



TOKYO TOKYO INC.,
Opposer,

-versus-

OMESH VASWANI,
Respondent-Applicant.

} **IPC No. 14-2012-00287**
}
} Opposition to:
} Application No.4-2011-014524
} Date filed: 6 December 2011
} TM: "**SUMO**"
}
}
}
}
}
}
}

x-----x

NOTICE OF DECISION

SANTIAGO & SANTIAGO
Counsel for Opposer
Ground Floor, Ortigas Building
Ortigas Avenue, 1605 Pasig City

SO MALAZARTE MIJARES GARCIA
Counsel for Respondent-Applicant
2/F, A & H Building, 1840 Evangelista St.
Pio Del Pilar, Makati City

GREETINGS:

Please be informed that Decision No. 2015 - 139 dated June 29, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 29, 2015.

For the Director:


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



TOKYO TOKYO INC.,
Opposer,

-versus-

OMESH VASWANI,
Respondent-Applicant.

}IPC NO. 14-2012-00287
}Opposition to:
}
}Appln. Ser. No. 4-2011-014524
}Date Filed: 6 December 2011
}Trademark: SUMO
}
}
x-----x}Decision No. 2015- 139

DECISION

TOKYO TOKYO INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2011-014524. The application, filed by OMESH VASWANI, (Respondent-Applicant)², covers the mark “SUMO”, for use on “Furniture namely: office chairs, office desks, office cabinets, file cabinets, folding tables, folding chairs, tables, chairs, MTO furniture, HDPE Folding plastic tables and chairs, bench, glider bench, adjustable table HT, reception desks, gang chairs, guest chairs restaurant cahirs and tables, monoblock type stacking plastic chairs and tables, home furniture namely cabinet, bed, sofa set, dining set, TV stand, wardrobe, computer table, racking shelves, furniture made of steel, plastic, wood mix” under Class 20 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

“5. Tokyo Tokyo opposes the abovementioned application of Vaswani on the ground that said application is identical or confusingly similar to the trademark 'SUMO' of Tokyo Tokyo, to wit:

Section 123. Registrability.- 123.1 A mark cannot be registered if it: xxx

(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.”

¹ Philippine corporation with address at 5 Pioneer St. Cor Sheridan, Mandaluyong City

² Filipino with address at 1161 Estrada cor. Espiritu St., Palanan Makati 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.

"6. The use and registration of the above-mentioned mark on the goods of Vaswani would indicate a connection between the goods sold by Vaswani and those sold by Tokyo Tokyo, which will likely result to damages on the part of Tokyo Tokyo, which will likely result to damages on the part of Tokyo Tokyo. xxx

"8. Based on the foregoing provision, the consuming public is likely to be (i) confused, (ii) be deceived and (iii) make mistakes as to origin of the merchandise of Vaswani and will result to the diminution of the distinctiveness and goodwill of Tokyo Tokyo, the registered trademark owner of 'SUMO' since 27 October 2008, and who has used, promoted and marketed the aforesaid mark in the sale of its Sumo Meals, as early as 1994.xxx

"9. It is clear from the above-quoted decision that Tokyo Tokyo is entitled to the protection of its trademark 'SUMO' in view of the efforts of Tokyo Tokyo to increase the popularity and sales of its Sumo Meals through the investment of countless resources in advertising and marketing of its products. Moreover, Vaswani is free to choose from a selection of words, names, symbols, emblems, signs and devices, or combination thereof to identify and distinguish his goods from that of others. xxx"

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

1. Copy of Philippine Trademark Registration No. 4-2007-002045 issued on 27 October 2008 for the mark "SUMO for goods under class 29, namely : "Cooked meats and seafoods";
2. Copy of trademark application of Respondent-Applicant for the mark "SUMO"; and
3. Copies of its Menu.⁴

The Respondent-Applicant filed its Answer on 26 November 2012, alleging among other things, the following:

"5. The disqualification in Section 123.1 (f) does not exist and is not applicable in the instant case since opposer's trademark is not well known mark pursuant to Section 123.1 (e) of R.A. 8293, as specified above;

"6. Moreover, opposer failed to submit any evidence to prove that its trademark is well known mark or otherwise shows exclusivity to the use of the mark; xxx

"13. The above-described SUMO trademark of Vaswani is used as stickers on various products, printed as carton marks and brand on boxes

⁴ Annexes "A" to "C"

of products, and is utilized in advertisement materials, billboards, newsprint, online advertising etcetera. xxx

