



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

Opposer,

-versus-

RNA GLOBAL VENTURES, INC.,
Respondent - Applicant.

X-----X

IPC No. 14-2010-00229

Opposition to:

Appln. Serial No. 4-2008-014563

Date filed: 2 December 2008

TM: "KOMATSU"

NOTICE OF DECISION

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RNA GLOBAL VENTURES, INC.,

Respondent-Applicant
2496 Taft Avenue
Pasay City

GREETINGS:

Please be informed that Decision No. 2014 - 276 dated November 03, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 03, 2014.

For the Director:


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



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RNA GLOBAL VENTURES, INC.,

Respondent-Applicant.

} **IPC NO. 14-2010-00229**

} Opposition to:

} Application No. 4-2008-014563

} Date filed : 2 December 2008

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} Trademark : **"KOMATSU"**

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DECISION

KABUSHIKI KAISHA KOMATSU SEISAKUSHO (also known as KOMATSU LTD.) (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2008-014563. The application, filed by RNA GLOBAL VENTURES, INC., (Respondent-Applicant)², covers the mark "KOMATSU", for use on "circuit breaker, fuse, safety switch, receptacle, electrical socket, electrical plug, service drop wires, wiring devices, wall switches, dimmers, wire extension, utility and junction boxes, electric buzzers, electric cables and wires, electric couplings, electric current switches, electric outlet covers, electric switch plates, electric switches all the aforementioned in class 9" under Class 9 and other goods under Classes 1, 2, 6 and 17 of the International Classification of Goods³.

The Opposer invokes Sec. 123.1 (d), (e) and (f) 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;

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

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

- (e) Is identical with, or confusingly similar to, or constitutes a translation of a mark with 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 public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;
- (f) Is identical with or confusingly similar to, or constitutes a translation of a mark, considered well known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods and services which are not similar to those with respect to which registration is applied for: *Provided*, that the use of the mark in relation to the 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 such use.”

and Article 6bis of the Paris Convention, to wit:

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 considered by 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.

The Opposer also alleges the following facts:

“12. In the Philippines, opposer is the owner of the trademark KOMATSU under international Class 9 registered with the Intellectual Property Office (IPO), the particular of which are as follows:

Trademark : KOMATSU
Registrant : Kabushiki Kaisha Komatsu Seisakusho
(also known as KOMATSU, LTD.)
Certificate of
Reg. No. : 4-1995-107029
Date Issued : July 12, 2000
Appln. No. : 4-1995-107029



Date Filed : December 20, 1995
Goods : 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-working, earth-handling, construction, metal working and also of land vehicles, visual-sensor device for inspection purposes (of electrical 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 and/or identifying objects lying under the ground, parts and attachments for said goods.

Class : 9

“13. Opposer is also the owner/registrant of other trademark registrations for KOMATSU under International Classes 7 and 12, the particulars of which are as follows:

a) Trademark: KOMATSU

Registrant : Kabushiki Kaisha Komatsu Seisakusho
(also known as KOMATSU, LTD.)

Certificate of

Reg. No. : 4-1995-107028

Date Issued : July 12, 2000

Appln. No. : 4-1995-107028

Date Filed : December 20, 1995

Goods : Earth-working machines and apparatus, namely bulldozers, swamp bulldozers, amphibious bulldozers, tire dozers, motor scrapes, towed scrapes, rippers and rake dozers, earth-handling machines and apparatus, namely, shovel loaders, wheel loaders, tractor loaders, compactors and loader buckets, excavators, namely backhoes, dozers, shovels, swamp type dozer shovels, swing dozers shovels, powershovels, bucket excavators, mining shovels, trenchers, and tunnel boring machines, construction machines and apparatus, namely, drop-hammers, tire-rollers, asphalt finishers, vibration rollers, vibroplates, 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, conveyors, chain saws, bush cutters, air compressor, truck cranes, engines and transmissions for said goods, parts and attachments for the aforementioned goods.

Class : 7

b) Trademark: KOMATSU

Registrant : Kabushiki Kaisha Komatsu Seisakusho
(also known as KOMATSU, LTD.)

Certificate of

Reg. No. : 4-1995-107030

Date Issued : July 12, 2000

Appln. No. : 4-1995-107030

Date Filed : December 20, 1995

Goods : Transportation vehicles, namely, forklift (trucks), electric liftrucks, 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.

Class : 12

“14. Opposer’s mark KOMATSU covering goods under International Class 9 was applied for registration as early as December 20, 1995, and was registered as early as July 12, 2000, long before respondent-applicant’s application for registration of the identical mark KOMATSU on December 2, 2008 for similar, related and competing goods under the same International Class 9. Hence, opposer’s registration for KOMATSU will bar the registration of respondent-applicant’s identical mark.

“15. The trademark KOMATSU of respondent-applicant and the trademark KOMATSU of opposer are identical. Hence, confusion in the minds of the purchasing public will most likely arise.

“16. Being identical to opposer’s registered mark KOMATSU, the registration of respondent-applicant’s mark is explicitly proscribed under Section 123.1, subparagraph (d) of the Intellectual Property Code,

xxx

“20. Opposer is the owner of and/or registrant of and/or applicant of many trademark registrations and applications for the mark KOMATSU in the Philippines and around the world under International Class 9, among other classes.

“20.1 Enclosed herewith as Annex ‘A’ and made an integral part hereof is opposer’s Worldwide Trademark Portfolio for KOMATSU.

