



**BATA BRANDS S.a.r.l.,**  
Opposer,

**-versus-**

**HARTZELL CALIBJO-PRADO,**  
Respondent-Applicant.

} **IPC No. 14-2014-00018**  
} Opposition to:  
} Appln. Serial No. 4-2013-0011891  
} Date Filed: 02 October 2013  
} **TM: "BATA IKI"**  
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### NOTICE OF DECISION

#### **A.Q. ANCHETA & PARTNERS**

Counsel for the Opposer  
10<sup>th</sup> Floor, Suites 1008-1009 Paragon Plaza Bldg.  
EDSA corner Reliance Street  
Mandaluyong City

#### **HARTZELL CALIBJO-PRADO**


Respondent-Applicant  
31-D Mayaman Street  
U. P. Village, Quezon City

#### **GREETINGS:**

Please be informed that Decision No. 2015 - 124 dated June 29, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 29, 2015.

For the Director:

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



**BATA BRANDS S.à.r.l.,**

Opposer,

-versus-

**HARTZELL CALIBJO-PRADO**

Respondent-Applicant.

IPC No. 14-2014-00018

Opposition to Trademark

Application No. 4-2013-0011891

Date Filed: 02 October 2013

Trademark: "**BATA IKI**"

x ----- x Decision No. 2015- 124

### DECISION

Bata Brands S.à.r.l.<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-0011891. The contested application, filed by Hartzell Calibjo-Prado<sup>2</sup> ("Respondent-Applicant"), covers the mark "BATA IKI" for use on "*clothing, footwear, headgear*" under Class 25 of the International Classification of Goods<sup>3</sup>.

The Opposer alleges that the dominant feature of the mark "BATA IKI" is confusingly similar to its own "BATA" trademarks registered and applied in several countries. The Respondent-Applicant's application covers goods similar and/or closely related to the Opposer's. The Opposer also avers that the word "BATA" forms part of its tradename. According to the Opposer, the Respondent-Applicant is in bad faith for there can be no explanation for the Respondent-Applicant's adoption of the word "BATA".

In support of its Opposition, the Opposer submitted the following as evidence:<sup>4</sup>

1. list of countries where the Opposer's mark "BATA" is registered;
2. copies of Application No. 4-2003-003510 and Certificate of Registration No. 4-2013-502129; and
3. affidavit of Leslie Tenenbaum.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 31 March 2014. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued on 10 February 2015

<sup>1</sup> A corporation organized and existing under the laws of California, USA, with business address at 9660 Chesapeake Drive, San Diego, California, USA.

<sup>2</sup> With address at 1B 12-14, New Galleria, Baclaran Mall, Taft Avenue Extension, Pasay City.

<sup>3</sup> 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.

<sup>4</sup> Marked as Exhibits "B" to "E".

Republic of the Philippines

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Order No. 2015-256 declaring the Respondent-Applicant in default and the case submitted for decision.

The issue to be resolved in this case is whether the Respondent-Applicant's trademark application should be allowed.

Section 123.1 paragraphs (d) and (e) of the IP Code provide that:

**"123.1. A mark cannot be registered if it:**

**(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:**

**(i) The same goods or services, or**

**(ii) Closely related goods or services, or**

**(iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;**

**(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;**

**xxx."**

Records reveal that at the time Respondent-Applicant filed for an application of registration of its mark "BATA IKI" on 02 October 2013, the Opposer has an existing and valid registration of its trademark "BATA" under Registration No. 4-2003-003510 issued on 21 January 2006 for "*clothing namely: sweaters, jackets, skirts and accessories namely: scarves, belts, gloves*" and "*retail store services*". Also, the Opposer filed on 05 August 2013 trademark application for the mark "BATA (Stylized)" for "*footwear, namely, men's and women's shoes, children's shoes, rubber shoes and casual rubber shoes, all in Class 25*".

The Opposer marks and the mark applied for registration by the Respondent-Applicant are depicted below for comparison:

*Opposer's marks:*

# Bata

# Bata

*Respondent-Applicant's Mark:*



The Respondent-Applicant appropriated the word "BATA" and merely added a second word "IKI" and a picture of a pig-like figure in baby diapers. These notwithstanding, the likelihood of confusion subsists. The word "BATA" in the Respondent-Applicant's mark immediately attracts the eyes. When referring to the Respondent-Applicant's mark orally, the sound of "BATA" rings to the ears. 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 ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchased as to cause him to purchase the one supposing it to be the other.<sup>5</sup> In **Del Monte Corporation vs. Court of Appeals**<sup>6</sup>, the Supreme Court held thus:

<sup>5</sup> Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

<sup>6</sup> G.R. No. L-78325, 25 January 1990.

***"The question is not whether the two articles are distinguishable by their label when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods is the touchstone."***

Succinctly, since the Respondent-Applicant will use or uses the mark "BATA IKI" on goods that are similar and/or closely related to that of Opposer's registered mark "BATA", the addition of the word "IKI" and the figure that comes with the applied mark will not diminish the likelihood of the occurrence of confusion, mistake and/or deception. It is highly probable that the purchasers will be led to believe that Respondent-Applicant's mark is a mere variation of Opposer's mark. Withal, the protection of trademarks as intellectual property is intended not only to preserve the goodwill and reputation of the business established on the goods bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods.<sup>7</sup>

Moreover, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. Callman notes two types of confusion. The first is the *confusion of goods* "in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other." In which case, "defendant's goods are then bought as the plaintiff's, and the poorer quality of the former reflects adversely on the plaintiff's reputation." The other is the *confusion of business*: "Here though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff, and the public would then be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."<sup>8</sup>

Finally, 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.<sup>9</sup> Based on the above discussion, Respondent-Applicant's trademark fell short in meeting this function. The latter was given ample opportunity to defend its trademark application but Respondent-Applicant did not bother to do so.

<sup>7</sup> Skechers, USA, Inc. vs. Inter Pacific Industrial Trading Corp., G.R. No. 164321, 23 March 2011.

<sup>8</sup> Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

<sup>9</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-0011891 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 29 June 2015.

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