



KABUSHIKI KAISHA KOMATSU SEISAKUSHO }
(also known as KOMATSU LTD.), }
Opposer, }

-versus-

RNA GLOBAL VENTURES, INC., }
Respondent-Applicant. }

IPC No. 14-2012-00036
Opposition:
Appln. Serial no. 14-2011-012474
Date filed: 17 October 2011
TM: "ZENOAH KOMATSU"

NOTICE OF DECISION

E.B. ASTUDILLO & ASSOCIATES

Counsel for the Opposer
10th Floor, Citibank Center
8741 Paseo de Roxas, Makati City

ALBERT TAN

For the Respondent-Applicant
35 Sandiko Street, BF Homes
Brgy. Holy Spirit, Capitol Hills
Quezon City

GREETINGS:

Please be informed that Decision No. 2013 - 1165 dated August 13, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 13, 2013.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



KABUSHIKI KAISHA KOMATSU SEISAKUSHO
(Also known as **KOMATSU LTD.**),

Opposer,

-versus-

RNA GLOBAL VENTURES, INC.,
Respondent-Applicant.

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IPC No. 14-2012-00036

Case Filed: 30 March 2012

Opposition to:

Appln. Serial No. 14-2011-012474

Date Filed: 17 October 2011

TM: "ZENOAH KOMATSU"

Decision No. 2013- 165

DECISION

KABUSHIKI KAISHA KOMATSU SEISAKUSHO ("Opposer")¹ filed on 30 March 2012 an opposition to Trademark Application Serial No. 4-2011-012474. The application, filed by RNA GLOBAL VENTURES, INC. ("Respondent-Applicant")², covers the mark "ZENOAH KOMATSU" for use on "metal welding rods, welding cable, electrode holder, welding rod holder, drill bits, gas tanks, welding & cutting outfit, cutting tips & welding tips, electrode holder, all kinds of abrasives (cutting, grinding wheel and cut off wheel), arc welding machine, welding tig inverter, ac/dc welding machine, plasma cut, mig welding, spot welding, oxy-acetylene welding and cutting machines, electric arc welding machines, electric welding machines, gas welding machines, welding & cutting outfit, cutting tips & welding tips, arc welding, ac/dc welding machine, grinding machine, grinders (power tools), cut-off machine, welding tig inverter, plasma cut, mig welding, spot welding, welding gun tips, welding contact tips, abrasives, cut-off wheel, depressed center wheel, grinding wheel, diamond cutting wheel, diamond blade, cup brush, air compressor, compressor head and its accessories, drilling machine and its accessories, grinding disc, welding and cutting attachment, concrete cutter blade (power tool) circular saw blade (power tool), engines, diesel engine, gas engine, generator, diesel generator, gas generator, water cooled engine, agricultural machines (manual/automatic), brush cutter (power tools), power sprayer (manual & automatic), engine driven sprayer/pump, portable sprayer, back pack sprayer, back pack engine driven sprayer, trolley type sprayer, belt driven sprayer, direct couple sprayer, irrigation sprayer/pumps, farming sprayer/pumps, harvesting sprayer/pumps, engine back pack sprayer, motor driven sprayer and pumps, centrifugal pump, suction pump, discharge pump, water pump, grass cutter, garden sprayer, pump, deep well pump, submersible pump, parts and accessories of the above pumps, sprayer, pressure washer, agricultural sprayer, chain saws, electric motor, lawn mower (power tools), impact wrench, acetylene regulators and valves, oxy-acetylene regulators and valves, co2 regulators, medical regulator, argon regulators, welding electrodes, welding helmets (protective work helmets), welding masks (protective work masks), welding & cutting torches, welding tips, electrode holder, welding rod holder, welding cables, welding gloves (protective work gloves), welding suits (protective work suits), pressure switch and pressure gauge, battery charger, oxy and acy twin hose, air hose, chemical hose,

¹ A corporation duly organized and existing under and by virtue of the laws of Japan with office address at 3-6, 2-Chome, Akasaka, Minato-ku, Tokyo, Japan.

² A corporation duly organized and existing under and by virtue of the laws of the Philippines with address at 2496 Taft Avenue, Pasay City.

garden hose, radiator hose, hydraulic hose, power sprayer hose, clear hose, discharge hose, flexible hose, flexible suction hose, concrete vibrator hose and corrugated hose" under Classes 6, 7, 9 and 17 of the International Classification of Goods and Services³.

