



VANS, INC.,
Opposer,

-versus-

VANDA PAPER PRODUCT ENT. CORP.,
Respondent - Applicant.

}
} IPC No. 14-2012-00544
} Opposition to:
} Appln. Serial No. 4-2012-009382
} (Filing Date: 31 July 2012)
} TM: "VANDA (Stylized)"
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NOTICE OF DECISION

BETITA CABILAO CASUELA SARMIENTO
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For Respondent-Applicant
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864 Alvarado Street, Binondo
Manila

GREETINGS:

Please be informed that Decision No. 2014 - 270 dated October 28, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 28, 2014.

For the Director:

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



VANS, INC.,

Opposer,

- versus -

IPC No. 14-2012-00544

Opposition to:

Appln. Serial No. 4-2012-009382

(Filing Date: 31 July 2012)

TM: "VANDA (STYLIZED)"

VANDA PAPER PRODUCT ENT.
CORPORATION,

Respondent-Applicant.

x-----x

Decision No. 2014- 270

DECISION

VANS, INC. ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2012-009382. The application, filed by VANDA PAPER PRODUCT ENT. CORPORATION ("Respondent-Applicant")², covers the mark "VANDA (STYLIZED)" for use on "team books, mathematics notebooks, bond papers, bio-data, class record, school register, graphic papers, spiral notebooks" under Class 16 of the International Classification of goods and services³

The Opposer alleges that the Respondent-Applicant's trademark application is contrary to Sec. 123.1, paragraphs (d), (e) and (f), of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). According to the Opposer, the mark VANDA (STYLIZED) is confusingly to its "VANS" marks. In support of its opposition, the Opposer submitted in evidence the following:

1. Exhibit "A" - original notarized and legalized Verified Notice of Opposition;
2. Exhibit "B" - original notarized and legalized Affidavit of Jennifer L. Dirks, the Legal Manager, Intellectual Properties of Opposer;
3. Exhibit "B-1" - representative samples of materials used in the promotion of the VANS MARKS;
4. Exhibit "B-2" - table showing the details of the applications and/or registrations for the VANS MARKS worldwide;
5. Exhibit "B-3" - representative samples of certified copies of the trademark registrations for the VANS MARKS from Australia, Canada, France, Hong Kong, Japan, United Kingdom and United States of America;

¹ A company duly organized and existing under the laws of Delaware, United States of America, with offices located at 6550 Katella Avenue Cypress, California 90630, United States of America.

² With address at 202 Gov. Pascual Avenue Catmon, Malabon, Metro Manila, Philippines.

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.

6. Exhibit "C" - original notarized Affidavit of Wendell Cunanan, the Chief Executive Officer of Venice 66 Fashions, Inc., exclusive importer and distributor of the products of Opposer;
7. Exhibit "C-1" - table of all stores in the Philippines where products bearing the VANS MARKS are sold;
8. Exhibit "C-2" - photographs and/or samples of the materials used in the marketing and promotion of VANS MARKS;
9. Exhibit "D" - computer printout of the trademark details report for VANS under Reg. No. 4-1990-071139 downloaded from the Intellectual Property Office of the Philippines ("IPOP HL") website;
10. Exhibit "E" - computer printout of the trademark details report for VANS under Reg. No. 4-2001-001708 downloaded from the IPOP HL website;
11. Exhibit "F" - computer printout of the trademark details report for VANS under Reg. No. 4-2006-003559 downloaded from the IPOP HL website;
12. Exhibit "G" - computer printout of the trademark details report for VANS under Reg. No. 4-2011-015275 downloaded from the IPOP HL website;
13. Exhibit "H" - computer printout of the trademark details report for VANS under Reg. No. 4-1989-067644 downloaded from the IPOP HL website;
14. Exhibit "I" - computer printout of the trademark details report for VANS under Reg. No. 4-1990-073024 downloaded from the IPOP HL website;
15. Exhibit "J" - computer printout of the trademark details report for VANS FLYING V LOGO under Reg. No. 4-2011-015276 downloaded from the IPOP HL website;
16. Exhibit "K" - computer printout of the trademark details report for VANS under Reg. No. 4-1999-004914 downloaded from the IPOP HL website;
17. Exhibit "L" - computer printout of the trademark details report for FLYING V LOGO under Reg. No. 4-2011-015285 downloaded from the IPOP HL website;
18. Exhibit "M" - Computer printout of the trademark details report for V IN A CIRCLE LOGO under Reg. No. 4-2011-015287 downloaded from the IPOP HL website;
19. Exhibit "N" - computer printout of the trademark details report for VANS OFF THE WALL SKATEBOARD LOGO under Reg. No. 4-2011-015290 downloaded from the IPOP HL website; and
20. Exhibit "O" - Original notarized and legalized Officer's Certificate and Power of Attorney signed by David Lin, the Vice President and Chief Financial Officer of the Opposer, with attached By-Laws, regarding the authority of the Opposer's counsel.

