



HAWK DESIGNS, INC.,
Opposer,

-versus-

VICTOR CHING,
Respondent-Applicant.

X-----X

IPC No. 14-2011-00347

Opposition to:

Appln. Serial No. 4-2011-000381

Date filed: 12 Jan. 2011

**TM: "HAWK KIDS AND REP. OF A
HAWK'S HEAD W/IN A CIRCLE
AND SEMI- ELLIPTICAL DESIGN"**

NOTICE OF DECISION

FEDERIS & ASSOCIATES LAW OFFICES

Counsel for the Opposer
2005 88 Corporate Center
141 Valero cor. Sedenos Sts. Salcedo Village
Makati City

VICTOR CHING

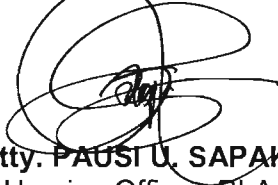
Respondent-Applicant
135 Sgt. Rivera Street
corner Banaue Street
Quezon City

GREETINGS:

Please be informed that Decision No. 2012 – 141 dated August 09, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 09, 2012.

For the Director:


Atty. PAUST U. SAPAK
Hearing Officer, BLA



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Decision No. 2012- 141

DECISION

HAWK DESIGNS, INC. ("Opposer")¹ filed on 06 September 2011 an opposition to Trademark Application Serial No. 4-2011-000381. The application, filed by VICTOR CHING ("Respondent-Applicant")², covers the mark "HAWK KIDS AND REPRESENTATION OF A HAWK'S HEAD WITHIN A CIRCLE AND SEMI-ELLIPTICAL DESIGN" for use on "*pants, shorts, jeans, t-shirts, briefs, jackets, suspenders, socks, slippers, shoes*" under Class 25 of the International Classification of goods.³

The Opposer alleges, among other things, that it is the prior applicant and user in the Philippines of the marks "HAWK", "TONY HAWK" and "HAWK HEAD DEVICE". It claims that its marks are well-known marks and protected under Sec. 123.1, pars. (e) and (f), of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines. Also, the Opposer points out that the mark HAWK is its company name which is protected under Sec. 165.2, pars. (a) and (b), of the IP Code. According to the Opposer, the registration of the Respondent-Applicant's applied mark will cause confusion and deception as to the origin, nature, quality, and characteristics of the goods on which it is affixed pursuant to Sec. 123.1(g) of the IP Code. Moreover, the registration will violate its proprietary rights and the Respondent-Applicant will unfairly profit commercially from the goodwill, fame and notoriety of the Opposer's marks causing the latter to incur damage and prejudice.

The Opposer's evidence consists of the following:

1. affidavit of Charles S. Exon, Executive Vice President of Hawk Designs, Inc.;
2. copy of Decision issued by the Intellectual Property Office of Taiwan ruling that the mark HAWK is confusingly similar to TONY HAWK;
3. affidavit of Amando S. Aumento, Jr., an Associate Lawyer of Federis & Associates Law Offices;
4. legalized Special Power of Attorney executed by the Opposer in favor of Federis & Associates Law Offices;

¹ A foreign corporation organized and existing under the laws of the U.S.A. with principal office at 15202 Graham Street, Huntington Beach, CA 92649, U.S.A.

² With address at 135 Sgt. Rivera Street, corner Banaue Street, Quezon City.

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.

5. certified true copies of Trademark Application Serial Nos. 4-2007-006691, 4-2007-006692, and 4-2010-001880;
6. affidavit of Sean Pence, Vice President and Assistant Secretary of Hawk Designs, Inc.;
7. certified true copies of trademark registrations for TONY HAWK or HAWK HEAD DEVICE in the United States ("U.S.") (No. 2299696 issued on 14 Dec. 1999 and No. 2931627 issued on 08 Mar. 2005), China (No. 3413808 issued on 21 Nov. 2004 and No. 3413806 issued on 14 Jan. 2005), Hong Kong (No. 200112874 issued on 20 Sept. 2001), India (No. 1297018 issued on 21 Feb. 2007), Indonesia (No. 494455 issued on 30 Nov. 2001), South Korea (No. 504852 issued on 29 Oct. 2001), Mauritius (No. 00813/2005 issued on 07 Nov. 2005); New Zealand (No. 663683 issued on 05 Jan. 2004), Singapore (No. T00/18097F issued on 03 Oct. 2000), South Africa (No. 2000/18719 issued on 06 Feb. 2007);
8. a database list of all trademark and service mark registrations and applications for the mark "TONY HAWK";
9. a certified true copy of a poster for the "HAWK European Tour" in 2007;
10. affidavit of Amando S. Aumento, Jr., an Associate Lawyer of Federis & Associates Law Offices;
11. legalized Special Power of Attorney executed by the Opposer in favor of Federis & Associates Law Offices;
12. printouts of the websites <http://www.quiksilver.com>, <http://tonyhawk.com> and <http://www.hawk-city.com>;
13. certified true copy of Trademark Application Nos. 4-2007-006691 for TONY HAWK covering goods in class 25 and 4-2007-006692 for HAWK HEAD AND DEVICE;
14. printout of internet websites where products bearing the mark TONY HAWK and/or HAWK HEAD DEVICE appear;
15. printout of relevant internet websites where the sports figure Tony Hawk is figured;
16. printout of the "Google page" showing the search results for the keywords TONY HAWK and HAWK CLOTHING; and
17. certified true copies of worldwide registrations for the mark TONY HAWK.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 17 November 2011. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant's trademark application be allowed?

