

THE STRIDE RITE CORPORATION, }
Opposer, }
 -versus- }
 EDDIE M. SIA, }
Respondent-Applicant. }
 X-----X

IPC No. 14-2015-00516
 Opposition to:
 Appln Serial No. 4-2014-008949
 Date Filed: 18 July 2014
 TM: STRIDER

NOTICE OF DECISION


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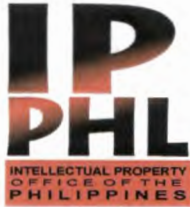
EDDIE M. SIA
 Respondent- Applicant
 15 San Antonio Street, San Francisco del Monte
 Quezon City, M. Manila

GREETINGS:

Please be informed that Decision No. 2016 - 277 dated 09 August 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 09 August 2016.


 Atty. **MARLITA V. DAGSA**
 Adjudication Officer
 Bureau of Legal Affairs



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DECISION

STRIDE RITE CORPORATION,¹ (“Opposer”) filed an opposition to Trademark Application Serial No. 4-2014-008949. The application filed by EDDIE M. SIA² (“Respondent-Applicant”), covers the mark “STRIDER” for use on “*pants, jeans, slacks, shorts, short pants, cycling shorts, boxing shorts, skirts, t-shirts, shirts with collar, dresses, tank tops, jackets, undershirts, camisole, blouses, nighties, briefs, panties, socks, slippers, sandals, shoes, caps, hats, visors, bonnets*” under Class 25 of the International Classification of Goods and Services.³

The Opposer alleges that it is the prior adopter, user, and true owner of the “STRIDE RITE” mark in the Philippines and elsewhere in the world, which has long been used to identify its goods locally and internationally. The Stride Rite Corporation was founded as “Green Shoe Manufacturing Company (Green Shoe)” in 1919 by Jacob Slosberg and partner Philip Green. It adopted The Stride Rite Corporation name in 1966 to emphasize the brand name of one of its best-known products.

According to the Opposer, it is the leading marketer of high quality children’s footwear in the Unites States and is a major marketer of athletic and casual footwear for children and adults. It markets products in countries outside the US and Canada through independent distributors and licensees. The Opposer’s business was founded on the strength of the Stride Rite children’s brand, but today includes a portfolio of American brands addressing different market segments within the footwear industry. In the Philippines, Opposer’s products are available online and in the following outlets, to name a few: SM Megamall; TriNoma Mall; Greenbelt 5; and Rustan's Makati.

The Opposer posits that being the owner of the mark STRIDE RITE which is registered under Registration Nos. 4-2010-003011 and 4-2010-003012, for Classes 25 and 35 respectively, it is entitled to protection in the Philippines against unauthorized use and/or expropriation by third parties of marks which are confusingly similar to the said marks. The mark STRIDER being applied for registration by Respondent-Applicant is confusingly

¹ A corporation duly organized and existing under the laws of Massachusetts, U.S.A., with principal office address at 191 Spring Street, Lexington, Massachusetts 02120, U.S.A.
² With address at 15 San Antonio Street, San Francisco Del Monte, Quezon City, Metro Manila.
³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks, which was concluded in 1957 and administered by the World Intellectual Property Organization.

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similar to Opposer's internationally well-known STRIDE RITE mark, for which it has already obtained registration in the Philippines and elsewhere in the world. The Opposer claims that STRIDE RITE mark is an internationally well-known mark and entitled to protection under the provisions of Republic Act No. 8293 (R.A. 8293),⁴ and Paris Convention for the Protection of Industrial Property (Paris Convention).⁵ Moreover, the registration and use of the trademark STRIDER by the Respondent-Applicant will diminish the distinctiveness and dilute the goodwill of Opposer's STRIDE RITE mark.

The Opposer's evidence consists of the following:

- 1) Duly executed and authenticated Special Power of Attorney (SPA)⁶ in favor of Opposer's counsel, Atty. Editha R. Hechanova;
- 2) Affidavit⁷ of Mr. Ronald S. Balk, the Vice President of The Stride Rite Corporation, Stride Rite Children's Group LLC, and SRC, LLC; and
- 3) Screenshots⁸ of Opposer's e-commerce website (<https://www.striderite.com>), confirming its existence.

