



ILLINOIS TOOL WORKS
INC.,

Opposer,

- versus -

GUANG ZHOU WYNNS TOOLS CO., LTD.,
Respondent-Applicant.

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IPC No. 14-2012-00058

Opposition to:

Appl. Serial No. 4-2011-005723
(Filing Date: 18 May 2011)

TM: "WYNN'S & LION DEVICE"

Decision No. 2014- 23

DECISION

ILLINOIS TOOL WORKS INC. ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2011-005723. The application, filed by GUANG ZHOU WYNNS TOOLS CO.,LTD. ("Respondent-Applicant")², covers the mark "WYNN'S & LION DEVICE" for use on *"agricultural implements other than hand-operated, namely, incorporators, seed drills, hay balers, coulters, cultivators, harvestors, disk harrows, seeders; tractor towed agricultural implements, namely, plows, harrows, disc harrows, mowers, reapers, harvesters, hay rakes, hay balers, broadcast seeders, manure spreaders, fertilizer distributors, corn huskers and rollers; saw blades(parts of machines); jacks(machines); electric hammers; tools other than hand operated, namely, hand held battery actuated hydraulic crimp tool; spray guns for paint; pressure valves (parts of machines); welding machines, electric"* under Class 7 of the International Classification of Goods and Services.³

The Opposer alleges, among other things, that the registration of mark WYNN'S & LION DEVICE is proscribed under Sec. 123.1, pars. (d), (e) and (f), of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). According to the Opposer, it is the owner of the registration in the Philippines for the mark "WYNN'S" under Reg. No. 4-2011-004335, dated 25 August 2011, for goods under Classes 1, 2, 3, 4 and 7. To support its opposition, the Opposer submitted as evidence the affidavit of one Kenneth L. Ng, various documents relating to its history and the extent of its business activities or presence and trademark protection in different countries.⁴

¹ A corporation duly registered and existing under the laws of Delaware, United States of America, with address at 3600 West Lake Avenue, Glenview, Illinois 60026, U.S.A.

² A company incorporated under the laws of China with address at No. 22 Building D., No. 23 Heliu Street, Nan'an Road, Liwan District, Guangzhou, Guangdong, China.

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 "C" to "NNNN".

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 25 April 2012. The Respondent-Applicant, however, failed to file an Answer. Accordingly, the Hearing Officer issued on 28 February 2013 Order No. 2013-361 declaring the Respondent-Applicant to have waived its right to file an Answer.

Should the Respondent-Applicant be allowed to register the mark WYNN's & liondevice?

Records show that at the time the Respondent –Applicant filed its application, the Opposer already has a pending application for the registration of the mark WYNN'S, filed on 13 April 2011. The application, which was allowed and for which a certificate of registration was issued on 25 August 2011 (No. 4-2011-004335) covers the following goods:

Class 1:

"CHEMICAL PRODUCTS FOR USE AS ADDITIVES TO ENGINE OILS, MOTOR FUELS, TRANSMISSION FLUIDS, BRAKE FLUIDS, RADIATOR FLUIDS, ENGINE CRANKCASES, FLUIDS FOR POWER STEERING; AUTOMOTIVE AND COMBUSTION ENGINE CHEMICAL FLUID ADDITIVE PRODUCTS, RADIATOR CHEMICAL ADDITIVES, POWER STEERING FLUID ADDITIVES, TRANSMISSION FLUID ADDITIVES, BRAKE FLUID ADDITIVES AND ENGINE CRANKCASE ADDITIVES"

Class 2:

"PRESERVATIVES AGAINST RUST; ANTI-CORROSION PRODUCTS, RADIATOR TREATMENT, CONTAINING A RUST INHIBITOR; DYE'S; PIGMENTS; UNDERCOATING'S FOR VEHICLE CHASSIS; ANTI-CORROSIVE PREPARATIONS; ANTI-RUST PREPARATIONS [FOR PRESERVATION]; ANTI-RUST OILS; ANTI-RUST GREASE;"

Class 3:

"CLEANING PREPARATIONS; ENGINE OIL SYSTEM CLEANERS; CARBURETOR CLEANERS; CONCENTRATES FOR COOLING SYSTEMS AND RADIATOR FLUSH; RADIATOR TREATMENT FLUID; BRAKE CLEANER; GLASS CLEANER; FINISH RESTORERS; TIRE SHINING PREPARATION; TIRE CLEANING PREPARATIONS; TIRE PROTECTION PREPARATIONS; CAR WAX; CAR WASH SOLUTIONS;"

Class 4:

"OILS, GREASES AND LUBRICANTS; ADDITIVES FOR ENGINE FUEL, LUBRICATION OIL AND GREASE, PENETRATION OIL SILICONE LUBRICANTS, AUTOMOTIVE AND COMBUSTION ENGINE FLUID ADDITIVE PRODUCTS-NAMELY, FLUID ENGINE FUEL ADDITIVES, PENETRATING OIL, POWER STEERING FLUID ADDITIVES, TRANSMISSION FLUID ADDITIVES, BRAKE FLUID LIQUID ADDITIVES, SILICONE LUBRICANTS; CUTTING FLUIDS; CUTTING OIL;"

Class 7:

"ENGINE COOLANT FLUSH MACHINE, ENGINE COOLANT DRAIN AND FILL AND BULK RECYCLING MACHINE, FUEL INJECTION CLEANING MACHINE, PRESSURE REDUCERS FOR AUTOMOTIVE COOLING SYSTEM; VEHICLE WASHING INSTALLATIONS, PRESSURE REDUCERS [PARTS OF MACHINES], AUTOMOTIVE ENGINE COOLING RADIATOR; AUTOMATIC TRANSMISSION FLUSH MACHINE; AUTOMATIC TRANSMISSION FILL MACHINE; COOLING SYSTEM PRESSURE RELIEF MACHINE (PARTS OF MACHINE);"

These goods are similar and/or closely related to those indicated in the Respondent-Applicant's application.

In this regard, the Opposer's mark, depicted below:

WYNN'S

is identical to the word component of the Respondent-Applicant's mark, to wit:



Succinctly, because the competing marks are used on similar and/or closely related goods, it is likely that the consumers will have the impression that these goods or products originate from a single source or origin. The presence of a device of a "Lion" in the Respondent-Applicant is of no moment. The device only makes the Respondent-Applicant's a variation of the Opposer's. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other⁵. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit: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.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filer wrapper of Trademark Application Serial No. 4-2011-005723 be returned, together with a copy of this decision to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 January 2014.


NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs

⁵ *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No. 112012, 4 April 2001, 356 SCRA 207, 217.

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