



INTELLECTUAL PROPERTY  
OFFICE OF THE PHILIPPINES

**ALPARGATAS, S.A.,**  
Opposer,

-versus-

**SCOTT SHOE CO., INC.,**  
Respondent- Applicant.

X-----X

}  
} **IPC No. 14-2014-00220**  
} Opposition to:  
} Appln. Serial No. 4-2013-004993  
} Date Filed: 30 April 2013  
} **TM: "SCOTT HAWAII"**  
}

**NOTICE OF DECISION**

**VERA LAW**  
**(DEL ROSARIO RABOCA GONZALES & GRASPARIL)**  
Counsel for Opposer  
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5<sup>th</sup> Floor, SEDCCO I Building  
120 Rada corner Legaspi Streets  
Legaspi Village, Makati City

**GREETINGS:**

Please be informed that Decision No. 2017 - 360 dated October 23, 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, October 24, 2017.

*Marilyn F. Retutal*

**MARILYN F. RETUTAL**  
IPRS IV  
Bureau of Legal Affairs

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Decision No. 2017- 360

### DECISION

ALPARGATAS S.A.,<sup>1</sup> ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2013-004993. The application, filed by SCOTT SHOE CO., INC.<sup>2</sup> ("Respondent-Applicant") covers the mark **SCOTT HAWAII** for use on goods such as "*sandals, footwear*" under Class 25 of the International Classification of Goods.<sup>3</sup>

Opposer alleges that its mark HAVAIANAS is a well-known mark that must be afforded protection under prevailing laws and jurisprudence. Opposer also alleges that Respondent-Applicant's application should not be granted considering that the mark sought to be registered is confusingly similar, if not identical, to the well-known mark HAVAIANAS owned by it. According to Opposer, a comparison of the mark being applied for, more particularly, with the use of the word "HAWAII" and its well-known HAVAIANAS mark shows that they are confusingly similar with each other, hence, should not be registered.

Opposer's evidence consist of the following:

1. Application details for the trademark SCOTT HAWAII;
2. Legalized and authenticated Special Power of Attorney/Secretary's Certificate;
3. Certified copy of the authenticated Affidavit Direct Testimony of Bruna Michele Pereira;
4. Certified copy of the Schedule of Registrations and Application for the mark HAVAIANAS as attached in the Affidavit Direct Testimony of Ms. Pereira;
5. Representative samples of print advertisement of HAVAIANAS products;
6. Copies of the printouts of relevant pages from the website <http://www.havaianas.com>;
7. Copies of the printout of relevant pages of Havaianas website in the Philippines, <http://ph-en.havaianas.com/en-PH>; and
8. Copies of samples of articles featuring Havaianas products.

<sup>1</sup> A corporation organized and existing under the laws of Brazil with principal office at Rua Funchal, 160, Vila Olimpia 04551-903 Sao Paulo, Brazil.

<sup>2</sup> A limited liability company with principal office at 1212 Kona Street, Honolulu, Hawaii, U.S.A.

<sup>3</sup>The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

On 05 August 2014, this Bureau issued a Notice to Answer and served the same to Respondent-Applicant's counsel on 11 August 2014. After several motions for extension, Respondent-Applicant filed the Answer on 11 November 2014. On 21 November 2014, Opposer filed a Manifestation with Omnibus Motion praying that this Bureau expunged the Verified Answer for failure to attached proof of authority of the signatory in the verification. Respondent-Applicant filed its Counter-Manifestation with Opposition on 22 December 2014. On 10 February 2015, this Bureau directed the Respondent-Applicant to submit a Special Power of Attorney and/or Secretary's Certificate. On 25 February 2015, Respondent-Applicant filed a Motion for Extension of Time (to submit Special Power of Attorney and/or Secretary's Certificate). On 02 March 2015, Opposer filed a Motion to Declare Respondent-Applicant in Default. Another motion for extension of time was filed by Respondent-Applicant on 09 March 2015. Opposer filed its Comment on and/or Opposition and Reply to the Opposition to declare Respondent in default. On 07 April 2015, Respondent filed a Manifestation and Motion praying that the Secretary's Certificate dated 28 December 2012 be admitted as proof of authority of the signatory to sign the verification. An Opposition was filed on 06 May 2015. On 13 September 2017, this Bureau declared Respondent-Applicant in default for failure to complete the requirements under Section 10 of the Rules and Regulations on Inter Partes Proceedings.

Should the Respondent-Applicant's mark **SCOTT HAWAII** be registered?

Opposer anchors its opposition on Section 123.1 (d) and (e) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), as amended, which provides:

Section 123. *Registrability.* - 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 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;

Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, or resembles a well-known mark, said mark cannot be registered.

Records will show that at the time Respondent-Applicant filed its application for registration of the mark SCOTT HAWAII on 30 April 2013, Opposer already has an existing registration for the mark HAVAIANAS. As such, the certificate of registration in its name is a *prima facie evidence* of the validity of the registration, ownership of the mark and its exclusive right to use the mark in connection with the goods and/or services and those that are related thereto, pursuant to Section 138 of the IP Code.

But are the marks of the parties confusingly similar as to likely cause confusion, mistake or deception on the consumers?

The marks of the parties are herein reproduced:

**havaianas.**

Opposer's Marks

**SCOTT HAWAII**

Respondent-Applicant's Mark


A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademark pictured in their manner of display. Inspection should be undertaken from the viewpoint of the 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.<sup>4</sup> Thus, confusion is likely between marks only if their overall presentation as to sound, appearance or meaning would make it possible for consumers to believe that the goods or products, to which the marks are attached, comes from the same source or are connected or associated with each other.

In this case, a scrutiny of the marks of the parties would show that there is no similarity between the contending marks. Opposer's mark consists of the word HAVAIANAS written in stylized font. On the other hand, Respondent-Applicant's mark consists of the words SCOTT HAWAII written in plain uppercase letters. Clearly, there is no similar element that can be found in the two marks.

Further, this Bureau does not agree with the Opposer that Respondent-Applicant's mark is confusingly similar with its HAVAIANAS mark because of the presence of the word HAWAII. HAWAII is not similar with HAVAIANAS. They have different connotations that one cannot be confused with the other. Further, it must be emphasized that the word "HAWAII" has also been disclaimed by Respondent-Applicant. Since it has been disclaimed, Respondent-Applicant does not claim exclusive appropriation of the word HAWAII, but only to the exclusive use of the word SCOTT and how the composite mark appears as a whole. Thus, considering that Respondent-Applicant's mark is not confusingly similar, visually, aurally and conceptually, to Opposer's mark, there is no bar to its registration.

Aptly, 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

<sup>4</sup> *Etepha A.G. v. Director of Patents, G.R. No. L-20635, 31 March 1966.*

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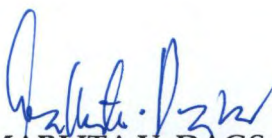
of an inferior and different article as his product. The mark of Respondent-Applicant meets this function.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is not prohibited by Sec. 123.1 (d) of the IP Code.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-004993 together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 23 OCT 2017.

  
**MARLITA V. DAGOSA**  
Adjudication Officer  
Bureau of Legal Affairs