



WOLVERINE WORLDWIDE, INC.,
Opposer,

-versus-

METRO VALUE VENTURES INC.,
Respondent-Applicant.

X-----X

} IPC No. 14-2011-00412
} Opposition to:
} Appln. Serial No. 4-2011-0042330
} Date Filed: 13 April 2011
} TM: "PUPPIES"

NOTICE OF DECISION

HECHANOVA BUGAY & VILCHEZ

Counsel for Opposer
G/F Chemphil Building
851 Antonio Arnaiz Avenue
Makati City

SALUDO FERNANDEZ AND AQUINO (SAFA LAW)

Counsel for Respondent-Applicant
SAFA Building, 5858 Alfonso corner Fermina Streets
Poblacion, Makati City

GREETINGS:

Please be informed that Decision No. 2013 - 50 dated March 15, 2013 (copy enclosed)
was promulgated in the above entitled case.

Taguig City, March 15, 2013.

For the Director:

Edwin O. Dating
ATTY. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



WOLVERINE WORLDWIDE, INC.,
Opposer,

IPC No. 14-2011-00412
Case Filed : 08 November 2011

-versus-

Opposition to:
Appln. No. : 4-2011-004330
Date Filed: 13 April 2011

METRO VALUE VENTURES INC.,
Respondent-Applicant.

TM : "PUPPIES"

x-----x

Decision No. 2013- 50

DECISION

WOLVERINE WORLDWIDE, INC., ("Opposer")¹ filed on 08 November 2011 an opposition to Trademark Application Serial No. 4-2011-004330. The application, filed by METRO VALUE VENTURES, INC., ("Respondent-Applicant")², covers the mark "PUPPIES" for use on "garments" under class 25 of the International Classification of Goods and Services³.

The Opposer anchors its opposition on the ground that the registration of the mark "PUPPIES" in the name of the Respondent-Applicant will violate and contravene Sec. 123 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). According to the Opposer, PUPPIES is similar to the Opposer's registered mark "HUSH PUPPIES". To support its opposition the Opposer's submitted the following:

1. Exhibit "A" - Duly notarized affidavit direct testimony executed by Atty. Chrissie Ann L. Barredo;
2. Exhibits "B" to "B-11" - Printouts from the Opposer's corporate website;
3. Exhibits "C" to "C - 23" - Printouts from the Official Website of Opposer's "HUSH PUPPIES";
4. Exhibits "D" to "D - 8" - Opposer's Philippines Hush Puppies website and online store and printouts;
5. Exhibit "E" to "E - 1" - Screen captures took of the video;

¹ Is a corporation organized and existing under the laws of Delaware, with principal office address at 9341 Courtland Drive, N.E. Rockford, Michigan 49351, U.S.A.

² With given address at Metro Gaisano, Ayala Center, Cebu Business Park, Archbishop Reyes Avenue, Cebu 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.

1

6. Exhibits "E – 2" to "E – 3" - Hush Puppies print advertisements featuring Phil Younghusband as the model and endorser;
7. Exhibits "F" to "F – 28" - Printouts of the search results which show that Opposer's "HUSH PUPPIES" trademark is registered with the WIPO, OHIM, USPTO and ATMOSS;
8. Exhibits "G" to "G – 4" - Printouts from the IPO Phil website;
9. Exhibit "H" – Affidavit of Atty. Bautista;
10. Exhibit "I" with sub-markings - Affidavit of Editha Hechanova;
11. Exhibit "J" with sub-markings - Authenticated Affidavit-Direct Testimony of Mr. Timothy E. Foley; and
12. Exhibits "K" to "K – 6" - Special Power of Attorney duly notarized and authenticated.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 12 December 2011. However, the Respondent-Applicant did not file an Answer. Accordingly, the Hearing Officer issued on 10 July 2012 Order No. 2012-931 declaring the Respondent-Applicant in default.

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 the 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 products.⁴

In this regard, 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 or 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 its trademark application on 13 April 2011, the Opposer has already existing registrations for the mark "HUSH PUPPIES" which cover the goods indicated in the Respondent-Applicant's application, to wit:

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999



Registration No. 052341

Goods/Services 25 – shirts, t-shirts, blouses, jeans, pants, short pants, jogging pants, jackets, sweaters, socks, handkerchiefs, brief, undershirts and lounging robes.

HUSH PUPPIES

Registration No. 42001003927

Goods/Services 25 – men's, women's and children's clothing namely, pants, shorts, skirts, dresses. Knit tops namely, pullovers, sweatshirts and t-shirts, socks, outwear namely, jackets and coats; footwear namely, shoes, boots and sandals and other types of footwear; headgear namely, hats and caps.



Registration No. 42001003929

Goods/Services 25 – men's, women's and children's clothing namely, pants, shorts, skirts, dresses, knit tops namely, pullovers, sweatshirts and t-shirts, socks, outwear namely, jackets and coats.

Also, the mark applied for registration by the Respondent-Applicant is practically no different from the Opposer's as can be gleaned below:



Respondent-Applicant's Mark

HUSH PUPPIES

Opposer's Mark

The only difference between the marks is that the Respondent-Applicant removed from HUSH PUPPIES the word "HUSH". This notwithstanding, the marks are still visually and aurally similar.

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 ingenious 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 other⁵. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename 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 article⁶

Succinctly, because the Respondent-Applicant will use or uses the mark PUPPIES on goods that are similar and/or closely related to those covered by the Opposer's registered trademarks, the removal of the word HUSH did not diminish the likelihood of the occurrence of mistake, confusion, or even deception.

Moreover, HUSH PUPPIES as used by the Opposer is a unique and distinctive trademark. There is the likelihood that information, assessment, perception or impression about PUPPIES products may unfairly cast upon or attributed to the HUSH PUPPIES products and the Opposer, and *vice-versa*.

It is stressed that the determining factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purpose of

⁵ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 4 April 2001, 356 SCRA 207, 217.

⁶ Emerald Garment Manufacturing Corp., v. Court of Appeals. G.R. No. 100098, 29 Dec. 1995.

A handwritten signature or set of initials in blue ink, located in the bottom right corner of the page. The signature appears to be a stylized 'R' or similar character.

purpose of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it⁷. 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 Court⁸.

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 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 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.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-004330 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action

SO ORDERED.

Taguig City, 15 March 2013.


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

/Joanne/

⁷ American Wire and Cable Co. v. Director of Patents et.al. (31 SCRA 544) G.R. No. L-26557, 18 Feb. 1970.

⁸ Converse Rubber Corporation v. Universal Rubber Products, Inc., et.al. G.R. No. L-27906, 08 Jan. 1987.