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| **RICHARD TAN,** | } | **IPC No. 14-2012-00427** |
| Opposer, | } | Opposition to: |
| | } | Appln No. 4-2012-007213 |
| | } | Date Filed: 15 June 2012 |
| **-versus-** | } | **TM: HI HIPPO & DESIGN** |
| | } | **(silhouette of a Hippopotamus)** |
| | } | |
| **TAMSONS ENTERPRISES, INC.,** | } | |
| Respondent-Applicant. | } | |

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## NOTICE OF DECISION

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**GREETINGS:**

Please be informed that Decision No. 2015 - 203 dated September 28, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 28, 2015.

For the Director:

**Atty. EDWIN DANILO A. DATING**
Director III
Bureau of Legal Affairs

**RICHARD TAN,**
Opposer,

- versus -

**TAMSONS ENTERPRISES, INC.,**
Respondent-Applicant.
x---------- x

IPC No. 14-2012-00427
Opposition to:

Appln. No. 4-2012-007213
Date Filed: 15 June 2012
Trademark: **"Hi hippo & Design (silhouette of a Hippopotamus)"**

Decision No. 2015 - 203

# DECISION

RICHARD TAN ("Opposer"),[1] filed an opposition to Trademark Application Serial No. 4-2012-007213. The application, filed by TAMSONS ENTERPRISES, INC., ("Respondent-Applicant")[2], covers the mark "Hi hippo & Design (silhouette of a Hippopotamus)" for use on goods under class[3] 11 namely: *water faucets, taps and hand wash basins.*

The Opposer alleges the following:

"2. Opposer is the registered owner of the trademark 'HIPPO AND REPRESENTATION OF HIPPOPORAMUS' and variants thereof under the following registrations, namely:

2.1 Registration No. 4-1997-123547 for 'HIPPO AND REPRESENTATION OF H IPPOPOTAMUS' issued on May 21, 2004 for use on abrasive papers and sanding papers falling under Class 16.

2.2 Registration No. 4-2005-007690 for 'HIPPO AND DEVICE OF A HIPPOPOTAMUS IN SIDEVIEW WITH OPEN MOUTH' issued on March 26, 2007 for use on grinding wheel, cutting wheel; paint brush, paint roller, mini roller, baby roller, masking tape, self adhesive tape; electric tape, aluminum duct tape, Teflon tape, fiberglass mesh tape and double sided tape falling under Classes 8, 16, and 17.

2.3 Registration No. 4-2010-006083 for 'HIPPO AND DEVICE OF A HIPPOPOTAMUS' issued on November 26, 2010 for use on aluminum wire, aluminum screen, welded sire, G.I. sheet, door knob, lockset, padlock, handle, aluminum (angel type, u-type, tube type), nail screw, bolts & nuts of metal, tool boxes, welding rods of metal, window frames of metal, wire of common metal alloys, galvanized wire; brushes (except paint brushes); and polyethylene screens falling under Classes 6, 21, and 22.

2.4 The foregoing registrations are in force and effect.

2.5 In addition, opposer has a pending application, namely: Application SN 4-2012-011680 for 'HIPPO AND DEVICE OF A HIPPOPOTAMUS' for use on hose clamp, angle valve, gate, valve, ball valve, swing check valve, vertical check vale, foot valve,

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1 Filipino citizen with business and postal address at 40-C Sta. Catalina Street, Sta. Mesa Heights, Quezon City.
2 With business address at Room 303, SINGSON Building, Plaza Moraga, Binondo, Manila.
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.



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float valve, shower head, hand shower/telephone shower, bidet shower, floor strainer, pig drinker, hose nozzle, hose coupling, pvc faucet, tank titting; garden hose, flexible hose, bathroom mirror and bathroom cabinet falling under Classes 6, 7, 11, 17, 20 and 21.

"3. Opposer first used the trademark HIPPO & REPRESENTATIION OF A HIPPOPOTAMUS on January 15, 1996. Opposer had not abandoned the use of the trademark HIPPO AND REPRESENTATION OF A HIPPOPOTAMUS and variants thereof, as he uses them continuously up to the present.

"4. As further proof of his continuous use of this registered trademark HIPPO AND REPRESENTATION OF A HIPPOPOTAMUS and variants thereof, Opposer submits herewith representative sales invoices of his company, Richplus Distributor, Inc., as well as photographs of representative products bearing the trademark HIPPO AND REPRESENTATION OD A HIPPOPOTAMUS and variants thereof.

"5. Opposer has advertised his trademark, the latest of which was in the Souvenir Program of the Rotary Club of Metro Sta. Mesa dated 27 August 2012.

"6. Respondent-Applicant's mark 'Hi hippo & Design (silhouette of a Hippopotamus)' is confusingly similar to Opposer's registered trademark HIPPO AND REPRESENTATION OF A HIPPOPOTAMUS and variants thereof.

"7. The goods covered by Respondent-Applicant's application are identical to, and/or closely related to the goods covered by Opposer's registrations/application.

"8. The approval of Respondent-Applicant's application for the registration of the mark 'Hi hippo & Design (silhouette of a Hippopotamus)' is contrary to section 123.1(d) of Republic Act No. 8293.

"9. The approval of the application in question violates the rights of Opposer to the exclusive use of his registered trademark HIPPO AND REPRESENTATION OF A HIPPOPOTAMUS and variants thereof on the goods listed in his certificates of registration, as well as his right to extend the use and coverage of his registered trademarks to other related goods.

