

NEW CENTURY CITY MARKETING CORP.  
Opposer,

- versus -

PREMIUM PLASTIC GROUP  
MANUFACTURING CORP.  
Respondent-Applicant.  
x-----x

IPC No. 14-2008-00213  
Case Filed: 19 Sept. 2008  
Opposition to:  
Date Filed: May 20, 2008  
Appln. Serial No. 4-2008-005935  
Trademark: MAYAMA & DEVICE

Decision No. 2009-108

## DECISION

This pertains to the Notice of Opposition filed by NEW CENTURY CITY MARKETING CORPORATION (“Petitioner”) against Trademark Application Serial No. 42008005935 filed on May 20, 2008 for the trademark “MAYAMA and DEVICE” covering goods under Class 22 specifically for tarpaulin in the name of PREMIUM PLASTIC GROUP MANUFACTURING CORP. (“Respondent-Applicant”).

Opposer, New Century City Marketing Corporation, is a corporation organized and existing under the laws of the Republic of the Philippines with postal address at No. 78 Santiago St., Dalandanan, Valenzuela City and is herein represented by the law firm King Capuchino Tan & Associates.

Respondent-Applicant, Premium Plastic Group Manufacturing Inc., is another domestic corporation organized and existing under the laws of the Republic of the Philippines with stated address on record at Guevarra Marketing, 2496 Taft Avenue, Pasay City, and may be served with summons and other legal processes through its Counsel, The Law Firm of (Ret.) Judge J. Madayag & Associates, with office address at Suites 1905-1906 Raffles Corporate Tower, Emerald Avenue, Ortigas Business Center, Pasig City.

On 19 September 2008, Opposer filed with this Bureau a Verified Notice of Opposition against the subject trademark application in the name of Respondent-Applicant, Premium Plastic Group Manufacturing Corporation.

### The Antecedents

Opposer filed this instant Opposition based on the following grounds and factual circumstances.

“1. Opposer/Complainant is NEW CENTURY CITY MARKETING CORPORATION (hereinafter referred to as New Century), a corporation duly organized and existing under Philippine laws with postal address at No. 78 Santiago St., Dalandanan, Valenzuela City, herein represented by its General Manager, Mr. Johnny Sy. A copy of the Secretary’s Certificate authorizing Mr. Sy to file a case on behalf of the Corporation is hereto attached as Annex “A”.

“2. Respondent-Applicant, PREMIUM PLASTIC GROUP MFG. CORP. is also a corporation duly organized and existing under Philippine laws with address at No. 2496 Taft Ave., Pasay City.

“3. New Century is engaged in the business of supplying/selling PVC and plastic products, tarpaulin in particular, using the mark MAYAMA and DEVICE since December 2004. A copy of the mark is hereto attached as Annex “B” (hereinafter referred to as ‘The Mark”).

"4. The Mark was accorded application number 04-2005-002123. However, The Mark was an abandoned application due to failure to submit certain requirements. Said application was given the erroneous Nice Classification of 16, 18 and 24 despite clear indication of "tarpaulin" as one of the covered products. We attach hereto a copy of the said application with the corresponding Official Receipts for payment of filing fees as our Annexes "c" to "C-4".

"5. In September 25, 2006, New Century had again applied for the registration of The Mark and was accorded application number 04-2006-010642. The same was registered on February 18, 2008 with Registration Number 42006010642. We attach hereto copies of the application for registration and the print out from the IP web page indicating registration of mark as our Annexes "D" to "D-3" and "E".

"6. However, due to the inadvertence, the goods for the registered mark covered those falling under Nice Classification No. 12 covering "tires" of all sizes instead of "tarpaulin".

"7. New Century again had The Mark applied for trademark registration on May 26, 2008, this time, containing the correct entries and Nice Classification, 22. The same was accorded Application No. 4-2008-006157 by this Office. A copy of the application is hereto attached as Annexes "F" to "F-3".

