

HONDA MOTOR COMPANY, LTD.,	}	IPC NO. 14-2008-00071
<i>Opposer,</i>	}	Case Filed : 28 March 2008
	}	Opposition to:
	}	
- versus -	}	Appl'n Serial No.: 4-2007-000841
	}	Date Filed : 26 January 2007
	}	Trademark : "ASIMO"
	}	
PURGOLD PRICE CLUB, INC.,	}	
<i>Respondent-Applicant.</i>	}	
x-----x	}	Decision No. 2009-32

DECISION

This is an opposition to the registration of the mark "ASIMO" bearing Application No. 4-2007-000841 filed on January 26, 2007 covering the goods falling under class 30 of the International Classification of goods namely "coffee, tea, cocoa, sugar, rice tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces, (condiments); spices, ice" which application was published in the Intellectual Property Philippines (IPP) E-Gazette, officially released on November 29, 2007.

The Opposer in this opposition proceeding is "HONDA MOTORS COMPANY LTD." a corporation duly organized and existing under and by virtue of the laws of Japan, with business address at 1-1, Minami-Aoyama 2-Chome, Minato-ku, Tokyo 107-8556, Japan.

On the other hand, the Respondent-Applicant is "PUREGOLD PRICE CLUB, INC." with address at 3<sup>rd</sup> Floor Tabacalera Building, No. 900 D. Romualdez Street, Ermita, Manila.

The grounds of the opposition are as follows:

- "1. The trademark "ASIMO" being applied for by Respondent-Applicant is identical to Opposer's trademark, as to be likely, when applied to or used in connection with the goods of Respondent-Applicant, to cause confusion, mistake and deception on the part of the purchasing public.
- "2. The registration of the trademark "ASIMO" in the name of Respondent-Applicant will violate Section 123.1, subparagraphs (e) and (f), as well as Section 131.3 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, and Section 6bis and other provisions of the Paris Convention for the Protection of Industrial Property to which the Philippines and Japan are parties.
- "3. The registration and use of the trademark "ASIMO" in the name of Respondent-Applicant is contrary to other provisions of the Intellectual Property Code of the Philippines.
- "4. The registration of the trademark "ASIMO" in the name of Respondent-Applicant is contrary to other provisions of the Intellectual Property Code of the Philippines.

Opposer relied on the following facts to supports its opposition:

- "1. Opposer HONDA MOTORS CO., LTD., is the world's largest manufacturer and one of the leading automakers. With a global network

of 507 subsidiaries and affiliates, Opposer develops, manufactures and markets a wide a variety of products, ranging from small general-purpose engines and scooters to specialty sports cars, to earn the company an outstanding reputation from customers worldwide. Since its establishment in 1948, Honda Motor Co., Ltd., has remained on the leading edge by creating new value and providing products of the highest quality at a reasonable price, for worldwide customer satisfaction. In addition, the company has conducted its activities with a commitment to protecting the environment and enhancing safety in a mobile society.

- “2. Following in steps of its motorcycles, cars and power products, Opposer began the development of a two-legged humanoid robot that can walk. Opposer wanted to create a partner for people, a new kind of robot that functions in society. The main concept behind Opposer’s robot research and development was to create a more viable mobility that allows robots to help and live in harmony with people.
- “3. Hence, the creation of a humanoid robot named “ASIMO” which is an acronym for “Advance Step in Innovative Mobility”. Standing at 130 centimeters (4 feet 3 inches) and weighing 54 kilograms (119 pounds), the robot resembles a small astronaut wearing a backpack and can walk on two feet at speed up to 6km/h (3.7 mph). It is the current model in a line of eleven that began in 1986. As of 2007, there are 46 ASIMO units in existence.
- “4. Opposer is the owner of and/or applicant in many trademark registrations and/or applications of the trademark “ASIMO” around the world for goods and/or services under international classes 7, 9, 11, 12, 14, 16, 35 and 41, among others.
- “5. Opposer is the owner of multiple registrations for the mark ASIMO covering several classes in countries including China, Hong Kong, India, Indonesia, Korea, Macao, Malaysia, Russian Federation, Singapore, Switzerland, Taiwan, Thailand and Vietnam. We enclose herewith as Annex “A” and made an integral part hereof a list of trademark registrations for the mark ASIMO obtained by Opposer from said countries. In the very recent case of *Sehwani, Inc. and Benita’s Frites, Inc. vs. In-n-Out Burger, Inc.*, G.R. No. 171053, dated October 15, 2007, the Supreme Court declared the disputed mark therein as an internationally well-known mark on the basis of “*registrations in various countries around the world and its comprehensive advertisements therein*”. Pursuant to this pronouncement, the Opposer’s mark ASIMO which is registered in numerous countries around the world and advertised internationally is clearly an internationally well-known mark.
- “6. By virtue of Opposer’s prior application and/or registration and ownership of the trademark ASIMO around the world, said trademark has therefore become distinctive of Opposer’s goods and business. The fact that the mark ASIMO is registered in numerous countries and has been extensively used and advertised all over the world qualifies the same as an internationally well-known mark.
- “7. Under Section 123.1 (f) of the Intellectual Property Code of the Philippines, a mark cannot be registered if it is identical with or confusingly similar to a mark which is considered to be well-known internationally, whether or not it is registered in the Philippines, and which are used for identical or similar goods. Moreover, under Section 123.1 (e)