“20.2 Also enclosed herewith as Annexes ‘B’ to ‘B-20’ and made integral parts hereof are Certificates of Registration for the mark KOMATSU from Australia, Brazil, Canada, Switzerland, China, Germany, Great Britain, Hong Kong, Italy, Japan, New Zealand, African Intellectual Property Organization (O.A.P.I.), European Union (Office of Harmonization in the Internal Market, OHIM), Russian Federation, Singapore, United Arab Emirates, United States of America, Indonesia, Chile, Trinidad & Tobago, and Sudan, the original or certified true copies of which will be presented during the preliminary conference of the instant opposition case.

“20.3. Further enclosed herewith as Annex ‘C’ and made an integral part hereof is a copy of the Decision dated December 29, 2008 in Panama upholding opposer’s rights to the mark KOMATSU, the original or certified true copy of which will be presented during the preliminary conference of the instant opposition case.

“21. Opposer has also caused extensive promotion and advertising of its products bearing the trademark KOMATSU in the Philippines and in various countries all over the world.

“21.1. Enclosed herewith as Annexes ‘D’ to ‘G’ and made integral parts hereof are advertising materials which appeared in various magazines distributed worldwide in 2008 and 2009, such as International Construction, African Review, Southeast Asia Construction, Asia Miner, Gulf Construction, MEED, Mining Magazine, World Coal, and Engineering & Mining Journal. It is noteworthy that the publications International Construction, Southeast Asia Construction, Asia Miner and World Coal are distributed in the Philippines.

“21.2. Also enclosed herewith as Annex ‘H’ and made an integral part hereof is opposer’s Magazine Advertising 2008-2009 table showing the dates when the advertising materials are placed on the foregoing worldwide publications.

“22. Likewise KOMATSU products are widely sold and distributed in different countries around the world such as U.S.A. and Canada in North America; Austria, Belgium, Denmark, Finland, France, Germany, Ireland, Italy, Netherlands, Norway, Portugal, Spain, Sweden, Switzerland, United Kingdom, Chechnya, Greece, Hungary, Iceland, Ukraine, Poland, Slovakia, and Israel in Europe, North Africa, Indonesia, Thailand, Malaysia, Singapore, Philippines, Vietnam, Myanmar, Laos, Cambodia, Taiwan and India in South East Asia, Australia, New Zealand, and New Caledonia in Australia, Brazil and Chile in Latin America, South Africa,

Turkey, Nari and Saudi Arabia in Middle East, China, Russia, Mongolia, and Korea.

“23. Opposer likewise maintains an official website on the Internet, i.e. www.komatsu.com, which may be accessed by anyone with just a click of the mouse. Print-outs of this website, containing basic information about oppose and its products, are enclosed herewith as Annexes ‘I’ to ‘I-17’ and made integral parts hereof. xxx”

The Opposer submitted as evidence the following:

1. List of Worldwide trademark portfolio;
2. Copies of certificates of registration in Australia, Brazil, Canada, Switzerland, China, Germany, Great Britain, Hong Kong, Italy, Japan, New Zealand, African Intellectual Property Organization (O.A.P.I.), European Union (Office of Harmonization in the Internal Market, OHIM), Russian Federation, Singapore, United Arab Emirates, United States of America, Indonesia, Chile, Trinidad & Tobago, and Sudan for the mark “KOMATSU” ;
3. Copy of Panamanian Decision dated 29 December 2008 in Panama;
4. Copies of various advertising materials for the mark “KOMATSU” and Magazine Advertising 2008-2009 table;
5. Print-out of website www.komatsu.com;
6. Notarized and legalized copy of the Opposer’s Japanese Commercial Register;
7. Notarized and legalized copy Affidavit of Kunio Noji;
8. KOMATSU 2010 Fact Book; and
9. KOMATSU 2010 Annual Report.⁴

This Bureau issued a “Notice to Answer” which was served upon the Respondent-Applicant on 22 November 2010. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 26 January 2013 Order No. 2013-339 declaring the Respondent-Applicant in default.

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

Section 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”) provides:

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;

⁴ Exhibits “A” to “M” inclusive of submarkings

The records show that when the Respondent-Applicant filed its application on 2 December 2008, the Opposer already has existing registrations for the trademark KOMATSU under Certificate of Registration No. 4-1995-107029 issued on 12 July 2000 for "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-working, earth-handling, construction, metal working and also of land vehicles, visual-sensor device for inspection purposes (of electrical 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 and/or identifying objects lying under the ground, parts and attachments for said goods" under Class 9; earth-working machines and apparatus under class 7; and transportation vehicles such as electric reach trucks under class 12. The goods covered by the Opposer's trademark registration are closely related to the goods indicated in the Respondent-Applicant's trademark application. That the Opposer's goods are not exactly the same is of no moment. In *Mighty Corporation and La Campana Fabrica de Tabaco, Inc. v. E. & J. Gallo Winery and the Andresons Group, Inc.*⁵, 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."

The competing marks, depicted below, are identical:

KOMATSU

KOMATSU

Opposer's mark

Respondent-Applicant's mark

⁵ G.R. 154342, July 14, 2004

Succinctly, because the Respondent-Registrant 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.⁶

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 manufacturer against substitution and sale of an inferior and different article as his product.⁷

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2008-014563 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, 3 November 2014.


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

⁶*Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

⁷*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).