

VANS, INC.,  
Opposer,

-versus-

YANG ZHI TUO,  
Respondent- Applicant.

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}  
} **IPC No. 14-2014-00469**  
} Opposition to:  
} Appln. No. 4-2014-000761  
} Date Filed: 17 January 2014  
} **TM: "HAPPY ONE 1 OF THE**  
} **BEST"**

**NOTICE OF DECISION**

**BETITA CABILAO CASUELA SARMIENTO**  
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TECHNICAL SERVICES CO.**  
Respondent- Applicant's Agent  
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L13 B152 Barangay Greater Lagro  
Quezon City

**GREETINGS:**

Please be informed that Decision No. 2016 - 267 dated July 28, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 28, 2016.

For the Director:


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

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}IPC NO. 14-2014-00469  
}Opposition to:  
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}Application No. 4-2014-000761  
}Date filed : 17 January 2014  
}Trademark: HAPPY ONE 1  
} OF THE BEST  
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}Decision No. 2016 267

### DECISION

VANS, INC, (Opposer)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2014-0000761. The application, filed by YANG ZHI TUO (Respondent-Applicant)<sup>2</sup>, covers the mark “”, for use on “Clothing, footwear and headgear” under Class 25 of the International Classification of Goods<sup>3</sup>.

The Opposer relies on the following grounds in support of its Opposition:

"1. The registration of the opposed mark is contrary to the provisions of Sections 123.1 (d), (e) and (f) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ('IP Code'), as amended, which prohibit the registration that :

“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 with which is considered by the competent authority of the Philippines

<sup>1</sup> A corporation organized and existing under the laws of Delaware, United States of America with address at 6550 Katella Avenue, Cypress, California 90630


<sup>2</sup> With address at 3030 Agtarap St. F.B. Harrison, Pasay City


<sup>3</sup> The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the World Intellectual Property Office, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.



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 public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;"

(f) is identical with, or confusingly similar to, or constitutes a translation of, a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: *Provided*, That use of the mark in relation to those goods or services, would indicate a connection between those goods and services, and the owner of the registered mark; *Provided further*, That the interests of the owner of the registered mark are likely to be damaged by such use"

The Opposer, among other things, also alleges that:

"2. The Opposer is the owner of the well-known  and

 marks (collectively, Skateboard Logo Marks), among others, which are registered with the Philippine Intellectual Property Office ('IPO'). The registration details of the Skateboard Logo Marks appear below:

MARK	Registration No.	Registration Date	Classes
	4-2011-015284	22 Sept. 2012	9,14,18,25, 35,41
	4-2011-015290	7 June 2012	9, 14, 18, 25, 35, 41

"3. Respondent's mark is confusingly similar to the Opposer's Skateboard Logo marks as to be likely to deceive or cause confusion. A

side-by-side comparison of the marks will suffice to illustrate this point.  
xxx

"4. The Opposer is entitled to the benefits granted to foreign nationals under Section 3 of the IP Code, which provides:

Section 3. International Conventions or Reciprocity

Any person who is a national or is domiciled or has a real and effective industrial establishment in a country which is a party to any convention, treaty or agreement relating to intellectual property rights or repression of unfair competition, to which the Philippines is also a party, or extends reciprocal rights to national of the Philippines by law, shall be entitled to benefits to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of an intellectual property right is otherwise entitled under this Act.xxx

"5. The Opposer's Skateboard Logo marks are well-known and world famous. Hence, the registration of the Respondent's mark constitute a violation of Article 6bis of the Paris Convention in conjunction with Section 3, 123.1(e) and 123.1 (f) of the IP Code.

"6. Opposer has used the skateboard logo marks in the Philippines and elsewhere prior to the filing date of the Respondent's mark. xxx

"7. The Opposer has extensively promoted its marks, including the Skateboard Logo Marks, worldwide. Over the years, the Opposer has obtained significant exposure for the goods and services upon which the Skateboard Logo marks are used in various media, including television commercials, outdoor advertisements, internationally well-known print publications and other promotional activities.xxx"


The Opposer submitted as evidence the following:

1. Legalized and verified notice of opposition;
2. Affidavit of David Lin dated 21 November 2014;
3. Computer print-out of trademark details of Opposer's Skateboard Logo;
4. Special Power of Attorney signed by David Lin dated 4 November 2014;
5. Affidavit of Atty. Marites Surtida dated 19 December 2014 ; and
6. Affidavit of Marlon Gayamo dated 6 November 2014.<sup>4</sup>


This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 26 January 2015. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 13 August 2015 Order No. 2015-1160 declaring the Respondent-Applicant in default. The Opposer submitted his position paper on 14 September 2015.

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<sup>4</sup> Exhibit "A" to "G"

Should the Respondent-Applicant be allowed to register the trademark HAPPY ONE 1 OF THE BEST  ?

The records show that when the Respondent-Applicant filed the subject application on 17 January 2014, the Opposer already has a trademark registration, No. 4-

2011-015284<sup>5</sup> for the trademark  issued on 22 September 2012 covering goods, "clothing, namely shirts, sports shirts, T-shirts, shorts, jogging suits, sweatshirts, jackets, underwear, belts, (not made of leather or imitations of leather), socks and swimsuits, swimwear, pants, unitards, leotards, athletic bras, leggings, skirts, rainsuits, turtlenecks, vests, parkas, tights, dresses, athletic uniforms, gloves, underwear, thermal underwear, infantwear, coveralls, running suits, bibs, pajamas, footwear, namely shoes, sports shoes, lifestyle shoes, canvas shoes, skate shoes, boots, sneakers, slippers and sandals, and headwear, namely hats, beanies, bandannas, headbands and caps" under Class 25.

But are the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?



Opposer's mark



Respondent-Applicant's mark

At a glance, the competing marks closely resemble each other. That the Respondent-Applicant replaced the phrase "VANS OF THE WALL" with "HAPPY ONE 1 OF THE BEST", is of no moment. The over-all look of the marks render them confusingly similar. The resulting marks are visually similar with the same commercial appearance. Since the Opposer proved that its skateboard marks are promoted and advertised and marketed around the world,<sup>6</sup> there is a likelihood of confusion among the consumers who see the familiar skateboard mark applied to Respondent-Applicant's clothing products. The "skateboard mark" is so unique that consumers would hardly think that the marks are supposedly owned or used by different proprietors.

Succinctly, because the Respondent-Applicant uses its mark on goods that are related to the Opposer's it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

<sup>5</sup> Exhibit "F"


<sup>6</sup> Exhibits "G", "H", "I"

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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 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.<sup>7</sup>

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2014-000761 is hereby **SUSTAINED**. Let the filewrapper 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 JUL 2016

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

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<sup>7</sup>*Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.