



OFFICE OF THE DIRECTOR GENERAL

MANOLO P. SAMSON,  
Appellant,

-versus-

CATERPILLAR, INC.,  
Appellee.

X-----X

APPEAL NO. 14-2013-0049  
IPC No. 14-2004-00015  
Opposition to:

Application No. 4-1997-121937  
Date Filed: 24 June 1997  
Trademark: CAT AND DESIGN (CAT  
with a Triangle Incorporate Beneath  
the Letter A)

NOTICE

**SIOSON SIOSON & ASSOCIATES**

Counsel for Appellant  
Unit 903 AIC Burgundy Empire Tower  
ADB Avenue corner Garnet & Sapphire Roads  
Ortigas Center, Pasig City

**QUISUMBING TORRES**

Counsel for Appellee  
12<sup>th</sup> Floor, Net One Center  
26<sup>th</sup> Street corner 3<sup>rd</sup> Avenue  
Crescent Park West Bonifacio Global City  
Taguig City

**NATHANIEL S. AREVALO**

Director, Bureau of Legal Affairs  
Intellectual Property Office  
Taguig City

**GREETINGS:**

Please be informed that on 02 October 2014, the Office of the Director General issued a Decision in this case (copy attached).

Taguig City, 03 October 2014.

Very truly yours,

  
**ROBERT NEREO B. SAMSON**  
Attorney V



**LENY B. RAZ**

Director, Bureau of Trademarks  
Intellectual Property Office  
Taguig City

**IPOPHL LIBRARY**

Documentation, Information  
and Technology Transfer Bureau  
Intellectual Property Office  
Taguig City



**LIBRARY**

DATE: OCT 10 2014

BY: 



OFFICE OF THE DIRECTOR GENERAL

MANOLO P. SAMSON,  
Opposer-Appellant,

-versus-

CATERPILLAR, INC.,  
Respondent-Appellee.

X-----X

Appeal No. 14-2013-0049

IPC No. 14-2004-00015

Opposition to:

Application No. 4-1997-121937

Date Filed: 24 June 1997

Trademark: CAT AND DESIGN

DECISION

MANOLO P. SAMSON (“Appellant”) appeals the decision<sup>1</sup> of the Director of Bureau of Legal Affairs (“Director”) dismissing the Appellant’s opposition to the registration of the mark “CAT AND DESIGN”

On 24 June 1997, CATERPILLAR, INC. (“Appellee”) filed an application to register the mark “CAT AND DESIGN” for use on work, sport, and casual clothing namely, caps, belts, ties, scarves, headwear, t-shirts, shorts, sweat pants, sweat shirts, wrist bands, jackets, vests, gloves, mittens, rain wear, one-piece jump suits and socks, and footwear. The trademark application was published in the Intellectual Property Office Official Gazette<sup>2</sup> on 18 December 2003.

On 09 February 2004, the Appellant filed a “VERIFIED NOTICE OF OPPOSITION” alleging that he will be damaged by the registration of CAT AND DESIGN. The Appellant cited the following grounds:

“1. Respondent-applicant’s trademark CAT AND DESIGN (CAT WITH A TRIANGLE INCORPORATED BENEATH THE LETTER A) is confusingly similar to opposer’s registered trademark CATERPILLAR and opposer’s other trademarks CATT’S WITH A TRIANGLE BENEATH THE LETTER A, and CAT WITH A TRIANGLE BENEATH THE LETTER A.

2. The approval of respondent-applicant’s Application Serial No. 4-1997-121937 violates Section 4(d) of Republic Act No. 166, as amended, the law in force at the time it was filed, examined and approved for publication for opposition.

3. The approval of respondent-applicant’s Application Serial No. 4-1997-121937 also violates Section 123 (d) and (g) of the new Intellectual Property Code of the Philippines.

<sup>1</sup> Decision No. 2013-191 dated 01 October 2013.

<sup>2</sup> Volume VI, Issue No. 11, page 47.

catdesign

4. Opposer will suffer irreparable damage and prejudice if respondent-applicant's Application Serial No. 4-1997-121937 will finally be approved."