"8. On July 9, 2008, New Century received a letter dated July 7, 2008 from the Law firm of (Ret.) Judge Madayag & Associates demanding New Century to cease and desist from using The Mark for being confusingly similar to its client's "MARUYAMA & DEVICE" and "MAYAMA and DEVICE" allegedly for registration by its client, herein Premium Plastic Group Mfg. Corp. A copy of the letter is hereto attached as Annexes "G" to "G-2".

"9. New Century through its former counsel replied to the letter and clarified its position. A copy of the letter is hereto attached as Annexes "H" to "H-1".

"10. On August 8, 2008, the mark MAYAMA and DEVICE (disputed mark) by Premium Plastic Group Mfg. Corp. accorded application serial number 42008005935 with filing date May 20, 2008 was published in the E-Gazette for Opposition.

"11. This opposition is being made because New Century will suffer irreparable damage if the disputed mark be allowed registration. New Century is an importer of tarpaulin products from China which is being sold in the Philippine market under the trademark "MAYAMA and DEVICE" (illustration of The Mark is earlier attached as our Annex B). The Mark was conceived and coined by New Century as early as 2004 and was introduced to the market as the trademark for the tarpaulin products being sold by New Century.

"12. The Mark has been in use by New Century since 2004. To show that this product has been in actual use and distributed in the market nationwide since 2004 we attach hereto the following pertinent documents, to wit:

12.1 "Copies of the delivery receipts of the product with the name "Mayama". The attached receipts contain the heading "JSH Marketing Ltd. Co.", this entry is a partnership that is owned by one of the stockholders and officers of New Century and is the marketing arm of the latter. Some of the receipts are hereto attached as our Annexes "I" to "I-29". The delivery receipt numbers below although when examined would reveal that the numbers for the year 2004 are higher than that of 2005, the reason for the same is because the personnel of New Century inadvertently got the wrong bundle for the year 2004.

12.2 "The affidavits executed by some of the customers of New Century namely Ever-Well Canvas & Gen. Merchandise, Megaflex Gen. Merchandise, Apollo Plastic Marketing Corp., and Victory Upholstery & Canvas Store stating that they were already purchasing from New Century the product bearing The Mark as early as 2004 as our Annexes "J" to "J-3

12.3 “Importation documents from the Bureau of Customs, Bill of Lading, and pro-forma invoice evidencing importation from China of the product bearing The Mark as our Annexes “K” to “K-2”.

“13. More importantly, The Mark has been applied for trademark registration in China as early as December 7, 2005. We attach hereto a copy of a certification from the China Business Patent Administration Office in favor of New Century as our Annex “L”. The Certificate as translated in English is attached hereto as our Annex “L-1”.

“14. Under Philippine law on trademark registration, a mark seeking registration cannot be registered if the same “is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of: (1) The same goods or services, or (ii) closely related goods or services, or (iii) if it nearly resembles such mark as to be likely to deceive or cause confusion OR “is identical or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of 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 knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark.”

“15. Under Philippine jurisprudence, enunciating the rule on Priority in Adoption and Use/ Exclusive Use, the Supreme Court ruled in the case of Chung Te vs. Ng Kian Giab, GR No. L-23791, Nov. 23, 1966 that the one who first used the mark is the one who is entitled to exclusively use and register the same.

“16. Also in Sy Ching vs. Gaw Liu G.R. No. L-29123, March 29, 1972 the higher court accorded registration rights to the user who has superior right in the trademark in view of “the chain of circumstances” favorable to him namely his “use thereof in commerce, and a “systematic preservation of the records to support his claim of continuous use, such as the making of the design, the printing of the design of the labels, the actual use on the goods, advertising in calendars and other acts of dominion, such as the filing of this petition for cancellation.

“17. The Mark having priority in use versus the Disputed Mark, the latter should be refused registration for being confusingly similar to The Mark.

The Notice to Answer dated September 29, 2008 with a copy of the Notice Opposition which directed Respondent-Applicant to file their Verified Answer within thirty (30) days from receipt of the subject notice. The Bureau received Respondent’s verified Answer on December 05, 2008.

In their Answer, Applicant interposed the following denials and admission:

- a. “Respondent-Applicant specifically denies paragraphs 1, 3, 4, 5, 6, 7, 11, 12, 12.1, 12.2, 12.3, and 13 for lack of knowledge or information sufficient to form a belief as to the truth or falsity thereof.
- b. “Respondent-Applicant admits paragraph 2, 8, 9 and 10 of the Opposition.
- c. “Respondent-Applicant denies paragraphs 14, 15, 16 and 17 for being mere conclusions of law and for reasons more specifically stated under the special and affirmative defenses.

and by way of Special and Affirmative defenses stated the following, to wit:

- d. "Opposer has neither legal nor factual basis of its claim that it will be damaged by the approval of the application or registration of the mark MAYAMA and DEVICE bearing Application Serial No. 42008005935 filed on 20 May 2008.
- e. "On 06 April 2001, the Intellectual Property Office or IPO issued Trademark Certificate of Registration No. 4-1996-115046 for the trademark MARUYAMA & DEVICE (the device consists of a gun-sight within an open circle) covering goods under Class 22 specifically for tarpaulin. The original applicant was Uni-Lonseal Plastics, Inc. A certified true copy of the Certificate of Trademark Registration is hereto attached and made an integral part hereof as Exhibit "A".
- f. "On 31 March 2008, the aforecited MARUYAMA & DEVICE trademark was assigned by Uni-Lonseal Plastics, Inc. to Respondent-Applicant Premium Plastic Group Mfg., Inc. Evidencing such recordal is the issuance of Certificate of Trademark Registration bearing the name of herein Respondent-Applicant, Premium Plastic Group Mfg., Inc. as Assignee therein and an original copy of the Deed of Assignment is hereto attached and made part hereof as Exhibit "B" & "B-1".
- g. "Respondent-Applicant conceptualized the subject mark MAYAMA and DEVICE hereby designated as M2, using the trademark MARUYAMA AND DEVICE hereby designated as M1, as its model, creating a replica or derivative of MARUYAMA & DEVICE minus the letters "R" and "U". Even the device was derived from the gun-sight logo/device of MARUYAMA & DEVICE. Shown side-by-side below are representations of these Citer: marks:



M1



M2

The mark MAYAMA and DEVICE copied exactly the printing style of the trademark MARUYAMA & DEVICE, likewise it positioned a substantially similar gunsight device above the word MAYAMA. Same device of a gunsight within an open circle is used except that in the mark MAYAMA and DEVICE, it opted for a closed circle.

- h. "The goods covered by Respondent-Applicant's MAYAMA and DEVICE are exactly the same as the goods covered by the trademark MARUYAMA & DEVICE, these are tarpaulin falling under Class 22.
- i. "The fact that Respondent's MARUYAMA AND DEVICE is registered, used, and continuously exists in trade, this Office should not have issued the Certificate of Registration for MAYAMA and DEVICE bearing Registration No. 42006010642 in favor of Opposer, New Century City Marketing Corp., bad faith is evident when it applied a substantially similar mark MAYAMA and DEVICE as a later applicant. The marks are shown below exactly as it appears in the small facsimiles or in the records as contained in Registration No. 41996115046 and Registration No. 42006010642 for Respondent's MARUYAMA AND DEVICE and Opposer's MAYAMA and DEVICE respectively, in gross violation of Section 123.1 of R.A. 8293, to wit:



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“Section 123.1 (d) of the Intellectual Property Code (R.A. 8293) prohibits the registration of a mark that: 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.

