

Title: **Mattel, Inc. vs. Jimmy A. Uy and the Intellectual Property Office**

Facts:

In 1991, Jimmy A. Uy (“Uy”) applied for the registration of the trademark “BARBIE” for confectionary products under Serial No. 78543 with the then Bureau of Patents, Trademarks and Technology Transfer (BPTTT). The application was published in 1993.

Mattel, Inc. (“Mattel”), a Delaware corporation owning the “Barbie” trademark for dolls and related products, opposed Uy’s application, arguing the trademarks were confusingly similar. Uy countered, asserting no confusion as the goods were non-competing. The case was initially handled by the BPTTT but transferred to the Intellectual Property Office (IPO) upon its creation following the enactment of Republic Act No. 8293 (Intellectual Property Code of the Philippines) in 1998.

After several years of legal back-and-forth, the IPO’s Bureau of Legal Affairs and later the Director-General sided with Uy, leading Mattel to seek review from the Court of Appeals (CA). The CA affirmed the IPO’s decision, leading Mattel to file a petition for review with the Supreme Court. Among the grounds Mattel raised were issues of trademark similarity, the IPO’s handling of Uy’s non-filing of a Declaration of Actual Use (DAU), and the claim that Uy intended to profit from Mattel’s trademark.

Uy argued his application was moot due to non-filing of the DAU, a point seemingly overlooked by the CA. The Supreme Court found this mootness critical to its decision.

Issues:

1. Whether confectionary products and dolls/accessories are sufficiently related to cause confusion with an identical trademark.
2. The relevance of the non-filing of a Declaration of Actual Use (DAU) and its impact on the trademark application.
3. Whether Uy’s adoption of the “BARBIE” trademark indicates an intention to capitalize on Mattel’s established trademark.
4. The treatment of trademark applications as “newly discovered evidence” in judicial proceedings.

Court’s Decision:

The Supreme Court dismissed Mattel’s petition, declaring the case moot and academic due

to Uy's admission of non-compliance with the DAU requirement. According to Philippine trademark law, failure to file a DAU results in the abandonment of a trademark application. This mooted any need to examine the contested issues, as Uy effectively relinquished any right to the trademark, obviating a conflict. The Court underscored that exercising judicial review requires an actual case or controversy, absent here due to the mootness induced by Uy's admission.

****Doctrine:****

1. Judicial Admissions - Parties are bound by their admissions, especially those that forfeit a right or interest, precluding the need for further judicial action if those admissions resolve the litigated matter.
2. Mootness - Courts refrain from determining cases that have become moot or academic, as judicial authority extends only to actual controversies needing resolution.

****Class Notes:****

- ****Trademark Similarity and Confusion****: To establish a claim of trademark infringement, the plaintiff must demonstrate that the similarities between the marks create a likelihood of confusion among consumers as to the origin of the goods.
- ****Declaration of Actual Use (DAU)****: A critical procedural requirement for maintaining a trademark application in the Philippines. Failure to file a DAU within the required timeframe leads to the application being deemed as abandoned.
- ****Mootness Doctrine****: A legal principle preventing courts from issuing judgments on matters where a resolution no longer affects the rights of the parties, often because intervening events have rendered the dispute irrelevant.
- ****Judicial Admission****: An explicit or implicit admission of fact made by a party in a legal proceeding, which is binding on the party making it and negates the need for evidence to prove the fact admitted.

****Historical Background:****

This case reflects the evolving nature of intellectual property law in the Philippines, particularly in response to the passage of the Intellectual Property Code (Republic Act No. 8293) and the establishment of the Intellectual Property Office. It illustrates the complexities of trademark law, especially concerning well-known global trademarks like "Barbie," and the challenges of applying these laws to differing categories of goods. The decision underscores the Philippine judiciary's deference to procedural requirements and

the principle of mootness in adjudicating disputes.