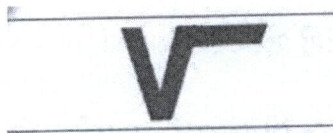
This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 27 January 2014. However, the Respondent-Applicant did not file the required Verified Answer, hence, Order No. 2014-435 dated 3 April 2014 was issued declaring the Respondent-Applicant in default.

Should the Respondent-Applicant's trademark application be allowed?

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 manufacturer against substitution and sale of an inferior and different article as his products.⁴

In this regard, the mark applied for registration by the Respondent-Applicant bears close resemblance to the Opposer's registered marks, to wit:

The logo for VANS, featuring the word "VANS" in a bold, black, sans-serif font with a horizontal line above the letters.The logo for VANDA, featuring the word "VANDA" in a stylized, outlined font with a horizontal line above the letters and a decorative flourish below the "A".A stylized, bold letter "V" with a horizontal line above it and another horizontal line below it, representing the "flying V" logo.

Opposer's marks

Respondent's mark

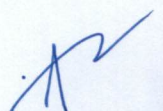
The mark applied for registration by the Respondent-Applicant includes the first three letters -"VAN"- in the Opposer's mark VANS. The Respondent-Applicant also adopted the stylized "V" or "flying V" in the Opposer's mark.

Records show that at the time the Respondent-Applicant filed its trademark application on 31 July 2012, the Opposer already has existing registrations in the Philippines for the mark VANS and/or FLYING V LOGO, under registration numbers 4-1990-071139, 4-2001-001708, 4-2006-003559, No. 4-2011-015275, 4-1989-067644, 4-1990-073024, 4-2011-015276, No. 4-1999-004914, 4-2011-015285, and 4-2011-015287, covering various goods and services under classes 9, 14, 18, 25, 28, 35 and 41.

In this regard, the goods indicated in the Respondent-Applicant's application are "team books, mathematics notebooks, bond papers, bio-data, class record, school register, graphic papers, spiral notebooks" under Class 16. This Bureau finds that three of the Opposer's trademark registrations for VANS and/or FLYING V LOGO cover goods or services that are related to those indicated in the Respondent-Applicant's trademark application, as follows:

1. Nos. 4-2011-015275 and 4-2011-015276: education, providing of training; entertainment; sporting and cultural events and activities (class 41);
2. No. 4-2011-015285: advertising business management; business administration, office functions (class 35); and

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114509, 19 Nov. 1999.

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3. No. 4-2001-001708: retail store services (class 35).

"Team books, mathematics notebooks, bond papers, bio-data, class record, school register, graphic papers, spiral notebooks" are school and office materials or articles. Retail stores carry these goods. Also, these goods are used in providing education and training services, in advertising, and in office functions. Thus, because of the similarities between the subject marks highlighted by the styling and adoption of the V and a flying V, the likelihood of confusion arises. It is emphasized that confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenious imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other⁵ because the competing marks are confusing similar, consumers may also likely assume, that the Respondent-Applicant's mark is just a variation of or related to the Opposer's and/or the goods or services originate or provided by one party alone or the parties themselves are connected or associated with one another while in fact there is none. The likelihood of confusion would subsist not only on the purchaser's perception of the goods but on the origins thereof as held by the Supreme Court.⁶

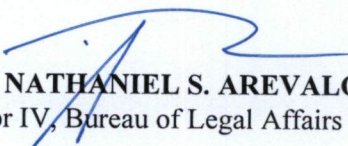
The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why of the millions of terms and combination of letters are available, the Respondent-Applicant had come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁷

According, this Bureau finds that the subject Trademark Application is proscribed by Sec. 123.1(d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filer of Trademark Application Serial No. 4-2012-009382, together with a copy of this Decision be returned to the Bureau of Trademark (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 28 October 2014.


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

⁵ *Societes Des Produits Nestle, S.A. v. Court of Appeals*, G.R. No. 112012, 4 Apr. 2001.

⁶ *Converse Rubber Corp. v. Universal Rubber Products, Inc. et.al.* G.R. No. L-27906, 08 Jan. 1987.

⁷ *American Wire and Cable Co. v. Director of Patents et. al.*, G.R. No. L-26557, 18 Feb. 1970.