The Opposer alleges among other things, the following:

1. The trademark "ZENOAH KOMATSU" being applied for by Respondent-Applicant is identical with Opposer's trademark KOMATSU, as to likely, when applied to or used in connection with the goods of Respondent-Applicant, to cause confusion, mistake and deception on the part of the purchasing public.
2. The registration of the trademark "ZENOAH KOMATSU" in the name of Respondent-Applicant will violate Section 123.1, subparagraph (d) of the Intellectual Property Code of the Philippines, to wit:

"Sec. 123. Registrability. – 123.1. 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;" (Underscoring supplied)

3. The registration of the trademark "ZENOAH KOMATSU" in the name of Respondent-Applicant is contrary to Section 123.1, subparagraph (e) of the Intellectual Property Code of the Philippines, as follows:

"Sec. 123. Registrability. – 123.1 A mark cannot be registered if it:

(e) is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large,

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.

including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;"

4. The registration of the trademark "ZENOAH KOMATSU" in the name of Respondent-Applicant is also contrary to Section 123.1, subparagraph (f) of the Intellectual Property Code of the Philippines, as follows:

"Sec. 123. Registrability. – 123.1. A mark cannot be registered if it:

- (f) is identical with, or confusingly similar to, or constitutes a translation of mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: *Provided*, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: *Provided, further*, That the interests of the owner of the registered mark are likely to be damaged by use;"

5. The registration of the trademark "ZENOAH KOMATSU" in the name of Respondent-Applicant will also violate Section 6bis of the Paris Convention for the Protection of Industrial Property, to which the Philippines is a party having acceded thereto as early as 27 September 1965, as follows:

"Article 6bis

Marks: *Well-Known Marks*

(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well-known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation of the prohibition of the use of marks registered or used in bad faith.

6. The registration and use by Respondent-Applicant of the trademark ZENOA KOMATSU will diminish the distinctiveness and dilute the goodwill of Opposer's identical trademark KOMATSU.
7. The registration of the trademark ZENOA KOMATSU in the name of Respondent-Applicant is contrary to other provisions of the Intellectual Property Code of the Philippines.

In support of its opposition, the Opposer submitted in evidence the following:

1. Exhibits "A" to "A-20" – Worldwide Trademark Portfolio for KOMATSU;
2. Exhibits "B" to "B-20" – Certificates of Registration for the mark KOMATSU in different countries;
3. Exhibit "C" – Decision dated 29 December 2008 in Panama;
4. Exhibits "D" to "G" – Worldwide advertising materials for KOMATSU;
5. Exhibit "H" – Opposer's Magazine Advertising 2008-2009;
6. Exhibits "I" to "I-17" – Print outs from the website www.komatsu.com;
7. Exhibit "J" – Duly notarized and legalized copy of Opposer's Japanese Commercial Register and its partial English translation in support of Mr. Kunio Noji's authority to act on behalf of Opposer;
8. Exhibit "K" – Duly notarized and legalized Affidavit-testimony of witness Kunio Noji; and
9. Exhibit "L" – 2011 Annual Report of Komatsu Ltd.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 26 April 2012. The Respondent-Applicant however, did not file its Verified Answer. Thus, the Hearing Officer issued on 06 November 2012 Order No. 2013-1426 declaring the Respondent-Applicant in default and the instant opposition deemed submitted for decision.

Should the Respondent-Applicant's trademark application be allowed?

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 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 products⁴.

Thus, Sec. 123.1 (d) of R.A. 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 or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

⁴ 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 17 October 2011, the Opposer has already existing trademark registration in the Philippines for the mark "KOMATSU" specifically;

1) Reg. No. 4-1995-107029 issued on 12 July 2000, for use on "battery chargers, protective helmets, silicon wafers, silicon semiconductors, integrated circuits, optical integrated circuits, magnetic tapes and cards, floppy discs and cards, data-based system of computer programmes capable of being stored in an IC card or disc, computer programmes capable of being transmitted on-line from one computer to another, computer programmes for the purpose of control and/or maintenance of machines and apparatus for mining, earth-handling, construction, metal working and also of land vehicles, visual-sensor device for inspection purposes (of electric and electronic machines and components thereof), by utilizing gray-scale treatment, machines and apparatus for laser-making, machines and apparatus for telecommunications and opto-electronic communications, optical character reading devices by semiconductor laser, radar device for determining and/or identifying objects lying under the ground, parts and attachments for said goods" under Class 9;