of the same Code, a mark cannot be registered even if it covers different goods, if the mark itself is identical with or confusingly similar to a well-known mark that has been registered in the Philippines.

- “8. Furthermore, Section 131.3 of the Code gives the owner/registrant of an internationally well-known mark the right to oppose the application for registration of any identical or confusingly similar mark, to wit:

“SEC. 131.3. x x x the owner of a well-known mark as defined in Section 123.1 (e) of this Act, that is not registered in the Philippines, may, against an identical or confusingly similar mark, oppose its registration, or petition the cancellation of its registration or sue for unfair competition, without prejudice to availing himself of other remedies provided for under the law.”

- “9. As early as in the leading case of *Ana L. Ang vs. Toribio Teodoro* (G.R. No. L-48226, December 14, 1942), the Supreme Court has judiciously pronounced that:

“x x x [T]here can be unfair competition or unfair trading even if the goods are non-competing, and that such unfair trading can cause injury or damage to the first user of a given trademark, first, by prevention of the natural expansion of his business and second, by having his business reputation confused with and put at the mercy of the second user. Then noncompetitive products are sold under the same mark, the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark created by its first user inevitably results. The original owner is entitled to the preservation of the valuable link between him and the public that has been created by his ingenuity and the merit of his wares or services. Experience has demonstrated that when a well-known trademark is adopted by another even for a totally different class of goods, it is done to get the benefit of the reputation and advertisements of the originator of said mark, to convey to the public a false impression of some supposed connection between the manufacturer of the article sold under the original mark and the new article being tendered to the public are the same or similar mark.

x x x

“x x x The mere relation or association of the articles is not controlling. As may readily be noted from what we have heretofore said, the proprietary connotation that a trademark or tradename has acquired is of more paramount consideration.” (Underscoring ours)

- “10. Respondent-Applicant’s mark ASIMO is identical to the world-famous mark ASIMO owned solely and exclusively by Opposer Honda Motor Co., Ltd. Both marks consist of the same letters placed in the same order. They are purely word marks in plain block letter and not stylized. Neither are in color nor compounded with a unique device or design. Hence, it cannot be denied that the subject application of Respondent-Applicant for

the trademark ASIMO, if allowed registration, will greatly prejudice Opposer and its business.

- “11. By adopting the identical mark ASIMO, for which Opposer is internationally known for, it is obvious that Respondent-Applicant’s intention is to “ride-on” the goodwill of Honda Motors Co., Ltd. and “pass-off” its goods as those of Honda Motors Co., Ltd.
- “12. A boundless choice of words, phrases and symbols are available to a person who wishes to have a trademark sufficient unto itself to distinguish his products from those of others. There is no reasonable explanation therefore for Respondent-Applicant to choose the mark ASIMO when the filed for its selection is so broad. Respondent-Applicant obviously intends to trade and its trading on Opposer’s goodwill.
- “13. The registration and use of the trademark ASIMO by Respondent-Applicant will deceive and/or confuse purchasers into believing that Respondent-Applicant’s goods and/or products bearing the identical trademark ASIMO emanate from or are under the sponsorship of Opposer Honda Motors Co., Ltd., applicant and/or owner/registrant of the trademark ASIMO all over the world. This will therefore diminish the distinctiveness and dilute the goodwill of Opposer’s trademark.
- “14. The allowance of Application Serial No. 4-2007-000841 in the name of Respondent-Applicant will likewise be in violation of the treaty obligations of the Philippines under the Paris Convention for the Protection of Industrial Property, to which the Philippines and Japan are member-states.
- “15. In the afore-quoted case of *Sehwani, Inc. and Benita’s Frites, Inc., vs. In-N-Out Burger, Inc.*, (G.R. No. 171053), the Supreme Court held that:

“Article 6bis which governs the protection of well-known trademarks, is a *self-executing provision and does not require legislative enactment to give it effect in the member country*. It may be applied directly by the tribunals and officials of each member country by the mere publication or proclamation of the Convention, after its ratification according to the public law of each state and the order for its execution. xxx”

x x x

“The fact that respondent’s mark are neither registered nor used in the Philippines is of no moment. The scope of protection initially afforded by Article 6bis of the Paris Convention has been expanded in the 1999 Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, wherein the World Intellectual Property Organization (WIPO) General Assembly and the Paris Union agreed to a nonbinding recommendations that *a well-known mark should be protected in a country even if the mark is neither registered nor used in that country.*”

Opposer submitted the following in support of its opposition.

Exhibit	Description
"A" to "A-14"	The duly notarized legalized affidavit testimony of the witness Mikio Yoshimi
"A-12-a"	Signature of Opposer's witness Mikio Yoshimi
"B"	Certified copy of Japanese Trademark Registration No. 4589893 for the mark ASIMO with English translation.
"C"	Certified copy of Japanese Trademark Registration No. 4497600 for the mark ASIMO with English translation.
"D"	Certified copy of Taiwan Trademark Registration No. 01255411 for the mark ASIMO
"E"	Certified copy of Macau Trademark Registration No. 022954 for the mark ASIMO.
"F"	Corporate profile of Honda Motors Co., Ltd.,
"G"	A catalogue showing goods bearing the mark ASIMO sold in Japan
"H"	Technical information brochure showing the details and specification of the robot ASIMO
"I"	Actual packaging of cookies bearing the mark ASIMO sold in Japan
"J"	Actual cookies bearing the mark ASIMO sold in Japan.

On the other hand, Respondent-Applicant failed to file its answer despite due notice.

Section 11 of the Summary Rules (Office Order No. 79, Series of 2005), provides:

Section 11. *Effect of failure to file an Answer.* – In case the Respondent-Applicant fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the Petition or Opposition, the affidavit of the witnesses and documentary evidence submitted by the Petitioner or Opposer.

The contending trademarks are reproduced below for comparison and scrutiny.



Opposer's mark



Respondent-Applicant's mark

It is observed that the competing trademarks are the same in *spelling*, *pronunciation* and as well in *meaning*. They are both written in capital letters, and consisting of three (3) syllables.

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of prospective buyer. The trademark complained should be compared and contrasted with the purchaser's memory (*not in juxtaposition*) of the trademark said to be infringed. (87 C.J.S. pp 288-291) Some such factors as sound; appearance; form, style shape, size or format;

color, idea connoted by the mark; the *meaning, spelling and pronunciation* of the words used; and the setting in which the words appear may be considered, (87 C.J.S. pp. 291-292) for indeed, trademark infringement is a form of unfair competition (Clark vs. Manila Candy Co., 36 Phil. 100, 106; Co Tiong Sa vs. Director of Patents, 95 Phil. 1, 4).

Confusion is likely between trademarks only if their over-all presentation in any of the particulars of sound, appearance or meaning are such as would lead the purchasing public into believing that the products to which the marks are applied emanated from the same source.

Considering therefore that the competing trademarks are confusingly similar to each other, the issue to be resolved is:

WHETHER OR NOT THE RESPONDENT-APPLICANT IS  
ENTITLED TO THE REGISTRATION OF THE MARK "ASIMO".

