



STANLEY SECURITY SOLUTIONS, INC.,
Opposer,

-versus-

ZHI YANG CAI,
Respondent-Applicant.

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IPC No. 14-2013-00104
Opposition to:
Appln. Serial No. 4-2012-011777
Date Filed: September 25, 2012
TM: **"BESTGUARD"**

NOTICE OF DECISION

SANTOS PILAPIL & ASSOCIATES

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DE GUZMAN LAW OFFICE

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GREETINGS:

Please be informed that Decision No. 2015 - 214 dated October 19, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 19, 2015.

For the Director:

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



STANLEY SECURITY SOLUTIONS, INC.,

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TM: **BESTGUARD**

Decision No. 2015- 216

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DECISION

STANLEY SECURITY SOLUTIONS, INC. ("Complainant")¹ filed an opposition to the Trademark Application Serial No. 4-2012-011777. The application filed by ZHI YANG CAI.² ("Respondent-Applicant"), covers the mark "BESTGUARD" for use on "lock installation kit consisting of metal lock, screws, hinges, and a screwdriver, metal locks, padlocks; metal locks for {indicate article to be locked, eg., doors, windows, desks}" under Class 6; "screw drivers, scissors, hammers, bolt cutters, allen wrench, pliers (long nose & cutter), knives, can opener, spoon and forks, saw, ax, grass cutters, combination wrench, shovel, cutter blades, wire strippers, socket sets, back wrench, open wrench, steel brush, L. squares, adjustable wrench, grind stones, chisel, vise grip pliers, declogger made of metal, glass cutter, hand grass cutter, riveters & hand operated tools" under Class 8; and "faucets, shower heads, water filter, floor drain, valves for plumbing, plumbing flexible pipes & plumbing fittings" under Class 11 of the International Classification of Goods.

Opposer alleges, among others, the following:

"1. Opposer is the creator, first adoptor and registered owner of the mark BEST covered by Registration No. 4-2001-004930 issued on December 19, 2005 by the Philippines' Intellectual Property Office xxx for locks, namely padlocks, mortise locks, cylindrical locks, mechanical locks controlled by electronic controls, electronic locks, tubular deadbolt locks, cabinet locks, lock cylinders, and parts of locks, keys" in class 06, "lock and key combining hand tools, namely, key combining cutter, lock combining kit comprised of hand tools, pin tumblers, and tumbler springs" in class 08 and "electronic locks and computer software for lock core and key inventory control" in class 09.

"2. On Oct. 25, 2011, Opposer filed with the IPO the required notarized Declaration of Actual Use with proof to that effect which therefore maintained the validity of aforesaid registration.

"3. The mark BESTGUARD being applied for registration by respondent is colorable imitation of, and confusingly similar with Opposer's registered mark BEST

¹ A company incorporated in Indiana, U.S.A with principal office located at 6161 East 75th Street, Indianapolis, IN. 46250 U.S.A.

² A Chinese citizen represented by with address at 4B #835 Salazar Street, Binondo, Manila.

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as to be likely when applied to or used in connection with respondent's goods, to cause confusion or mistake and deceive public, or the public may be led to believe that the goods of respondent are owned by Opposer, or originated from or sponsored by Opposer.

"4. Thus, the subject application should not be given due course and should be denied because it is proscribed by Opposer's prior and existing registration of a similar mark, under the provisions of Republic Act No. 8293, the Intellectual Property Code or IP Code, Sec. 123.1 (d) which pertinently provides that a mark cannot be registered if it:

x x x

"5. In light of the confusing confusing similarity of the mark being applied for by the respondent with Opposer's registered mark, BEST, the approval of the subject application will violate Opposer's right to the exclusive use of its registered trademark BEST and will cause grave and irreparable damage and injury, within the meaning of Sec. 134 of the IP Code by diluting and misappropriating the tremendous goodwill and brand value in Opposer's trademark."

Opposer's evidence consists of the following:

1. Exhibit "A" and "B" - Duly legalized and authenticated Sworn Statement of John D. DeLPONTI;
2. Exhibit "B" - Duly authenticated Certification that John D. DeLPONTI is duly authorized by Opposer to represent the company;
3. Exhibit "C" - Certified copy of Certificate of Registration No. 4-2001-004930 for the mark BEST;
4. Exhibits "D" - copy of Declaration of Actual Use of the mark BEST;
5. Exhibits "E" - brochures, photographs showing use of the mark BEST.

On 25 April 2013, this Bureau issued a Notice to Answer and personally served a copy thereof to the Respondent-Applicant's agent on 30 April 2013. On 04 June 2013, Respondent filed an Urgent Motion for Extension of Time to File Answer. On 24 June 2013, Respondent filed its Verified Answer. On 08 July 2013, this Bureau issued Order No. 2013-979 denying the motion for extension for being filed out of time. In the same order, the verified answer was also considered filed out of time. Consequently, it is as if no answer was filed. Accordingly, pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark **BESTGUARD**?

The essence of trademark registration is to give protection to the owners of 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 product. It is found that Respondent-Applicant's mark sufficiently met the requirement of the law.

The records show that at the time the Respondent-Applicant filed its application for the mark BESTGUARD on 25 September 2012, the Opposer has already been issued a registration for its trademark BEST (STYLIZED). Opposer's mark is used on goods such as "locks, namely padlocks, mortise locks, cylindrical locks, mechanical locks controlled by electronic controls, electronic locks, tubular deadbolt locks, cabinet locks, lock cylinders, and parts of locks, keys" in class 06; "lock and key combining hand tools, namely, key combining cutter, lock combining kit comprised of hand tools, pin tumblers, and tumbler springs" in class 08; and "electronic locks and computer software for lock core and key inventory control" in class 09 while Respondent-Applicant's mark is used on "lock installation kit consisting of metal lock, screws, hinges, and a screwdriver, metal locks, padlocks; metal locks for (indicate article to be locked, eg., doors, windows, desks)" under Class 6; "screw drivers, scissors, hammers, bolt cutters, allen wrench, pliers (long nose & cutter), knives, can opener, spoon and forks, saw, ax, grass cutters, combination wrench, shovel, cutter blades, wire strippers, socket sets, back wrench, open wrench, steel brush, L. squares, adjustable wrench, grind stones, chisel, vise grip pliers, declogger made of metal, glass cutter, hand grass cutter, riveters & hand operated tools" under Class 8; and "faucets, shower heads, water filter, floor drain, valves for plumbing, plumbing flexible pipes & plumbing fittings" under Class 11. As such the goods of the Opposer and Respondent-Applicant are similar and or related.

But, are the competing marks identical or confusingly similar as to likely deceive or cause confusion?

The marks are reproduced below for comparison:



Opposer's Mark



Respondent-Applicant's Mark

Respondent-Applicant's mark is similar to Opposer's mark in so far as the word BEST which is Opposer's mark itself appears in Respondent-Applicant's marks. Aside from the word BEST, Respondent-Applicant's mark also contain the word guard connected to the word "BEST" and a pictographic representation of a knight in a horse. But does the presence of the word "guard" and a picture of a knight in a horse sustain a finding of non-confusing similarity between the competing marks? This Bureau finds the contrary. The presence of the word "guard" and the device of a knight does not veer away a finding of confusing similarity between the two marks. Because Respondent-Applicant adopted Opposer's mark BEST in its mark and the fact that the goods upon which the marks are used are similar, that is, locks, there is a possibility that the consumers will likely be confused or mistaken to think that the mark of the Respondent-

Applicant is just a mere variation of the Opposer's mark. The likelihood of confusion as to the origin and source of the goods is also not remote.

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 other³. 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 trade name with that of the other mark or trade name in their over-all 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 article⁴.

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.⁵ 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.⁶

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.

It has been held time and again that in cases of grave doubt between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favour with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.⁷

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

3 See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

4 See *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

5 See *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

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

7 See *Del Monte Corporation et. al. v. Court of Appeals*, GR No. 78325, 25 Jan. 1990.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-011777, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 19 October 2015.


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