



MIKUNI CORPORATION,
Opposer,

-versus-

PYRAKAM CORPORATION,
Respondent-Applicant.

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IPC No. 14-2012-00495
Opposition to:
Appln. Serial No. 4-2011-014366
Date filed: 02 December 2011
TM: "MLKUNI & DEVICE"

NOTICE OF DECISION

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PYRAKAM CORPORATION

LENVY CHUA
Respondent-Applicant
4-B Fema Road, Project 8
Quezon City

GREETINGS:

Please be informed that Decision No. 2014 - 72 dated March 14, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 14, 2014.

For the Director:


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



MIKUNI CORPORATION,	}	IPC No. 14-2012-00495
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PYRAKAM CORPORATION,	}	TM: MLKUNI & DEVICE
<i>Respondent-Applicant.</i>	}	
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DECISION

MIKUNI CORPORATION (“Opposer”)¹ filed an opposition to Trademark Application Serial No. 4-2011-014366. The application, filed by PYRAKAM CORPORATION (“Respondent-Applicant”)², covers the mark “MLKUNI & DEVICE” for use on “oil filter, carburetors, piston kit, piston ring, motorcycle spare parts namely chain, mirrors, handle grips, cables, connecting rod kit, rims, shock absorber, handle bar, lever, sprockets, hub, mugs, brake pad, brake shoe, tires and interior tubes” under Classes 7 and 12 of the International Classification of Goods and Services.³

The Opposer anchors its opposition on the ground that the registration of the Respondent-Applicant’s mark is contrary to Sec. 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”) 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;

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

¹ A corporation organized and existing under the laws of Japan, with office address at 13-11, Sotokanda 6-Chome, Chiyoda-ku, 101- 0021 Tokyo.

² With address at 4-B Fema road, Project 8, Quezon City.

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.



1. Exhibit "A" – the authenticated affidavit of Mr. Hisataka Ikuta, dated 17 December 2012;
2. Exhibit "B" – certified true copy of Japanese Reg. No. 1908648 and its authenticated English translation;
3. Exhibit "C" – certified true copy of Japanese Reg. No. 2466746 and its authenticated English translation;
4. Exhibit "D" – certified true copy of Japanese Reg. No. 2620648 and its authenticated English translation;
5. Exhibit "E" – certified true copy of Japanese Reg. No. 3054664 and its authenticated English translation;
6. Exhibit "F" – certified true copy of Japanese Reg. No. 4187553 and its authenticated English translation;
7. Exhibit "G" – certified true copy of Japanese Reg. No. 4283370 and its authenticated English translation;
8. Exhibit "H" – certified true copy of Japanese Reg. No. 4414304 and its authenticated English translation;
9. Exhibit "I" – certified true copy of Japanese Reg. No. 5007845 and its authenticated English translation;
10. Exhibit "J" – certified true copy of Japanese Reg. No. 5283902 and its authenticated English translation;
11. Exhibit "K" – certified true copy of Philippine Trademark Reg. No. 4-2006-004537;
12. Exhibit "L" – printout of Respondent- Applicant's MLKUNI & DEVICE;
13. Exhibit "M" certified true copy of the Opposer's three year Declaration of Actual Use;
14. Exhibit "N" – duplicate original of Opposer's 5th Anniversary Declaration of Actual Use;
15. Exhibit "O" – printout of Opposer's website page on History;
16. Exhibit "P" – printout of MLKUNI Website; and
17. Exhibit "Q" – catalog/brochure.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 16 January 2013. However, the Respondent-Applicant did not file an answer. Thus the Hearing Officer issued Order No. 2013-679 on 30 April 2013 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 products.⁴

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999

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 competition⁵.

Records show that at the time the Respondent-Applicant filed its trademark application on 02 December 2011, Opposer already has an existing trademark registration in the Philippines for the mark MIKUNI bearing Serial No. 4-2006-004537.⁶ The registration covers goods that are similar and/or closely related to those indicated in the Respondent-Applicant's trademark application. Reg. No. 4-2006-004537 covers "alternators, generators of electricity, motors for boats, motors, other than for land vehicles, motors, electric, other than for land vehicles, pumps (machines), valves (parts of machines), hydraulic valves, compressors(machines), hydraulic components (not including vehicle hydraulic system), pneumatic components, jacks (machines), propulsion mechanisms other than for land vehicles, transmissions, other than for land vehicles, fuel supply apparatus for engines, fuel supply apparatus of internal combustion engines for lawnmowers, fuel supply apparatus for internal combustion engines for land vehicles, carburetters, fuel supply apparatus of internal combustion engines for boats, fuel supply apparatus of internal combustion engines for snowmobiles, fuel supply apparatus of internal combustion engines for motorcycles".

But are the competing marks depicted below, confusingly similar?

The logo for the Opposer's mark, featuring the word "MIKUNI" in a bold, black, sans-serif font. The letters are closely spaced and have a slight shadow effect.

Opposer's Mark

The logo for the Respondent-Applicant's mark, featuring the word "AIKUNI" in a bold, black, sans-serif font. The letters are closely spaced and have a slight shadow effect. The letter "I" is stylized with a red diagonal stroke.

Respondent-Applicant's Mark

This Bureau finds that the competing marks are confusingly similar. They have the same number of letters and almost identical font style, and are visually look alike. The only difference between the two is letter "L" in the Respondent-Applicant's mark which is identical to the letter "I" of the Opposer in their manner of display. In sum, the competing marks are identical in all aspects. In this regard, confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. The slight variance is insignificant because it did not diminish the likelihood of the occurrence of mistake, confusion or even deception cannot be avoided. Consumers will likely assume that the Respondent-Applicant's mark is just a variation of or related to the Opposer and/or the goods and services originate from the same source while in fact it is not. The likelihood of confusion would subsist not only on the purchaser's perception of the goods but on the origins thereof.

⁵ Clarke v. Manila Candy Co. 36 Phil 100, 106, Co Tiong SA v. Director of Patents as Phil. 1, 4.

⁶ Exhibit "K".

The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of letters are available, the Respondent-Applicant had come up with a mark identical or so closely similar if there was no intent to take advantage of the goodwill generated by the other mark.⁷

It is stressed that the law on trademarks and tradenames is based on the principle of business integrity and common justice. This law, both in letter and spirit is laid upon the premise that, while it encourages fair trade in energy way and aims to foster, and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing others business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another⁸.

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

Accordingly, this Bureau finds that the registration of the Respondent-Applicant's mark is proscribed by Sec. 123.1 (d) of IP Code.

WHEREFORE, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-014366 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 14 March 2014.


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

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⁷ American Wire and Cable C. v. Director of Patents et.al. SCRA 544, G.R. No. L-26557, 18 Feb. 1970.

⁸ La Chemise Lacoste v. Judge Oscar C. Fernandez, et.al. G.R. No. L-63796-97, 02 May 1984.