	:	June 27, 1995
	Term	:	-
m.	Japan		
	Registration No.	:	4010737
	Class	:	25
	Registered On	:	June 13, 1997
	Term	:	June 13, 2007
n.	Korea		
	Registration No.	:	0198855
	Class	:	27
	Registered On	:	July 28, 1990
	Renewed On	:	August 7, 2000
	Term	:	Effective until August 24, 2010
o.	Laos		
	Registration No.	:	6212

	Class	:	25
	Registered On	:	February 18, 1998
	Term	:	February 18, 2008
p.	Malaysia		
	Registration No.	:	89/00481
	Class	:	25
	Registered On	:	June 25, 1995
	Term	:	-
q.	Mexico		
	Registration No.	:	367837
	Class	:	-
	Registered On	:	January 18, 1989
	Term	:	-
r.	New Zealand		
	Registration No.	:	190125
	Class	:	25
	Registered On	:	June 7, 1991 with effect from January 5, 1989
	Term	:	Effective until January 5, 2010; renewable for fourteen years
s.	Saudi Arabia		
	Registration No.	:	367/73
	Class	:	25
	Registered On	:	04-02-1996
	Term	:	Nine years, eight months
t.	South Africa		
	Registration No.	:	88/11718
	Class	:	25
	Registered On	:	December 29, 1988
	Term	:	Effective until December 29, 2008
u.	Cyprus		
	Registration No.	:	42312
	Class	:	25
	Registered On	:	March 22, 1995
	Term	:	Seven years, renewable for fourteen years
v.	China		
	Registration No.	:	917364
	Class	:	25
	Registered On	:	December 21, 1996
	Term	:	December 20, 2006
w.	Vietnam		
	Registration No.	:	27/405
	Class	:	25
	Registered On	:	June 26, 1998
	Term	:	Ten years

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

"16. Opposer cites Application Serial No. 90613 filed on January 24, 1994 (Annex "A" of the Opposition) as a bar to the registration of Caterpillar Inc.'s subject trademark. However, Opposer's claimed mark subject of such application is nearly identical with or confusingly similar to Caterpillar Inc.'s internationally famous CAT and CAT AND DESIGN trademarks, in that:

a. Caterpillar Inc.'s trademarks consist of the three (3) English letters "C", "A" and "T", read as "CAT". Opposer's mark comprises the same letters "C", "A" and "T", followed by another "T", an apostrophe and the letter "S", read as "CATT'S". Undeniably, Opposer's mark is a close variant of Caterpillar Inc.'s trademarks, differing only in the former's use of "T'S" added after "CAT";

b. Caterpillar Inc.'s CAT AND DESIGN trademark distinctly uses a letter "A" with base angles of a triangle device underneath and touching upon the base of the letters "C" and "T". Opposer's mark utilizes the same triangle device;

c. The font and style used in Caterpillar Inc.'s CAT AND DESIGN trademark are not the same ones utilized by Opposer in his mark;

d. All told, these cited marks of Opposer are nothing but unashamed and slavish replicas of Caterpillar Inc.'s internationally famous marks;

"17. Under Application Serial No. 90613, Opposer's claimed date of first use of the mark CATT'S WITH A TRIANGLE BENEATH THE LETTER "A", which is nearly identical to or confusingly similar with Caterpillar Inc.'s CAT AND DESIGN trademark, is 2 March 1992. However, Caterpillar Inc. is the prior user and registrant of the trademark CAT, which, as discussed above, was used worldwide as early as in 1925, and registered in the Philippines on 16 July 1955 under Certificate of Registration No. 1609;

"18. Caterpillar Inc. is likewise the prior user and registrant of the mark CAT AND DESIGN. As can be gleaned from the representative samples of certificates of registrations covering Caterpillar Inc.'s CAT AND DESIGN trademark enumerated in paragraph 15 above, at least ten (10) registrations, namely, those in Australia, Canada, France, Hong Kong, Indonesia, Italy, Korea, Mexico, New Zealand and South Africa, pre-date by as much as three years, Opposer's claimed date of first use of the mark nearly identical to CAT AND DESIGN. These prior registrations worldwide prove Caterpillar Inc.'s ownership and prior appropriation of the CAT AND DESIGN mark;

