



EMERSON ELECTRIC CO.,
Opposer,

-versus-

KCJT GROUP, INC.,
Respondent-Applicant.

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} IPC No. 14-2011-00454
} Opposition to:
} Appln. Serial No. 4-2011-004509
} Date filed: 18 April 2011
} TM: "RIGID"

NOTICE OF DECISION

BENZON NEGRE UNTALAN
Intellectual Property Attorneys
Counsel for the Opposer
Second Floor SEDDCO Building
Rada corner Legaspi Streets
Legaspi Village, Makati City

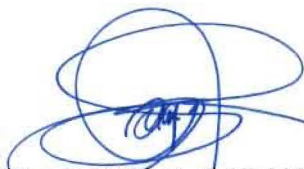
KCJT GROUP, INC.
Respondent-Applicant
1353 Alvarado Extension Street
Stat Cruz, Manila

GREETINGS:

Please be informed that Decision No. 2012 – 142 dated August 10, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 10, 2012.

For the Director:


Atty. PAUSI U. SAPAK
Hearing Officer, BLA



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IPC No. 14-2011-00454
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(Filing Date: 18 Apr. 2011)
TM: "RIGID"
Decision No. 2012- 142

DECISION

EMERSON ELECTRIC, CO. ("Opposer")¹ filed on 05 December 2011 an opposition to Trademark Application Serial No. 4-2011-004509. The application, filed by KJCT GROUP INC. ("Respondent-Applicant")², covers the mark "RIGID" for use on "*shovels and rakes*" under Class 8 of the International Classification of goods³.

The Opposer alleges, among other things, that the mark RIGID is identical with or confusingly similar to its mark "RIDGID", hence, should not be registered pursuant to Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It also claims that RIGID is descriptive and therefore not registrable pursuant to Sec. 123.1(g) of the IP Code. The Opposer's evidence consists of the Power of Attorney it executed in favor of the law firm Bengzon Negre Untalan, the affidavit of its Vice President/Assistant Secretary and Associate General Counsel Timothy G. Westman, certificate of registration of the mark RIDGID in the Philippines, and certified copies of various foreign registrations of the said mark.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 06 February 2012. The Respondent-Applicant, however, did not file an Answer.

It is emphasized that the essence of trademark registration is to give protection to the owner of the trademarks. The function of a trademark is to point out distinctly the origin of 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 products.⁵ Thus, Sec. 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") 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 and services, or if it is nearly resembles such a mark as to be likely to deceive or cause confusion.

¹ Is a corporation organized under the laws of Missouri, United States, with address at 8000 West Floessant Avenue, St. Louis Missouri, 63136.

² With address at 1353 Alvarado Extension Street, Sta. Cruz, 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 "P", inclusive.

⁵ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999

Records show that at the time the Respondent-Applicant filed its trademark application on 18 April 2011, the Opposer has an existing trademark registration for RIDGID (No. R-2635 issued on 27 December 1960 and continuously renewed thereafter). The registration covers “heavy duty wrenches, stillson pipes, wrenches, hex wrenches, pipe threaders, geared threaders, pipe cutters, pipe vises, power drives, pipe and bolt threading machines” under Class 07. Although the aforementioned goods fall under Class 07, these should be considered closely related to those indicated in the Respondent-Applicant’s application, which belong to Class 08. These goods are essentially manually operated tools. Moreover, the competing marks, as shown below, resemble each other as to be likely to deceive or cause confusion.



Opposer’s Mark



Respondent-Applicant’s Mark

The competing marks are practically identical. The absence of the letter “D” after the letters “RI” in the Respondent-Applicant’s mark and the difference in font styles are of no consequence. The marks simply look and sound alike.

Thus, because the goods bearing these marks are closely related (manually operated tools), mistake, confusion or deception is likely. There is the likelihood that information, assessment, perception or impression about RIGID products may unfairly cast upon or attributed to the RIDGID products and the Opposer, and *vice-versa*. The likelihood of confusion would subsist not only on the purchaser’s perception of goods but on the origins thereof as held by the Supreme Court:⁶

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily 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.

With the foregoing findings and conclusion, there is no need to pass upon the issue raised by the Opposer that the mark applied for registration by the Respondent-Applicant is descriptive. This Bureau, in fact, noticed that in arguing on the issue, the Opposer erroneously referred to the goods covered by the Respondent-Applicant’s trademark application as “hexagonal shafting, hexagonal housing, lower cap, upper cap, center cap, upper shafting, center shafting, sprockets, chains, v-pulleys, disc plough cap, disc plough pin, roller drum, roller pin, oilseals, lower shaft round end, lower shaft square end, stud shaft, stud pulley adapter, agricultural implements spare parts, ball bearing, agricultural centrifugal water pump, agricultural self-priming pumps” under Class 07. The mark applied for registration by the Respondent-Applicant is for use on “shovels and rakes” which belong to Class 08.

⁶ See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-004509 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 10 August 2012.



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

