



**PELICAN PRODUCTS, INC.,**  
*Opposer,*

**-versus-**

**GLOBAL TECH CHINA LIMITED,**  
*Respondent-Applicant.*

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**IPC No. 14-2016-00020**  
Opposition to:  
Appln. Serial No. 4-2015-009851  
Date Filed: 27 August 2015

**TM: M MIGHTYLITE**

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**NOTICE OF DECISION**

**BETITA CABILAO CASUELA SARMIENTO**  
*Counsel for Opposer*  
Suite 1104, Page One Building  
1215 Acacia Avenue, Madrigal Business Park  
Ayala Alabang, Muntinlupa City

**ANGEL O. OLANDRES, JR.**  
*Respondent- Applicant's Representative*  
24 Libya Street, Better Living Subdivision  
Don Bosco, Bicutan, Metro Manila

**GREETINGS:**

Please be informed that Decision No. 2017 - 276 dated 29 June 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, 03 July 2017.

  
**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs

**PELICAN PRODUCTS, INC.,  
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} **IPC NO. 14- 2016-00020**

} Opposition to:

} Application No. 4-2015-009851

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} Trademark: **M MIGHTYLITE**

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x-----x } Decision No. 2017- 276

### DECISION

PELICAN PRODUCTS, INC.<sup>1</sup> (“Opposer”) filed a Verified Opposition to Trademark Application Serial No. 4-2015-009851. The application, filed by GLOBAL TECH CHINALIMITED,<sup>2</sup> (“Respondent-Applicant”) covers the mark “M MIGHTYLITE” for use on “light bulbs, arc lamps, electric lamps, lamps, incandescent burners, pocket torches, electric discharge tubes, electric for lighting, light diffusers, sockets for electric lights, lighting apparatus and installations, ceiling lights, filaments for electric lamps, laboratory lamps, safety lamps, lamp reflectors, luminous tubes fro lighting, magnesium filaments for lighting, Miner's lamps, torches for lighting, flashlights, searchlights, street lamps, aquarium lights, diving lights, light emitting diodes (LED) lighting apparatus, lighting installations for air vehicles, lights for vehicles, headlights for automobiles, bicycle lights, light bulbs for directional signals for vehicles, cycle lights, vehicle headlights, lighting apparatus for vehicles, automobile lights, lanterns for lighting” under Class 11 of the International Classification of Goods and Services.<sup>3</sup>

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

“1. The registration of M MIGHTYLITE mark will be contrary to the provisions of Sections 123.1 (e) and (f)

<sup>1</sup> A corporation duly organized and existing under the laws of Delaware, U.S.A., with office address at 23215 Early Avenue, Torrance, California, 90505, U.S.A.

<sup>2</sup> A corporation with address at Flat A 3/4 Wai, Yip Industrial Building, 171 WAI YIP street, Kwun Tong, Hong Kong.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks, which was concluded in 1957 and administered by the World Intellectual Property Organization.

(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;”

(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.”

- “2. The Opposer is the owner and first user of the well-known and famous MITYLITE mark. Hence, the registration of the Respondent’s mark constitutes a violation of Articles 6bis of the Paris Convention in conjunction with Section 3 123.1 9e) and 123.1 (f) of the IP Code.
- “3. The Opposer has used the MITYLITE mark in the Philippines and elsewhere well prior to the filing date of the opposed application. The Opposer continues to use the MITYLITE mark in the Philippines and in numerous other countries worldwide.
- “4. The Opposer has extensively used and promoted its MITYLITE mark worldwide. Over the years, the Opposer has obtained significant exposure for the goods and services upon which MITYLITE mark is used in various media, including television commercials, outdoor advertisements, internationally well-known print publications, and other promotional events. Opposer also promotes its products bearing the MITYLITE mark through its websites, [www.pelican.com](http://www.pelican.com) and [www.peli.com](http://www.peli.com) which are accessible to users worldwide, including those from the Philippines.
- “5. The MITYLITE mark is registered and has been applied for registration in the name of the Opposer in various countries around the world. xxx
- “6. Respondent’s M MIGHTYLITE mark is confusingly similar to the Opposer’s well-known MITYLITE mark as to be likely to deceive or cause confusion, if it has not already been deceived or caused confusion.
- “6.1. The element ‘MIGHTYLIFE’ in Respondent’s M MIGHTYLITE mark is almost identical in terms of appearance, pronunciation and spelling to

the Opposer's well-known MITYLIFE mark. In fact, the mark applied for registration by Respondent includes all letters – 'M.I.T.Y.L.I.T.E.'- of the Opposer's MITYLITE mark.

"6.2. The registration and use of the Respondent's M MIGHTYLITE mark on goods in class 11, the same class under which Opposer's MITYLITE mark is used, will likely deceive, if it has not already deceived, consumers by suggesting a connection, association or affiliation with the Opposer, thereby causing damage to the goodwill and reputation associated with Opposer's MITYLITE mark.

"6.3. M MIGHTYLIFE is applied for registration to be used in connection with light bulbs, are lamps, electric lamps, selling lights, flashlights, searchlights, diving lights, and many other goods under class 11, all of which are the same or similar to the goods on which the Opposer's MITYLITE mark are used, namely, flashlights, and other lighting products sold by Pelican, such as headlamps, dive lights, right angle lights, specialty lights (e.g. stealth light, mini flasher) remote area lighting system.

"6.4. Applying either the dominancy test or the holistic test, there is no doubt that Respondent's M MIGHTYLITE closely resembles the Opposer's MITYLITE, which will likely cause confusion, mistake and deception on the part of the purchasing public. Taken in consideration from visual and aural standpoints, the two marks look so similar that they can easily be confused for one over the other in a manner that will likely deceive the public into believing that the Respondent's product also originates from or is under the sponsorship of the Opposer.

"6.5. Furthermore, the *idem sonans* rule is sufficient ground to establish confusing similarity between the Opposer's MITYLITE mark and the mark applied for registration by the Respondent. The Supreme Court has continuously ruled that there is confusion between trademarks that sound alike such as Lusolin, and Sapolin, Salonpas and Lionpas, Celdura and Cordura. Without a doubt, MITYLITE and MIGHTYLIFE falls squarely within the purview of the *idem sonans* rule.

"7. Hence, the registration of the Respondent's M MIGHTYLIFE mark will be contrary to Section 123.1 (e) and (f) of the IP Code and Article 7 of the Paris Convention for the Protection of Industrial Property as provided below. xxx"

In support of the Opposition, the Opposer submitted the following:

1. Original notarized and legalized Notice of Opposition;

2. Original notarized and legalized Affidavit of John Padian;
3. Screenshots from www.pelican.com and www.peli.com;
4. Images of MITYLITE 1900 and MITYLITE 2430 flashlights;
5. Representative invoices; catalogues and brochures;
6. Print-out from websites of retailers;
7. List of registrations and applications; and
8. Copies of trademark registrations for MITYLITE.<sup>4</sup>

This Bureau served a Notice to Answer to Respondent-Application on 8 April 2016. However, the Respondent-Applicant failed to file an Answer. Thus, the Hearing Officer issued an order on 31 January 2017 declaring the Respondent-Applicant in default.

Should the Respondent-Applicant be allowed to register the trademark M MIGHTYLITE?

Section 134. of Republic Act 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code") provides that:

Section 134. *Opposition.* - Any person who believes that he would be damaged by the registration of a mark may, upon payment of the required fee and within thirty (30) days after the publication referred to in Subsection 133.2, file with the Office an opposition to the application. Such opposition shall be in writing and verified by the oppositor or by any person on his behalf who knows the facts, and shall specify the grounds on which it is based and include a statement of the facts relied upon.

The Respondent-Applicant applied for registration of the mark "M MIGHTYLITE" on 27 August 2015. The Respondent-Applicant's mark is reproduced below:



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.<sup>5</sup>

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<sup>4</sup> Exhibits "A" to "C" inclusive of submarkings

<sup>5</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.

Preceding therefrom, it is observed that the Opposer proved that it is the owner of the mark MITYLITE applied on flashlights, as seen from the Opposer's websites<sup>6</sup> and pictures of its products, the availability of which can be seen on the internet.<sup>7</sup> As attested by John Padian in his affidavit<sup>8</sup>, the MITYLITE products are sold abroad and in the Philippines. The Opposer also submitted registrations of the mark MITYLITE in various countries abroad. The Respondent-Applicant's mark M MIGHTY LITE is phonetically and aurally identical to the Opposer's mark, despite of the difference in the spelling of the word, MIGHTY. When pronounced, MIGHTY and MITY are *idem sonans*. It is not farfetched that the buying public might conclude that the Respondent-Applicant's products bearing the mark M MIGHTY LITE are a variation of Opposer's mark MITYLITE. Thus, in *Marvex Commercial Co., Inc. v. Petra Hawpia*<sup>9</sup>, the Supreme Court held:

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, *Unfair Competition and Trade Marks*, 1947, vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jazz-Sea"; "Silver Flash" and "Supper-Flash"; "Cascarete" and "Celborite"; "Celluloid" and "Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo". Leon Amdur, in his book "TradeMark Law and Practice", pp. 419-421, cites, as coming within the purview of the *idem sonans* rule, "Yusea" and "U-C-A", "Steinway Pianos" and "Steinberg Pianos", and "Seven-Up" and "Lemon-Up". In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Cordura" are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin", as the sound of the two names is almost the same.

Succinctly, because the Respondent-Applicant uses a mark confusingly similar to that of the Opposers, it is likely that the consumers will have the impression that these goods originate from a single source or origin, more so that the goods of the Respondent-Applicant are similar and related to the goods/products of the Opposer. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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

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<sup>6</sup> Exhibit "B"

<sup>7</sup> Exhibit "B-1"; "B-7"

<sup>8</sup> Exhibit "B"

<sup>9</sup> G.R. No. L--19297, 22 December 1966

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.<sup>10</sup>

The Respondent-Applicant despite the opportunity given, did not file an Answer to defend his trademark application and to explain how he arrived at using the mark M MIGHTY LITE which is confusingly similar and identical to that of the Opposer's MITYLITE.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application Serial No. 4-2015-009851 is hereby **SUSTAINED**. Let the filewrapper of the subject application be returned to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 29 JUN 2017.

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

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<sup>10</sup>*Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.