



**WORLD BALANCE
INTERNATIONAL, INC.,**
Opposer,

-versus-

LEUGIM D. CACATIAN,
Respondent- Applicant.

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IPC No. 14-2013-00421
Opposition to:
Appln. Serial No. 4-2012-501172
Date Filed: 11 May 2012
TM: "W"

NOTICE OF DECISION

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LEUGIM D. CACATIAN
Respondent-Applicant
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98 V.A. Rufino corner Valero Streets
Salcedo Village, Makati City

GREETINGS:

Please be informed that Decision No. 2016 - 194 dated June 27, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 27, 2016.

For the Director:


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

**WORLD BALANCE
INTERNATIONAL, INC.,**

Opposer,

- versus -

LEUGIM D. CACATIAN,

Respondent-Applicant.

IPC NO. 14 - 2013- 00421

Opposition to:

Appln Serial No. 42012501172

TM: "W"

DECISION NO. 2016 - 194

X-----X

DECISION

WORLD BALANCE INTERNATIONAL, INC. (Opposer)¹, filed an Opposition to Trademark Application No. 4-2012- 501172 on 11 December 2013. The application filed by LEUGIM D. CACATIAN (Respondent-Applicant)², covers the mark "W" for "*clothing, footwear, headgear*" under Class 25 of the International Classification of Goods.³

The Opposer based its Opposition on the following grounds:

- 1.) The approval of Application SN 4-2012-501172 is contrary to Sections 123.1 (d), 138, and 147 of Republic Act No. 8293 (IP Code).
- 2.) Respondent-Applicant is not entitled to register the mark "W" in his favor and the approval of Application SN 4-2012-501172 has caused and will continue to cause great and irreparable damage and injury to herein Opposer.

The pertinent portions of the Opposition are quoted as follows:

- "1. Opposer is a corporation duly organized and existing under the laws of the Philippines, with business and office address at 19 V. Mapa Street, Caloocan City.
x x x
- "2. Opposer is the registered owner of the trademark "W" and variants thereof, namely:
"2.1. The STYLIZED LETTER W INSIDE AN OBLONG under Registration No. 4-1998-004103 issued on April 16, 2004 for use on shoes, slippers, sandals, boots, t-shirts, pants, jeans, slacks, socks, briefs, polo, polo shirts, jackets,

¹ A corporation duly organized and existing under the laws of the Philippines with business address at 19 V. Mapa Street, Caloocan City.

² with address at Unit 1214 Herrera Tower 98 V. A. Rufino St. cor. Valero St. Salcedo Village, Makati city

