

JAGUAR LAND ROVER LIMITED,
Opposer,

-versus-

SOUTHWIND AUTOMOTIVE COMP. INC.,
Respondent-Applicant.

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IPC No. 14-2014-00255

Opposition to:

Appln. Serial No. 4-2013-004984

Date Filed: 30 April 2013

TM: JAGO

NOTICE OF DECISION

QUISUMBING TORRES

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SOUTHWIND AUTOMOTIVE COMP. INC.

Respondent- Applicant

1161 Padre Algue Street,

Tondo, Manila

GREETINGS:

Please be informed that Decision No. 2016 - 303 dated 09 September 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 09 September 2016.

Atty. Z'ISA MAY B. SUBEJANO-PE LIM

Adjudication Officer

Bureau of Legal Affairs

Republic of the Philippines

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IPC No. 14-2014-00255

Opposition to:

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Date Filed: 30 April 2013

Trademark: "**JAGO**"

X ----- X Decision No. 2016- 303

DECISION

Jaguar Land Rover Limited¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-004984. The contested application, filed by Southwind Automotive Comp., Inc.² ("Respondent-Applicant"), covers the mark "JAGO" for use on "*piston rings, piston assembly, engine valve, cylinder liner, water pump assembly, bell crank, piston liner, engine mount, full-set overhauling gasket, cylinder head gasket, engine valve seal, engine o-rings, engine oil seal, engine seal kit, engine hydraulic & pneumatic seal, hose and tubing, packing and sealant, fan belt, timing belt, rubber belt, oil seal, transmission belt, fuel and oil hose, air pressure, pneumatic hose, engine support, air filter, oil filter and fuel filter*" and "*brake master assembly, brake master cylinder, clutch master assembly, wheel cylinder, clutch operating assembly, clutch cover, clutch operating kit, clutch disc, cv joint, the rod end, brake shoe, brake pads, ball joint, idler arm, pitman arm, racke end, drag link, center link, suspension shaft kit, stabilizer link, steering boots, cv brense, muffler support, spring bushing, stabilizer bushing, suspension arm assembly, suspension arm bushing, shock mounting, control arm bushing, center bearing assembly, shock mounting stopper, cab cushion, stabilizer bushing, suspension bushing, bumper support, spring bushing, radiator support, center bearing assembly, brake hose, clutch hose, transmission support*" under Classes 07 and 12, respectively of the International Classification of Goods³.

The Opposer alleges that it a well-renowned car manufacturer whose use of the "JAGUAR" trademark dates as far back as 1936. In the Philippines, it began using the mark as early as 26 January 1979 and was able to secure registration therefore on the same date under Registration No. 002312. Currently, it has registered and/or applied for registration of its "JAGUAR" trademarks for goods under Classes 03, 09, 12, 14, 18, 25, 28 and 37. It thus contends that the

¹ A corporation duly organized and existing under and by virtue of the laws of England and Wales with principal address at Abbey Road, Whitley Coventry CV3 4LF, Coventry, United Kingdom.

² With known address at 1161 Padre Algue St., Tondo, Manila.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

Respondent-Applicant's mark "JAGO" should not be allowed registration for being confusingly similar to its registered mark "JAGUAR". In support of its opposition, the Opposer submitted the following as evidence:⁴

1. first "JAGUAR" trademark registration in the Philippines;
2. printouts from various car review websites that refer to its vehicles as "JAG";
3. printouts from screen grabs from car enthusiast and car clubs that use the word "JAG"; and,
4. affidavit of Carlo E. Abarquez, with attachments.

A Notice to Answer was issued and served upon the Respondent-Applicant on 25 September 2014. The latter, however, did not file an Answer. Thus, on 26 May 2016, the Hearing Officer issued Order No. 2016-894 declaring the Respondent-Applicant in default and the case submitted for decision.

The issue to be resolved is whether the Respondent-Applicant's mark "JAGO" should be allowed registration.

Section 123.1 (d) and (f) provides that:

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

x x x

(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; x x x"

Records reveal that the Opposer was issued registration for the mark "JAGUAR" as early as 26 January 1979. On the other hand, the Opposer filed the contested application only on 30 April 2013.

But are the competing marks, as shown hereafter, confusingly similar?

⁴ Marked as Exhibits "C" to "K".



JAGUAR

Opposer's marks



Respondent-Applicant's mark

A practical approach to the problem of similarity or dissimilarity is to go into the *whole* of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear" may be considered.⁵ Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

⁵ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

The competing marks begin with the syllable "JAG". This, however, is not sufficient to conclude that confusion is likely to occur. Contrary to the Opposer's assertion, "JAG" cannot be considered as the prevailing feature of its marks. Looking at the Opposer's marks, what is retained in the eyes and mind when one encounters the same is the word "JAGUAR" and/or the figure of the said animal. Hence, the appreciation of its marks should not be dissected on a per syllable basis. Whether its marks are also known as "JAG" to car enthusiasts is of no moment as far as this opposition is concerned as the Opposer did present evidence that it applied for or secured trademark registration for "JAG".

Perusing the Respondent-Applicant's mark, on the other hand, it can be gleaned that the prominent features thereof is the word "JAGO" and device consisting of a circle with a line from the upper left portion slanting downwards to the lower right. None of these elements appear in the Opposer's marks. In the same manner, the word and/or figure of a jaguar are not appropriated by the Respondent-Applicant's trademark. Therefore, there can be no likelihood of confusion between the contending marks.

Further noteworthy, the competing companies are engaged in vehicles and/or vehicle parts. Thus, their target market is discerning consumers knowledgeable of the products involved making confusion, much more deception, improbable. Aptly, in **Del Monte Corporation vs. Court of Appeals**⁶, the Supreme Court held that:

"Among these, what essentially determines the attitude of the purchaser, specifically his inclination to be cautious, is the cost of the goods. To be sure, a person who buys a box of candies will not exercise as much care as one who buys an expensive watch. As a general rule, an ordinary buyer does not exercise as much prudence in buying an article for which he pays a few centavos as he does in purchasing a more valuable thing. Expensive and valuable items are normally bought only after deliberate, comparative and analytical investigation. But mass products, low priced articles in wide use, and matters of everyday purchase requiring frequent replacement are bought by the casual consumer without great care. In this latter category is catsup."

Finally, it is emphasized that 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


⁶ G.R. No. L-78325, 25 January 1990.

product.⁷ In this case, the Respondent-Applicant's mark sufficiently met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-004984 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 09 SEP 2016


ATTY. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

⁷ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.