

ROCKY BRANDS WHOLESale LLC,
Opposer,

-versus-

ERWIN C. CHOACHUY,
Respondent- Applicant.

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IPC No. 14-2014-00205
Opposition to:
Appln. Serial No. 4-2014-003002
Date Filed: 11 March 2014
TM: ROCKY MOUNTAIN

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NOTICE OF DECISION

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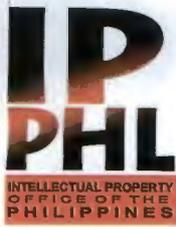
GREETINGS:

Please be informed that Decision No. 2017 - 113 dated April 17, 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, April 17, 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



ROCKY BRANDS WHOLESALE LLC,
Opposer,

- versus -

ERWIN C. CHOACHUY,
Respondent-Applicant.

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IPC No. 14-2014-00205
Opposition to:

Appln. No. 4-2014-003002
Date Filed: 11 March 2014
Trademark: "ROCKY MOUNTAIN"

Decision No. 2017 - 113

DECISION

ROCKY BRANDS WHOLESALE LLC ("Opposer")¹, filed a verified opposition to Trademark Application Serial No. 4-2014-003002. The application, filed by ERWIN C. CHOACHUY ("Respondent-Applicant")², covers the mark "ROCKY MOUNTAIN" for use on goods under class 25³ namely: *"footwear namely, shoes, sandals, slippers"*.

The Opposer alleges that it is the prior adopter, user and true owner of the trademark "ROCKY", which has been earlier registered in various countries and jurisdictions worldwide. It is a fully-owned subsidiary of ROCKY BRANDS, INC., a company which designs, develops, manufactures and markets premium quality outdoor, work, western, duty and military footwear, as well as outdoor apparel and accessories. The Rocky Brands family of brands includes "ROCKY", "GEORGIA BOOT", "DURANGO", "LEHIGH", and "CREATIVE RECREATION".

The Opposer avers that its trademark "ROCKY" and its variants are internationally well-known. Opposer has caused its application and registration in several countries and jurisdictions worldwide. Opposer's parent company filed an application for the registration of "ROCKY" trademark in Benelux as far back as 1987 and was issued registration for goods in class 25 for articles of clothing, headwear and footwear. In the Philippines, the Opposer applied for registration of the mark "ROCKY" in class 25 for footwear, boots, shoes. It spent significant amounts for advertising and promotion, thereby establishing goodwill and fame. It also owns and maintains accounts on popular social media sites networks in order to better disseminate information such as the Facebook, Twitter, You Tube and Pinterest. Opposer's "ROCKY" line of products may be purchased online, retail stores and local dealers, and directly through its Custom Fit websites which are tailored to meet the specific needs of customers. In the Philippines, the Opposer's "ROCKY" products are sold and distributed through its authorized distributor since 2012.

According to the Opposer, Respondent-Applicant's "ROCKY MOUNTAIN" mark is confusingly similar to its internationally well-known "ROCKY" trademark and its variants. Thus, it is entitled to protection against confusingly similar marks covering similar or related goods, whether or not it is registered in the Philippines. The term "ROCKY MOUNTAIN" is a geographical name which is not

¹ A corporation duly organized and existing under the laws of the State of Delaware with office address at 39 East Canal Street, Nelsonville, Ohio 45764.
² With registered address at 13 Spolarium Street, Cebu City, Cebu, Philippines.
³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

subject to exclusive appropriation. Finally, the word "ROCKY" forms part of the corporate name of Opposer, which is protected under Article 6sexies and Article 8 of the Paris Convention.

The Opposer submitted the following evidence:

1. Authenticated and notarized Special Power of Attorney;
2. Authenticated Affidavit-Direct Testimony by Mr. David Sharp;
3. Copies of foreign registrations of Opposer's trademark ROCKY and its variants;
4. Print-out from IPOPhil online trademark database containing details of Application No. 4-2014-501971 and 4-2014-003002;
5. Samples of advertising and promotional materials featuring Opposer's ROCKY products;
6. Affidavit-Direct Testimony by Atty. Chrissie Ann L. Barredo;
7. Pictures of Opposer's ROCKY-branded footwear sold in Nashe Enterprises.
8. Screen captures of social media sites owned and maintained by Opposer;

On 13 November 2014, the Respondent-Applicant filed his Answer. The Affirmative Defenses are provided as follows:

- "A. Opposer has failed to prove that the 'ROCKY' trademark and its variants are internationally well-known. The provisions of Sections 123.1 (e) and (f) of the IP Code, and Article 6bis of the Paris Convention are inapplicable in this case.
- "B. Respondent-Applicant's 'ROCKY MOUNTAIN' trademark is not confusingly similar to Opposer's 'ROCKY' trademark.
- "C. Assuming arguendo that there is confusing similarity between the 'ROCKY' and 'ROCKY MOUNTAIN' trademarks, Opposer has no basis to oppose Respondent-Applicant's trademark registration as Opposer's mark are not internationally well-known and Respondent-Applicant is the prior user and registrant in the Philippines of the 'ROCKY MOUNTAIN' mark.
- "D. 'ROCKY MOUNTAIN' is an arbitrary mark when used in connection with footwear.
- "E. The protection accorded to a tradename under Section 165 of the IP Code is limited to preventing use by third parties of the same or similar name or mark, and does not extend to a trademark that is different or sufficiently distinctive.
- "F. Opposer will not suffer any damage by the registration of Respondent-Applicant's 'ROCKY MOUNTAIN' trademark. The application for registration of the 'ROCKY MOUNTAIN' trademark should thus be allowed to proceed to registration."

