KWH MIRKA, LTD., Opposer, -versus- **JAYVEE K. ONG,** Respondent-Applicant.	}	**IPC No. 14-2010-00050** Opposition to: Appln. Serial No. 4-2009-004200 Date filed: 28 April 2009 TM: **"MAD DOG & DEVICE"**

NOTICE OF DECISION

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JAYVEE K. ONG
Respondent-Applicant
c/o Megan Dragon Enterprises, Inc.
No. 73 Hizon Street, 10th Avenue
Caloocan City

GREETINGS:

Please be informed that Decision No. 2013 - 39 dated February 22, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 22, 2013.

For the Director:

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

KWH MIRKA, LTD.,
Opposer,

- versus -

JAYVEE K. ONG,
Respondent-Applicant.

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IPC No. 14-2010-00050

Opposition to:
Appln Serial No. 42009004200
Date filed: 28 April 2009

TM: **"MAD DOG & DEVICE"**

DECISION NO. 2013 - 39

DECISION

KWH MIRKA, LTD (Opposer)[1] filed on 23 February 2010 an opposition to Trademark Application Serial No. 4-2009-004200. The application, filed by JAYVEE K. ONG (Respondent-Applicant)[2], covers the mark "MAD DOG & DEVICE", for use on *"Abrasive Rolls, Coated Abrasives, Sandpaper in the form of Belts, Sheets, Rolls and Disc"* covered under the Class 03 of the International Classification of Goods[3]. The Opposer alleges, among other things, the following:

"1. The Opposer is the first to adopt, use and register the trademark BULLDOG DEVICE in the Philippines, for several goods, among which are coated abrasives in the form of discs, sheets, strips, bands, belts, pads and rolls; and therefore enjoys under section 147 of Republic Act (R.A.) No. 8293 the right to exclude others from registering or using an identical or confusingly similar mark such as Respondent-Applicant's trademark 'MAD DOG & DEVICE' for similar and related goods/services such as abrasives, sandpaper in the form of belts, sheets, rolls and discs.

"2. The 'MAD DOG & DEVICE' mark nearly resembles the BULLDOG DEVICE mark of Opposer, in sound, spelling, and appearance as to be likely to deceive or cause confusion as contemplated under Section 123 (d), R.A. 8293.

"3. The Opposer's BULLDOG DEVICE mark, used among others, for coated abrasives in the form of discs, sheets, strips, bands, belts, pads, and rolls is well-known internationally and in the Philippines, taking into account the knowledge of the relevant sector of the public, as being a trademark owned by Opposer, hence, Respondent-Applicant's "MAD DOG & DEVICE" trademark cannot be registered in the Philippines, especially for similar and

[1] A foreign corporation duly formed under the laws of Finland, with business address at FIN-66850 Jepua, Finland.
[2] With business address at Mega Dragon Enterprises, Inc. No. 73 Hizon Street, 10th Avenue Caloocan 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.

related goods/services pursuant to the express provision of Section 123 (e) of R.A. No. 8293.

"4. The Respondent-Applicant, in adopting the 'MAD DOG & DEVICE' is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association with the Opposer, or as to origin, sponsorship, or approval of its goods/services by the Opposer, for which it is liable for false designation of origin; false description or representation under Section 169 of R.A. No. 8293."

To support its opposition, the Opposer submitted as evidence the following:

1. Certificate of Registration of the Trademark "BULLDOG DEVICE" with Registration No. 4-1997-119646 (Exhibit "A");
2. Sworn affidavit of Mr. Ralf Karlstrom dated 25 January 2010. (Exhibit "B"); and
3. Print-out copy of E-Gazette publication of trademark "MAD DOG & DEVICE" released on 26 October 2009 (Exhibit "C").

This Bureau issued a Notice to Answer on 19 March 2010 and served a copy thereof upon the Respondent-Applicant on 28 June 2010. However, the Respondent-Applicant did not file an answer to the Opposition.

It is emphasized that the essence of the 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 applied; 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.[4] Section 123.1 of the 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 is nearly resembles such a mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent filed his trademark application on 28 April 2009, the Opposer already has an existing trademark registration for the mark "BULLDOG DEVICE" (Reg. No. 4-1997-119646), for use on *"Coated abrasives in the form of disc, sheets, strips, bands, belts, pads, rolls."* The competing marks are, therefore, used on similar and / or related goods.

But do the marks as shown below, resemble each other such that mistake or confusion or even deception, is likely to occur?

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[4] Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, November 19,1999

Opposer

Respondent-Applicant

The profile of a dog, particularly a bulldog, is the prominent feature of both marks. While it is true that the words "MAD" and "DOG" are absent in the opposer's mark, the same idea or concept is conveyed by the applicant's mark. A dog or a bulldog is a unique mark in relation to the goods involved in this instance. This kind of marks is inherently distinctive and deserves strong protection in favor of the original owner. Thus, the attempt of respondent-applicant to add embellishments or ornaments on its own illustration of the bulldog is not sufficient to distinguish its mark from the Opposer's.

Time and again, it has been held in our jurisdiction that the law does not require that the competing trademarks must be so identical as to produce actual error or mistake. It would be sufficient, for purposes of the law that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.[5] Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.[6] Because the Respondent-Applicant will use his mark on goods that are similar and/or closely related to the Opposer's, the consumer is likely to assume that the Respondent-Applicant's goods originate from or sponsored by the Opposer or believe that there is a connection between them, as in a trademark licensing agreement. 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:[7]

> 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.

Definitely, the field from which a person may select a trademark is practically unlimited. As in all other cases of colourable imitation, the unanswered riddle is why,

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[5] American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970
[6] Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992
[7] Converse Rubber Corporation vs. Universal Rubber-Products, Inc. et. al. G.R. No. L27906, January 8, 1987

of the millions of terms and combination of design available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.[8]

WHEREFORE, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2009-004200 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 22 February 2013

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

[8] American Wire & Cable Company vs. Dir. Of Patent, G.R. No. L-26557, February 18, 1970.