"10. Should the trademark 'Hi hippo & Design (silhouette of a Hippopotamus)' be registered in the name of Respondent-Applicant, the likelihood of confusion on the part of the consuming public with respect to the goods of the parties is bound to occur, as well as confusion of source, affiliation or connection.

"11. Opposer will be damaged by the registration of the trademark 'Hi hippo & Design (silhouette of a Hippopotamus)' in the name of Respondent-Applicants in that the use of said mark by Respondent-Applicant will prejudice the rights of Opposer over his registered trademark HIPO AND REPRESENTATION OF A HIPPOPOTAMUS and variants thereof; thereby, irreparably impairing and/or destroying the goodwill generated by him and his company over this registered trademark HIPPO AND REPRESENTATION OF A HIPPOPOTAMUS and variants thereof for the past seventeen (17) years."

The Opposer's evidence consists of the following:

1. Certified copy of Certificate of Registration No. 4-1997-123547 for HIPPO AND REPRESENTATION OF HIPPOPOTAMUS under Class 16;
2. Certified copy of Certificate of Registration No. 4-2005-007690 for HIPPO AND DEVICE OF A HIPPOPOTAMUS IN SIDEVIEW WITH OPEN MOUTH under Classes 8, 16 and 17;
3. Certified copy of Certificate of Registration No. 4-2010-006083 for HIPPO AND DEVICE OF A HIPPOPOTAMUS" under Classes 6, 21 and 22;

4. Duplicate original of Application SN 4-2012-011680 for HIPPO AND DEVICE OF A HIPPOPOTAMUS under Classes 6, 7, 11, 17, 20 and 21;
5. Certified copies of the Declarations of Actual Use;
6. Representative sales invoices of Richplus Distributor, Inc., photographs of representative products bearing the trademark HIPPO AND REPRESENTATION OF A HIPPOPOTAMUS and variants thereof;
7. 2012 General Information Sheet of Richplus Distributor Incorporated;
8. Souvenir Program of the Rotary Club of Metro Sta. Mesa dated 27 August 2012;
9. Print-out of Respondent-Applicant's mark as published in the e-Gazette last 03 September 2012; and,
10. Notarized affidavit of Richard Tan.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 07 December 2012. Respondent-Applicant however, did not file an answer. Thus, in Order No. 2013-506 dated 27 March 2013, Respondent-Applicant is declared in default and this case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark **Hi Hippo & Design (silhouette of a Hippopotamus)**?

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 at the time Respondent-Applicant filed its application for the trademark "Hi hippo & Design (silhouette of a Hippopotamus)" on 15 June 2012, herein Opposer already has the following registrations: Registration No. 4-1997-123547 for the mark HIPPO AND REPRESENTATION OF HIPPOPOTAMUS issued on 21 May 2004 under Class 16[5]; Registration No. 4-2005-007690 for the mark HIPPO AND DEVICE OF A HIPPOPOTAMUS IN SIDEVIEW WITH OPEN MOUTH issued on 26 March 2007 under Classes 8, 16 and 17[6]; Registration No. 4-2010-006083 issued on 26 November 2010 under Classes 06, 21 and 22[7]; and Registration No. 4-2012-011680 for the mark HIPPO AND DEVICE OF A HIPPOPOTAMUS issued on 27 June 2013 under Classes 6, 7, 11, 17, 20 and 21[8]. Under the law, 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.[9]

The competing marks are reproduced below for comparison and scrutiny:

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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).

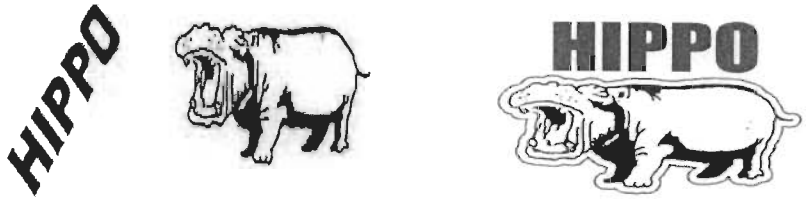
5 Exhibit "A" of Opposer.

6 Exhibit "B" of Opposer.

7 Exhibit "C" of Opposer.

8 Exhibit "D" of Opposer; IPOPhil Trademarks Database, available at http://www.wipo.int/branddb/ph/en/ (last accesses 21 September 2015).

9 Sec. 138, IP Code.




Opposer's Trademarks

Hi hippo

Respondent-Applicant's Trademark

The contending marks both contain the word "hippo" and the representation of a hippopotamus in variant displays. The word "hippo" obviously refers to the device representing a large herbivorous animal called "hippopotamus". While the word "Hi" preceding "hippo" in Respondent-Applicant's mark does not produce any significant distinction of the marks as to the appearance of the marks. Further, the contending marks cover similar and related goods, particularly that falling under class 11. Indeed, these goods are found in the same channels of business and trade and/or cater its products to the same segment of consumers.

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.[10] 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.[11]

Also, 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. 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:[12]

> Cullman 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

10 Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 200, 356 SCRA 207, 217.
11 Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.
12 Id.

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.

Thus, Sec. 123.1 (d) of the IP Code provides:

> A mark cannot be registered if it:
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> x x x
>
> (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;

Corollarily, 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, It is emphasized that the function of 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.[13]

In contrast, the Respondent-Applicant despite the opportunity given, failed to explain how it arrived at using the mark "Hi hippo & Design (silhouette of a Hippopotamus)" as it failed to file its Answer to the opposition.

**WHEREFORE,** premises considered, the instant Opposition to Trademark Application No. 4-2012-007213 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, 28 September 2015.

**Atty. NATHANIEL S. AREVALO**
*Director IV, Bureau of Legal Affairs*

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13 Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.