

MANOLO P. SAMSON,
Opposer,

-versus-

CATERPILLAR, INC.,
Respondent-Applicant.

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IPC No. 14-2004-00014
Opposition to:
Appln. Serial No. 4-1997-121938
Date Filed: 24 June 1997

TM: CATERPILLAR & DEVICE

NOTICE OF DECISION

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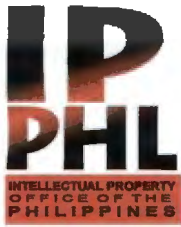
GREETINGS:

Please be informed that Decision No. 2017 - 297 dated 07 July 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, 10 July 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



MANOLO P. SAMSON,
Opposer,

- versus -

CATERPILLAR, INC.,
Respondent-Applicant.

X ----- X

IPC No. 14-2004-00014
Opposition to:

Appln. No. 4-1997-121938
Date Filed: 24 June 1997
Trademark: "CATERPILLAR &
DEVICE"

Decision No. 2017 - 297

DECISION

MANOLO P. SAMSON ("Opposer")¹, filed a verified opposition to Trademark Application Serial No. 4-1997-121938. The application, filed by CATERPILLAR, INC. ("Respondent-Applicant")², covers the mark "CATERPILLAR & DEVICE" for use on *"leather and imitation leather goods namely, wallets, credit card cases, business card cases, key holders, coin holders, briefcases, garments bags for travels, back packs, duffel bags, flight bags, tote bags, umbrellas, travelling bags, athletic bags, sport bags, book bags, should bags, purses"* under class 18³ of the International Classification of Goods and Services.

The Opposer alleges that it is the registered owner of the trademark CATERPILLAR WITH A TRIANGLE DEVICE under Registration No. 64705 issued on 16 June 1997 for use on shoes, slippers, sandals and boots. It has also pending applications for the registration of the trademark CATERPILLAR WITH A TRIANGLE DEVICE for use on goods under Classes 18 and 25 under Application Serial Nos. 123893 and 123894.

Opposer further alleges that it is also the owner of the trademarks CATTS WITH A TRIANGLE DEVICE BENEATH THE LETTER A and CAT WITH A TRIANGLE BENEATH THE LETTER A by virtue of prior adoption and continuous use in the Philippines. The former application of trademark is now the subject of Inter Partes Case No. 14-1999-00049 between the parties.

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- ¹ Filipino citizen and a resident of 146 E. Rodriguez Avenue, Concepcion I, Marikina City, Philippines.
 - ² A corporation organized and existing under the laws of the State of Delaware, U.S.A., with address at 100 N.E. Adams St., Peoria, Illinois 61629, U.S.A.
 - 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.

The Opposer cites the following grounds for opposition:

1. Respondent-Applicant's trademark CATERPILLAR & DESIGN is confusingly similar to Opposer's registered trademark CATERPILLAR and Opposer's other trademarks CATT'S WITH A TRIANGLE BENEATH THE LETTER A and CAT WITH A TRIANGLE BENEATH THE LETTER A.
2. The approval of Respondent-Applicant's Application Serial No. 4-1997-121938 violates Section 4(d) of R.A. No. 166, as amended, the law in force at the time it was filed, examined and approved for publication for opposition.
3. The approval of Respondent-Applicant's Application Serial No. 4-1997-121938 also violates Section 123(d) and (g) of the New Intellectual Property Code of the Philippines.
4. Opposer will suffer irreparable damage and prejudice if Respondent-Applicant's Application Serial No. 4-1997-121938 will finally be approved.

On 11 March 2004, Respondent-Applicant submitted its Answer. It alleges that it has the right to use and register the CATERPILLAR AND DESIGN trademark in the Philippines, being the owner by prior adoption and use of the mark CATERPILLAR & DESIGN, an internationally famous or well-known trademark which has long been used and registered worldwide in many countries including the Philippines.

The mark "CATERPILLAR AND DESIGN" and its derivative mark "CAT AND DESIGN" are offshoots of the marks "CATERPILLAR" and "CAT" which have been used by Caterpillar Inc. worldwide in its core business of manufacturing heavy machinery and equipment for construction, mining, road building and agricultural industries since 1925. The marks "CATERPILLAR" and "CAT" are registered worldwide, including in the Philippines in 1938.

The Respondent-Applicant further alleges that it has expanded into other business activities, including Caterpillar Inc. footwear, clothing and accessories, Cat Financial, Cat Logistics and Cat Electric Power. Beginning 20 October 1988, the marks "CAT AND DESIGN" and "CATERPILLAR AND DESIGN" were introduced and commercially-used by Caterpillar Inc. in its business activities. Such use has been continuous and has not been abandoned. In fact, to protect Caterpillar Inc.'s ownership of the mark "CATERPILLAR AND DESIGN" and "CAT AND DESIGN", it registered the same in many countries for various classes of goods.

According to Respondent-Applicant, Opposer cites his Philippine Registration No. 64705 for "CATERPILLAR WITH A TRIANGLE BENEATH THE LETTER A", Application Serial No. 90613 for "CATT'S WITH A TRIANGLE BENEATH THE LETTER A", and Application Serial Nos. 123895 and 123896 covering the mark "CAT WITH A TRIANGLE DEVICE BENEATH THE LETTER A" as bar to the registration of Caterpillar Inc.'s subject trademark. Under said registrations, Opposer's claimed priority of use and registration and first use of the mark CATT'S WITH A TRIANGLE BENEATH THE LETTER A. However, Respondent-Applicant refuted the allegation that Caterpillar Inc. is the prior user and registrant of the trademark "CATERPILLAR AND DESIGN" and also the prior user and registrant of the trademark "CAT", which was used worldwide as early as in 1925 and registered in the Philippines on 16 July 1955 under Certificate of Registration No. 1609.

Finally, Respondent-Applicant invokes Philippine treaty obligations to protect Caterpillar Inc.'s "CATERPILLAR AND DESIGN" mark and to prohibit use by Opposer of marks identical thereto.

The pre-trial conference was conducted and terminated. Then after, the trial on the merits ensued.

The Opposer's evidence consists of the following:

1. Duly notarized affidavit of Opposer's counsel and first witness, Florencio Z. Sioson, and page 2 thereof showing the signature of Florencio Z. Sioson;
2. Certification of documents taken from the records of Registration No. 64705 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
3. Opposer's Certificate of Registration No. 64705 issued on June 16, 1997 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A for use on shoes, slippers, sandals and boots and the dorsal portion thereof indicating Opposer's filing of the affidavit of use following its 5th anniversary;
4. Duly accepted Affidavit of Use following the 5th anniversary of Registration No. 64705 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
5. Certification of true copies of Order No. 96-518 and Order No. 97-34 taken from the file of IPC No. 4227 entitled Caterpillar, Inc. v. Manolo P. Samson;
6. Order denying Caterpillar Inc.'s Motion to Admit Verified Notice of Opposition for having been filed beyond the reglementary period and the page 2 thereof;
7. Order giving due course to Manolo P. Samson's Application Serial No. 90614 for the registration of the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A and page 2 thereof;
8. Duly accepted Affidavit of Use following the 10th anniversary of Registration No. 64705 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
9. Certification of documents taken from the file wrapper of Application Serial No. 4-1997-123893 filed August 22, 1997 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
10. Trademark Application Serial No. 4-1997-123893 filed on August 22, 1997 by Manolo P. Samson for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A for use on coin purse, wallet, handbags, overnight bags, travel bags, school bags, attaché case, luggage;
11. Drawing and facsimiles of the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
12. Acknowledgment of Filing of Application Serial No. 4-1997-123893 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
13. Letter to the IPO Director General dated June 1, 1998 announcing Manolo P. Samson's desire to have his Application Serial No. 4-1997-123893 for the trademark

- CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A examined and approved under R. A. No. 166, as amended;
14. Examiner's action, marked Paper No. 5;
 15. Manolo P. Samson's response to the Examiner's action, Paper No. 5;
 16. Examiner's action, marked Paper No. 7;
 17. Manolo P. Samson's response to the Examiner's action, Paper No. 7 and page 2 thereof;
 18. Letter dated November 27, 2001, submitting the required Declaration of Actual Use together with supporting documents for Application Serial No. 123893;
 19. Declaration of Actual Use for Application Serial No. 4-1997-123893 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A filed on December 3, 2001, together with cash invoices and labels and page 2 thereof;
 20. Cash Invoice Nos. 8766 and 8784 of Caterpillar Boutique dated November 16 and 17, 2001, respectively;
 21. Labels bearing the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
 22. Certification of documents taken from the file wrapper of Application Serial No. 4-1997-123894 filed by Manolo P. Samson on August 22, 1997 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
 23. Trademark Application Serial No. 4-1997-123894 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A for use on jeans, pants, polo, t-shirts, polo shirts, briefs, shorts, sandos, socks, belts, jogging pants, sweatshirts, suits, coats, overcoats, topcoats, jackets, neckties, caps, vests, dresses, skirts;
 24. Drawing and facsimiles of the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
 25. Acknowledgment of Filing of Application Serial No. 4-1997-123894 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
 26. Letter to the IPO Director General dated June 1, 1998 announcing Manolo P. Samson's desire to have his Application Serial No. 4-1997-123894 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A examined and approved under R.A. No. 166, as amended;
 27. Examiner's action, marked Paper No. 5;
 28. Manolo P. Samson's response to the Examiner's action, Paper No. 5;
 29. Examiner's action, marked Paper No. 7;
 30. Manolo P. Samson's response to the Examiner's action, Paper No. 7 and page 2 thereof;
 31. Letter dated November 27, 2001, submitting the required Declaration of Actual Use together with supporting documents for Application Serial No. 4-1997-123894;
 32. Declaration of Actual Use for Application Serial No. 4-1997-123894 for the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A, together with cash invoices and labels and page 2 thereof;
 33. Cash Invoice Nos. 7365 and 8759 of Caterpillar Boutique dated November 7 and 14, 2001, respectively;

34. Labels bearing the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A;
35. Duly notarized affidavit of Opposer's Marketing Officer and second witness, Rudy Ong Cortan, dated January 29, 2008;
36. Certified machine copy of the Certificate of Incorporation together with the Articles of Incorporation of Mano Shoes Manufacturing Corporation issued by the Securities and Exchange Commission on January 15, 1993;
37. Certification of the registration of the business name Caterpillar Boutique & General Merchandise issued by the Department of Trade and Industry on August 8, 2002 in favor of Manolo P. Samson;
38. Certificate of Renewal of the registration of the business name Caterpillar Boutique & General Merchandise issued by the Department of Trade and Industry;
39. Photographs of Opposer's shoes, shoe box for low-cut shoes, sandals, current box for sandals, jeans, skirt, polo shirt, t-shirt, socks, cap, visor, labels, hangtags and cloth labels, plastic wrapper, paper bag and plastic packaging bearing the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A in lieu of the actual products;
40. Various Cash Invoices of Itti Shoes and Caterpillar Boutique evidencing sales of Opposer's products bearing the trademarks CATERPILLAR and CAT;
41. Photographs of Opposer's coin purse, traveling bag, belt, and slippers bearing the trademark CATERPILLAR WITH A TRIANGLE DEVICE BENEATH THE LETTER A in lieu of the actual products; and
42. Certified machine copy of the Certificate of Incorporation together with the Articles of Incorporation of Itti Shoes Corporation issued by the Securities and Exchange Commission on September 29, 1992.

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

1. Affidavit of Pericles R. Casuela together with his signature;
2. Special Power of Attorney issued by Caterpillar, Inc. in favor of Quisumbing Torres and authenticated by the Consul General of the Philippine Embassy in Washington D. C.;
3. Certified true copy of Certificate of Registration No. 575 for CATERPILLAR issued by the Intellectual Property Office on 7 June 1968 and renewed for another 20 years from 7 June 1988;
4. Certified true copy of Certificate of Registration No. 1609 for CAT issued by the IPO on 16 July 1975 and renewed for another 20 years from 16 July 1995;
5. Certified true copy of Certificate of Registration No. 16811 for CATERPILLAR issued by the IPO on 16 July 1975 and renewed for another 20 years from 16 July 1995;
6. Certified true copies of various trademark registrations issued by the IPO in favor of Caterpillar, such as: Certificate of Registration No. 4-1999-001830 for CAT IN BOLD LETTERS WITH A SOLID TRIANGLE UNDER THE LETTER "A"; Registration No. 4-1998-005057 for CATERPILLAR AND DESIGN; Registration No. 4-1998-005059 for CATERPILLAR AND DESIGN; Registration No. 4-1998-005058 for CAT AND DESIGN; Registration No. 4-1998-005060 for CAT AND

- DESIGN; Registration No. 4-1999-006389 for CAT; Registration No. 4-2001-002533 for THE CAT RENTAL STORE LOGO; Registration No. 4-2003-009565 for CATERPILLAR AND DESIGN; Registration No. 4-2003-009564 for CAT AND DESIGN; Registration No. 4-1999-001831 for CATERPILLAR AND DESIGN; Registration No. 4-1999-006388 for CAT AND DESIGN; Registration No. 4-1999-006387 for CATERPILLAR AND DESIGN; Registration No. 4-2006-009671 for CAT AND DESIGN; Registration No. 4-2006-009670 for CATERPILLAR & DESIGN; Registration No. 4-1998-009050 for CATERPILLAR & TRIANGULAR DESIGN; Registration No. 4-1998-009051 for CAT AND TRIANGULAR DESIGN; Registration No. 4-2007-005211 for CAT; Registration No. 4-2007-005212 for CAT AND DESIGN; Registration No. 4-2007-007839 for CATERPILLAR; Registration No. 4-2007-011171 for MACHINE BODY HORIZONTAL (WITH CAT IN BLACK AND WHITE); Registration No. 4-2006-009672 for CATERPILLAR & DESIGN; and Registration No. 4-2006-009673 for CAT & DESIGN, for various classes of goods and services, such as classes 1, 2, 4, 6, 7, 8, 9, 11, 12, 16, 17, 19, 20, 24, 28, 35, 36, 37, 39 and 42;
7. Certified true copies of various trademark applications filed in the name of Caterpillar with the IPO, such as: Trademark Application No. 4-2007-001774 and 4-2007-005210 for CATERPILLAR; Application Nos. 4-1997-116433, 4-1997-121938, 4-2007-001760, 4-2007-001764 and 4-2007-005209 for CATERPILLAR AND DESIGN; Application No. 4-2007-001763 for CAT; and Application Nos. 4-1997-116432, 4-1997-121936, 4-1997-121937, 4-2007-001762 and 4-2007-001765 for CAT AND DESIGN, for various classes of goods and services, such as classes 4, 7, 9, 12, 14, 18, 25, 35, 36, 37 and 42;
 8. Original computer print out of the search report generated as of 13 November 2008 by the IPO's Trademark Online Search System disclosed on the IPO's official website, www.ipophil.gov.ph for all the trademark applications and registrations under the name of Caterpillar, Inc.;
 9. Original computer print out of the search report generated as of 13 November 2008 by the IPO's Trademark Online Search System disclosed on the IPO's official website, www.ipophil.gov.ph for all the trademark applications and registrations that use or incorporate the word CATERPILLAR in the mark;
 10. Certified true copy of Decision No. 728, rendered by the Director of the Philippine Patent Office on 8 August 1973 in a trademark opposition case entitled *Caterpillar Tractor Co. v. Ceferino L. Benedicto* docketed as Inter Partes Case No. 573;
 11. Affidavit of Peter L. Calimag and his signature thereto;
 12. Certificate of Authenticity issued by the Honorable Office's Records Officer IV, Marilyn F. Retutal, attesting to the fact that "the Affidavit of J. Michael Hurst with Annexes... are copies from the original on file with the records of this Office which forms part of the records of IPC No. 14-2006-00030...";
 13. Affidavit of J. Michael Hurst and authenticated before the Consul General of the Philippine Embassy in Washington, D. C., along with an envelope containing the Annexes referred to in Mr. Hurst's Affidavit;
 14. Annex 1 of Mr. Hurst's Affidavit which is an original computer print-out of a table generated from Caterpillar's corporate database that lists in detail the various registrations secured by Caterpillar for its CATERPILLAR mark around the world;

15. Annex 2 of Mr. Hurst's Affidavit which is an original computer print-out of a table generated from Caterpillar's corporate database that lists in detail the various registrations secured by Caterpillar for its CAT mark around the world;
16. Annex 3 of Mr. Hurst's Affidavit which is an original computer print-out of a table generated from Caterpillar's corporate database that lists in detail the various registrations secured by Caterpillar for its CATERPILLAR & DESIGN mark around the world;
17. Annex 4 of Mr. Hurst's Affidavit which is an original computer print-out of a table generated from Caterpillar's corporate database that lists in detail the various registrations secured by Caterpillar for its CAT & DESIGN mark around the world;
18. Annex 5 of Mr. Hurst's Affidavit which is a compilation of various promotional materials, product catalogues, retail support materials, price lists and order forms used by Caterpillar for its various products, such as bags, beltbags, wallets, coin purses, belts, caps, shirts, jackets, socks, stuffed toys, juggling balls, colored pencils, pencil cases, watches, gloves, pocket knives, multi-tools, ear plugs, high-visibility vests, sunglasses, golf balls and tees, umbrellas, pins, soccer balls, baseballs, pumps, stationery, pens, flash drives, portfolios, calculators, lanyards, rings, playing cards, mugs, keychains, sports bottles, scale models and footwear;
19. Copy of the article entitled "*There's no business like shoe business*" written by Ching M. Alano and published in the Philippine Star on 8 November 1998;
20. Official Receipt No. 0245380 issued by the IPO in payment for securing certified true copies of Mr. Hurst's Affidavit; and
21. Certified true copy of the article entitled "*There's no business like shoe business*" written by Ching M. Alano and published in the Philippine Star on 8 November 1998.¹

The parties filed their Memorandum on 08 and 13 December 2010, respectively.

Should the Respondent-Applicant be allowed to register the trademark CATERPILLAR AND DESIGN?

The Opposer anchors its opposition on Section 4(d) of Republic Act No. 166, as amended, the law in force at the time the subject application was filed, which provides that:

Section 4. Registration of trademarks, trade names and service marks. - The owner of a trademark, trade name or service mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same, unless it:

x x x

(d) Consists of or comprises a mark or trade name which so resembles a mark or trade name registered in the Philippines or a mark or trade name previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers.

The above-quoted provision, however, must be taken in the light of the other provisions of the said Act. In this regard, Section 20 of R.A. 166, as amended, provides:

Section 20. Certificate of registration prima facie evidence of validity. - A certificate of registration of a mark or trade name shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark or trade name, and of the registrant's exclusive right to use the same in connection with the goods, business or services specified in the certificate, subject to any conditions and limitations stated therein.

The force and effect of Section 4(d) of R.A. 166, as amended, thus, is subject to the conditions under Section 20. Hence, Section 4(d) will apply only if the goods bearing the mark of the subsequent applicant for registration are covered by the Certificate of Registration of the prior registrant. In the same manner, said provision applies only if the goods bearing the mark of the subsequent applicant is the same as, or similar to, the goods of the prior user of the identical trademark.

In this regard, the competing marks are reproduced below for purposes of comparison, to wit:



Opposer's mark



Respondent-Applicant's mark

There is no doubt that the marks are identical in spelling and style, and if pronounced, would produce the same sound effect. The Opposer's Certificate of Registration however, covers "shoes, slippers, sandals and boots" under Class 25 while the goods indicated in the Respondent-Applicant's trademark application include "leather and imitation leather goods namely, wallets, credit card cases, business card cases, key holders, coin holders, briefcases, garments bags for travels, back packs, duffel bags, flight bags, tote bags, umbrellas, travelling bags, athletic bags, sport bags, book bags, should bags, purses" under Class 18. The goods covered by the Opposer's mark on one hand, and those of the Respondent-Applicant's do not belong to the same classification of goods and they are actually non-competing goods. However, they are deemed related because of physical attributes, characteristics of goods and channel of public availability which makes these goods derivative of each other.

Also, while it is true that the mark CATERPILAR has been previously registered and used in the Philippines, such prior use and registration pertains to the Respondent-Applicant itself. In fact, the Respondent-Applicant was able to present evidence of use which pre-dates the claimed date of first use (year 19992) of the mark by the Opposer. The Respondent-Applicant even obtained registration in Hong Kong for CATERPILLAR AND DESIGN as early as 1988 for goods under Class 25, including clothing, footwear and headgear. The prohibition under

just

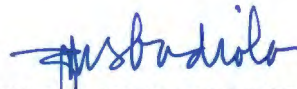
Section 4(d) of R.A. 166 applies only if the prior registrant or user is a party other than the Applicant.

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.⁴ This Bureau finds that the Respondent-Applicant's mark meets this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-1997-121938 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 07 JUL 2017



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

⁴ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.