

MAN TRUCK & BUS AG (formerly
MAN NUTZFAHRZUEGE AG,
Opposer,

-versus-

LEE COMMERCIAL EQUIPMENT, INC.,
Respondent- Applicant.

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IPC No. 14-2012-00337
Opposition to:
Appln. Serial No. 4-2012-001222
Date Filed: 1 February 2012
TM: "SHACMAN MOTORS"

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 417 dated November 18, 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, November 21, 2016.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

MAN TRUCK & BUS AG (formerly NUTZFAHRZUEGE AG), Opposer,	} IPC NO. 14-2012-000337 } Opposition to: }
-versus-	} Appln. Ser. No. 4-2012-001222 } Date Filed: 1 February 2012 }
LEE COMMERCIAL EQUIPMENT, INC., Respondent-Applicant.	} Trademark: "SHACMAN MOTORS" }
x-----x	} Decision No. 2016- 417

DECISION

MAN TRUCK & BUS AG, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2012-001222. The application, filed by LEE COMMERCIAL EQUIPMENT, INC. (Respondent-Applicant)², covers the mark "SHACMAN", for use on "automotive/motor vehicles, namely automobiles, trucks, vans, sport utility vehicles and structural parts thereof" under Class 12 of the International Classification of Goods³.

The Opposer relies on the following grounds in support of its opposition:

"6. Opposer is the registered owner of the trademark 'MAN' and device as used on goods falling under Classes 7, 12, 16, 25, 28, 35 37 and 39 in the Philippines under Certificate of Registration No. 4-2009-005233. Opposer also has trademark applications and/or registrations for the mark in various classes of goods in at least 117 different countries worldwide long before the appropriation and filing of respondent-applicant of an application for the registration of the trademark 'SHACMAN MOTORS'.

"7. The following schedule shows some of the oldest registration of the mark 'MAN' in other countries

"8. Through years of international marketing and promotion, the name, the mark created and adopted by the Opposer has become internationally well known and has acquired worldwide goodwill.xxx

"9. Under Section 147 of Republic Act No. 8293, the Opposer has the right to exclude others from registering or using confusingly similar

¹ A foreign corporation duly organized and existing under the laws of Germany with address at Dachauer Strabe 667, 80995 Munchen, Germany

² A corporation organized and existing under the with address at Bldg. A LCEI Compound Delbros Ave., cor de Leon St., Bo. Ibayo, Paranaque City

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the World Intellectual Property Office, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

marks such as respondent-applicant's mark 'SHACMAN MOTORS' for goods falling under International Class 12, 35 and 37.

"10. Opposer submits that Respondent-Applicant's 'SHACMAN MOTORS' mark should not be allowed for registration because it is confusingly similar to Opposer's 'MAN' trademark, being applied for use in the same classes of goods as those covered by Opposer's trademark registration. Registration of the mark 'MAN' in the name of the respondent-applicant would violate the pertinent provision of Republic Act No. 8293 (Intellectual Property Code), hereunder quoted as follows:

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

(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;

(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.

"10. Worse, both respondent-applicant and Opposer's marks are intended for products belonging to the same classes of goods (Class 12, 35 and 37), thus, further increasing the probability of causing confusion to the consuming public. xxx

"12. The inclusion of the word MAN in the mark applied for registration gives the impression that the goods/services carrying the mark SHACMAN are actually connected or affiliated with the business of the owner of the mark MAN and device – the Opposer. A likelihood of confusion, specifically as to business or origin of goods/services, can arise.

"13. Moreover, through years of continuous international marketing and advertising, Opposer's trademarks have acquired popularity and goodwill in various jurisdictions. Thus, the goodwill of the mark MAN

and device can be affected adversely if it turns out that the quality of the goods/services carrying the mark 'SHACMAN MOTORS' pales in comparison with the high quality standards of goods/services carrying the mark MAN. Further, the inclusion of the word 'MAN' gives the impression that the applicant for 'SHACMAN' is attempting to ride on the goodwill and international popularity of the mark MAN.

"14. Thus, Opposer's rights under the provisions of the IP Code and the Paris Convention on the Protection of Industrial Property must be protected. Allowing the registration of respondent-applicant's mark will inevitably cause the dilution and loss of distinctiveness of Opposer's trademark.

"15. Accordingly, respondent-applicant should be precluded from appropriating and registering the mark 'SHACMAN MOTORS' in its name since it is confusingly similar to Opposer's mark 'MAN'. Opposer is the rightful owner of the mark and it is responsible for establishing it as an internationally well-known mark.xxx"

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

1. Table of trademark registrations and applications of the mark "MAN";
2. Copies of trademark registrations of the mark "MAN" in other jurisdictions;
3. Pictures of actual products bearing the "MAN" mark; and
4. Pictures of promotions, advertising, signage of the mark; sample official receipts.
5. Copy of Certificate of Registration No, 59321 dated 21 September 1994 for the mark "MAN" for goods under classes 12 and 7 namely: "Trucks, buses, municipal vehicles and components of such, engines for land vehicles vessels and/or stationary operation, and components for such" ⁴

The Respondent-Applicant filed its Answer on 17 January 2013, alleging among other things, the following:

- A. The Marks 'MAN' and 'SHACMAN MOTORS' Are Not Confusingly Similar.

"Opposer claims that the registration of Respondent-Applicant's mark 'SHACMAN' is prohibited under Section 123.1 (d) of the IP Code. Under Section 123.1 (d) of the IP Code, a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor in respect of the same goods or closely related goods, or if it nearly resembles such mark as to be likely to cause confusion xxx

Thus, under Section 123.1(d) of the IP Code, a mark cannot be registered if:

⁴ Exhibits "A" to "G"

- 1) It is identical with a registered mark belonging to a different proprietor, or a mark with an earlier filing or priority date in respect of the same goods; or
- 2) It is identical with a registered mark belonging to a different proprietor, or a mark with an earlier filing or priority date in respect of closely related goods; or
- 3) It nearly resembles such a mark as to be likely to deceive or cause confusion.

As regards the first circumstance cited above, Opposer's mark 'MAN' and Respondent-Applicant's mark 'SHACMAN MOTORS' are not identical marks. Thus, the first circumstance does not apply.

Neither does the second circumstance apply because, again, Opposer and Respondent-Applicant's marks are not identical.

Thus, the issue at hand is whether Respondent-Applicant's mark falls under the third circumstance, that is, whether it nearly resembles Opposer's mark as to be likely to deceive or cause confusion. However, contrary to Opposer's claim, 'SHACMAN MOTORS' and 'MAN' do not nearly resemble each other.

In determining confusing similarity between two (2) marks, various factors such as sound, appearance, form, style, shape, size, format, color, ideas connoted by the marks, meaning, spelling and pronunciation of the words used are considered. Measured against the foregoing factors of determining confusing similarity, neither a visual nor aural comparison of the two marks shows that they are confusingly similar.

Curiously, while Opposer bases the instant Opposition on its supposed Trademark Registration No. 4-2009-005233, Opposer did not even bother to submit to this Honorable Office a certified copy, or even a photocopy, of this registration. Hence, for purposes of illustrating the non-similarity of the two marks, Respondent-Applicant is constrained to submit a print-out of Certificate of Registration No. 4-2009-005233 for the mark 'MAN & DEVICE' taken from the Intellectual Property Office website and made an integral part hereof xxx

Opposer's mark consists of the word 'MAN' above the stylized figure of a standing lion inside a rectangular box. The figuring of a standing lion, which is an integral part of Opposer's mark, is in itself a substantial distinguishing feature and clearly contributes to the differences between the two marks which would not lead a consumer to confuse it with plain word 'SHACMAN MOTORS'.

The only similarity if any between the cited mark and the subject mark would be the word 'MAN'. However, the presence of the word 'MAN' in the subject and the cited mark is not a ground to proscribe the registration of the subject mark. The Supreme Court has not barred registration of a trademark solely on the ground that the same contains some syllables or words which are identical to a registered trademark. xxx

Opposer's emphasis on the inclusion of the word 'MAN' in Respondent-applicant's mark 'SHACMAN MOTORS' deserves scant consideration. In fact, the suffix '-MAN'- is fairly common and is used in many registered marks in Class 12, 35 and 37, including but not limited to:

1. Trademark :TIEMAN xxx
2. Trademark :STEARMAN xxx
3. Trademark : CAYMAN xxx
4. Trademark :GRANSTAR WINGMAN xxx
5. Trademark :AUMAN xxx
6. Trademark : WUNDERMAN xxx
7. Trademark : TAGMAN xxx
8. Trademark :HARMAN xxx
9. Trademark : BIG DUTCHMAN LOGO xxx

The fact that there are other registered marks containing the word 'MAN' in the same classes as Opposer's trademark registration means that they are not confusingly similar and thus, they can co-exist.

B. It Is Highly Improbable To Confuse, Mislead or Deceive The Public Given the Distinguishing Characteristics of the Subject Mark.

It thus cannot be said that the mark 'SHACMAN MOTORS' is but a play of the Opposer's mark 'MAN', with the deliberate inclusion of the word 'MAN'. It bears emphasis that in making such averment, Opposer actually implies that there was some malice involved in Respondent-Applicant's designation of the mark. However, there is no proof of such malice on the part of the Respondent-Applicant. xxx

There is no likelihood of confusion because although the marks cover the same class, the marks are used on different goods. The Applicant-Appellant's mark 'SHACMAN MOTORS' is used on automobiles, trucks, vans, sports utility vehicles while Man Truck & Bus AG's 'MAN' is used only on 'trucks in weight categories from 7.49 to 44 tonnes and heavy-duty special-purpose vehicles.'