2) Reg. No. 4-1995-107028 issued on 20 December 1995 for use on "earth-working machines and apparatus, namely, bulldozers, swamp bulldozers, amphibious bulldozers, tire dozers, motor scrappers, towed scrappers, rippers and rake dozers, earth-handling machines and apparatus, namely, shovel loaders, wheel loaders, tractor loaders, compactors and loader buckets, excavators, namely, backhoes, dozer shovels, swamp type dozer shovels, swing dozers shovels, power shovels, bucket excavators, mining shovels, trenchers, and tunnel boring machines, construction machines and apparatus, namely, drop-hammers, tire-rollers, asphalt finishers, vibration rollers, vibro-plates, pipe-laying machines, and motor graders, metal working machines and apparatus, namely, mechanical presses, press brakes, bending machines, shearing machines, stretching machines, peeling machines, gun-drill machines, crankpin millers, crankshaft millers, cylinder block deburring machines, slug choppers, slug upsetters, lathes, molding machines, engraving-type laser marking machines (for metal surfaces), mask type laser marking machines (for plastic surfaces), laser-marker controller, other molding machines, and machine tools, loaders, stackers, reclaimers, belt-conveyors, generators or dynamos, chain saws, bush cutters, air compressors, truck cranes, engines and transmissions for said goods, parts and attachments for the aforementioned goods" under Class 7; and

3) Reg. No. 4-1995-107030 issued on 12 July 2000 for use on "transportation vehicles, namely, forklift (trucks), electric lift trucks, electric reach trucks, tractors, towing tractors, dump trucks, concrete mixers trucks, snow vehicles, engines and transmissions for said goods, parts and attachments for the aforementioned goods" under Class 12. Likewise, the Opposer has registered its trademark "KOMATSU" in different countries⁵. The goods indicated in the Respondent-Applicant's trademarks application are therefore similar and/or closely related to those covered by the Opposer's trademark registrations.

⁵ Exhibits "B" to "B-20".

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

KOMATSU

ZENOAH
KOMATSU

Opposer's Mark

Respondent-Applicant's Mark

Jurisprudence says that a practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of the prospective buyer. The trademark complained should be compared and contrasted with the purchaser's memory of the trademark said to be infringed. Some factors such as sound; appearance; form, style, shape, size or format; color, idea connoted by the mark; the meaning, spelling and pronunciation of the words used; and the setting in which the words used; may be considered for indeed, trademark infringement is a form of unfair competition⁶.

The Respondent-Applicant's mark consists of two (2) words, "ZENOAH" and "KOMATSU". Notwithstanding the fact that the word ZENOAH is represented in a font bigger than that for the word KOMATSU, the latter stands out because of its visual, aural and conceptual properties. KOMATSU is unique as far as this jurisdiction is concerned; it is not part of the everyday language in this country. As the records show, the Respondent-Applicant will use its mark on goods that are similar and/or closely related to those covered by the Opposer's registered trademarks. If goods bearing the mark ZENOAH KOMATSU is placed side-by-side with goods under the Opposer's mark KOMATSU, chances are, the consumers will likely assume that the goods came from one source or origin or, at least coming from a party that is connected or associated with the other.

It is hard to believe that the Respondent-Applicant included the word KOMATSU in its trademark without having been inspired or motivated by an intention to imitate the Opposer's mark and take advantage of the goodwill the mark may have already earned. In fact, the word KOMATSU is part of the corporate or company name of the Opposer. Confusion cannot be avoided by merely adding, removing or changing some letters of registered mark. Confusing similarity exists when there is such a close or ingenious 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 other⁷.

Accordingly, this Bureau finds the instant opposition meritorious. Hence, the Respondent-Applicant's trademark application is proscribed under Sec. 123.1 (d) of the IP Code.

It is stressed that the Respondent-Applicant was given the opportunity to explain its side and defend its trademark application. However, it failed and/or chose not to do so.

⁶ Clarke v. Manila Candy Co. 36 Phil. 100, 106, Co Tiong SA v. Director of Patents 95 Phil. 1.4.

⁷ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207.

WHEREFORE, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 14-2011-012474 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 13 August 2013.



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



/pausl/joanne