"19. As for Opposer's Application Serial Nos. 123895 and 123896 covering the mark CAT WITH A TRIANGLE DEVICE BENEATH THE LETTER "A", the same are exact copies of Caterpillar Inc.'s CAT AND DESIGN trademark. Opposer's claimed date of first use under said application is also March 2, 1992, which is pre-dated, by as much as three years, by Caterpillar Inc.'s above-enumerated international registrations;

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

"21. Opposer's Application Serial No. 90613 is not a bar to the registration of the subject mark. The approval of such application for publication was contrary to the provisions of law. For this reason, said application, as discussed above, was opposed by Caterpillar Inc. and is subject of Inter Partes Case No. 14-1999-00049;

"22. Caterpillar Inc.'s prior use and registration worldwide of the CAT AND DESIGN

trademark for different classes of goods in relation to its various business activities controvert Opposer's claim of ownership of marks identical with or confusingly similar thereto. Caterpillar Inc. is therefore entitled to the registration of its subject trademark. To allow Opposer's Application Serial Nos. 90613, 123895 and 123896 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 *arguendo* that Opposer's Application No. 90613 would be allowed registration, the registration would only be for printed labels and other means customary in the trade, for shoes, slippers, sandals and boots. Opposer's exclusive right under said registration is limited to such goods;

"23. As stated above, the allowance of Opposer's Application Serial No. 90613 has been assailed by Caterpillar Inc. before this Honorable Office in IPC No. 14-1999-00049. Assuming Opposer's CATT'S WITH A TRIANGLE DEVICE BENEATH THE LETTER "A" is allowed registration despite Caterpillar Inc.'s opposition, Caterpillar Inc. submits that such registration does not preclude the allowance of the subject trademark;

"24. Application Serial No. 90613, a copy of which is attached as Annex "A" of the Opposition, enumerates only four goods under Class 25 as part of its coverage, namely shoes, slippers, sandals and boots. Under Section 20 of the old Trademark Law, the law under which said application and the subject application is being pursued, a certificate 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. It is not conclusive but can and may be rebutted by controverting evidence;

x x x

"27. 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 pines, watch movements, parts for watches"

"28. The aforesaid goods are in a different class and totally unrelated to shoes, slippers, sandals and boots covered by Application Serial No. 90613. They are also sold in different channels of trade;

"29. Equally important, while Caterpillar Inc. has long been using its CAT AND DESIGN trademark for goods under Class 14, particularly watches, watch bands, watch chains, chronometers and chronographs 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, even if Application Serial No. 90613 is allowed registration, such registration would be limited to printed labels and other means customary in the trade as applied on shoes, slippers, sandals and boots. Opposer cannot claim exclusivity of use to his mark, which is a brazen imitation of CAT AND DESIGN, for any and all goods; and

"30. Finally, assuming once more that Application Serial No. 90613 would be allowed

registration, it should be noted that even under the Intellectual Property 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 Application Serial No. 90613."

The pre-trial conference was conducted and terminated on 24 August 2004. Then after, the trial on the merits ensued.

The Opposer presented its witnesses and offered the following evidence consisting of Exhibits "A" to "W" inclusive of submarkings, which were duly admitted by this Bureau.

1. Certification of documents taken from the records of Registration No. 64705 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
2. 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;
3. The dorsal portion of Exhibit "A-1" 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 page 2 thereof;
7. Certification of true copies of documents taken from the file of IPC No. 14-1999-00049 entitled "Caterpillar, inc. vs. Manolo P. Samson";
8. Application Serial o. 90613 filed on January 24, 1994 by Manolo P. Samson for the trademark CATT'S WITH A TRIANGLE DEVICE BENEATH THE LETTER A for use on shoes, slippers, sandals and boots;
9. Acknowledgment of Filing of Application Serial No. 90613 for the trademark CATT'S WITH A TRIANGLE DEVICE BENEATH THE LETTER A";
10. Examiner's action marked Paper No. 3 and bearing mailing date of February 16, 1995;
11. Manolo P. Samson's response dated April 6, 1995 to the examiner's action, Paper No. 3;
12. Notice of Allowance and Payment of Publication Fee of Application Serial No. 90613 for the trademark CATT'S WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
13. Copy of the Official Gazette released on October 26, 1999 showing the publication of Opposer's mark CATT'S WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
14. Certification of documents taken from the file wrapper of Application Serial No. 4-1997-123895 filed August 22, 1997 for the trademark CAT. WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
15. Trademark Application Serial No. 4-1997-123895 filed on August 22, 1997 by Manolo P. Samson for the trademark CAT. WITH A TRIANGLE DEVICE BENEATH THE LETTER A for use on coin purse, wallet, handbags, overnight bags, travel bags, school bags, attache' case, luggage;
16. Drawing and facsimiles of the trademark CAT. WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
17. Acknowledgment of Filing of Application Serial No. 4-1997-123895 for the trademark CAT. WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
18. Letter to the IPO Director General dated June 1, 1998 announcing Manolo P. Samson's desire to have his Application Serial No. 4-1997-123895 for the trademark CAT. WITH A TRIANGLE