Accordingly, the goods covered by the said marks are vastly different and are not replacement goods; one cannot be substituted for the other. Cars and heavy-duty special purpose vehicles are distinctly different modes of transportation and are marketed to different consumers with

different life styles. Hence, the goods are non-competing goods and cannot be assumed to come from a common source. xxx

D. Opposer Has Failed to Substantiate Its Claim That The Mark 'MAN' Is Well-Known.xxx”

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

1. Certified true copy of Registrability Report for the mark SHACMAN MOTORS;
2. Certified true copy of Notice of Allowance; and
3. Print-out from the IPO database registry of the status of the marks: MAN and DEVICE, TIEMAN, STEARMAN, CAYMAN, GRANSTAR WINGMAN 110, AUMAN, WUNDERMAN, TAGMAN, HARMAN and BIG DUTCHMAN LOGO.⁵

The Hearing Officer issued on 2 April 2013 a notice initially setting the Preliminary Conference on 2 May 2013. On 22 May 2013, the Preliminary Conference was terminated, wherein both parties were directed to file their respective position papers. The Opposer and the Respondent-Applicant filed their position papers on 20 June 2013 and 4 June 2013, respectively.

Should the Respondent-Applicant be allowed to register the trademark SHACMAN MOTORS?

Records show that at the time Respondent-Applicant applied for registration of the mark “SHACMAN MOTORS” the Opposer already registered the mark “MAN” under of Registration No. 022189 on 24 February 1975 and MAN AND DEVICE under Registration No. 42009005233 19 August 2010 under classes 7, 12, 16, 25, 28, 35, 37 and 39. The goods covered by the Opposer’s trademark registration are also under Class 12, namely: “Trucks, buses, municipal vehicles and components of such, engines for land vehicles vessels and/or stationary operation, and components for such”.

But do the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

Opposer’s marks

Respondent-Applicant’s mark



SHACMAN MOTORS

⁵ Exhibits "1" to "4" inclusive of submarkings

The marks contain the syllable, MAN. While the marks are similar in respect of the use of the word MAN, such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur. The Respondent-Applicant's mark consists of six letters S-H-A-C-M-A-N, which prefix, "SHAC" produces a distinctive sound. When pronounced, the word "SHACMAN" is distinct from the mark "MAN". In one variation of Opposer's mark, "MAN AND DEVICE"⁶, it includes the figure of a standing lion which is a significant feature or component of the mark. As may be gleaned from the foregoing, the visual dissimilarities between the two (2) marks are evident and significant, negating the possibility of confusion in the minds of the ordinary purchaser, especially considering the distinct aural difference between the marks. The prefix "SHAC" creates a deviation from Opposer's "MAN" mark which results to an different overall commercial impression. The word "MOTORS" is disclaimed.

Besides, the products involved in this case are trucks, buses, vehicles, automotive/motor vehicles, automobiles etc. which are costly products and not merely ordinary household items. The tendency of the buyer is to mull and contemplate over his or her purchase of these types of products, i.e. trucks, buses, vehicles. The Supreme Court in *Emerald Garment Manufacturing Corporation v. Court of Appeals*⁷ held:

"First, the products involved in the case at bar are, in the main, various kinds of jeans. These are not your ordinary household items like catsup, soysauce or soap which are of minimal cost. Maong pants or jeans are not inexpensive. Accordingly, the casual buyer is predisposed to be more cautious and discriminating in and would prefer to mull over his purchase. Confusion and deception, then, is less likely. In *Del Monte Corporation v. Court of Appeals*, we noted that:

. . . Among these, what essentially determines the attitudes 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."

Finally, the Bureau also takes note that IPO trademark database registry is replete with other registered marks with the suffix "MAN" under Class 12⁸. The Respondent-Applicant cites in its evidence, the registered marks: TIEMAN, STEARMAN, CAYMAN, GRANSTAR WINGMAN 110, AUMAN, WUNDERMAN, TAGMAN, HARMAN and BIG DUTCHMAN LOGO⁹, for goods under class 12. Thus, in view of the prevalence of marks with the suffix "MAN", affixed with distinct prefixes, confusion is unlikely and the marks of both parties may co-exist.

⁶ Exhibit "3"

⁷ G.R.No. 100098, 29 December 1995


⁸ Exhibits "4"- A-H

⁹ Exhibits "4"- H

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-001222 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, 18 NOV 2016.


Atty. ADORACION U. ZARE, LL.M.
Adjudication Officer
Bureau of Legal Affairs