It is emphasized that the essence of trademark registration is to give protection to the owner of trademarks. The function of a trademark is to point out distinctly the origin of 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 products.⁵ Thus, Section 123.1 (d) of the IP Code provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date in respect of the same goods or services or closely related goods and services, or if it is nearly resembles such a mark as to be likely to deceive or cause confusion.

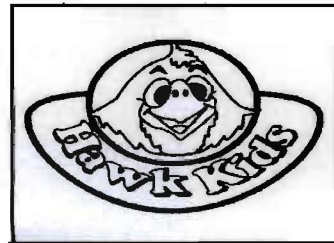
Records show that at the time the Respondent-Applicant filed his trademark application on 12 January 2011, the Opposer has an existing trademark application for the mark TONY HAWK

⁴ Marked as Exhibits "A" to "AA", inclusive.

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114509, 19 Nov. 1999.

(Serial No. 4-2010-001880). The goods covered by the said trademark application are similar and closely related to the goods indicated in the Respondent-Applicant's application, namely pants, shorts, jeans, jackets, socks, slippers and shoes under class 25. But, are the competing marks, as shown below, identical, or resemble each other such that confusion, mistake or deception is likely to occur?

TONY HAWK



Opposers Mark

Respondent-Applicant's Mark

The Respondent-Applicant appropriated the word "hawk" as part of his composite mark. When one looks at or describes the Respondent-Applicant's mark, what is impressed upon and retained in the mind is the word "hawk". Not only is the word "hawk" printed conspicuously in the Respondent-Applicant's mark, it is also the idea or concept that is represented by the figure above the words "Hawk Kids". In fact, the title of the mark is "HAWK KIDS AND REPRESENTATION OF A HAWK'S HEAD..." Hence, the word and/or the concept of a "hawk" is the feature in the Respondent-Applicant's mark that identifies the product and, supposedly, the origin thereof.

A scrutiny of the Opposer's mark also yields the same conclusion. While the mark is composed of two words, stress is on the word "HAWK". That word defines the character of the Opposer's mark as the "product-origin" identifier.

Aptly, because the mark applied for registration by the Respondent-Applicant covers goods that are similar and/or closely related to those bearing the Opposer's marks, confusion, mistake, or even deception is likely. In this regard, confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. The conclusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term.⁶

Moreover, it is also likely that the consumers will assume that the Respondent-Applicant's applied mark is just another variation of the Opposer's TONY HAWK mark. The consumers may also assume that the goods bearing the mark applied for registration by the Respondent-Applicant originated from or is connected with the Opposer, as the latter's line of goods for "kids" or children. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:⁷

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. Here, 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

⁶ *Continental Connector Corp., v. Continental Specialties Corp.*, 207 USPQ 60.

⁷ See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

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.

Significantly, this Bureau also takes cognizance via judicial notice of its Decision No. 2012-140, dated 31 July 2012, in Inter Partes Case No. 14-2011-00215, sustaining the opposition filed by Co Yee Lock and Robin K. Chan to the Respondent-Applicant's trademark application. The opposition was sustained because the Respondent-Applicant's mark is also confusingly similar to the Lock's and/or Chan's trademarks which are registered or applied for registration earlier than the filing date of the Respondent-Applicant's trademark application. As in this case, the Respondent-Applicant did not bother to explain or defend his trademark application in IPC No. 14-2011-00215.

Accordingly, this Bureau finds that the registration of the Respondent-Applicant's trademark application is proscribed by Sec.123.1 (d) of the IP Code. And, with these finding and conclusion, there is no need to pass upon the other issues raised by the Opposer.

WHEREFORE, premises considered, the opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-000381 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 09 August 2012.


ATTY. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs

