

ORIENTAL AND MOTOLITE MARKETING CORPORATION,

Opposer,

-versus-

TUESDAY CECILE M. CHUA,

Respondent- Applicant.

X-----X

IPC No. 14-2015-00572

Opposition to:

Application No. 4-2015-504076

Date Filed: 22 July 2015

TM: "MARATHON AND LOGO"

NOTICE OF DECISION

VERALAW [DEL ROSARIO RABOCA GONZALES GASPARIL]

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GREETINGS:

Please be informed that Decision No. 2017 - 272 dated June 30, 2017 (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, June 30, 2017.

MARILYN F. RETUAL

IPRS IV

Bureau of Legal Affairs

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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TUESDAY CECILE M. CHUA,
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IPC No. 14-2015-00572

Opposition to Trademark
Application No. 4-2015-504076
Date Filed: 22 July 2015

Trademark: "**MARATHON AND
LOGO**"

Decision No. 2017- 272

DECISION

Oriental and Motolite Marketing Corporation¹ (Opposer) filed an opposition to Application No. 4-2015-504076. The contested application, filed by Tuesday Cecile M. Chua² ("Respondent-Applicant"), covers the mark "MARATHON AND LOGO" for use on "*motorcycle spare parts and accessories, namely gasket, bearing, filter, piston, piston ring*" under Class 07 of the International Classification of Goods³.

The Opposer alleges, among others, that it manages and distributes all products of Philippine Battery Incorporated ("PBI") for local and export markets, including the product "MARATHONER". PBI manufacture the brands Motolite, Century and Supercharge. "MARATHONER" is a battery for automotive and motorcycles that is heavy duty, made with RamcarFibrex Technology and better grid design, combined with low water consumption rate, vibration pads and strap protector. Basically, the Opposer contends that the mark "MRATHON AND LOGO" is confusingly similar with its mark "MARATHONER". In support of its opposition, the Opposer submitted the following as evidence:⁴

1. copy of the Respondent-Applicant's mark;
2. affidavit of its Vice President for Sales, Richard A. Chan, with annexes; and,
3. copy of its registration of the mark "MARATHONER".

A Notice to Answer was issued and served upon the Respondent-Applicant on 29 June 2016. The latter, however, did not file an Answer. The Adjudication Officer then issued Order No. 2016-1134 on 05 July 2016 declaring the Respondent-Applicant in default and the case submitted for decision.

¹A domestic corporation with address at 80-82 Roces Avenue, Diliman, Quezon City.

²With known address at #Lot 22, Block 29 Guijo Street, Town and Country, Marilao, Bulacan.

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.

⁴ Marked as Exhibits "A", "D" to "E", inclusive.

The issue to be resolved is whether the trademark application of Respondent-Applicant for "MARATHON AND LOGO" should be allowed.

Records reveal that at the time Respondent-Applicant applied for registration of her mark on 22 July 2015, the Opposer has a valid and existing registration for its trademark "MARATHONER" issued on 16 April 2015 under Certificate of Registration No. 4-2014-504646.

Section 123.1(d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), provides that:

"Section 123.1. 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; x x x"***

To determine whether the competing marks are confusingly similar, the same are reproduced below for comparison:

MARATHONER

Opposer's mark



Respondent-Applicant's mark

The prevalent feature of the Opposer's mark is the word "MARATHONER". The said word is what is impressed in the eyes and mind when one encounters the mark. The Respondent-Applicant's mark, on the other hand, consists of the word "MARATHON" and two parallel wavy lines forming the letter "M". Despite the Respondent-Applicant's omission of "ER" and the "M" logo, the said mark is still confusingly similar with that of the Opposer's. After all, 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 purchasers as to cause him to purchase the one supposing it to be the other.⁵

Moreover, the Respondent-Applicant will use or uses the mark "MARATHON AND LOGO" to motorcycle parts and accessories, which goods are similar and/or related to the Opposer's goods automotive and motorcycle batteries. Thus, the differences will not diminish the likelihood of the occurrence of confusion, mistake and/or deception. It is highly probable that the purchasers will, at the very least, be reminded of the Opposer's marks when they encounter the Respondent-Applicant's, and vice-versa. Withal, the protection of trademarks as intellectual property is intended not only to preserve the goodwill and reputation of the business established on the goods bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods.⁶

Furthermore, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."⁷

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 product.⁸ Based on the above discussion, Respondent-Applicant's trademark fell short in meeting this function. The latter was given ample opportunity to defend its trademark application but Respondent-Applicant failed to do so.

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

⁵ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁶ Skechers, USA, Inc. vs. Inter Pacific Industrial Trading Corp., G.R. No. 164321, 23 March 2011.

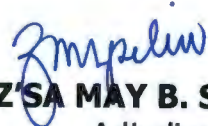
⁷ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

⁸ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2015-504076 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 30 JUN 2017



ATTY. ZSA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs