



INTELLECTUAL PROPERTY
OFFICE OF THE
PHILIPPINES
CATERPILLAR, INC.,
Opposer,

-versus-

NAUGHTY CAT., LTD (KR),
Respondent-Applicant.

X-----X

} **IPC No. 14-2014-00330**
} Opposition to:
} Appln. Serial No. 4-2013-012919
} Date Filed: 25 October 2013

} **TM: N.CAT**

NOTICE OF DECISION

QUISUMBING TORRES

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PATENTPROSE

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GREETINGS:

Please be informed that Decision No. 2017 - 24 dated 30 January 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 02 February 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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CATERPILLAR, INC.,

Opposer,

-versus-

NAUGHTY CAT., LTD [KR]

Respondent-Applicant.

IPC No. 14-2014-00330

Opposition to Trademark

Application No. 4-2013-012919

Date Filed: 25 October 2013

Trademark: "N. CAT"

x ----- x Decision No. 2017- 24

DECISION

Caterpillar, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-012919. The contested application, filed by Naughty Cat, Ltd. [KR]² ("Respondent-Applicant"), covers the mark "N. CAT" for use on *"bracelets (jewelry), chains of precious metal, ornamental pins of precious metal, silver ornaments, pendants (jewelry), jewel chains, accessories of jewelry, ornaments (jewelry), brooches (jewelry), ornaments for ankle (jewelry), rings (jewelry), necklaces (jewelry), gold thread (jewelry), pins (jewelry), belt ornaments of precious metal, badges of precious metal, hat ornaments of metal, earrings of precious metal", "leather key chains, bags, leather and imitation leather bags, leather purses, leather handbags, small bags for men, handbags for men, multipurpose purses, backpacks, shoulder bags, handbags, handbag frames" and "bows for the hair, pigtail ribbons for Korean hair style (Daeng-gi), oriental hair pins, lace, ribbons (haberdashery), hair ribbons, hair nets, top-knots (pompoms), hair ornaments (not of precious metal), hair pins and hair grips, hair pins (not of precious metal), hat ornaments (not of precious metal), badges for wear (not of precious metal), Korean ornamental hairpins (beenyer, not of precious metal), ornamental novelty pins (other than jewelry), accessories (not of precious metal and jewelry), feathers (clothing accessories), buckles for clothing accessories (not of precious metal), brooches for clothing accessories (not of precious metal), birds feathers (clothing accessories), ostrich feathers (clothing accessories), decorative ribbons, ornamental novelty badges (buttons, not of precious metal), elastic ribbons, hair bands"* under Classes 14, 18 and 26, respectively of the International Classification of Goods³.

The Opposer alleges, among others, that it is the first user and owner off the marks "CATERPILLAR", "CAT", "CATERPILLAR & DESIGN" and "CAT & DESIGN". It has existing registration and/or pending applications for Classes 14, 18 and 25.

¹ A corporation organized and existing under the laws of Delaware, United States of America, with principal place of business at 9660 Chesapeake Drive, San Diego, California, USA.

² With known address at 3-20 Toegyero 6 Gil, Jung-gu, Seoul (Hoehyen-dong), Republic of Korea.

³ 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.

Thus, it contends that the Respondent-Applicant's mark is confusingly similar to its "CAT" trademarks. In support of its Opposition, the Opposer submitted the affidavits of Christina Marie Gensler, its Corporate Secretary, and Atty. Bienvenido A. Marquez III, with respective annexes.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 10 November 2014. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Adjudication Officer issued on 11 March 2016 Order No. 2016-423 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 "N. CAT" on 29 October 2013, the Opposer has existing and valid registrations of its trademark "CAT" issued as early as 2006.

To determine whether the competing marks are confusingly similar, the same are reproduced hereafter for comparison:

⁴ Marked as Exhibits "B" and "C", inclusive.

Opposer's marks:

CATERPILLAR

CAT



Respondent-Applicant's Mark:

N.Cat

Costume Fashion Jewelry

Since 1991

A practical approach to the problem of similarity or dissimilarity is to go into the *whole* of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear" may be considered.⁵ Thus, confusion is likely between

⁵ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

Vis-à-vis the Opposer's mark "CATERPILLAR", the Respondent-Applicant's mark "N. CAT" is clearly different in spelling, pronunciation and connotation. With respect to the Opposer's "CAT" mark, the same conclusion can be drawn. The applied mark includes "N." which does not appear in any of the Opposer's marks. As such, they differ visually and aurally. Also, it can be presumed that the Opposer's "CAT" mark is the shortened version of its "CATERPILLAR" trademark and/or trade name. On the other hand, the Respondent-Applicant's applied mark appears to be a shortened version of its trade name "NAUGHTYCAT". It is likewise noteworthy that the Opposer's "CAT" and "CATERPILLAR" registered marks pertain to goods and/or services under Classes 07, 09, 12, 35, 36, 37 and 42, none of which are applied for by the Respondent-Applicant.

While it is true that the Opposer also has pending applications of its "CAT" trademarks dating as early as 1997 for goods under Classes 14, 18 and 25, confusion is still unlikely. Aside from the differences previously cited between the competing marks, the Trademark Registry of this Office reveals several other trademarks appropriating the word "CAT" involving the same classes, belonging to different proprietors, including:



Reg. No. 4-2013-010063



Reg. No. 42010-003750

FELIX THE CAT

Reg. No. 057927


Hence, similarity in this aspect alone is not enough to prevent a junior user registration of its mark provided that the later mark is endowed with other distinguishing features and characteristics such as that of the Respondent-Applicant's.

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.⁶ Based on the above discussion, Respondent-Applicant's trademark sufficiently met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-012919 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **30 JAN 2017**


Atty. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.