“There is no denying that Respondent-Applicant is the prior adopter and registrant of the marks involved. Respondent-Applicant has been using MARUYAMA AND DEVICE for the sale, marketing and distribution of tarpaulins since 1996 when it applied for registration of the mark MARUYAMA AND DEVICE. The more than two (2) decades of exclusive and uninterrupted use of MARUYAMA AND DEVICE has already earned for Respondent-Applicant immense and valuable goodwill in the retail business, attached hereto and made integral part hereof is a certified true copy of the Affidavit of Use as Exhibit “C”. The trademark MARUYAMA AND DEVICE with reference to tarpaulins has become distinctive of the business and/or goods of Respondent-Applicant.

“Recently, in order to maintain its goodwill in the market, the Respondent-Applicant engaged one of the most prominent TV/Movie celebrity- Cesar Montano to endorse its product which includes Maruyama Tarpaulin. Attached hereto and made an integral part hereof as Exhibits “D”, “D-1” and “D- 2” are the newspaper clippings announcing the contract signing of the Product Endorsement by Movie Celebrity - Cesar Montano, and his 2009 posters and calendars to be distributed nationwide, respectively.

- j. “Moreover, MARUYAMA is a coined, fanciful or made-up word, it is not one that would naturally occur for Opposer to create and/or conceptualize since it is not generic, a common word or a word found in the dictionary. To allow substantially similar marks to co-exist in the business will lead to confusion in trade and eventually damage Respondent’s business reputation as a known seller and/or distributor of quality tarpaulins carrying either the mark MARUYAMA AND DEVICE or the shortened version, which is MAYAMA and DEVICE mark. There is possibility or greater likelihood of mistaking or associating Opposer’s goods with the mark MAYAMA and DEVICE to be Respondent-Applicant’s MARUYAMA AND DEVICE or MAYAMA and DEVICE tarpaulins because of the close resemblance of the marks involved as applied to identical goods.
- k. “It is not Opposer but Respondent-Applicant therefore who will suffer irreparable damage if Respondent-Applicant’s MAYAMA and DEVICE will be refused registration. Between Opposer’s MAYAMA and DEVICE and Respondent’s MAYAMA and DEVICE, it is the latter who has its root, deriving its concept from the wisdom and concept of MARUYAMA AND DEVICE. Respondent’s MAYAMA and DEVICE, subject of this instant suit, is a shortened version of MARUYAMA AND DEVICE as it is accepted or is common practice nowadays in the retail business to adopt a shortened version of trademarks such as A/X for Armani Exchange, GIO for Giordano and the local BNY for Bunny.
- l. “For Opposer’s part, a factual basis is wanting to substantiate its claim of ownership over MAYAMA and DEVICE mark as applied to tarpaulins, to explain to this forum how it coined or conceptualized this trademark when there exists in the market a prior and substantially similar registered trademark, MARUYAMA AND DEVICE. Being the owner and prior user of MARUYAMA AND DEVICE since 1985, Respondent-Applicant has exclusive, vested and superior rights over MARUYAMA AND DEVICE and any variation thereof, including the adoption of a shortened version of the mark such as MAYAMA and DEVICE. Hence, any pretensions of Opposer that he owns the trademark MAYAMA and DEVICE are absolutely without basis.

- m. "The law on trademarks and tradenames is based on the principle of business integrity and common justice. This law, both in letter and spirit, is laid upon the premise that, while it encourages fair trade in every way and aims to foster, and not to hamper, competition, no one, especially a trader, is justified in damaging or jeopardizing another's business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built up by another" (Baltimore v. Moses, 182 Md 229, 34 A (2d) 338).
- n. "The choice by Opposer of exactly the same or substantially similar mark MAYAMA and DEVICE when there is prior MARUYAMA AND DEVICE trademark in trade which is owned, used and not abandoned by Respondent-Applicant and in fact through its exclusive and continuous use, it has established for Respondent-Applicant valuable goodwill and reputation in the tarpaulin business, provides a vacuum for Opposer's side to explain, considering that Opposer's act is hardly a result of coincidence. In the case of Shangri-La vs. Developers Group of Companies, G.R. No. 159938, March 31, 2006, the Supreme Court held that:

"When a trademark copycat adopts the word portion of another's trademark as his own, there may still be some doubt that the adoption is intentional. But if he copies not only the word but also the word's exact font and lettering style and in addition, he copies also the logo portion of the trademark, the slightest doubt vanishes. It is then replaced by the certainty that the adoption was deliberate, malicious and in bad faith."

- o. "More importantly, Opposer's registered MAYAMA and DEVICE pertains to tires (all sizes) under Class 12, not tarpaulin as claimed by Opposer. Nowhere in the registration mentioned that the trademark likewise includes goods under Class 22, particularly for tarpaulin. We find the case of Faberge Incorporated vs. Intermediate Appellate Court, et. al., G.R. No. 71189, November 04, 1992, relevant at this point, the Supreme Court ruled, thus: "In short, paraphrasing Section 20 of the Trademark Law as applied to the documentary evidence adduced by petitioner, the certificate of registration issued by the Director of Patents can confer upon petitioner the exclusive right to use its own symbol only to those goods specified in the certificate, subject to any conditions and limitations stated therein." Opposer's justification that it has originally applied for goods under Class 22, particularly for tarpaulin as evidenced by an abandoned application has no stand or persuasive effect under the law, given the factual circumstances and evidence adduced by herein Respondent.
- p. "Respondent-Applicant attaches as Exhibit "E" the Affidavit of Mr. Nelson Guevarra, President of Premium Plastic Group Manufacturing Corp. to substantiate its claim and defense/s in this Opposition and allow the registration of MAYAMA and DEVICE in the name of Respondent-Applicant Premium Plastic Group Manufacturing Corp. for goods falling under Class 22, specifically for tarpaulin.

In support of Opposer's claim, the following evidences were filed and submitted: (1) Secretary's Certificate authorizing Mr. Sy to file a case in behalf of the corporation (Annex "A"); (2) Copy of the mark MAYAMA and DEVICE (Annex "B"); (3) Copy of application number 04-2005-002123 (Annexes "c" to "C-4"); (4) Copies of the application for registration which was accorded Registration Number 4200601 0642 for The Mark and the print out from the IP web page indicating registration of the mark (Annexes "D" to "D-3" and "E"); (5) Copy of Application No. 4-2008-006157 (Annexes "F" to "F-3"); (6) Copy of the letter from the Law firm of (Ret.) Judge Madayag & Associates demanding Opposer to cease and desist from using The Mark (Annexes "G" to "G-2"); (7) Reply of Opposer's counsel to the letter from the law firm of (Ret.) Judge Madayag & Associates (Annexes "H" to "H-1 "); (8) Delivery receipts of Opposer's product with the name "Mayama" (Annexes "I" to "I-29"); (9) Affidavits executed by some of the customers of New Century (Annexes "J" to "J-3"); (10) Importation documents from the Bureau of Customs, Bill of Lading, and pro-forma invoice evidencing importation from China of the product

bearing The Mark (Annexes "K" to "K-2"); and (11) Copy of a certification from the China Business Patent Administration Office (Annex "L" and "L-1").

The following evidences were filed in support of Respondent-Applicant's claim and defenses: (a) Certified true copy of the Certificate of Trademark Registration for MARUYAMA & DEVICE (Exhibit "A"); (b) Copy of the Cert. of Trademark Registration bearing the name of Applicant as Assignee and original copy of the Deed of Assignment (Exhibits "B" & "B-1"); (c) Certified true copy of the Affidavit of Use (Exhibit "C"); (d) Newspaper clippings announcing the contract signing of the product endorsement by Cesar Montano and 2009 posters and calendars (Exhibits "D", "D-1" and "D-2"); and (e) Affidavit of Mr. Nelson Guevarra (Exhibit "E").

#### The Issue

The basic issue submitted for consideration of this Bureau is:

Whether or not Respondent-Applicant's "MAYAMA & DEVICE" under Application Serial No. 42008005935 covering goods under Class 22 should be granted registration.

#### The Ruling of this Bureau

After carefully considering, examining and thoroughly evaluating the evidences and pertinent records at hand, this Bureau resolved to deny this opposition and sustain Applicant's property rights to the exclusive use of the mark MAYAMA & DEVICE for tarpaulin products falling under Class 22.

Opposer filed its application to register the mark MAYAMA & DEVICE on September 25, 2006 for tires (all sizes) under Class 12 and was accorded a status of 'deemed registered' (Annex "E", Opposer) as of February 18, 2008 by the Intellectual Property Office (IPO). Respondent-Applicant applied for the registration of the mark MARUYAMA & DEVICE (Exhibit "C", Respondent-Applicant) on 24 October 1996, or ten (10) years before Opposer filed for registration of similar mark MAYAMA & DEVICE for the same or identical goods. It ripened into registration on April 06, 2001. Notwithstanding the prior application and registration of Respondent's mark MARUYAMA & DEVICE (THE DEVICE CONSISTS OF A GUN-SIGHT WITHIN AN OPEN CIRCLE) or MARUYAMA & DEVICE or MARUYAMA brand for brevity, were the evidences sufficient to prove confusing similarity in both trademarks?

Evidence on record showed that Uni-Lonseal, Inc. applied for the trademark MARUYAMA & DEVICE in 1996. By virtue of an assignment (Exhibit "B-1", Respondent-Applicant) executed between Uni-Lonseal, Inc. and Respondent-Applicant, Premium Plastic Group Mfg. Corp., Applicant became the registered owner and acquired rights over the trademark MARUYAMA & DEVICE. From the time of acquisition by Applicant of the rights over the trademark MARUYAMA & DEVICE, it has introduced in the market another brand, a variation or modification to its original trademark MARUYAMA & DEVICE, causing the subject application to be filed on 20 May 2008 for the registration of the mark MAYAMA & DEVICE. The subject mark is to be used on or applied to identical goods covered under its original trademark, MARUYAMA & DEVICE. Applicant describes the mark as "the mark consists of the word mayama in stylized font and a device consisting of two (2) concentric circles wherein two (2) vertical lines connects the outer and inner circles".

Opposer, for its part, applied a substantially similar mark MAYAMA & DEVICE in 2006 to cover different goods, as it is written in the trademark application under the portion of what goods or services to cover, is plain and simple TIRES (OF ALL SIZES) (Annex "D-1", Opposer), it was originally intended to include tarpaulin, but the probability of having it registered is quite nil as it will run counter to the registrability requirement under the IP Code, specifically Section 123.1 (d) of R.A. 8293, which provides, to wit:

"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 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; x x x

As it is, not just confusion, but deception is likely to happen with the marks below coexisting in the market:



Respondent's MARUYAMA & DEVICE  
Registration No. 41996115046  
Date of Application: 10/24/1996



Opposer's MAYAMA and DEVICE  
Registration No. 42006010642  
Date of Application: 9/25/2006

As can be gleaned from a side-by-side comparison of the above marks is the obvious similarity in both the word and logo used. The most likely source of the font used by Opposer for his mark MAYAMA & DEVICE is Respondent's original trademark, MARUYAMA & DEVICE. Not just the printing style bears a striking resemblance to Respondent's MARUYAMA brand, worth noting is how the logo should appear and how it is placed and positioned with the logo appearing atop the word mark was appropriated in bad faith. The manner how Opposer's logo was to be drawn and to appear is meant to maliciously copy Respondent's trademark. The inescapable conclusion given the foregoing factual milieu is that Opposer clearly intends to freely ride on the popularity and unfairly benefit from the goodwill of Respondent's MARUYAMA & DEVICE trademark. The Supreme Court in the case of Shangri-La vs. Developers Group of Companies, G.R. No. 159938, March 31, 2006, made this pronouncement when confronted with similar issue/s and circumstances:

