

MIKASA SANGYO CO., LTD.,
Opposer,

INTER PARTES CASE NO. 1864

OPPOSITION TO,

- versus

Application Serial No. 42399
Filed : September 2, 1980
Applicant : Atendido Heavy
Industries, Inc.
Trademark : IGRI-MIKASA &
DEVICE
Used on : Construction equipment,
such as concrete vibrator, etc.

ATENDIDO HEAVY INDUSTRIES, INC.,
Respondent-Applicant.

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DECISION NO. 88-70 (TM)
August 9, 1988

DECISION

Mikasa Sangyo Co., Ltd., a Japanese corporation, filed a Notice of Opposition (Inter Partes Case No. 1864) to Application Serial No. 42399 for the trademark "IGRI-MIKASA & DEVICE" used on construction equipment (Class 7), which application was filed on September 2, 1980 by Atendido Heavy Industries, Inc., a domestic corporation, and published in the Official Gazette (Page 15 of Supplement to O.G., Vol. 80, No. No. 8) on February 20, 1984 and officially released on July 4, 1984.

Opposer alleged in its Opposition that Respondent-Applicant's Application Serial No. 42399 should be denied registration on the ground, among others, that registration thereof would violate Section 4(d) of Republic Act 166, as amended, and Articles 6bis and 8 of the Paris Convention for the Protection of Industrial Property.

For Failure to file an Answer, and upon Opposer's motion, Respondent-Applicant was declared in default. Accordingly, Opposer was allowed to present its evidence ex parte (Order No. 85-039).

The issue to be resolved is whether or not Respondent-Applicant's trademark "IGRI-MIKASA & DEVICE" is confusingly similar with Opposer's trademark "MIKASA & 3 DIAMOND DEVICE".

The evidence shows that Respondent-Applicant's trademark "IGRI MIKASA & DEVICE" is identical to Opposer's trademark "MIKASA & 3 DIAMOND DEVICE" in spelling, sound and appearance. The only difference is the word "IGRI" appended to the word "MIKASA" (Exhs. "D", "E", "L", "L-1", "L-2" and "M"). Both parties' goods belong to the same class (Class 7; see records of Application Serial No. 42399- Exh. "D") and therefore flow through the same channels of trade. Hence, there is factual basis to hold that Respondent-Applicant's trademark is confusingly similar with Opposer's trademark.

Respondent-Applicant may not appropriate Opposer's trademark in toto and avoid likelihood of confusion by adding the word "IGRI" thereto. Thus, in *Continental Connector Corp. vs. Continental Specialties Corp.*, 207 USPQ 60, it has been ruled that "Courts have repeatedly held that the confusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term". Examples: "MISS USA" and "MISS USA WORLD" (*Miss Universe, Inc. vs. Patricelli*, 161 USPQ 129); "GUCCI" and "GUCCI-GOO" (*Gucci Shops vs. R.H. Macy & Co.*, 446 F. Supp. 838); "COMFORT" and "FOOT COMFORT"

(Scholl, Inc. vs. Washington Mint, Inc., 176 USPQ 251) ; and “ACE” and “TEN-ACE” (Becton, Dickinson & Co. vs. Wigwam Mills, Inc., 199 USPQ 607).

Opposer’s trademark “MIKASA & 3 DIAMOND DEVICE” is registered in the United States of America, Australia and Korea (Exhs. “C-5”, “C-6”and “C-7”), used in the Philippines for almost 21 years (first used in the Philippines on September 7, 1967; Exhs. “D”, “E”, “F” and “F-1”), and Opposer participated in the “Japan Industrial Exposition” sponsored by the Tradefair Department of the Japan External Trade Organization from March 2 to 17, 1968 at the Loyola Center, Katipunan Road, Quezon City (Exhs. “H”, “H-1” and “H-2”). Therefore, Opposer deserves protection under Section 4(d), *ibid*.

WHEREFORE, the Opposition is GRANTED; Application Serial No. 42399 filed by Atendido Heavy Industries, Inc. is DENIED.

Let the records of this case be remanded to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director