



DO IT MARKETING CO., PHIL. INC.,
Opposer,

-versus-

JAPAN HOME INC.,
Respondent- Applicant.

X-----X

}
} IPC No. 14-2009-000233
} Opposition to:
} Appln. Serial No. 4-2009-002069
} Date Filed: 26 February 2009
} TM: "DO IT (STYLIZED)"
}
}
}

NOTICE OF DECISION

OFFICE OF BAGAY-VILLAMOR & FABIOSA

Counsel for the Opposer
Unit 107, Building A Oakridge Business Center
880 A.S. Fortuna Street Banilad
Mandaue City

ATTY. TUSITALA F. FAJARITO


The Law Firm of (Ret.) Judge Job Madayag & Associates
Counsel for the Respondent-Applicant
No. 35 Sandiko Street, BF Homes
Brgy. Holy Spirit, Quezon City

GREETINGS:

Please be informed that Decision No. 2014 - 134 dated May 07, 2014 (copy enclosed)
was promulgated in the above entitled case.

Taguig City, May 07, 2014.

For the Director:


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



DO IT MARKETING CO., PHIL. INC.,
Opposer,
-versus-
JAPAN HOME INC.,
Respondent-Applicant.

} IPC NO. 14-2009-000233
} Opposition to:
}
} Application No. 4-2009-002069
} Date filed :26 February 2009
}
} Trademark: DO IT (STYLIZED)
}
} Decision No. 2014- 134

x-----x

DECISION

DO IT MARKETING CO., PHIL. INC. (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2009-002069. The application, filed by JAPAN HOME INC. (Respondent-Applicant)², covers the mark “DO IT (STYLIZED)”, for use on “Retailer of household goods, home products, bath ware, retailer of electronics, hardware, kitchenware” under Class 35 of the International Classification of Goods³.

The Opposer alleges that the subject mark DO IT (STYLIZED) is the same and is confusingly similar to its registered “DO IT” marks and believes that if the subject mark is allowed registration, this will lead to confusion of source.

The Opposer relies on the following facts in support of its Opposition:

“2. The Opposer, since the year 2001, has been engaged in the business of manufacturing and selling aerosol paints, aerosol, anti-corrosion fluids, aerosol filling, maintenance aerosol, household aerosol, car care aerosol, paints and coating aerosol, personal care products, and other household accessory products such as portable gas range and aerosol digital dispensers bearing the trademark ‘DO IT’ in various hardware stores, including Ace Hardware, Handyman Robinsons, and other stores nationwide.

“3. As early as November 3, 2003, The Opposer filed applications for the registration of ‘DO IT’ as a trademark for Classes 1 and 2. It was subsequently granted registrations on 20 March 2005.

“4. The Opposer’s trademark registrations of ‘DO IT’ for Classes 1 and 2 x x x cover the following products: ‘aerosol filling, aerosol paint, aerosol anti-corrosive fluid’.

¹ A corporation organized and existing under Philippine laws with address at 7946 C. Padilla St., Mambaling, Cebu

² A corporation organized under Philippine law with address at 21 Panay Ave., Quezon City

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

“5. Since its adoption in the year 2001 and its continued use in commerce up to the present day, the Opposer’s ‘DO IT’ trademarks have been developed and have been applied for trademark registration. The same marks were extensively advertised by the Opposer in the Philippines on the following products: aerosol paints, aerosol, anti-corrosion fluids, aerosol filling, lubricants and maintenance aerosol, household aerosol, personal care aerosol, car care aerosol, special paints and coatings aerosol, and other household accessory products.

xxx

The foregoing exhibits would show the extent of promotional expenses spent to promote the ‘DO IT’ brand. As by these exhibits, among the promotional activities of the Opposer’s ‘DO IT’ are as follows:

- a) actual van sales and product demonstrations of the Opposer’s entire range of ‘DO IT’ products in the towns and cities in the Visayas and Mindanao areas; and
- b) seminars on the usage of ‘DO IT’ custom-made aerosol touch-up paints on scratches for refrigerators and air-conditioning units for Panasonic Manufacturing Philippines Corp. service centers nationwide.

“6. The Opposer is filing this Opposition against the registration of the mark ‘DO IT (STYLIZED)’ on the ground that it creates confusion of origin, source, and business- causing injury and damage on the original trademarks ‘DO IT’. The Opposer is entitled to the preservation of the valuable link between it and the public that has been created by its adoption and use of the “DO IT’ trademarks on its business and products by restraining the use by the Opposer of the subject mark. By reason of the Opposer’s exclusive, extensive and uninterrupted use of the ‘DO IT’ marks for many years, the Opposer has established goodwill and distinct reputation for its products and consumers recognize them to belong to the Opposer.