“When a trademark copycat adopts the word portion of another's trademark as his own, there may still be some doubt that the adoption is intentional. But if he copies not only the word but also the word's exact font and lettering style and in addition, he copies also the logo portion of the trademark, the slightest doubt vanishes. It is then replaced by the certainty that the adoption was deliberate, malicious and in bad faith.”  
(Emphasis supplied)

Through long, continued and exclusive use of the MARUYAMA brand since 1996, it is but normal for a proprietor in the business to expand, conceptualize and offer a different brand, be it a shortened version or significantly different in all attributes vis-a-vis the original brand. Thus, the registration of the mark MAYAMA & DEVICE came to the picture and is now the subject of the instant opposition. Confusion is unlikely because it was appropriated by the same owner and association between the two marks is what it purports to establish and no other. However, for the same mark MAYAMA & DEVICE to be appropriated by another proprietor, Opposer herein, for identical goods is likely to mislead the public, particularly as to the nature, quality, characteristics and origin of said goods, it may likewise mislead the public into believing that Opposer's goods are produced by or are under the sponsorship of Respondent-Applicant. And why from a million words and designs to create and conceptualize, why would Opposer choose a composite mark that is not just confusingly similar but identical to the one already appropriated by Respondent-Applicant if there was no unmistakable intention to imitate? Similarly, in a long line of cases, the Supreme Court held that:



“Those who desire to distinguish their goods from the goods of another have a broad field from which to select a trademark for their wares and there is no such poverty in the English language or paucity of signs, symbols, numerals etc. as to justify one who really wishes to distinguish his product from the other entering the twilight zone of or field already appropriated by another (Weco Products Co., Milton Ray Co., 143 F. 2d. 985, 32 C.C.P.A. Patents 1214).

“why of the millions of terms and combinations of letters and designs available, the appellee had to choose those so closely similar to another’s trademark if there was no intent to take advantage of the goodwill generated by the other mark” (American Wire & Cable Co., vs. Dir. of Patents 31 SCRA 544)

“ xxx why, with all the birds in the air, and all fishes in the sea, and all the animals on the face of the earth to choose from, the defendant company (Manila Candy Co.) elected two roosters as its trademark. Although its directors and managers must have been well aware of the long continued use of a rooster by the plaintiff with the sale and achievement of its goods? x x x a cat, a dog, a carabao a shark, or an eagle stamped upon the container in which candies are sold would serve as well as rooster for the product of defendants factory. Why did defendant select two roosters as its trademark? (Clarke vs. Manila Candy Co., 36 Phil 100).” Opposer’s MAYAMA & DEVICE is an exact representation of Respondent’s MARUYAMA brand. Both Opposer and Respondent-Applicant’s marks are derivatives of Respondent’s MARUYAMA brand, presented in this wise:



Therefore, between Opposer and Respondent-Applicant, the latter provided valid and plausible reason why it appropriated, adopted and used the mark MAYAMA & DEVICE simply that it is the shortened version to Respondent’s original MARUYAMA &

DEVICE trademark, to be applied on the same and identical goods as MARUYAMA’s tarpaulins. For Opposer’s part, it had the occasion to give their version or explanation as to why it adopted the mark MAYAMA & DEVICE. In their position paper filed on May 22, 2009, they claimed that:

“x x x The word was derived from the word “mayaman” which pertains to “rich” in the vernacular, only removing the letter “n” at the end, and the device is a representation of Chinese money in the olden times that has a hole in the center. x x x

This Bureau finds this explanation of how Opposer had coined the mark MAYAMA & DEVICE to be not credible and illogical considering that your device is a representation of a Chinese money and yet the letter “N” was intentionally deleted when it should have been maintained to give meaning to the device. Simply put, it doesn’t make sense at all, off-tangent as it is, but only reinforced Respondent’s claim that Opposer indeed appropriated the mark in bad faith, that Opposer’s pretension that he owns the subject mark is without basis.