This Bureau served a Notice to Answer to Respondent-Applicant on 20 February 2015. However, he failed to file the answer despite receipt of the Notice. Thus, this Bureau issued Order No. 2015-1000 declaring the Respondent-Applicant in default.

Opposer anchors its argument on Section 123.1, subparagraphs (d), (e), and (f) of the Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") which provide:

123.1. A mark cannot be registered if it:

xxx

(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 section 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;

⁴ Otherwise known as the Intellectual Property Code. Took effect on 1 January 1998.

⁵ Article 6bis of the Paris Convention. Ratified on 14 April 1980.

⁶ Exhibit "A" with submarkings.

⁷ Exhibit "B" with submarkings.

⁸ Exhibits "C-6" to "C-8."

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use.

Records show that at the time Respondent-Applicant filed its trademark application, the Opposer already has a valid and existing registration for the mark "STRIDE RITE" under Registration Nos. 4-2010-003011 and 4-2010-003012 issued on 02 September 2010. Opposer's mark is used on "*footwear*" under Class 25 and "*retail shoe store services*" under Class 35 while Respondent-Applicant's is used on "*pants, jeans, slacks, shorts, short pants, cycling shorts, boxing shorts, skirts, t-shirts, shirts with collar, dresses, tank tops, jackets, undershirts, camisole, blouses, nighties, briefs, panties, socks, slippers, sandals, shoes, caps, hats, visors, bonnets*" under Class 25. As such, Respondent-Applicant's goods are similar and/or related to the goods of the Opposer.

The competing marks are depicted below:

STRIDE RITE

Opposer's Mark

STRIDER

Respondent-Applicant's Mark

This Bureau agrees with the Opposer that the use of Respondent-Applicant of the STRIDER mark will cause confusion, mistake, and deception in the mind of the purchasing public. The Respondent-Applicant appropriated the letters "S-T-R-I-D-E-R" which forms the word "STRIDE" and the first letter of the word "RITE" in the Opposer's mark. That the Respondent-Applicant deleted the three last letters "I-T-E" of Opposer's mark is of no moment. 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 purchaser as to cause him to purchase the one supposing it to be the other⁹.

Furthermore, when Respondent-Applicant's STRIDER mark is pronounced, it produces the same sound as that of Opposer's STRIDE RITE mark such that to the ears they are indistinguishable from one other. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark. Similarity of sound is sufficient ground to rule that two marks are confusingly similar when applied to merchandise of same descriptive properties. In fact, the Supreme Court has in many cases took into account the aural effects of the words and letters contained in the marks in

⁹ See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

determining the issue of confusing similarity. In *Marvex Commercial Co., Inc. v Petra Hawpia & Co., et al.*¹⁰, the Court held:

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, *Unfair Competition and Trade Marks*, 1947, vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jazz-Sea"; "Silver Flash" and "Supper-Flash"; "Cascarete" and "Celborite"; "Celluloid" and "Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo". Leon Amdur, in his book "TradeMark Law and Practice", pp. 419-421, cites, as coming within the purview of the idem sonans rule, "Yusea" and "U-C-A", "Steinway Pianos" and "Steinberg Pianos", and "Seven-Up" and "Lemon-Up". In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Cordura" are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin", as the sound of the two names is almost the same." (*Emphasis supplied*)

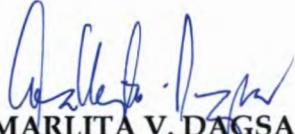
Thus, the use by the Respondent-Applicant of the trademark STRIDER is likely to give rise to confusion or wrong belief that the its products bearing the mark originated from, manufactured or sponsored by the Opposer or vice-versa.

Anent the claim of Opposer that its mark is well-known, this Bureau finds that it not anymore necessary to dwell on the issue.

WHEREFORE, premises considered, the instant Opposition to Trademark Application Serial No. 4-2014-008949 is hereby **SUSTAINED**. Let the filewrapper of the subject application be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 09 AUG 2016


MARLITA V. DAGOSA
Adjudication Officer
Bureau of Legal Affairs

¹⁰ G.R. No. L-19297. December 22, 1966 cited in *McDonald's Corporation v. L.C. Big Mak Burger, Inc.*, G.R. No. 143993. August 18, 2004.