The Appellee filed an "ANSWER" dated 10 March 2004 alleging that it has the right to use and register CAT AND DESIGN being the owner by prior adoption and use of this mark and the mark "CATERPILLAR AND DESIGN". The Appellee maintained that it has registered these marks in many countries for various classes of goods while the Appellant's registration of the mark "CATERPILLAR" was obtained fraudulently and contrary to the provisions of the laws on trademark.

After the appropriate proceedings, the Director dismissed the opposition and held that the essence of trademark registration is to give protection to the owners of trademarks. According to the Director, the Appellee satisfied the test of ownership of the mark and has proven the prior use and registration of CAT AND DESIGN.

Not satisfied with the ruling of the Director, the Appellant filed an "APPEAL MEMORANDUM" dated 22 November 2013 contending that the decision of the Director is not supported by the evidence on record and is contrary to the applicable law on trademark and established jurisprudence. The Appellant argues that it is the registered owner and prior user of the mark "CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER "A"" and it was gross error for the Director to disregard completely the registration of this mark issued for use on shoes, sandals, slippers, and boots.

The Appellee filed its "COMMENT ON APPEAL" dated 02 January 2014 citing the Appellee's certificates of registration and pending applications for registration of the marks "CATERPILLAR", "CATERPILLAR AND DESIGN", "CAT", and "CAT AND DESIGN" which the Office may take judicial notice and consider in the determination of the Appellee's preferential right over these marks. The Appellee reiterates its claim of being the prior user and first registrant of the mark CATERPILLAR in the world and in the Philippines and cites the decision of the then Philippine Patent Office sustaining the fame of this mark in favor of the Appellee.<sup>3</sup>

On 14 January 2014, this case was referred to the IPOPHL Alternative Dispute Resolution (ADR) Services pursuant to Office No. 154 Series of 2010, Rules of Procedure for IPO Mediation Proceedings. Subsequently, on 25 February 2014, this Office received a copy of the "MEDIATOR'S REPORT" stating the refusal of the parties to undergo the mediation proceedings.

Going now to the substantive issues raised by the Appellant, this Office noticed that they are similar to those which this Office has resolved in another case between the

---

<sup>3</sup>COMMENT ON APPEAL dated 02 January 2014, page 16, paragraph no. 40 citing the Philippine Patent Office Decision No. 728, 8 August 1973.



parties involving the mark CATERPILLAR. In Appeal No. 14-2013-0014, this Office has ruled that:

"The Appellee has proven that as early as 1938, it has created, used and registered the mark CATERPILLAR. Through the years, it expanded the application of this mark to other products, business, and services and has developed variations of this mark including the subject mark CATERPILLAR & DESIGN. It is, therefore, only just and equitable that the Appellee be allowed registration of a variation of the mark CATERPILLAR.

On the other hand, other than the registration and applications for registration of a mark similar to those of the Appellee, the Appellant failed to explain how it arrived in using the mark CATERPILLAR. Between the Appellee, which has established prior and continuous use of the mark CATERPILLAR in its business operations, and the Appellant who uses CATERPILLAR much later than the Appellee, any doubt should be resolved in favor of the Appellee.

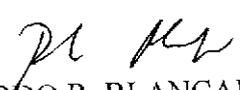
The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services. The registration of the Appellee's mark for CATERPILLAR & DESIGN has been delayed for several years now and it is but only fitting to give to the Appellee the registration of a mark where its ownership and use are clearly established."<sup>4</sup>

Similarly, the Appellee has established its ownership of CAT AND DESIGN which is a variation of the mark CATERPILLAR. Accordingly, the giving of due course to the Appellee's trademark application for CAT AND DESIGN is in accordance to the essence of granting trademark registration which is to give protection to the owner of the mark.

Wherefore, premises considered, the appeal is hereby dismissed. Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Legal Affairs for appropriate action. Further, let also the Director of the Bureau of Trademarks and the library of the Documentation, Information and Technology Transfer Bureau be furnished a copy of this decision for information, guidance, and records purposes.

SO ORDERED.

02 OCT 2014 Taguig City

  
RICARDO R. BLANCAFLOR  
Director General

<sup>4</sup> DECISION, 07 February 2014.