

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

**-versus-**

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

X-----X

} **IPC No. 14-2010-00232**  
}  
} Opposition to:  
} Appln. Serial No. 4-2010-001880  
} Date filed: 19 February 2010  
} **TM: "TONY HAWK"**

### NOTICE OF DECISION

#### **SIOSON SIOSON & ASSOCIATES**

Counsel for the Opposers  
Unit 903 AIC-BURGUNDY EMPIRE Tower  
ADB Avenue corner Garnet & Sapphire Roads  
Ortigas Center, Pasig City

#### **FEDERIS & ASSOCIATES LAW OFFICES**

Counsel for Respondent-Applicant  
Suite 2004 & 2005 , 88 Corporate Center  
141 Valero cor. Sedeno Streets, Salcedo Village  
Makati City

#### **GREETINGS:**

Please be informed that Decision No. 2016 - 10 dated January 11, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 11, 2016.

For the Director:

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



CO YEE LOCK and  
ROBIN K. CHAN,  
Opposers,

IPC NO. 14-2010-00232  
Opposition to:

- versus -

Appln. Serial No. 4-2010-001880  
(Filing Date: 19 February 2010)  
Trademark: "TONY HAWK"

HAWK DESIGN, INC.,  
Respondent-Applicant.

x-----x

Decision No. 2016- 10

### DECISION

CO YEE LOCK and ROBIN K. CHAN ("Opposers")<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2010-001880. The application, filed by HAWK DESIGNS, INC. ("Respondent-Applicant")<sup>2</sup>, covers the mark "TONY HAWK" for use on "*backpacks, duffle bags, and wallets*" falling under Class 18, and "*apparel namely belts, coats, jackets, jerseys, pants, rainwear, shirts, shorts, sweat pants, sweat shirts, sweaters, t-shirts, tank tops, wind resistant jackets; headgear namely, hats, caps, bonnets, head bands, sun visors*" falling under Class 25<sup>3</sup>.

The Opposers allege that in Inter Partes Case No. 14-2009-00072<sup>4</sup>, the Respondent-Applicant claimed under oath that the Opposers' mark "HAWK" is identical with or confusingly similar to the mark "TONY HAWK" and can no longer be registered in the name of the Opposers under Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). According to the Opposers, the Respondent-Applicant is now *estopped* from claiming otherwise. The Opposers argue that the Respondent-Applicant is not entitled to the registration of the mark "TONY HAWK", the Opposers being the prior users and therefore, the lawful owners of the trademark "HAWK" and "LADY HAWK & DESIGN". Furthermore, the Opposers will be damaged by the registration of the mark "TONY HAWK" in favor of the Respondent-Applicant.

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

1. Exhibit "A" - duplicate original of Alias Notice to Answer, together with the Verified Notice of Opposition in IPC No. 14-2009-00072;
2. Exhibits "B" and "C" - copies of the Respondent-Applicant's Exhibit "H" (certified true copy of Application Serial No. 4-2007-006691 for "TONY HAWK") and Exhibit "H-1" (certified true copy of Application Serial No. 4-2007-006692 for "REPRESENTATION

<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.  
<sup>4</sup> An opposition proceeding initiated by the herein Respondent-Applicant against herein Opposer's Trademark Application Serial No. 4-2008-009722 covering the mark "HAWK".

OF A HEAD OF A BIRD OF PREY") attached by the Respondent-Applicant to its Notice of Opposition in IPC No. 14-2009-00072;

3. Exhibit "D" - duplicate original copy of Decision No. 2009-194 issued by the Director of Bureau of Legal Affairs promulgated on 04 December 2009 in IPC No. 14-2009-00072;

4. Exhibit "E" - printout of Respondent-Applicant's Application Serial No. 4-2010-001880 filed on 19 February 2010 for the registration of the mark "TONY HAWK";

5. Exhibit "F" - printout of the Opposers' Application Serial No. 4-2008-009722 for the registration of the mark "HAWK" as published in the "e-Gazette";

6. Exhibit "G" - copy of Certificate of Reg. No. 4-2009-008818 issued in favor of the Opposers on 25 March 2010 for the mark "LADY HAWK & DESIGN";

7. Exhibit "H" - duly notarized Joint Affidavit of Co Yee Lock and Robin K. Chan;

8. Exhibit "I" to "I-3"<sup>5</sup> - copies of the Opposers' letter dated 20 November 2009, Withdrawal of Authority to Represent dated 23 November 2009, Manifestation filed on 23 November 2009, and Notice of Decision mailed to the Opposers on 24 November 2009; and

9. Exhibit "J"<sup>6</sup> - printout of Application Serial No. 4-2007-00691 for "TONY HAWK".

The Respondent-Applicant filed its Answer on 18 February 2011 alleging that the case cited by the Opposers as their basis for the instant opposition is still pending appeal. According to the Respondent-Applicant, the claim of the Opposers that they have trademark rights over the mark "HAWK" is bereft of merit. The Respondent-Applicant claims that it has shown that it is the party with the better right to the "HAWK" mark, and that it filed an earlier application for the registration of the mark "TONY HAWK".

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

1. Exhibit "1" - legalized Affidavit of Charles S. Exon;

2. Exhibit "2" - Affidavit of Amando S. Aumento, Jr.;

3. Exhibit "3" - legalized Special Power of Attorney executed by the Respondent-Applicant;

4. Exhibit "4" - certified copy of the legalized Affidavit of Sean Pence;

5. Exhibits "5" to "16" - 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;

6. Exhibit "17" - copy of the database list of all trademark and service mark registrations and applications for the mark "TONY HAWK";

7. Exhibit "18" - certified copy of a poster for the "HAWK European Tour" in 2007;

8. Exhibit "19" - certified copy of the Affidavit of Amando S. Aumento, Jr. in IPC No. 14-2009-00072;

9. Exhibit "20" - certified copy of the legalized Special Power of Attorney executed by the Respondent-Applicant in relation to IPC No. 14-2009-00072;

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<sup>5</sup> Exhibits "I" to "I-3" attached to Opposer's Reply.

<sup>6</sup> Exhibits "J" attached to Opposer's Reply.

10. Exhibit "21" to "21-B" - printouts of webpages <http://www.quiksilver.com>, <http://www.tonyhawk.com>, and <http://www.hawk-city.com>;
11. Exhibit "22" to "22-A" - 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 "23" to "23-Z" - printout of webpages where products bearing the marks "TONY HAWK" and/or "HAWK HEAD DEVICE" appear;
13. Exhibit "24" to "24-S" - printouts of relevant internet websites where the sports figure Tony Hawk is featured;
14. Exhibits "25" to "25-A" - printouts of the Google page showing the search results for the keywords "TONY HAWK" and "HAWK CLOTHING"; and
15. Exhibits "26" to "26-ZZ" - certified copies of trademark registration of TONY HAWK issued in Argentina, Australia, Canada, Chile, China, OHIM, Costa Rica, Czech Republic, El Salvador, Hong Kong, Hungary, India, Indonesia, Israel, Japan, Korea, Mauritius, Mexico, New Zealand, Panama, Peru, Russia, Singapore, South Africa, Switzerland, Taiwan, Thailand, Turkey, U.S.A., and Venezuela.

The Opposers filed a Reply on 03 March 2011. After the termination of the preliminary conference, the parties filed their respective position papers.

The Opposers anchor their opposition on Section 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 of priority date in respect of the same goods or services or closely related goods or services, or if it 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 its trademark application on 19 February 2010, the Opposer already have a pending application for the registration of the marks "HAWK" and "LADY HAWK". A comparison between the Opposer's marks on one hand, and the mark applied for registration by the Respondent-Applicant on the other, shows that confusion among the consumers is likely to occur. The word "HAWK" is the distinctive feature or component of the Respondent-Applicant's mark. Because both parties' marks are used on similar and closely related goods, it is likely that consumers will be misled into believing that these goods originate from one source only or that there is a connection between the parties. There is the likelihood of consumers assuming that one mark is just a variation of the other.

Thus, applying Sec. 123.1(d) of the IP Code, the Respondent-Applicant should not be allowed to register in its favor the mark "HAWK"

While the Respondent-Applicant raised the issue as to who had the better right over the mark "HAWK", this was already passed upon by this Bureau in its decision in IPC No. 14-2009-00072. This Bureau held in favor of the Opposers, to wit:

"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>7</sup>. In his Decision promulgated on 24 August 2012, the Director General dismissed the appeal. The decision also tackled the issue raised by the herein Respondent-Applicant's that it filed trademark applications earlier than the Opposers', to wit:

"The Office requested the Bureau of Trademarks (BOT) to issue a certification on the status of the Appellant's trademark application for TONY HAWK. On 10 May 2012, the BOT issued a 'Certification' stating that the Appellants Trademark Application No. 4-2007-006691 for TONY HAWK was abandoned with finality on 09 January 2010. The BOT also certifies that the Appellant has another application for TONY HAWK (Application No. 4-2010-001880) which is subject of opposition in another case at the Bureau of Legal Affairs.


"In this regard, the Appellant anchors its appeal primarily on its trademark application for TONY HAWK which was filed earlier than the subject trademark application of the Appellees. With the abandonment of the Appellant's trademark application for TONY HAWK, the Appellant's legal basis on this part of the appeal was rendered moot. The Office, therefore need not rule on whether the trademark application TONY HAWK filed by the Appellant bars the Appellees from registering HAWK.

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

WHEREFORE, premises considered, the instant opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2010-001880 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

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<sup>7</sup> Appeal No. 14-2010-0024.