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

- sweatshirts, shorts, skirts, blouses, jogging suits, belts, caps, suspender, sandos, neckties, coats under Class 25;
- "2.2. W DEVICE under Registration No. 4-2001-005278 issued on December 25, 2005 for use on bags and wallets under Class 18; t-shirts, polo, polo shirts, blouses, sando, pants, slacks, skirts, shorts, jackets, socks, sweatshirts, briefs, panties, stockings, jogging suits, swim suits, swimming trunks, caps, belts, suspender, vest. coats, shoes, slippers under Class 25;
- "2.3. STYLIZED W ENCLOSED BY AN INCOMPLETE OBLONG DEVICE under Registration No. 4-2010-007919 issued on September 1, 2011 for use on coin purse, wallet, card holders, key holders, handbags, overnight bags, travel bags, school bags, attache cases, luggages, backpacks, belt bags, belts (made from leather and imitation of leather) under Class 18; towels and handkerchiefs under Class 24; shoes, slippers, sandals, boots, t-shirts, polo, polo shirts, jeans, pants, slacks, shorts, skirts, socks, stockings, belts of clothing, coats, jogging suits, jackets, robes, vests, sweaters, sweatshirts, sandos, briefs, panties, bras, caps, berets, hats, neckties, suspender, swim suits, swimming trunks, wrist bands, head bands, under Class 25; archery implements play balloons, balls for games-basketball, volleyball, soccer ball, balls for games, (small) bar-bells, baseball gloves, bats for games, battling gloves, stationery exercise bicycles, billiard cue tips, billiard cues, billiard markers, billiard table cushions, billiard tables, body building apparatus, boots with skates attached, bowling apparatus and machinery, bows for archery, boxing gloves, chalk for billiard cues, chest expanders (exercisers), climbers harness, golf clubs, counters (discs) for games discusses for sports, dumb-bells, rollers for stationery exercise, bicycles, fencing gauntlets, fencing masks, fencing weapons, flippers for swimming, tables for indoor football, games (automatic) other than coin-operated and those adapted for use with television receivers only, golf bags, golf gloves, gut for rackets, appliances for gymnastics, knee guards (sports articles), ninepins, machines for physical exercise, playing balls, swimming pools, rackets, string for rackets, shuttlecocks, skateboards, sole coverings for skis, spring boards, surf boards, swimming webs, tables for table tennis, targets, tennis nets under Class 28;
- "2.4. STYLIZED W (PRINTED DIAGONALLY TO LOOK LIKE A SWALLOW) under Registration No. 4-2009-005002 issued on November 5, 2009 for use on coin purse, wallet, card holders, key holders, handbags, overnight bags, travel bags, school bags, attache cases, luggages, backpacks, belt bags, belts under Class 18; towels under Class 24; shoes slippers, sandals, boots, t-shirts, polo, polo shirts, jeans, pants, slacks, shorts, socks, stockings, belts of clothing, coats, jogging suits, jackets, robes, vests, sandos, briefs, panties, caps, berets, hats, neckties, suspender, swim suits, swimming trunks, wrist bands, head bands under Class 25; basketball under Class 28;
- "2.5. STYLIZED W (PRINTED DIAGONALLY TO LOOK LIKE A SWALLOW) under Registration No. 4-2009-013081 issued on May 27, 2012 for use on coin purse, wallet, card holders, key holders, hand bags, overnight bags, travel bags, school bags, attache cases, luggages, backpacks, belt bags, belts under Class 18; towels under Class 24; shoes, slippers, sandals, boots, t-shirts, polo, polo shirts, jeans, pants, slacks, shorts, skirts, socks, stockings, belts of clothing, coats, jogging suits, jackets, robes, vests, sweaters, sweatshirts, sandos, briefs, panties, bras, caps, berets, hats, neckties, suspender, swim suits, swimming trunks, wrist bands, head bands under Class 25; archery implements, play balloons, balls for games- basketball, volleyball, soccer ball, balls for games, (small) bar-bells, baseball gloves, bats for games, battling gloves, stationery exercise bicycles, billiard cue tips, billiard cues, billiard markers, billiard table cushions, billiard tables, body building apparatus, boots with skates attached, bowling apparatus and machinery, bows for archery, boxing gloves, chalk for billiard cues, chest expanders (exercisers), climbers harness, golf clubs, counters (discs) for games discusses for sports, dumb-bells, rollers for stationery exercise, bicycles,



fencing gauntlets, fencing masks, fencing weapons, flippers for swimming, tables for indoor football, games (automatic) other than coin-operated and those adapted for use with television receivers only, golf bags, golf gloves, gut for rackets, appliances for gymnastics, knee guards (sports articles), ninepins, machines for physical exercise, playing balls, swimming pools, rackets, string for rackets, shuttlecocks, skateboards, sole coverings for skis, spring boards, surf boards, swimming webs, tables for table tennis, targets, tennis nets under Class 28;

x x x

- "3. Opposer has not abandoned the use of its registered trademark "W" and variants thereof, but continues their use since January 5, 1981 up to the present.
x x x
- "4. As further proof of the continuous use of its registered trademark "W" and variants thereof, Opposer submits herewith representative delivery receipt and sales invoices of its predecessor (Whisky Bravo Marketing Corporation) and of itself for products bearing the trademark "W" and variant thereof x x x
- "5. Likewise submitted herewith x x x are photographs of representative products bearing the trademark "W" and variants thereof x x x
- "6. Opposer has advertise its registered trademark "W" and variants thereof x x x
- "7. Respondent-Applicant's Application SN 4-2012-501172 filed on May 11, 2012 for the registration of the mark "W" is proscribed under Section 123.1 (d) of the IP Code, the mark "W" covered thereby being confusingly similar, if not outright identical, to Opposer's registered trademark "W" and variants thereof x x x
- "8. The goods covered by Respondent-Applicant's application are identical and/or related to the goods specified in the certificates of registration issued in favor of Opposer for its mark "W" and variants thereof x x x
- "9. Approval of Respondent-Applicant's application violates the right of Opposer to the exclusive use of its trademark "W" and variants on the goods and those related thereto, specified in the certificates of registration issued to it x x x
- "10. In the event of the approval of Respondent-Applicant's application, the likelihood of confusion on the part of the consuming public is bound to occur, as well as confusion of source, affiliation or connection, since Respondent-Applicant's mark is identical or at the very least, confusingly similar to Opposer's registered mark "W" and variants thereof, and Respondent-Applicant's goods are identical and/or related to the goods enumerated in the Opposer's certificates of registration.
- "11. Opposer will be damaged by the registration of the trademark "W" in favor of Respondent-Applicant, in that the use of said mark by Respondent-Applicant will prejudice the rights of Opposer over its registered trademark "W" and variants thereof, thereby irreparably impairing and/or destroying the good will generated by said mark "W" and variants thereof in its favor for the last thirty-two (32) years."

