



WINSTON UYCHIYONG,
Opposer,

-versus-

ALEX TAI,
Respondent- Applicant.

x-----x

}
} IPC No. 14-2010-00203
} Opposition to:
} Appln. Serial No. 4-2009-003279
} Date File: 30 March 2009
} TM: "YAZAKI"

NOTICE OF DECISION

SIOSON SIOSON & ASSOCIATES

Counsel for the Opposer
Unit 903 AIC-BURGUNDY EMPIRE TOWER
ADB Avenue corner Garnet & Sapphire Roads
Ortigas Center, Pasig City

MR. ALEX TAI

Respondent-Applicant
35-B, 8th corner 10th Avenue
Grace Park, Caloocan City

GREETINGS:

Please be informed that Decision No. 2014 - 139 dated May 15, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 15, 2014.

For the Director:

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



WINSTON UYCHİYONG,
Opposer,

-versus-

ALEX TAI,
Respondent-Applicant.

} IPC NO. 14-2010-00203
} Opposition to:
}
} Appln. Ser. No. 4-2009-003279
} Date Filed: 30 March 2009
} Trademark : "YAZAKI"
}
}
} Decision No. 2014- 139

x-----x

DECISION

WINSTON UYCHİYONG, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2009-003279. The application, filed by ALEX TAI (Respondent-Applicant)², covers the mark "YAZAKI", for use on "Welding machine, air compressor, power tool, drill, heat gun, planer, angle grinder, bench grinder, cutting machine, drill bit, grinding machine, plasma welding machine, impact drill" under Class 7 of the International Classification of Goods³.

The Opposer invokes Sec. 123.1 (d) and 138 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") which provide:

Sec. 123.1. Registrability. 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.

xxx

Sec. 138. Certificates of Registration

A certificate of registration of a mark shall be *prima facie* of the validity of the registration, the registrant's exclusive right to use the same in connection with

¹ Filipino with address at 2nd Floor, Winhaus Buiding, 2366 Leon Guinto Street, Malate, Manila.
² Filipino with address at 35 B 8th cor 10th Ave., Grace Park, 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.

the goods or services and those that are related thereto specified in the certificate.”

The Opposer relies on the following facts in support of its Opposition:

“2. Opposer is the registered owner of the trademark ‘YASAKI & DEVICE’ under Registration No. 48841 issued on August 3, 1990 for use on scales, bulbs, fluorescent tube, starter, ballast, insulating material i.e. tube, plate and rod, flashlight, lantern, socket, lampholder, electric wiring devices and electric motor and generator falling under classes 7, 9, 11 and 17.

“3. Registration No. 48841 continues to be in full force and effect.

“4. Last August 2, 2010, Opposer filed his Petition for Renewal of Registration No. 48841.

“5. Through Wintrade Industrial Sales Corp., of which he is President, Opposer has used and continues to use his registered trademark ‘YASAKI & DEVICE’.

“6. The trademark ‘YAZAKI’ being applied for registration by respondent is confusingly similar to Opposer’s registered trademark ‘YASAKI & DEVICE’.

“7. The goods covered by respondent’s application are related to the goods covered by Opposer’s Registration No. 48841.

Accordingly, the approval of the application in question is contrary to Section 123.1 (d) of Republic Act No. 8293, which provides: xxx

“8. The approval of the application in question violates the right of the opposer and his company to the exclusive use of his registered trademark ‘YASAKI & DEVICE’ on goods listed in the registration certificate issued to him or related to them.”

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

1. Certified copy of Certificate of Registration No. 48841 for the mark YASAKI & DEVICE dated 13 August 1990;
2. Certified copies of the Affidavit of Use/Declaration of Actual use dated 24 July 1996; 18 July 2001 and 31 May 2006, respectively;
3. Certified copy of Petition for Renewal of Registration No. 48841 dated 2 August 2010;
4. Certified copies of sales invoices of Wintrade Industrial Sales Corp. bearing ‘YASAKI & DEVICE’;
5. Print-out of the Respondent-Applicant’s application in the e-Gazette; and

6. Notarized Affidavit of Winston Uychiyong.⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 10 October 2010. The Respondent-Applicant, however did not file an Answer. Thus, the Hearing Officer issued on 19 May 2011 Order No. 2011-613 declaring the Respondent-Applicant to have waived his right to file an Answer.

Should the Respondent-Applicant be allowed to register the trademark YAZAKI?

The records show that when the Respondent-Applicant filed its application on 30 March 2009, the Opposer already has an existing registration for the trademark YASAKI & DEVICE⁵ issued on 3 August 1990 covering goods under class 9, 7, 11 and 17 namely: "scales, bulbs, fluorescent tube, starter, ballast, insulating material i.e. tube, plate and rod, flashlight, lantern, socket, lampholder, electric wiring devices and electric motor and generator". The Respondent-Applicant's trademark application therefore indicates goods that are similar and/or closely related to those covered by the Opposer's trademark registration. The Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's, particularly, Welding machine, air compressor, power tool, drill, heat gun, planer, angle grinder, bench grinder, cutting machine, drill bit, grinding machine, plasma welding machine, impact drill, which flow through the same channels of trade. In *Mighty Corporation and La Campana Fabrica de Tabaco, Inc. v. E. & J. Gallo Winery and the Andresons Group, Inc.*⁶, the Supreme Court held:

"In resolving whether goods are related, several factors come into play:

- (a) the business (and its location) to which the goods belong
- (b) the class of product to which the goods belong
- (c) the product's quality, quantity, or size, including the nature of the package, wrapper or container
- (d) the nature and cost of the articles
- (e) the descriptive properties, physical attributes or essential characteristics with reference to their form, composition, texture or quality
- (f) the purpose of the goods
- (g) whether the article is bought for immediate consumption, 100 that is, day-to-day household items
- (h) the fields of manufacture
- (i) the conditions under which the article is usually purchased and
- (j) the channels of trade through which the goods flow, how they are distributed, marketed, displayed and sold."

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

⁴ Exhibits "A" to "H" inclusive of submarkings

⁵ Exhibits "A" and "B"

⁶ G.R. 154342, July 14, 2004

Opposer's mark



Respondent-Applicant's mark

YAZAKI

The literal elements of the marks are identical except the letter "Z" used by the Respondent-Applicant to replace the Opposer's "S" in YASAKI. In spite of this, the two words sound exactly the same. That the Opposer's mark is a composite mark which utilizes a device in addition to the word YASAKI is of no consequence. When the marks are applied on related goods, confusion and deception is likely to result. Evidence shows that the Opposer has registered its mark under Registration No. 48841⁷ since August 3, 1990 and has continuously used the same in commerce as proven by sales invoices/receipts⁸ bearing the mark YASAKI to describe its products.

Succinctly, because the Respondent-Applicant uses its mark on goods that are similar or closely related to the Petitioner's it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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.⁹

The public interest, therefore, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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

⁷ Exhibit "A"

⁸ Exhibit "F"

⁹ *Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

manufacturer against substitution and sale of an inferior and different article as his product.¹⁰

The Respondent-Applicant despite the opportunity given, did not file an Answer in order to defend its trademark application and explain how it arrived at using a mark that is practically identical/confusingly similar to the Opposer's registered mark.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2009-003279 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 15 May 2014.


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

¹⁰ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).