

**CO YEE LOCK and ROBIN K. CHAN,**  
Opposer,

**-versus-**

**HAWK DESIGN, INC.,**  
Respondent-Applicant.

X-----X

**IPC No. 14-2009-00259**  
Opposition to:  
Appln. Serial No. 4-2007-006692  
Date Filed: 27 June 2007  
**TM: "A REPRESENTATION OF  
A HEAD OF A BIRD OF PREY"**

**NOTICE OF DECISION**

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**GREETINGS:**

Please be informed that Decision No. 2016 - 23 dated January 11, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 11, 2016.

For the Director:

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

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Trademark: "A REPRESENTATION OF"  
A HEAD OF A BIRD OF PREY"

Decision No. 2016- 23

## DECISION

CO YEE LOCK and ROBIN K. CHAN ("Opposers")<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2007-006692. The application, filed by HAWK DESIGNS, INC. ("Respondent-Applicant")<sup>2</sup>, covers the mark "A REPRESENTATION OF A HEAD OF A BIRD OF PREY" for use on "*luggage, backpacks, wallets, fanny packs, travel bags, tote bags, duffel bags, and athletic bags*" and "*clothing and headwear, namely, shirts, t-shirts, sweatshirts, sweatpants, tanks tops, shorts, pants, jackets, sweaters, socks, belts, gloves, thermal t-shirts, hats, caps, visors, and snow hats*" falling under Classes 18 and 25 of the International Classification of Goods and Services<sup>3</sup>, respectively.

The Opposers allege that they are the prior user and lawful owners of the marks "HAWK" and "LADY HAWK & DESIGN". According to the Opposers:

"1. Opposers are the prior , true and lawful owners of the trademarks 'HAWK' and 'LADY HAWK & DESIGN' for use on shoes.

"1.1. Rosa Kaw adopted and strated using the marks HAWK and LADY HAWK & DESIGN on shoes on December 13, 1985.

"On May 28, 1987, Rosa Kaw filed Application Serial No. 61776 for the registration of the mark HAWK for use on shoes falling under Class 25.

"On November 3, 1989, Rosa Kaw was issued Certificate of Registration No. 46817 for the mark HAWK;

"1.2. On July 27, 1988, Rosa Kaw filed Application Serial No. 65330 for the registration of the mark LADY HAWK & DESIGN for use on shoes falling under Class 25.

<sup>1</sup> Filipino citizens with business and postal address at M-1 Las Buenas Building, No. 37 Industrial Avenue, Potrero, Malabon City.

<sup>2</sup> A foreign corporation with address at 15202 Graham Street, Huntington Beach, CA 92649, U.S.A.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty 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 for Registration of Marks concluded in 1957.

"On October 1, 1990, Rosa Kaw was issued Certificate of Registration No. 49237 for the mark LADY HAWK & DESIGN;

"1.3. Opposers, together with Rosa Kaw, are the majority stockholders of Sportrend Mfg. Corp., a corporation duly organized under the laws of the Philippines and existing since its incorporation.

"1.4. Relying simply on what appears in the face of both Exhibits 'A' and 'B', Rosa Kaw assumed that her arks were registered for a term of 20 years. Rosa Kaw did not file any affidavit of use for her registrations, although through Sportrend Mfg. Corp., her registered marks HAWK and LADY HAWK & DESIGN have been continuously used without any interruption and without any intention of abandoning them.

"1.5. On August 12, 2008, ROSA KAW filed Application Serial No. 4-2008-009722, by way of re-application of her Registration No. 46817 which was ordered cancelled for non-filing of an affidavit of use following its 5th anniversary.

"Application Serial No. 4-2008-009722 was approved by the Bureau of Trademarks and published for opposition in the e-Gazette of this Office released for circulation last November 7, 2008. Earlier, on September 15, 2008, Rosa Kaw assigned said application in favor of Opposers.

"Last September 3, 2009, Opposers, as beneficial owners and with the tacit approval of Rosa Kaw, filed Application Serial No. 4-2009-008818 for the registration of the mark LADY HAWK & DEVICE.

"1.6. There was no abandonment of the marks HAWK and LADY HAWK & DESIGN as the use thereof continues up to the present;

x x x

"1.7. Beginning 2003, Opposers, through their new corporate vehicle, Shoexpress, Inc. have continued using the marks HAWK and LADY HAWK & DESIGN for footwear.

"1.8. The exclusive right of Opposers to the marks HAWK and LADY HAWK & DESIGN has been preserved by express provisions of Section 236 of the IP Code.

"2. Opposers have better and superior right to the marks HAWK and LADY HAWK & DESIGN.

"2.1. Respondent-Applicant's mark 'A REPRESENTATION OF A HEAD OF A BIRD PREY' is confusingly similar to Opposer's marks HAWK and LADY HAWK & DESIGN.

"2.2. As early as December 13, 1985, that is fourteen (14) years before Respondent-Applicant allegedly adopted and started using in 1999 the mark TONY HAWK for clothing falling under Class 25, and the mark A REPRESENTATION OF A HEAD OF A BIRD OF PREY in 2000, Rosa Kaw, assignor to Opposers, had adopted and later, together with Opposers and through their corporate vehicle, Sportrend Mfg. Corp., continued using the marks HAWK and LADY HAWK & DESIGN on shoes. Such commercial use continues up to the present.

"2.3. Through actual and continuous commercial use since December 13, 1985, Opposers have acquired ownership of the marks HAWK and LADY HAWK & DESIGN for use on shoes pursuant to Section 2-A of Republic Act No. 166, as amended.

"2.4. Opposer's right of ownership of the marks HAWK and LADY HAWK & DESIGN, including the right to register said mark, has been preserved by express provisions of Section 236 of the IP Code.

"2.5. Respondent-Applicant's claim that it first used its mark 'A REPRESENTATION OF A HEAD OF A BIRD OF PREY' on November 11, 2000, is still fifteen (15) years after the date of first use on December 13, 1985 of the marks HAWK and LADY HAWK & DESIGN by Opposer's assignor, Rosa Gaw.

"By December 13, 1985, when Opposer's assignor adopted and started using the marks HAWK and LADY HAWK DESIGN, Respondent-Applicant was not yet existing, much less using its mark 'A REPRESENTATION OF A HEAD OF A BIRD OF PREY'.

"3. The use and registration by Respondent-Applicant of the trademark 'A REPRESENTATION OF A HEAD OF A BIRD OF PREY' will likely cause confusion, mistake, and deception, as the consuming public will likely think that Respondent-Applicant' goods come from, and/or authorized and licensed by, Opposers.

"4. The approval of the application in question has caused and will continue to cause great and irreparable damage and injury to Opposers and as such, Respondent-Applicant is clearly not entitled to the registration of the mark 'A REPRESENTATION OF A HEAD OF A BIRD OF PREY'."

To support its opposition, the Opposers submitted the following as evidence:

1. Exhibit "A" - certified copy of Certificate of Reg. No. 46817 for the mark "HAWK" issued on 03 November 1989 in favor of Rosa Kaw;
2. Exhibit "B" - certified copy of the Certificate of Reg. No. 49237 for the mark "LADY HAWK & DESIGN";
3. Exhibit "C" - certified copy of the Certificate of Incorporation, together with the Articles of Incorporation of Sportrend Mfg. Corp.;
4. Exhibit "D" - certified copy of the Deed of Assignment executed by Rosa Kaw in favor of the Opposers;
5. Exhibit "E" to "E-13" - certified copies of the Acknowledgment of Filing; Trademark Application Form; Registrability Report; Response dated 13 October 2008; Drawing; and Notice of Allowance, as well as a printout of the e-Gazette;
6. Exhibit "F" - duplicate original of Application Serial No. 4-2009-008818 for the registration of the mark "LADY HAWK DEVICE";
7. Exhibit "G" to "G-8" - original and/or certified copies of the Mayor's Permits issued to Sportrend Mfg. Corp. indicating sale of products bearing the marks HAWK and LADY HAWK & DESIGN;
8. Exhibit "H" to "H-7" - original and/or certified copies of representative Sales Invoices of Sportrend Mfg. Corp. indicating sale of products bearing the marks HAWK and LADY HAWK & DESIGN;
9. Exhibits "I" to "I-12" - original and/or certified copies of Price Lists of Sportrend Mfg. Corp. for its HAWK and LADY HAWK & DESIGN products;
10. Exhibits "J" to "J-13" - original and/or certified copies of representative samples of advertising and promotional materials of products bearing the marks HAWK and LADY HAWK & DESIGN;
11. Exhibits "K" to "K-30" - original and/or certified copies of various Print Budget Appropriations, Broadcast Telecast Orders and Contracts for HAWK and LADY HAWK & DESIGN products for the years 1991-1995;

12. Exhibit "L" - certified true copy of the Certificate of Incorporation and Articles of Incorporation of Shoexpress, Inc.;
13. Exhibits "M" and "M-1" - certification issued by the Government of Malabon City re the issuance to Shoexpress, Inc. of Mayor's Permits from 2001 to the present, and the Certification issued by the Office of the Barangay Captain of Potrero, Malabon City;
14. Exhibits "N" to "N-12" - original and/or certified copies of representative Sales Invoices of Shoexpress, Inc. indicating sale of products bearing the marks HAWK and LADY HAWK & DESIGN;
15. Exhibit "O" - Affidavit of Rosa Kaw;
16. Exhibit "P" - Affidavit of Co Yee Lock and Robin K. Chan;
17. Exhibit "Q" - printout of Application Serial No. 4-2007-006691 for the mark TONY HAWK showing that it has been abandoned with finality;
18. Exhibit "R" - Withdrawal of Application Serial No. 4-2008-012851 for the mark HAWKSTOCK AND DEVICE;
19. Exhibit "R-1" - Withdrawal of Authority to Represent in relation to IPC No. 14-2009-00117;
20. Exhibit "R-2" - Manifestation dated 23 November 2009 in relation to IPC No. 14-2009-00117; and
21. Exhibit "R-3" - Notice of Decision in relation to IPC No. 14-2009-00117 received by certain Basilisa V. Te on 24 November 2009.

The Respondent-Applicant filed its Answer on 08 April 2010 alleging that the competing marks are not confusingly similar. According to the Respondent-Applicant, it is the party who has better right to the HAWK mark and that its application was filed ahead. Hawk is a protected well-known name and that there is now a ruling that the mark "A REPRESENTATION OF A BIRD OF PREY" is owned by the Respondent-Applicant.

The Respondent-Applicant's evidence consist of the following:

1. Exhibit "1" - legalized Special Power of Attorney executed by the Respondent-Applicant;
2. Exhibit "2" - Affidavit of Atty. Amando S. Aumento, Jr.;
3. Exhibit "3" - certified copy of Compliance in relation to IPC No. 14-2009-00072;
4. Exhibit "4" - certified copy of the Verified Opposition in relation to IPC No. 14-2009-00072;
5. Exhibit "5" - certified copy of the legalized Affidavit of Sean Pence;
6. Exhibits "6" and sub-markings - certified copies of trademark registrations for the marks "HAWK HEAD DEVICE" and "TONY HAWK" in the United States of America, China, Hong Kong, India, Indonesia, South Korea, Mauritius, New Zealand, Singapore, and South Africa;
7. Exhibit "7" - copy of the database list of all trademark and service mark registrations and applications for the mark "TONY HAWK";
8. Exhibit "8" - certified copy of a poster for the "HAWK European Tour" in 2007;
9. Exhibit "9" - certified copy of the Affidavit of Amando S. Aumento, Jr. in IPC No. 14-2009-00072;

10. Exhibit "10" and sub-markings - printouts of webpages <http://www.quiksilver.com>, <http://www.tonyhawk.com>, and <http://www.hawk-city.com>;
11. Exhibit "11" and sub-markings - certified copies of Trademark Application Serial No. 4-2007-006691 for "TONY HAWK" covering goods in Class 25 and Trademark Application Serial No. 4-2007-006692 for "HAWK HEAD & DEVICE";
12. Exhibit "12" and sub-markings - printout of webpages where products bearing the marks "TONY HAWK" and/or "HAWK HEAD DEVICE" appear;
13. Exhibit "13" - printouts of relevant internet websites where the sports figure Tony Hawk is featured; and
14. Exhibit "14" - printouts of the Google page showing the search results for the keywords "TONY HAWK" and "HAWK CLOTHING".

The Opposers filed a Reply on 04 September 2009. After the termination of the preliminary conference, the parties filed their respective position papers.

The issue as to who, between the parties, has the better right over the mark "HAWK", has already been resolved in Inter Partes Case No. 14-2009-00072. This Bureau held in favor of the herein Opposers :

"A review of the Respondent's evidence would show that Rosa Kaw filed its application for registration of the mark HAWK way back on May 28, 1987 and November 3, 1989, the said trademark was registered in her favor under Certificate of Registration No. 46817. For the LADY HAWK & DESIGN mark, she filed an application for registration on 27 July 1988 and the mark was registered on October 1, 1990 under Certificate of Registration No. 49237. Both marks were registered while the old Trademark Law was still in effect. Considering therefore that the acquisition of ownership over the mark HAWK and LADY HAWK & DESIGN was pursuant to the old, which was based on actual use in commerce, following the rule on preservation of rights under Section 236 of the IP Code, Respondents have a better right over the subject mark since the trademark right acquired by Rosa Kaw was passed to them upon assignment."

The decision was appealed to the Director General<sup>4</sup>. In his Decision promulgated on 24 August 2012, the Director General dismissed the appeal.

However, the mark that is the subject of this opposition is not the mark "HAWK" but "A REPRESENTATION OF A HEAD OF A BIRD OF PREY". In the above-cited decision rendered by the Director General, the issue of whether the Respondent-Applicant's mark of "A REPRESENTATION OF A HEAD OF A BIRD OF PREY" is confusingly similar to the Opposers' marks HAWK and LADY HAWK & DESIGN, was resolved, to wit:

"Moreover, the Appellant cannot rely on its earlier trademark application for HAWK HEAD DEVICE to support its appeal seeking the rejection of the Appellees' application to register HAWK. A check on the details of the Appellant's trademark application shows that the title of the mark is 'A Representation of a Head of a Bird of Prey' which may not necessarily refer to a 'hawk'. Furthermore, the Appellant is applying HAWK HEAD DEVICE for goods that are different from footwear namely: shoes, boots, sandals, and slippers that are covered by the Appellees' trademark application. Nonetheless, the Appellees are registering the word mark 'HAWK' and in the absence of the Appellant's trademark application for TONY HAWK, the

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<sup>4</sup> Appeal No. 14-2010-0024.

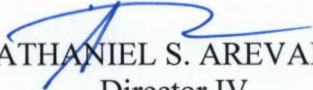
Appellant's adoption of the HAWK HEAD DEVICE cannot on its own bar the registration of HAWK."

In effect, the Director General ruled that the competing marks are not confusingly similar.

WHEREFORE, premises considered, the instant opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2007-006692 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 11 January 2016.

  
NATHANIEL S. AREVALO  
Director IV  
Bureau of Legal Affairs