To support its Opposition, the Opposer submitted the following evidence:

Exhibit "A" – Certified Machine Copy of Opposer World Balance International Inc.'s Articles of Incorporation;

Exhibit "B" – Copy of Certificate of Registration No. 4-1998-004103 for the trademark STYLIZED LETTER W INSIDE AN OBLONG issued on April 16, 2004;

Exhibit "C" – Copy of Certificate of Registration No. 4-2001-005278 for the trademark W Device issued on December 25, 2005;

Exhibit "D" – Copy of the Certificate of Registration No. 4-2010-007919 for the trademark Stylized W Enclosed by an incomplete Oblong Device issued on September 1, 2011;

Exhibit "E" – Copy of Certificate of Registration No. 4-2009-005002 for the trademark Stylized W (printed diagonally to look like a swallow) issued on November 5, 2009;

Exhibit "F" – Copy of the Certificate of Registration No. 4-2009-013081 for the trademark Stylized W (printed diagonally to look like a swallow) issued on May 27, 2012;

Exhibit "G" to "G-6" – Copies of the Declaration of Actual Use filed on December 3, 2001, January 22, 2010, October 14, 2003, August 1, 2011, May 31, 2013, February 24, 2012 and August 1, 2012;

Exhibit "H" to "H-6" – Representative delivery receipt and sales invoices of products bearing the trademark "W" and variant thereof;

Exhibit "I" to "I -7" – Photographs of representative products bearing the trademark "W" and variants thereof;

Exhibit "J" to "J-3" – Representative samples of advertisement bearing the trademark "W" and variant thereof;

Exhibit "K" – Print-out of respondent applicant's mark "W", as published in the e-Gazette; and

Exhibit "L" – Duly notarized affidavit of Barnaby L. Chong, President of World Balance Inc.

This Bureau issued a Notice to Answer on 19 December 2013 and served a copy to the Respondent-Applicant on 7 January 2014. However, the Respondent-Applicant did not file an Answer to the Opposition. In view of the failure to file an Answer, an Order dated 30 May 2014 was issued declaring the Respondent-Applicant in default. Consequently, this case was deemed submitted for decision.

The issue in the present case is whether to allow the registration of herein Respondent-Applicant "W" trademark.

The Intellectual Property Code of the Philippines under Section 123.1 specifically 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 or priority date with respect to the same goods or services or closely related goods or services, or if it is nearly resembles such a mark as to be likely to deceive or cause confusion.

Records show that the Opposer has a prior and existing trademark registration when the Respondent-Applicant filed his trademark application.

Furthermore, the Respondent-Applicant's trademark is being applied for the used on "*clothing, footwear, and headgear*" under Class 25 of the International Classification of Goods while the Opposer's trademark is registered to be used on a

number of goods covered under International Classification of Goods including among other those under Class 25 for "shoes, slippers, sandals, boots, t-shirts, pants, jeans, slacks, socks, briefs, polo, polo shirts, jackets, sweatshirts, shorts, skirts, blouses, jogging suits, belts, caps, suspender, sandos, neckties, and coats." Based on the above enumerations, there is no doubt that the competing marks are being used on similar and/or related goods since both are used in clothing, footwear and head gear products.

The question now is, do the marks as shown below resemble each other such that mistake or confusion or even deception is likely to occur?



Opposer's Trademarks



Respondent-Applicant's Trademark

This Bureau answers the above question in the affirmative.

While it is true that the competing trademarks, as shown above, are stylized and may have some additional devices, the most prominent and distinctive feature in both trademarks is the letter "W." It is this feature that will leave the impression on the buying public and the difference in the style is not sufficient to distinguish the Respondent-Applicant's mark from the numerous trademarks of the Opposer. Therefore, the Opposer, being the original owner and prior registrant, deserves protection against the confusingly similar mark being applied by the Respondent-Applicant.

Succinctly, it has been consistently held in our jurisdiction that the law does not require that the competing trademarks must be so identical as to produce actual error or mistake. It would be sufficient, for purposes of the law that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.⁴ Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.⁵ Because the Respondent-Applicant will use his mark on goods that are similar and/or closely related to the Opposer's, the consumer is likely to assume that the Respondent-Applicant's goods originate from or sponsored by the Opposer or believe that there is a connection between them, as in a trademark licensing agreement. The likelihood of

⁴ American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

⁵ Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992

confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:⁶

It is emphasized that the essence of the 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 applied; 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.⁷ The mark applied for registration by the Respondent-Applicant does not serve this function.

WHEREFORE, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-501172 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 27 JUN 2016


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

⁶ Converse Rubber Corporation vs. Universal Rubber-Products, Inc. et. al. G.R. No. L27906, January 8, 1987

⁷ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, November 19, 1999