"17. Suffice it to say that opposer's trademark registration is for Class 29 - cooked meat and seafoods while respondent's application is for Class 20 - various furnitures. Opposer's products are being sold in Tokyo Tokyo restaurants or outlets while respondent-applicant's goods are sold on-line via www.costules.com.ph and other partner sites and business showroom, Cost U Less, is a warehouse located at 5112 Filmore St., Makati City, furthermore, the goods are apparently so alien and distinct, in form and object, that it is unlikely that the consuming public will be confused or deceived and make mistakes as to the origin of the merchandise of the respondent-applicant, which may result in the diminution of the alleged goodwill earned and claimed by the opposer. xxx"

To support its Answer, the Respondent-Applicant submitted as evidence the following:

1. Copy of Trademark Application form for the mark "SUMO";
2. Pictures of Boxes and packaging carton with the mark "SUMO";
3. Pictures of Respondent-Applicant's products, i.e. chairs, tables;
4. Actual Business cards of Respondent-Applicant;
5. Print-out of webpage of COST U LESS with the mark "SUMO";
6. Representative sales invoices for "SUMO" products; and
7. Sample advertising flyers of COST U LESS with "SUMO" mark.⁵

The Preliminary Conference was held on 16 May 2013 where both parties were directed to file their respective position papers.

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

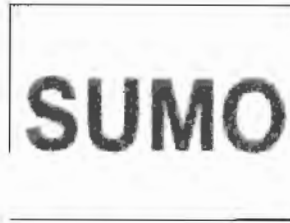
Records show that at the time Respondent-Applicant applied for registration of the mark "SUMO" the Opposer already registered the mark SUMO under Registration No. 4-2007-002045 issued on 27 October 2008 for the mark "SUMO for goods under class 29, namely : "Cooked meats and seafoods". Respondent-Applicant's trademark application is applied on goods under class 20, namely: "furniture".

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

The competing marks are reproduced are identical:

⁵ Annexes "A" to "I"

SUMO



Opposer's mark

Respondent-Applicant's mark

Even if the marks of the parties are identical, the kind, nature or type of goods upon which the marks are to be applied must be considered in determining the likelihood of confusion. The Opposer uses its mark on goods under class 29, cooked meat while the Respondent-Applicant uses its mark on a variety of furniture. The channels of trade where the goods flow are worlds apart. The target market or consumers are also different, thus it is unlikely that on account of the identity of the marks SUMO, the public would be vulnerable to confusion much less deception.

It is basic in trademark law that the same mark can be used on different types of goods. The Supreme Court in *Philippine Refining Co. Inc. v. Ng Sam*⁶ held:

A rudimentary precept in trademark protection is that "the right to a trademark is a limited one, in the sense that others may use the same mark on unrelated goods."¹ Thus, as pronounced by the United States Supreme Court in the case of *American Foundries vs. Robertson*, "the mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description."

Such restricted right over a trademark is likewise reflected in our Trademark law. Under Section 4(d) of the law, registration of a trademark which so resembles another already registered or in use should be denied, where to allow such registration could likely result in confusion, mistake or deception to the consumers. Conversely, where no confusion is likely to arise, as in this case, registration of a similar or even identical mark may be allowed.

In *Canon Kabushiki Kaisha v. Court of Appeals*⁷ likewise held:

xxx petroleum products on which the petitioner therein used the trademark ESSO, and the product of respondent, cigarettes are "so foreign to each other as to make it unlikely that purchasers would think that petitioner is the manufacturer of respondent's goods". Moreover, the fact that the goods involved therein flow through different channels of trade highlighted their dissimilarity xxx

Thus, the evident disparity of the products of the parties in the case at bar renders unfounded the apprehension of petitioner that confusion of business or origin might occur if private respondent is allowed to use the mark CANON."

⁶ .GR. No. L-26676 July 30, 1982

⁷ G R. 120900 July 20, 2000

A handwritten signature in blue ink, appearing to be the initials "A.R." followed by a flourish.

The evidence also reveal that the Respondent-Applicant uses the SUMO trademark with the image of a SUMO wrestler as it appears below:



This variation of Respondent-Applicant's mark is seen prominently in its advertising materials/flyers⁸; internet website;⁹ and its cartons and boxes¹⁰. Because the marks are used on products of different nature, confusion and deception is unlikely. There is no likelihood of confusion of business. It is improbable for one who is buying or patronizing Opposer's food products to be reminded of the Respondent-Applicant's mark "SUMO" which is applied on a wide range of furniture products. "SUMO" is not a word invented by the Opposer nor is it exclusively identified with the Opposer. Both parties are using the word as arbitrary marks. Thus, both co-exist as long as the goods/services are not similar or closely related. In fact, the parties' respective businesses are so unrelated to even think that Opposer is producing such goods.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-014524 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 29 June 2015.


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

⁸ Exhibit "I"

⁹ Exhibit "F"

¹⁰ Exhibit "B"