“7. The opposed mark is being applied for the following service: “retailer of household goods, home products, bath ware, retailer of electronics, hardware, kitchenware’.

“8. The Opposer’s aerosol paints, aerosol, anti-corrosion fluids, aerosol filling are hardware products, household goods, and home products. Thus, the Opposer’s products will be sold in the same channels as the Respondent’s hardware products, household goods and home products.”

The Opposer submitted as evidence the following:

1. Certified true copy of Certificate of Registration No. 4-2003-010048 issued on 20 March 2005 for the mark "DO IT & DEVICE";
2. Certified true copy of Certificate of Registration No. 4-2003-010049 issued on 13 January 2006 for the mark "DO IT & DEVICE"; and
3. Advertising materials for the mark "DO IT & DEVICE".⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 6 November 2009. On 18 August 2010, the Respondent-Applicant filed a Motion to Admit Verified Answer. On 10 January 2011, the Hearing Officer issued Order No. 2011-009 denying the Motion to Admit Verified Answer for lack of merit. On 9 February 2011, the Respondent-Applicant filed a Motion for Reconsideration of Order No. 2011-009. The Hearing Officer issued on 26 April 2014, Resolution No. 2014-001, denying the Motion for lack of merit and declaring that the instant opposition case is submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark DO IT (STYLIZED)?

Section 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides:

Sec. 123.1. Registrability. A mark cannot be registered if it:

- (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.

The records show that when the Respondent-Applicant filed its application on 26 February 2009, the Opposer already has existing registrations for the trademark DO IT & DEVICE⁵ issued on 20 March 2005 for "aerosol filling" and on 13 January 2006 for "aerosol paint, aerosol and anti-corrosive fluid". The goods covered by the Opposer's trademark registration are closely related to the "retail services of household goods, hardware products" indicated in the Respondent-Applicant's trademark application. That the Opposer's goods are under classes 1 and 2, while the Respondent-Applicant's service belongs to class 35 is of no moment. Products such as "aerosol paints, aerosol, anti-corrosion fluids, aerosol filling, lubricants and maintenance aerosol, household aerosol, personal care aerosol, car care aerosol, special paints and coatings aerosol, and other household accessory products" are sold or retailed in establishments selling household and hardware products. In *Mighty Corporation and La Campana Fabrica de Tabaco, Inc. v. E. & J. Gallo Winery and the Andresons Group, Inc.*⁶, the Supreme Court held:

⁴ Exhibits "A" to "C" inclusive of sub-markings

⁵ Exhibits "A" and "B"

⁶ G.R. 154342, July 14, 2004

"In resolving whether goods are related, several factors come into play:

- (a) the business (and its location) to which the goods belong
- (b) the class of product to which the goods belong
- (c) the product's quality, quantity, or size, including the nature of the package, wrapper or container
- (d) the nature and cost of the articles
- (e) the descriptive properties, physical attributes or essential characteristics with reference to their form, composition, texture or quality
- (f) the purpose of the goods
- (g) whether the article is bought for immediate consumption, 100 that is, day-to-day household items
- (h) the fields of manufacture
- (i) the conditions under which the article is usually purchased and
- (j) the channels of trade through which the goods flow, how they are distributed, marketed, displayed and sold."

But are the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

The competing marks, depicted below, are identical:

Opposer's mark

Respondent-Applicant's mark

The Respondent-Applicant's mark "DO IT" is identical in literal components with the Opposer's mark. Visually and aurally, the competing marks are confusingly similar. The only differences are with respect to the presentations and font styles. The Opposer's mark DO IT is written in between two horizontal lines, wherein the period of the small letter "I" is drawn above it intersecting the first horizontal line. The Respondent-Applicant's mark, DO IT (STYLIZED) is depicted with a stylized letter "D" overlapping the letter "O". These differences nonetheless, are inconsequential. The fact remains, that the two words consisting the mark applied for registration by the Respondent-Applicant are identical to the Opposer's. As shown in its advertising materials, the Opposer has adopted the mark DO IT & DEVICE on various household products for cleaning and car maintenance. The Respondent-Applicant, in adopting an identical mark for retail services of hardware and household products, could result to confusion among the buying public.

Succinctly, because the Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

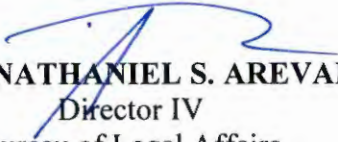
Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.⁷

The public interest, therefore, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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.⁸

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2009-002069 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 7 May 2014.


Atty. **NATHANIEL S. AREVALO**
Director IV
Bureau of Legal Affairs

⁷ *Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

⁸ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).