The Respondent-Applicant submitted the following evidence:

1. Special Power of Attorney;
2. Certified true copy (Ctc) of the Amended Articles of Incorporation of CKOK;
3. Print-outs from the IPO database showing registration details of Respondent-Applicant's secured registrations of the following marks: Robertsons, Zapadrilles, Twister and Treads;
4. Print-outs from Facebook pages for CARS footwear and GLEE footwear maintained by CKOK;
5. Picture of GLEE shoebox and hangtag;
6. Print-out from the IPO database showing registration details of ROCKY MOUNTAIN;

7. Ctc of the 5th year Declaration of Use for the Rocky Mountain mark;
8. Order slips covering orders for ROCKY MOUNTAIN footwear;
9. Invoice showing sale of ROCKY MOUNTAIN mark;
10. Photograph of a display rack for ROCKY MOUNTAIN footwear;
11. Photograph during the ROCKY MOUNTAIN Dance Challenge;
12. Copy of the Removal from Registry for Non-Filing of DAU;
13. Copy of the request for priority examination and the grant of request;
14. Ctc of the 3rd year Declaration of Actual Use for the ROCKY MOUNTAIN;
15. Copy of the Notice of Allowance; and,
16. Affidavit of Erwin C. Choachuy.

The Preliminary Conference was conducted and terminated on 29 July 2015. Thereafter, the parties submitted their respective position papers on 10 August 2015. Hence, this decision.

Should the Respondent-Applicant be allowed to register the trademark ROCKY MOUNTAIN?

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 out into the market a superior 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.⁴

Records show that the Respondent-Applicant filed its application for registration on 11 March 2014 for the subject mark "ROCKY MOUNTAIN". On the other hand, the Opposer filed its trademark application for "ROCKY" on 08 May 2014. It was later issued registration on 02 October 2014.⁵ In the Philippines, a certificate of registration constitutes a prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.⁶

The competing marks are reproduced below for comparison and scrutiny:



Opposer's Trademark



Respondent-Applicant's Trademark

The competing marks contain the prominent word "ROCKY". The word "MOUNTAIN" in Respondent-Applicant's mark appears as mere translation of the device incorporated in the Opposer's mark, in a representation of a mountain beside the word "ROCKY". Moreover, the stylized font of the word marks appear similar. These features are visually apparent.

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

⁵ IPPhil Philippine Trademark Database, available at <http://www.wipo.int/branddb/ph/en/> (last accessed 11 April 2017).

⁶ Sec. 138, IP Code.

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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 other.⁷ Colourable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colourable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark with that of the other mark or trade name in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.⁸

As to the goods covered by the marks, they are similar and/or related to each other, covering class 25, particularly referring to footwear. Considering the similarity or relatedness of goods carried by the contending marks, the consumers will have the impression that these products originate from a single source or origin or they are associated with one another. Thus, the likelihood of confusion therefore, would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:⁹

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Hence, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

As such, considering the probable purchaser's attitude and habits, marketing activities, and commercial impression, there is a high likelihood that the trademarks of the Opposer and the Respondent-Applicant pertain to related fields of manufacture, distribution and marketing under similar conditions. Both are likely to be conveyed and move in the same channels of trade. Thus, the goods of the Opposer and the Respondent-Applicant are of a character which purchasers would be likely to attribute to a common origin. In fact, Opposer has shown proof of prior use and registration of its "ROCKY" trademark to demonstrate ownership thereof. It has verily shown evidence of its history¹⁰, prior foreign trademark registrations¹¹, continuous presence and use in Philippine market,¹² internet sites¹³, advertisements and publicities in different forms¹⁴.

While this Bureau finds that the Opposer failed to substantially establish that the trademark "ROCKY" is a well-known mark, it confirmed that the application for registration of the mark "ROCKY MOUNTAIN" is within the prohibition imposed by paragraph (d) of Sec. 123.1 R.A. No. 8293, also known as the Intellectual Property Code, to wit:

A mark cannot be registered if it:

x x x

⁷ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 200, 356 SCRA 207, 217.
⁸ Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.
⁹ Id.
¹⁰ Exhibit "B" of Opposer.
¹¹ Exhibits "B-8" to "B-42" of Opposer.
¹² Exhibits "B-58" to "B-65", "C-103" to "C-106" of Opposer.
¹³ Exhibits "C-59" to "C-66" of Opposer.
¹⁴ Exhibits "B-43" to "B-57" of Opposer.

(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;

The public interest requires that the two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented.

Finally, the intellectual property system was established to recognize creativity and give incentives to innovations. The trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-003002 is hereby **SUSTAINED**. Let the file wrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. **17 APR 2017**



Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs