MITSUBISHI JUKOGYO KABUSHIKI KAISHA	}	**IPC No. 14-2012-00356**
(d/b/a Mitsubishi Heavy Industries, Ltd.),	}	Opposition to:
Opposer,	}	Appln. Serial No. 4-2012-003577
	}	Filing Date: 21 March 2012
-versus-	}	**TM: "ATS & DEVICE"**
	}	
	}	
HANA INTERNATIONAL FZE,	}	
Respondent- Applicant.	}	

x----------x

NOTICE OF DECISION

BUCOY POBLADOR AND ASSOCIATES
Counsel for Opposer
21st Floor, Chatham House Streets
116 Valero corner Herrera Streets
Salcedo Village, Makati City

CHITO B. DIMACULANGAN
Counsel for Respondent-Applicant
Suite 2016 Cityland Ten Tower One
6815 N. Ayala Avenue, Makati City

FELICITO C. CORDERO
Counsel for Respondent-Applicant
Unit – IC GV Square Building B-167, L-31 Casa Milan
Commonwealth Avenue Extension
Greater Lagro 2, Quezon City

GREETINGS:

Please be informed that Decision No. 2014 - 09 dated January 15, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 15, 2014.

For the Director:

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

MITSUBISHI JUKOGYO KABUSHIKI KAISHA (d/b/a Mitsubishi Heavy Industries, Ltd.),
Opposer,

-versus-

HANA INTERNATIONAL FZE,
Respondent-Applicant.
x----------x

IPC No. 14-2012-00356

Appln. Serial No.: 4-2012-003577
(Filing Date: 21 March 2012)

TM: "ATS & DEVICE"

Decision No. 2014-09

DECISION

MITSUBISHI JUKOGYO KABUSHIKI KAISHA (d/b/a Mitsubishi Heavy Industries, Ltd.) ("Opposer")[1] filed on 05 October 2012 an opposition to Trademark Application Serial No. 4-2012-003577. The application, filed by HANA INTERNATIONAL FZE ("Respondent-Applicant")[2], covers the mark "ATS & DEVICE" for use on various goods and services under Class 7 of the International Classification of Goods[3], as follows:

> "all parts and fittings included in Class 7 for agricultural tractors, commercial vehicles and diesel engines including piston ring kits, piston segments, pistons (for engines, parts of machines or engines,), cylinder liners, crank shafts, engine bearings, conrod assemblies (as parts of machines & engines), crankcases for machines, motors and engines, engine valves & valve guides, gaskets, oil pumps & balancers, fuel pumps (other than petrol vending pumps), water pumps & hydraulic pumps, starter motors & instruments, clutch components, transmission (apparatus for machines other than for land vehicles), transmission shafts and gears, differential gears, axles & brakes, steering (as linkage for machines), hydraulic lift)other than hand operated), bushes (parts of engines), & thrust washers, bearings, agricultural implements (other than hand operated), pressure valves, roller bearings, sealing joints, shafts (bearings of transmission), ball bearings, bearings for transmission shafts, belts for motors and engines, carbon bushes, springs (parts of machines), sparking plugs for internal combustion engines, injectors for engines."[4]

The Opposer alleges, among other things, that the registration of the contested mark in favor of the Respondent-Applicant will violate Section 123.1, pars. (d) and (e) of Rep. Act 8293, also known as the Intellectual Property Code of the Philippines ('IP Code"), and contravenes the provisions of Article 6bis of the Paris Convention on the Protection of Industrial Property and the World Trade Organization's Agreement on Trade Related Aspects of Intellectual Property Rights. To support its opposition, Opposer submitted the following:

1. Exhibit "A" - duly authenticated Special Power of Attorney coming Mitsubishi Heavy Industries, Ltd. (MHI) and signed by Hiromichi Ito;

---

[1] A corporation duly organized and existing under the laws of Japan, with business address at 16-5, Konan 2-Chome, Minato-Ku, Tokyo, Japan.
[2] With business address at P.O. Box 17900, Jebel Alifree Zone, Dubai, U.A.E.
[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] Respondent-Applicant's trademark application (Item No. 6); file wrapper.

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE
Intellectual Property Center, 28 Upper McKinley Road, McKinley Hill Town Center
Fort Bonifacio, Taguig City 1634 Philippines
T: +632-2386300 • F: +632-5539480 • www.ipophil.gov.ph

2. Exhibit "B" – duly authenticated company certificate from MHI signed by Yoshiyashi Tsukuda;
3. Exhibit "C" – duly authenticated affidavit of Hiromichi Ito;
4. Exhibit "D" – certified copy of Trademark Registration Certificate No. 4-2005-01459 for the mark Triple Diamond Device dated 05 November 2007;
5. Exhibit "E" – certified copy of Trademark Registration Certificate No. 4-2010-01211 for the mark Three Diamonds Device dated 16 September 2010;
6. Exhibit "F" – certified copy of Declaration of Actual Use dated 09 January 2008 for Trademark Certificate No. 4-2005-01459, Triple Diamond Device;
7. Exhibits "G-1" to "G-2" – pages/excerpts from the MHI Guidebook about the outline and objects of MHI;
8. Exhibits "H-1" to "H-2" – downloaded pages/excerpts from the website Mitsubishi.com and mhi-global.com about the origin and history of MHI;
9. Exhibit "I" – downloaded pages/excerpts from the website Mitsubishi.com and mhi-global.com about the origin and history of the mark;
10. Exhibit "J" – pages/excerpts from the MHI Guidebook about the consolidated statement of accounts of MHI;
11. Exhibit "K" – downloaded pages/excerpts from the website mhi-global.com about MHI's global network;
12. Exhibit "L" – downloaded pages/excerpts from the website mhi-global.com about MHI's Philippine Offices;
13. Exhibit "M" – pages/excerpts taken from the book "Famous Trademarks in Japan" published by the AIPPI; and
14. Exhibit "N" – side by side comparison of the marks Triple Diamond Device and ATS & Device.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 24 October 2012. While this Bureau granted the Respondent-Applicant's two motions for the extension of time to file answer, the said party still failed to submit its answer. This prompted the Hearing Officer to issue on 19 April 2013 Order No. 2013-631 declaring the Respondent-Applicant in default.

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.[5] In this regard, Sec. 123.1(d) of the IP Code provides that a mark shall not be registered if:

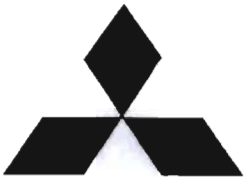
> (d) is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:
> (i) the same goods or services; or
> (ii) closely related goods or services, or
> (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion.

Records show that at the time Respondent-Applicant file its trademark application on 21 March 2012, the Opposer already has existing trademark registrations in the Philippines for

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

the mark "TRIPLE DIAMOND DEVICE", under Reg. Nos. 4-2005-01459 (issued 05 November 2007)[6] and 4-2010-001211 (issued 16 September 2010)[7] for various goods under Classes 7 and 37. The Opposer also has registered its mark in many countries, with the earliest issued in 1962[8]. These registrations cover goods that are similar and/or closely related to those indicated in the Respondent-Applicant's trademark application, like machines, engines, motors, industrial/power tools, among others.

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



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 of 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 competition.[9]

In this regard, when one looks at the mark applied for registration by the Respondent-Applicant, the outline of three "diamond shapes" that are connected or conjoined together at the tips appears. In fact, the Respondent-Applicant described its mark as one that "*consists of three (3) diamond shapes with their tips conjoined together.*"[10] The configuration of a three diamond shapes conjoined together can hardly escape the eyes of even those of a mere casual observer. The prominence of the conjoined three diamond shapes is enhanced by the dark-shaded triangles that formed in the spaces between the diamond shapes.

Unfortunately, the conjoined three diamond shapes is practically identical to the Opposer's registered mark "TRIPLE DIAMOND DEVICE". That there appears a letter on each of the diamond shapes is of no moment. 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 other[11]. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all

---

[6] Exhibit "D".
[7] Exhibit "E".
[8] Par. 7 of the Affidavit of Hiromichi Ito (Exhibit "C").
[9] Clarke v. Manila Candy Co. 36 Phil. 100, 106; Co Tiong SA v. Director of Patents 95 Phil. 1, 4.
[10] See Respondent-Applicant's trademark application (Item No. 4); filewrapper.
[11] Societe Des Produits Nestle , S.A v. Court of Appeals, G.R. No.112012, 4 April 2001, 356 SCRA 207, 217.

presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article[12].

Succinctly, because the Respondent-Applicant will use or uses the mark on goods and services that are similar and/or closely related to those dealt in by the Opposer under the registered trademarks "TRIPLE DIAMOND DEVICE", there is the likelihood of confusion. It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, 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.[13] 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:[14]

> 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.

Thus, information, assessment, perception or impression about the Respondent-Applicant's products may unfairly be cast upon or attributed to the Opposer and *vice-versa.*

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

WHEREFORE, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-003577 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 15 January 2014.

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

[12] Emerald Garment Manufacturing Corp. v. Court of Appeals. G.R. No. 100098, 29 Dec. 1995.
[13] American Wire and Cable Co. v. Director of Patents et al., (31 SCRA 544) G.R. No. L-26557, 18 Feb. 1970.
[14] Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 Jan. 1987.