



TEIKOKU PISTON RING CO. LTD.,
Opposer,

-versus-

PHILIPPINE SUNTAL CORPORATION,
Respondent- Applicant.

}
} IPC No. 14-2010-00254
} Opposition to:
} Appln. Serial No. 4-2009-010312
} Date Filed: 12 October 2012
} TM: "TP PISTON COMPANY
} LIMITED AND DEVICE"
}

X-----X

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 247 dated October 09, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 09, 2014.

For the Director:

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



TEIKOKU PISTON RING CO. LTD., } **IPC NO. 14-2010-00254**
 Opposer, } Opposition to:
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 -versus- } Application No. 4-2009-010312
 } Date filed :12 October 2012
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PHILIPPINE SUNTAL CORPORATION, } **Trademark: TP PISTON COMPANY**
 Respondent-Applicant. } **LIMITED AND DEVICE**
 }
 x-----x } Decision No. 2014- 247

DECISION

TEIKOKU PISTON RING CO. LTD. (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2009-010312. The application, filed by PHILIPPINE SUNTAL CORPORATION (Respondent-Applicant)², covers the mark “TP PISTON COMPANY LIMITED AND DEVICE”, for use on “pistons for motorcycles” under Class 12 of the International Classification of Goods³.

The Opposer alleges that:

“7. The registration of the mark TP PISTON COMPANY LIMITED AND DEVICE in the name of the Respondent-Applicant will violate and contravene the provisions of Sections 123.1 (d), (e), (f) and (g) of the IP Code, as amended, because said mark is confusingly similar to Opposer’s internationally well-known trademark TP, owned, registrerd in the Philippines, used and not abandoned by the Opposer as to be likely to cause confusion or mistake, or deceive the purchasers thereof as to the origin of the goods.

“8. The registration of the mark TP PISTON COMPANY LIMITED AND DEVICE in the name of the Respondent-Applicant will cause grave and irreparable injury and damage to the Opposer for which reason it opposes said application based on the grounds set forth hereunder:

A. Opposer is the prior adopter, user and true owner of the trademark TP in the Philippines, and elsewhere around the world.

¹ A corporation duly organized and existing under the laws of Japan, with principal office at 9-9 Yaesu 1-Chome, Chuo-Ku Tokyo

² Philippine corporation with address at 127 A. Del Mundo Street, 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.

“9. Opposer is internationally well-known as a manufacturer of world class quality powertrain products such as piston rings, cylinder liners, sintered products and other products, not only in Japan but elsewhere. As an engine function parts maker, Opposer supports the auto and related industries in its development of eco-friendly engines.

“10. Opposer’s history dates back to 1939, when it was known as Tanaka Piston Ring Co. Ltd., and was established in Osaka to manufacture piston rings for airplanes and ships as its major products. In 1943, the corporate name was changed to TEIKOKU PISTON RING CO. LTD.

“11. Herewith attached as Exhibit ‘B’ to ‘B-17’ is a duly notarized Affidavit –Direct-Testimony executed by Atty. Christine Ann L. Barredo, wherein she provides printouts of the Opposer’s website (http://www.tpr.co.jp/tp_e/index.html). Information on the Opposer’s overview, history, products and technologies, and affiliated companies, among others, can be found on said site.

“12. Opposer is the owner of the mark TP, registered with the IPOPhil as early March 22, 1995 covering goods under class 12, specifically ‘industrial machinery and implements, prime movers and implements (excluding motors) and others belonging to Class 9 under the Japanese classification.’ As proof of the foregoing, herewith attached as Exhibit ‘C’ is a certified true copy of Registration No. 022322. As such registered trademark, TP is entitled to protection in the Philippines against unauthorized use or expropriation by third parties.

“13. Opposer has been using its TP trademark in the Philippines since 1972 and products bearing the TP trademarks are distributed in the Philippines through the following:

- a. CHUAN LAM, located at 2815 Jose Abad Santos Avenue, Tondo, Manila;
- b. KINGSWEALTH, located at 1009 Rm. 107, Benavides St. Binondo, Manila;
- c. DTH, located at 224 D. Tuazon St. Quezon City, Metro Manila; and
- d. ISUZU SALES, located at 950 Benavides St. M

B. Respondent-Applicant’s mark TP PISTON COMPANY LIMITED AND DEVICE is confusingly similar to Opposer’s internationally well-known TP trademark.

“14. Respondent-Registrant’s mark TP PISTON COMPANY LIMITED AND DEVICE is confusingly similar to the trademark TP, for which Opposer has already obtained an earlier registration in the Philippines.

“15. Representations of both Opposer’s and Respondent-Applicant’s mark are herein replicated for easy reference xxx
The visual comparison above only highlights the striking similarity between the competing marks.

“16. The Opposer’s well-known mark is comprised of the upper-case letters ‘T’ and ‘P’; the ‘P’ being smaller in size so as to fit under one of the horizontal lines of the upper case ‘T’. The visual comparison above clearly shows that Respondent-Applicant has completely appropriated the entirety of Opposer’s mark, merely enclosing the same in a ring. Needless to say, the dominant feature of Respondent-Applicant’s mark is its TP component, which is IDENTICAL to Opposer’s registered TP Mark.

xxx

“19. The confusing similarity between Respondent-Applicant’s TP PISTON COMPANY LIMITED AND DEVICE and Opposer’s well-known mark TP is highly likely to deceive the purchasers of goods on which the mark is being used as to the origin or source of said goods and as to the nature, character, quality and characteristics of the goods to which it is affixed. Furthermore, the unauthorized use by others of a trademark similar or identical to Opposer’s TP will certainly dilute the distinctiveness of the latter, and adversely affect the function of said trademarks as indicator of origin, and/or the quality of the product.

C. Being confusingly similar, the registration of Respondent-Applicant’s mark TP PISTON COMPANY LIMITED AND DEVICE should not be allowed, since Opposer’s TP trademark is registered in the Philippines.

“20. As earlier stated, the goods covered by Opposer’s trademark TP fall under Class 12, specifically ‘industrial machinery and implements, prime movers implements (excluding motors) and others belonging to Class 9 under Japanese classification’, whereas Respondent-Applicant’s mark covers goods in Class 12, specifically ‘piston for motorcycles’.

“21. Despite belonging to different Classes, the opposing parties’ goods, by virtue of their characteristics and functions, are nevertheless closely related. Respondent-Applicant’s product, the piston, is a ‘sliding piece moved by or moving against fluid pressure which usually consists of a short cylindrical body fitting within a cylindrical chamber or vessel along which it moves back and forth’. Thus, it is considered a piece of industrial machinery or implement, used to form part of a bigger machine. Such industrial machineries and/or implements are goods covered by Opposer’s trademark registration.

“22. More importantly, and quite obviously, Opposer is in the business of manufacturing and distributing piston rings, much like respondent

applicant is presumably is, given that the latter's application covers 'piston for motorcycles' as goods. In fact, this is apparent from Opposer's corporate name alone, TEIKOKU PISTON RING CO. LTD.

"23. Even assuming arguendo that the goods covered by the competing marks are non-competing, confusion is still likely to arise. The use of identical or closely similar marks or trade names on non-competing goods or services may likely caused confusion or mistake as to their source or origin where the non-competing goods or services are so related with each other that it might reasonably be assumed that they originate from one manufacturer. (Page 53, Agpalo, The Law on Trademark Infringement and Unfair Competition 2000 Edition). xxx

D. Opposer's trademark TP is internationally well-known.

"28. In order to protect their rights to the TP trademark, Opposer has secured the registration of TP as a trademark in several strategic countries worldwide, xxx

"29. As proof of the foregoing, herewith attached as Exhibit 'D' to 'D-78' is the notarized and duly authenticated Affidavit-Direct Testimony of Isao Hiraide, the president and CEO of Opposer company, wherein he attests to the foregoing worldwide registrations, among others. Attached to the aforementioned Affidavit -Direct Testimony are copies of some of these registrations.

"30. Opposer has been exporting products bearing the TP trademark such as piston rings, liners, etc. in large quantities in many parts of the world, including the Philippines, and has established substantial goodwill and reputation in general public throughout the world.

"31. Worldwide sales of TP - branded products for the last five (5) years are as follows:

YEAR	SALES (in Million Yen)
2009	43,990
2008	51,922
2007	58,127
2006	52,307
2005	48,507

"32. In the Philippines, sales of TP-branded products for the last five (5) years are as follows:

YEAR	SALES (In Million Yen)
2009	144
2008	222
2007	149

2006	124
2005	101

“24. Opposer has spent substantial amounts of money in marketing and promoting the TP trademark in relation to its goods worldwide, including in the Philippines. For the last five (5) years, the amount spent by the Opposer for advertising and promotions are as follows:

YEAR	In Million Yen
2009	7
2008	7
2007	7
2006	7
2005	7

“34. Samples of advertisements of the TP trademark are attached to the Affidavit –Direct Testimony of Isao Hiraide as its Annexes ‘C’ and ‘E’.

“35. For the purpose of reaching more consumers globally and to better provide information about itself and its products, Opposer maintains an official website at http://www.tpr.co.jp/tp_e/index.html, where information on Opposer’s history, and products and services, among others, are made available to visitors.

“36. As a result of the extensive use and promotion of the TP trademark by the Opposer, the latter has built up and enjoys valuable and extensive goodwill and reputation in the Philippines and on a global basis.

E. Since Opposer’s trademark TP is internationally well-known, it is entitled to protection against confusingly similar marks covering similar or related products.

“37. Opposer’s trademark is internationally well-known, having met the criteria under Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Tradenames, and Marked or Stamped Containers. According to Section 123.1 (e) and (f) of the IP Code, a mark cannot be registered if it is identical with, or confusingly similar to well-known marks, xxx”

The Opposer submitted as evidence the following:

1. Notarized and authenticated Special Power of Attorney dated 17 September 2010;
2. Notarized Affidavit of Atty. Chrissie Ann L. Barredo dated 26 October 2010;
3. Certified true copy of Registration No. 022322 of the mark “TP” dated 22 March 1995; and

4. Notarized and authenticated Affidavit of Isao Hiraide dated 27 September 2010.⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 8 December 2010. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark TP PISTON COMPANY LIMITED AND DEVICE?

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.

The records show that when the Respondent-Applicant filed its application on 12 October 2009, the Opposer already has existing registrations for the trademark TP⁵ issued on 7 May 1995 for "industrial machinery and implements, prime movers and implements (excluding motors) and others belonging to Class 9 under the Japanese classification". The goods covered by the Opposer's trademark registration are closely related to the "pistons for motorcycles" indicated in the Respondent-Applicant's trademark application. As explained by the Opposer, "the Respondent-Applicant's product, the piston, is a 'sliding piece moved by or moving against fluid pressure which usually consists of a short cylindrical body fitting within a cylindrical chamber or vessel along which it moves back and forth'.⁶ Thus, it is considered a piece of industrial machinery or implement, used to form part of a bigger machine." That the Opposer's goods are under classes 24 and 36, while the Respondent-Applicant's service belongs to class 12 is of no moment. Products such as "pistons" are sold or retailed in establishments selling industrial machinery and implements, particularly pistons for engines. In *Mighty Corporation and La Campana Fabrica de Tabaco, Inc. v. E. & J. Gallo Winery and the Andresons Group, Inc.*⁷, 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

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

⁵ Exhibits "C"

⁶ <http://www.merriam-webster.com/dictionary/piston>

⁷ G.R. 154342, July 14, 2004

- (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?



Opposer's mark



Respondent-Applicant's mark

The Respondent-Applicant's mark "TP" is identical with the Opposer's mark. Visually and aurally, the competing marks are confusingly similar. The only differences are with respect to the words PISTON COMPANY LIMITED written along the circumference of the circle device enclosing the letters TP. This difference nonetheless, is inconsequential. The words "PISTON COMPANY LIMITED" are disclaimed in the application. The fact remains, that the two dominant letters consisting the mark applied for registration by the Respondent-Applicant are identical to the Opposer's. The Respondent-Applicant, in adopting an identical mark for retail services of hardware and household products, could result to confusion among the buying public.

Succinctly, because the Respondent-Applicant uses or will use the mark TP PISTON COMPANY LIMITED AND DEVICE marks on goods that are identical and/or closely related to the Opposer's it is likely that the consumers will have the impression that these goods originate from a single source or origin or mislead them into believing that the parties are connected to each other. 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.⁸

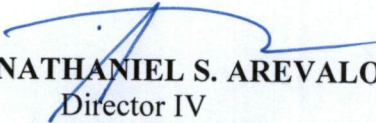
The public interest, therefore, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized 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.⁹

It is emphasized that the Respondent-Applicant despite the opportunity given, did not file an Answer to defend his trademark application and to explain how he arrived at using the mark TP PISTON COMPANY LIMITED AND DEVICE. It is incredible for the Respondent-Applicant to have come up with exactly the same mark for use on similar goods by pure coincidence.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2009-0010312 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, 9 October 2014.


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

⁸ *Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

⁹ *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).