



SAO PAOLO ALPARGATAS,
Opposer,

-versus-

ALAN S. YU,
Respondent-Applicant.

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} IPC No. 14-2010-00075
} Opposition to:
} Appln. Serial No. 4-2009-001449
} Date filed: 11 February 2009
} TM: "HAVANA JOE & DEVICE"
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}
}
}

NOTICE OF DECISION

VERA LAW
(DEL ROSARIO RABOCA GONZALES GRASPARIL)
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ALAN S. YU
Respondent-Applicant
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106 Kamias Road, Quezon City

GREETINGS:

Please be informed that Decision No. 2013 - 117 dated June 20, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 20, 2013.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



SAO PAULO ALPARGATAS.,
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IPC No. 14-2010-00075
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Decision No. 2013- 117

DECISION

SAO PAULO ALPARGATAS S.A. ("Opposer")¹, filed on 23 March 2010 filed an opposition to Trademark Application Serial No. 4-2009-001449. The application, filed by ALAN S. YU (Respondent-Applicant)², covers the mark "HAVANA JOE AND DEVICE" for use on "clothing namely t-shirts, polo shirts, blouses, dresses, tanks, camisoles, polo, walking shorts, skirts, jeans, jackets, slacks, vest, blazer; underwear namely briefs, bras, panties, tank tops/sandos, socks, brassieres, corsets, body briefs, slips, bra-slips, half-slips, negligees, stockings, garters, corselets, girdles, hip-shaping, garments for clothing purposes, roll-on girdles, lingerie, chemise and panty headwear namely bonnets, visors, headbands and caps; sportswear namely jogging pants, training, shorts, gym shorts, running shorts, board shorts, leggings, tights, aerobics suits, and windbreaker; swimwear namely swimming trunks, swim suits; accessories namely belt, bandanas, gloves and wrist bands; footwear namely rubber shoes, hiking shoes, leather shoes, sandals, slippers and boots" falling under class 25 of the International Classification of goods and services.³

The Opposer alleges among other things, that it is the prior adopter, user and owner of the internationally well-known trademark "HAVIANAS" and its variations which are registered in the Philippines and in various countries around the world. According to the Opposer, because its mark and the Respondent-Applicant's are confusingly similar, the latter's trademark application is proscribed under Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code").

In support of its opposition, the Opposer submitted as evidence a copy of the notarized "Special Power of Attorney" it issued in favor of the law firm *Del Rosario Bagamasbad and Raboca*, the notarized "Verification and Certification against Forum Shopping", copy of the Opposer's Trademark Application Serial No. 4-2009-001449, printouts of some of the web pages of the website www.havaianas.com, printout of the "google search" for the mark "HAVAIANAS", Affidavit direct testimony of Carlos

- 1 A corporation duly organized and existing under and by virtue of the laws of Brazil with principal office at Rua Funchal, 160, Vila Olimpia 04551-903 Sao Paulo, SP.
- 2 With address at Room 201 CRM Building III 106 Kamias Road Quezon City.
- 3 The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

Augusto Rosa, and copy of Trademark Reg. No. 4-2002-010318.

On 13 August 2013, the Respondent-Applicant filed his Verified Answer, in essence arguing that the mark he applied for registration is not confusingly similar to the Opposer's.

The preliminary conference was conducted and terminated on 07 March 2012. The Respondent-Applicant did not attend the preliminary conference, hence, was deemed to have waived the right to file a position paper. Then after, the Opposer filed its position paper on 21 March 2012.

Should the Respondent-Applicant be allowed to register the mark HAVANA JOE AND DEVICE?

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

In this regard, records show that at the time the Respondent-Applicant filed his trademark application, the Opposer already has an existing trademark registration for the mark HAVAIANAS (No. 4-2002-010318). The goods covered by the said registration are similar and/or closely related to those indicated in the Respondent-Applicant's trademark application.

But, are the competing marks, as shown below, identical or closely resemble each other such that confusion or mistake is likely to occur?

havaianas



Opposer's mark

Respondent-Applicant's mark

Jurisprudence says that a practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of the prospective buyer. The trademark complained should be compared and contracted with purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some factors such as sound; color; idea connoted by the mark; the meaning; spelling and pronunciation of the words used; and the setting in which the words appear may

A handwritten signature or set of initials in blue ink, located in the bottom right corner of the page. The signature appears to be 'A.B.' or similar.

be considered for indeed, trademark infringement is a form of unfair competition.⁴ Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanated from the same source or are connected or associated with one another.

The Opposer's mark is a word mark, composed of nine (9) letters or three (3) syllables. This Bureau of course notices that the word HAVANA in the Respondent-Applicant's mark bears resemblance to the Opposer's mark HAVAIANAS. Like the Opposer's, Respondent-Applicant's mark also starts with "HAVA" and contain the syllable "NA". However, there are sufficient features in the Respondent-Applicant's mark that make it easily distinguishable from the Opposer's mark, thus avoiding the likelihood of confusion, much less deception. Unlike the Opposer's mark which is a single word, the Respondent-Applicant's mark is composite consisting of two (2) words – "HAVANA" and "JOE" and a device, i.e. a caricature or profile of a male person wearing a hat. The word "JOE" and the device, which are equally if not more prominent than the word HAVANA, rendered upon the Respondent-Applicant's mark visual and aural properties that are clearly distinct from those of the Opposer's mark. The device immediately draws the eyes. Succinctly, to a consumer, the Respondent-Applicant's mark is not simply HAVANA but HAVANA JOE. The word JOE is inseparable to the word HAVANA such that the mark is likely to be pronounced, or talked about, or be recalled as HAVANA JOE.

It is emphasized that the essence of trademark registration is to give protection to the owner of the 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 manufacture against and sale of an inferior and different article of his products.⁵ This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE, premises considered, the opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2009-001449 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 20 June 2013.


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

⁴ Clarke v. Manila Candy Co. Director of Patents 95 Phil, 1, 4.

⁵ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999.