OFFICE OF THE DIRECTOR GENERAL

SUPER TRADE MACHINERIES GLOBAL, INC.,
Appellant,

-versus-

DIRECTOR OF THE BUREAU OF TRADEMARKS,
Appellee.
x----------x

Appeal No. 04-2013-0001

Application No. 4-2010-000716
Date Filed: 21 January 2010
Trademark: SUPER MINDONG AND LOGO

DECISION

SUPER TRADE MACHINERIES GLOBAL, INC. ("Appellant") appeals the decision of the Director of the Bureau of Trademarks ("Director") which sustained the final rejection of the Appellant's application to register the mark "SUPER MINDONG AND LOGO".

Records show that the Appellant filed on 21 January 2010 Trademark Application No. 4-2010-000716 for SUPER MINDONG AND LOGO for use on generator and alternator. Subsequently, the Examiner-in-Charge ("Examiner") issued a finding[1] that the mark may not be registered because it nearly resembles a mark with an earlier filing or priority date and the resemblance is likely to deceive or cause confusion.

On 23 June 2010, the Appellant filed a response to the Examiner's finding claiming that the mark cited by the Examiner is different in form, style, and/or representation from its mark and that there would not be any likelihood of confusion. The Appellant averred that its mark contains a device with two (2) words while the mark cited by the Examiner is only a word mark. The Appellant further maintained that the marks covered different classification of goods.

The Examiner issued another official action,[2] reiterating her finding that the Appellant's mark resembles a registered mark and is likely to deceive or cause confusion. According to the Examiner, the word "MINDONG" is the dominant feature on both marks and that the word "SUPER" does not make the Appellant's mark different from the mark she cited. The Examiner asserted that the commercial impression of both marks is the same and that they cover similar goods (generator).

[1] REGISTRABILITY REPORT, Paper No. 04, with mailing date of 26 May 2010.
[2] Paper No. 06 with mailing date of 03 August 2010.

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The Appellant filed another response letter on 23 September 2010 claiming that the presence of the word "MINDONG" in both marks does not support a finding of near resemblance and that under Philippine trademark law and jurisprudence, competing marks should be viewed in their entirety to determine confusing similarity. The Appellant posited that regard should be taken of the spelling, color, pronunciation, manner of display and over-all commercial impression of the marks. According to the Appellant, the presence of other features, particularly, the addition of the word "SUPER" and the presence of a device consisting of a stylized circle in its mark will render them distinctively different from each other.

On 20 October 2010, the Examiner issued a "FINAL REJECTION"[3] of the Appellant's trademark application on the ground that the Appellant's mark nearly resembles a registered mark with an earlier filing or priority date and the resemblance is likely to deceive or cause confusion.

On 23 December 2010, the Appellant appealed to the Director the final rejection of its trademark application. The Director denied the appeal on 13 June 2012. The Director held that the Appellant's mark and the mark cited by the Examiner are visually, aurally and phonetically similar and that both marks are used on generators. According to the Director, a consumer would assume that the Appellant's product originated from the owner of the mark cited by the Examiner or vice versa. The Appellant filed on 06 July 2012 a "MOTION FOR RECONSIDERATION" which the Director denied on 03 January 2013.

Not satisfied, the Appellant filed on 25 January 2013 a "MEMORANDUM OF APPEAL" contending that the possibility of anyone confusing its mark with the mark cited by the Examiner is very remote. The Appellant points out that the diesel generators involved in this case are not inexpensive and common household items bought off the shelf by undiscerningly rash purchasers. The Appellant maintains that the ordinary purchaser of expensive diesel generators is one who gives special attention to the purchase and is wary thereof considering the type of product and the cost involved. The Appellant argues that there are sufficient dissimilarities between its mark and the mark cited by the Examiner such that there is no likelihood that one will be confused for the other.

The Appellee filed on 06 March 2013 her comment on the appeal claiming that the Appellant did not offer any new arguments and, thus, she is maintaining her decision.

The issue in this case is whether the Director was correct in sustaining the final rejection of the Appellant's application to register SUPER MINDONG AND LOGO.

The appeal is not meritorious.

Sec. 123.1(d) of the IP Code, states that a mark cannot be registered if it:

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[3] Paper No. 08 with mailing date of 26 October 2010.

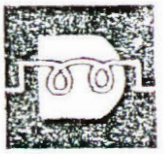
(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

(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;

Below are the illustrations of the Appellant's mark and the mark cited by the Examiner:

SUPER MINDONG

Appellant's mark



Mark cited by the Examiner

At a glance, one can see the similarity of the marks which both contain the word "MINDONG". The Appellant's trademark application was filed on 21 January 2010 for use on generator and alternator. On the other hand, the mark cited by the Examiner belongs to Winhua Electro Machinery Center, Inc. which was registered as early as 04 May 1993 for use on electric motors, generator, aerator machine, pump, and grinders.

In this regard, the Director and the Examiner were correct in rejecting the registration of the Appellant's mark pursuant to Sec. 123.1 (d) of the IP Code. This provision bars the registration of the Appellant's mark that resembles the registered mark cited by the Examiner and which would likely cause confusion.

Regarding the Appellant's contention that there are sufficient dissimilarities between the marks, these differences are not enough to overcome the likelihood of confusion. Because of the similarity in the appearance of the marks and the goods to which the marks are used, it is very likely that the purchasing public would be deceived or be confused on the source or origin of the goods. The purchasing public may associate or mistake the Appellant's goods as those of the owner of the mark cited by the Examiner or vice versa. In addition, the presence of the word "MINDONG" in those marks gives the impression that the Appellant's mark is just a variation of the mark cited by the Examiner.

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.[4]

To allow the registration of the Appellant's mark would be contrary to the provisions of the IP Code and defeat the very rationale of trademark registration. Sec. 123.1 (d) of the IP Code bars the registration of SUPER MINDONG AND LOGO in the name of the Appellant because this mark resembles a registered mark belonging to a different proprietor which is used on the same or related goods.

Moreover, the proceeding for the registration of a mark before an examiner in the Bureau of Trademarks is *ex-parte*. It is prosecuted *ex parte* by the applicant, that is, the proceedings are like a lawsuit in which there is a plaintiff (the applicant) but no defendant, the court itself (the Examiner) acting as the adverse party.[5] The Intellectual Property Office of the Philippines represented by the Examiner is not supposed to look after the interest of an applicant. The law imposes that duty upon the applicant himself. The Examiner is charged with the protection of the interests of the public and, hence, must be vigilant to see that no registration issues for a mark contrary to law and the Trademark Regulations.[6] The Examiner will look if the trademark can be registered or not.

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 the library of the Documentation, Information and Technology Transfer Bureau for its information and records purposes.

SO ORDERED.

07 FEB 2014 Taguig City

RICARDO R. BLANCAFLOR
Director General

[4] Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 November 1999.
[5] Trademark Regulations, Rule 600.
[6] Trademark Regulations, Rule 602.