



OFFICE OF THE DIRECTOR GENERAL

BINDY PARTS CORPORATION,
Appellant,

Appeal No. 04-2013-0005
Application No. 4-2011-004567
Date Filed: 19 April 2011

- versus -

Trademark: **KYOTO**

**DIRECTOR OF THE BUREAU
OF TRADEMARKS,**
Appellee.

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DECISION

BINDY PARTS CORPORATION ("Appellant") appeals the Decision, dated 30 May 2013, sustaining the disposition in Official Action Paper No. 4, relating to the final rejection of the Appellant's application to register the mark "KYOTO" for "automobile spare parts, automobile engine components, automobile chassis components, and automobile electrical components", under Class 12.

Records show that the Appellant filed the subject trademark application on 19 April 2011. On 23 April 2012, the Examiner issued a final rejection on the ground that the mark subject of application nearly resembles the trademark "KYOTO", with Registration No. 4-2000-03553 issued on 28 April 2006 in the name of POWERPOINT SALES CENTER INC., covering goods under Class 12, specifically, "all glass sealed beams made of glass, halogen bulbs and glow plugs". In the Action Paper No. 4, the Examiner stated that both marks share the dominant word KYOTO, which has the same sound, spelling, meaning, overall commercial impression, connotation, and covers closely related goods, hence, confusion as to source of origin is likely to occur, which is proscribed under Section 123.1 (d), of Republic Act 8293 (IP Code).

On 22 May 2012, the Appellant filed its appeal with the Director of the Bureau of Trademarks ("Director"), to which the Examiner filed an Answer dated 9 August 2012. Appellant, in its appeal, argues that the goods subject to their mark pertain to automobile spare parts, automobile engine components, automobile chassis components, and automobile electrical components, whereas the goods covered by the cited mark pertain to home/industrial electrical components. In the Answer filed by the Examiner, it was reiterated that the mark may not be registered as proscribed under Section 123.1 (d) of the IP Code as it nearly resembles a mark with an earlier filing or priority date, and the resemblance is likely to deceive or cause confusion, and that the goods of the cited mark form part of automotive lighting, and thus move in the same channels of trade as those of the subject mark, and that the marks share dominant features which is the word "KYOTO".

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The Director sustained the findings of the Examiner, citing the similarity of the marks in question in their entirety, as to their appearance, sound, connotation, and commercial impression, the relatedness of the goods as described in the application or registration, and the similarity of established, likely-to-continue trade channels. The Director likewise noted that peripheral differences such as the rays on the Appellant's mark will not remove the likelihood of confusion, as greater weight is given to the word therein, because it is the word that purchasers would use to refer to or request the goods or services.

The Director agreed with the findings of the Examiner in that the goods pertaining to both marks are related. The cited mark's goods include items which are comprehensively included in the entire range of automobile spare parts, thus the products involved move in the same channels of trade.

Dissatisfied with the ruling, Appellant appealed the Decision of the Director dated 30 May 2013, to this Office through an Appeal Memorandum dated 1 July 2013. The said Memorandum alleges that the Director committed serious errors in sustaining the decision of the Examiner in Official Action Paper No. 4 which rejected with finality the trademark application of the Appellant for the mark "KYOTO" due to confusing similarity. Appellant argues that the public will not be confused about the source of origin of their mark and the cited mark. It alleges that the goods covered by the Appellants mark relate to automobile parts, whereas the goods under the cited mark pertain to home/industrial electrical components, and not apparatus for locomotion by land, air, or water.

The Appellee filed on 2 August 2013 her comment to the appeal, and subsequently, both parties manifested to this Office that they will no longer submit their Memorandum, and lieu thereof will adopt the arguments presented in their previous pleadings.

The issue in this appeal is whether the Director was correct in sustaining the final rejection of the Appellant's application to register the mark "KYOTO" for resembling a registered mark belonging to a different proprietor, and the resemblance is likely to deceive or cause confusion, as proscribed under Section 123.1 [d][ii] of Republic Act No. 8293.

In this regard, Section 123.1 (d) of the IP Code provides:

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

(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; XXX

The Appellant's mark and the prior-registered mark cited by the Examiner are reproduced below for comparison:

Appellant's Mark:

Cited Prior-Registered Mark:



Kyoto

Filed on: 19 April 2011

Registered on 28 April 2006

As held by the Director in the challenged Decision, an examination of the above marks shows that the two are similar and resemble each other. Both marks share the dominant word "KYOTO" which has the same sound, spelling, meaning, overall commercial impression, connotation, and cover closely related goods. The addition of terms that are descriptive or suggestive of the named goods or services, if the dominant portion of both marks are the same, will not necessarily remove the same from being confusingly similar to another mark. Also, due to the similarity between both marks and that due to nature of the goods running in the same channels of trade, likelihood of confusion as to the source or origin was properly noted. Due to the aforementioned, this Office agrees with the findings of both the Director and the Examiner in relation to Action Paper No. 4, and sees no cogent reason to disturb the same.

Thus, the registration of the Appellant's mark is clearly proscribed by Section 123.1 (d) of the IP Code, which provides that a mark cannot be registered if it nearly resembles a registered mark belonging to a different proprietor, as to be likely to deceive or cause confusion.

When two marks are confusingly similar, the consumers will have the impression that the goods or services covered by these marks originated from a single source or origin, or assume that one mark is just a variation of the other and there is a connection or association between the two marks and/or between the contending parties themselves, when in fact there is none. The likelihood of confusion therefore, would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, in *Converse Rubber Corporation v. Universal Rubber Products, Inc. et. al.* (G.R. No. L-27906 8 January 1987)

WHEREFORE, premises considered, the appeal is hereby **DISMISSED**. Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Trademarks. Let a copy of this Decision be furnished also to the library of the Documentation, Information and Technology Transfer Bureau for its information and records purposes.

SO ORDERED.

17 FEB 2014 Taguig City.


RICARDO R. BLANCAFLOR
Director General