The applicable provision of the law is Section 123.1 (d) of Republic Act No. 8293, which provides:

Sec. 123. *Registrability* – 123.1 *A mark cannot be registered if it:*

- |      |   |   |
|------|---|---|
| x    | x   | x |
| “(d) | Is identical with a registered mark belonging to a different proprietor or 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;   |   |

Records of the case will show that the Opposer’s mark “ASIMO” has been registered in Japan, the country of origin under Registration No. 4497600 issued on *August 10, 2001* for the goods falling under classes 29, 30, 32, 33 and 35 of the International Classification of goods.

It is likewise further shown that the same mark “ASIMO” has been registered in other countries of the world, such as China, Taiwan and Macau.

The right to register trademarks, trade-names and service marks is based on ownership. Only the owner of the mark may apply for its registration (*Bert R. Bagano vs. Director of Patents, et. al., G.R. No. L-20170, August 10, 1965*) and *Unno Commercial Enterprises, Inc., vs. General Milling Corporation (120 SCRA 804)*.

It is worthy to note that the Respondent-Applicant “PUREGOLD PRICE CLUB, INC.” filed its trademark application for the mark “ASIMO” on January 26, 2007 and when published for opposition, however, Respondent-Applicant did not file its answer despite receipt of the Notice to Answer on April 29, 2008, hence, it failed to show/submit any proof of evidence showing ownership of the mark “ASIMO”. Under Section II of Office Order No. 79, Series of 2005, this case shall be decided on the basis of the Opposition, the affidavit of witnesses and the evidence of Opposer.

The Opposer submitted as proof of ownership over its mark “ASIMO” namely:

1. Certified copy of Japanese Trademark Registration No. 4589893 for the mark “ASIMO” with English translation (Exhibit “B”).

2. Certified copy of Japanese Trademark Registration No. 4497600 for the mark "ASIMO" with English translation (Exhibit "C"). The Certificate was issued on *August 10, 2001* covering the goods/classes 29, 30, 32, 33 and 35.

Another point to be taken into consideration is the statement of Opposer's witness "MIKIO YOSHIMI" to the effect that "Honda Motors Co., Ltd.," the Opposer, filed an application for the registration of the trademark "ASIMO" in the Philippines on March 13, 2007 for goods under classes 7, 9, 11, 12, 14, 16, 35 and 41 (Exhibit "A-6").

It is difficult to understand why Respondent-Applicant's mark adopted a mark identical to Opposer's mark "ASIMO" or to create its trademark "ASIMO" which is an exact replica of the Opposer's mark "ASIMO" compounded by the fact that the goods covered are likewise the same under class 30 of the International Classification of goods.

In the case at bar, the Opposer has been able to register its trademark "ASIMO" in its country of origin, Japan, way back in *August 10, 2001*, six (6) years prior to the filing of the Respondent-Applicant's trademark application. Therefore, it is very clear that the Opposer is the prior *adopter* and *user* of the mark "ASIMO".

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 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.

The basic requirement in trademark registration is that it is the owner of the mark who has the right to register it. It does not necessarily mean that the one who *first used* the mark in the Philippines is *ipso facto* the owner of the mark. In the instant case, the Opposer has submitted evidence that it has registered its trademark in its country of origin, Japan and likewise registered the same in other countries. Further, Opposer filed the registration of its mark "ASIMO" in the Philippines on March 13, 2007. With the circumstances above-mentioned, there is no doubt that the mark "ASIMO" has been appropriated by the Opposer before the Respondent-Applicant filed its trademark "ASIMO" being opposed.

With the evidence submitted by the Opposer, the burden of evidence is shifted to the Respondent-Applicant to show ownership of the mark. However, the said party did not introduce any evidence whatsoever, to overcome or contradict the Opposer's evidence of prior *appropriation* and *use*.

WITH ALL THE FOREGOING, the opposition is, as it is hereby SUSTAINED. Consequently, Application No. 4-2007-000841 filed on January 26, 2007 for the mark "ASIMO" by "PUREGOLD PRICE CLUB, INC." is, as it is hereby REJECTED.

Let the filewrapper of the trademark "ASIMO" subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 10 March 2009.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs  
Intellectual Property Office