Records further showed that Respondent-Applicant undertook extensive advertising and marketing activities and spent considerable amounts for the promotion of its MARUYAMA & DEVICE mark. Respondent-Applicant, for example, engaged the services of actor Mr. Cesar Montano to endorse its tarpaulin products bearing the trademark MARUYAMA & DEVICE. Samples of these advertising materials are newspaper clippings, posters and calendars (Exhibits "D" to "D-2", Respondent-Applicant).

True enough, as per Opposer's posture and observation that the core of the issue here is the determination of whether or not to reject or give due course to Respondent's application for the mark MAYAMA & DEVICE to be applied and used for tarpaulins, given the existence of Opposer's MAYAMA & DEVICE as applied to tires (of all sizes). Opposer's goods, per his Registration Certificate (Annex "E", Opposer), are limited to TIRES (OF ALL SIZES) under Class 12 as specified under the goods covered. On the other hand, Respondent's application for the same mark indicated the goods to fall under Class 22, specifically for tarpaulins. At this juncture, emphasis is placed on Section 20 of the old Trademark Law or Art. 138 of R.A. 8293, which is the pertinent provision to resolve this point, thus:

"SECTION 20. Certificate of registration prima facie evidence of validity. -A certificate of registration of a mark or trade-name shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark or trade-name, and of the registrant's exclusive right to use the same in connection with the goods, business or services specified in the certificate, subject to any conditions and limitations stated therein. "

Likewise in the case of Faberge, Incorporated vs. Intermediate Appellate Court, et al, G.R. No. 71189, November 04, 1992, the Supreme Court restated the aforementioned section to the effect that:

"In short, paraphrasing Section 20 of the Trademark Law as applied to the documentary evidence adduced by petitioner, the certificate of registration issued by the Director of Patents can confer upon petitioner the exclusive right to use its own symbol only to those goods specified in the certificate, subject to any conditions and limitations stated therein."

In some cases, the Supreme Court allowed the existence of identical marks as applied to related goods, how much more for this instant opposition that despite the similarity of the marks involved, the goods are entirely different, tarpaulins (Class 22) vis-a-vis tires (Class 12). The case of Philippine Refining Co., Inc. vs. Ng Sam, 201 Phil 61, is one that can be cited stressing this particular point, the court ruled:

"The trademark "CAMIA" is used by petitioner on a wide range of products: lard, butter, cooking oil, abrasive detergents, polishing materials and soap of all kinds. Respondent desires to use the same on his product, ham. While ham and some of the products of petitioner are classified under Class 47 (Foods and Ingredients of Food), this alone cannot serve as the decisive factor in the resolution of whether or not they are related goods. Emphasis should be on the similarity of the products involved and not on the arbitrary classification or general description of their properties or characteristics."

As evidence of use, Opposer attached several invoices to prove use of its MAYAMA & DEVICE mark since 2004 (Annexes "I" to "I-29", Opposer), Sworn Statements of Opposer's customers (Annexes "J" to "J-3", Opposer) and Importation documents (Annexes "K" to "K-2", Opposer), including its China's trademark registration (Annexes "L" to "L-1", Opposer) but these are machine copies which this Bureau cannot appreciate and admit since the evidence runs counter to the requirement under Office Order No. 79 that evidence should either be original or certified true copies.

Based on the foregoing and considering that Respondent-Applicant adopted the mark as shortened version to its original MARUYAMA brand and the goods covered by its application is

entirely different to Opposer's tires under Class 12, this Bureau resolves to give due course to Respondent's application for the mark MAYAMA & DEVICE as applied to tarpaulins.

WHEREFORE, the Notice of Opposition filed by herein Opposer is, as it is hereby, DENIED. Accordingly, application bearing Serial No. 4-2008-005935 for the mark "MAYAMA & DEVICE" filed on 20 May 2008 for tarpaulins under Class 22 is, as it is hereby GIVEN DUE COURSE.

Let the filewrapper of MAYAMA & DEVICE, subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Makati City, August 12, 2009.

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