



CATHERINE SALES DY,
Opposer,

-versus-

WONG TIAN CHIONG,
Respondent- Applicant.

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IPC No. 14-2010-00090
Opposition to:
Appln. Serial No. 4-2009-009376
Date filed: 17 September 2009
TM: "NITTO"

NOTICE OF DECISION

FELICILDA & ASSOCIATES LAW FIRM

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GREETINGS:

Please be informed that Decision No. 2013 - 229 dated November 25, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 25, 2013.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



CATHERINE SALES DY,
Opposer,

IPC No. 14-2010-00090
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(Filing Date: 17 Sept. 2009)
TM: "NITTO"

WONG TIAN CHIONG,
Respondent-Applicant.

X-----X

Decision No. 2013- 229

DECISION

CATHERINE SALES DY ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2009-009376. The application, filed by WONG TIAN CHIONG ("Respondent-Applicant")² covers the mark NITTO for use on "*agricultural sprayer*" under class 08 of the International Classification of Goods and Services.³

The Opposer alleges, among other things, that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). According to the Opposer, on 16 June 2006, the mark NITTOO for use on gasoline and diesel engines was registered in her favor under Reg. No. 4-2004-001855. The Opposer contends that NITTO is confusingly similar to her registered mark NITTOO.

To support the opposition, the Opposer submitted as evidence certified copy of Cert. of Reg. No. 4-2004-001855, certified copy of Declaration of Actual Use of the mark NITTOO, representative sales invoices of the Opposer's distributors indicating sales of products bearing the mark NITTOO, and a printout of the Respondent-Applicant's application as published in the "E-Gazette".⁴

The Respondent-Applicant filed the Answer on 15 September 2010, alleging, among other things:

"2.2. Moreover, the mark NITTO has been the subject of Certificate of Registration No. 4-1994-97729 for agricultural sprayer in the name of the herein Respondent. Said registration was issued on 08 June 2001 on the basis of an application filed on 18 November 1994. Because the required affidavit of use was not filed within the reglamentary period, this registration will be rendered cancelled. Thus, a new application was refiled- Appln. No. 4-2009-009376, the subject matter of the opposition.

"2.3. Clearly, the earlier registration of the Respondent for the mark NITTO was issued much earlier than the date of filing of the application for the mark NITTOO by the Opposer. Thus, if confusing similarity is in issue, it is the

¹ With postal address at 901 Philam Homes, Quezon City.

² With address at 081-1085 Arlegui St., Quiapo, Manila.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

⁴ Marked as Exhibits "A" to "E", inclusive.

Opposer who is the junior party in this case and therefore, it is the Opposer's registration that should be cancelled."

As evidence, the Respondent-Applicant submitted his own Affidavit, a printout of the webpages from the website of the Intellectual Property Office of the Philippines showing the status of Cert. of Reg. No. 4-1994-97729, and photocopy of documents showing proof of sale of products under the name NITTO.⁵

The Opposer anchored her opposition on Sec. 123.1(d) of the IP Code which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date in respect of the same goods or services or closely related goods or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

In this regard, records and evidence shows that there is a registered mark that is identical to the mark NITTO and used on exactly the same goods prior to the filing of the Respondent-Applicant's trademark application on 17 September 2009. This is Reg. No. 4-1994-97729, issued on 08 June 2001 and thus much earlier also than the issuance of the Opposer's Cert. of Reg. No. 4-2004-001855. The registrant with respect to Reg. No. 4-1994-97729 however, happens to be the Respondent-Applicant. There is no evidence that this registration was already cancelled when the Respondent-Applicant filed Trademark Application Serial No. 4-2009-009376 and also at the time the same application was allowed.

This Bureau finds that Trademark Application Serial No. 4-2009-009376 only seeks to address a technicality affecting Reg. No. 4-1994-97729 and thus continue the protection accorded to the mark NITTO. The Respondent-Applicant reasoned, to wit:

"x x x Moreover, the mark NITTO has been the subject of Certificate of Registration No. 4-1994-97729 for agricultural sprayer in the name of the herein Respondent. Said registration was issued on 08 June 2001 on the basis of an application filed on 18 November 1994. Because the required affidavit of use was not filed within the reglamentary period, this registration will be rendered cancelled. Thus, a new application was refiled- Appln. No. 4-2009-009376, the subject matter of the opposition."⁶

Considering therefore that the earlier registered mark NITTO and the identical mark NITTO covered by Application Serial No. 4-2009-009376 belong to one and the same proprietor (Respondent-Applicant), Sec.123.1 (d) of the IP Code does not apply.

WHEREFORE, premises considered, the instant opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2009-009376 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 25 November 2013.


ATTY. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs

⁵ Marked as Exhibits "1" to "3".

⁶ Par. 2.2 of the Respondent-Applicant's Answer.