- DEVICE BENEATH THE LETTER A examined and approved under R. A. No. 166, as amended;
19. Examiner's action, bearing mailing date of July 18, 2000;
 20. Manolo P. Samson's response dated September 11, 2000 to the Examiner's action;
 21. Examiner's action, marked Paper No. 4, bearing mailing date of March 15, 2001;
 22. Manolo P. Samson's response dated May 7, 2001 to the Examiner's action, Paper No. 4 and the page 2 thereof;
 23. Letter dated November 27, 2001, submitting the required Declaration of Actual Use together with supporting documents for Application Serial No. 123895;
 24. Declaration of Actual Use for Application Serial No. 4-1997-123895 for the trademark CAT. WITH A TRIANGLE DEVICE BENEATH THE LETTER A filed on December 3, 2001, together with cash invoices and labels and page 2 thereof;
 25. Cash Invoice Nos. 2703 and 7351 of Caterpillar Boutique dated October 31, 2001 and June 1, 2001, respectively;
 26. Labels bearing the trademark CAT. WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
 27. Certification of documents taken from the file wrapper of Application Serial No. 4-1997-123896 filed by Manolo P. Samson on August 22, 1997 for the trademark CAT. WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
 28. Trademark Application Serial No. 4-1997-123896 for the trademark CAT. WITH A TRIANGLE DEVICE BENEATH THE LETTER for use on shoes, slippers, sandals, boots, jeans, pants, polo, polo shirts, t-shirts, briefs, shorts, sandos, socks, belts, jogging pants, sweatshirts, suits, coats, overcoats, topcoats, jackets, neckties, caps, vests, dresses, skirts, blouses, suspender;
 29. Drawing and facsimiles of the trademark CAT. WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
 30. Acknowledgment of Filing of Application Serial No. 4-1997-123896 for the trademark CAT. WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
 31. Letter to the IPO Director General dated June 1, 1998 announcing Manolo P. Samson's desire to have his Application Serial No. 4-1997-123896 for the trademark CAT. WITH A TRIANGLE DEVICE BENEATH THE LETTER A examined and approved under R. A. No. 166, as amended;
 32. Examiner's action, marked Paper No. 5, bearing mailing date of July 18, 2000;
 33. Manolo P. Samson's response dated September 11, 2000 to the Examiner's action, Paper No. 5 and page 2 thereof;
 34. Examiner's action, marked Paper No. 7, bearing mailing date of March 15, 2001;
 35. Manolo P. Samson's response dated May 7, 2001 to the Examiner's action, Paper No. 7 together with the page 2 thereof;
 36. Letter dated November 27, 2001, submitting the required Declaration of Actual Use together with supporting documents for Application Serial No. 4-1997-123896;
 37. Declaration of Actual Use for Application Serial No. 4-1997-123896 for the trademark CAT. WITH A TRIANGLE DEVICE BENEATH THE LETTER A filed on December 3, 2001, together with cash invoices and labels and the page 2 thereof;
 38. Cash Invoice No. 2708 of Caterpillar Boutique dated October 31, 2001;
 39. Labels bearing the trademark CAT. WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
 40. Duly notarized affidavit of Opposer's counsel and first witness, Florencio Z. Sioson, dated September 12, 2007 and the second page thereof showing the signature of Florencio Z. Sioson;
 41. Duly notarized affidavit of Opposer's Marketing Officer and second witness, Rudy Ong Cortan, dated September 12, 2007 and the second page thereof showing the signature of Rudy Ong Cortan;
 42. 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;
 43. Certification of the registration of the business name Caterpillar Boutique and General Merchandise issued by the Department of Trade and Industry on August 8, 2002 in favor of

Manolo P. Samson;

44. Certificate of Renewal of the registration of the business name Caterpillar Boutique and General Merchandise issued by the Department of Trade and Industry last September 5, 2007;
45. Photographs of Opposer's shoes, sandals, labels and cloth labels, caps, socks, sole bearing the trademark CAT. WITH A TRIANGLE DEVICE BENEATH THE LETTER A in lieu of the actual products;
46. Opposer's coin purse, belt bag, belt, wallet, polo shirt, t-shirt bearing the trademark CAT. WITH A TRIANGLE DEVICE BENEATH THE LETTER A in lieu of the actual products;
47. Various Cash Invoices of Itti Shoes and Caterpillar Boutique evidencing sales of Opposer's various products bearing the trademarks CATERPILLAR and CAT;
48. 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; and
49. 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.

For its part, the Respondent-Applicant presented its witness and offered the following documentary evidence, duly admitted by this Bureau:

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. Retutal 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 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

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

The Opposer and the Respondent-Applicant filed their Memorandum on 08 December 2010 and 13 December 2010, respectively.

Should the Respondent-Applicant be allowed to register the trademark CAT 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.

Thus, to warrant the denial of the trademark application, the above-quoted provision requires the party opposing the same to prove the existence of resemblance between the contending marks, the prior use of the mark in the Philippines and not abandoned and the possibility of confusion or mistake when applied to or used in connection with the goods or services of the prior applicant.

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

The word "CATT'S" in a bold, black, sans-serif font. A white triangle is positioned below the letters "A" and "T", pointing upwards.

The word "CAT." in a bold, black, sans-serif font. A white triangle is positioned below the letters "A" and "T", pointing upwards.

Opposer's Marks

The word "CAT" in a bold, black, sans-serif font. A white triangle is positioned below the letters "A" and "T", pointing upwards.

Respondent-Applicant's Mark

Obviously, the marks are identical and give the same physical impression. The Opposer's applications, however, cover "*shoes, slippers, sandals and boots; shoes slippers, sandals, boots, 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, blouses, suspenders; coin purse, wallet, handbags, overnight bags, travel bags, school bags, attache case, luggages*" under Classes 25 and 18 while the goods indicated in the Respondent-Applicant's trademark application includes "*work, sport and casual clothing namely, caps, belts, ties, scarves, t-shirts, shorts, sweat pants, sweat shirts, wrist bands, jackets, vests, gloves, mittens, rain wear, one-piece jump suit and socks, caps, hats, and garments made to cover and protect the head; shoes, boots, and protective coverings for the feet*" under Class 25. The goods covered by the Opposer's marks on one hand, and those of the Respondent-Applicant's on the other are identical as to class 25. It is however different and unrelated as to class 18 as it is covered by a different class of goods, possessing different physical attributes or essential characteristics, and serving different purposes.

Culled from the evidence presented by the parties, the prior use and registration of the mark CAT pertains to the Respondent-Applicant itself. The Respondent-Applicant was able to present evidence of use which pre-dates the filing of the Opposer's CATT'S WITH A TRIANGLE BENEATH THE LETTER A mark (1994). As proof thereof, the Respondent-Applicant presented a registration in Hong Kong for CAT AND DESIGN⁵ obtained as early as 1988 for goods under Class 25.

On the contrary, Opposer's CATT'S WITH A TRIANGLE BENEATH THE LETTER A mark covered by Application Serial No. 90613 has already been withdrawn by the Opposer in a letter dated 15 April 2008, which caused the dismissal of IPC No. 14-1999-00049 involving the said trademark application. With the voluntary withdrawal by the Opposer of its CATT'S WITH A TRIANGLE BENEATH THE LETTER A mark, he did not acquire superior right over the said trademark. With respect to Opposer's CAT WITH A TRIANGLE mark (Application Serial Nos. 4-1997-12395 and 4-1997-123896), the records would show that at the time the Opposer filed said applications on 22 August 1997, the Respondent-Applicant had already filed a similar mark CAT AND DESIGN on 07 May 1997.

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 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.

In this regard, this Bureau takes judicial notice of its Decision No. 2013-59, promulgated on 10 April 2013, in Inter Partes Case No. 14-2002-00086 which is a dispute on the mark "CAT AND DESIGN (Consists of the Word "CAT" with a Triangle Incorporated Under the Letter "A")", involving the same parties in this instant case. This Bureau finds no cogent reason to deviate from the ruling in the said earlier case.

⁵ Exhibit "8-e" of the Affidavit of Peter L. Calimag.

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).

WHEREFORE, premises considered, the opposition to Trademark Application No. 4-1997-121937 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, 01 October 2013.



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