

MIKASA SANGYO CO., LTD.,
Junior Party-Applicant,

INTER PARTES CASE NO. 1896

INTERFERENCE BETWEEN:

Application Serial No. 38494
Filed : June 6, 1979
Applicant : Mikasa Sancyo Co., Ltd.
Trademark : MIKASA & DEVICE
Used on : Compaction equipment,
concrete vibrator, pile
drive equipment, earth
drilling machine, etc.

- versus -

-and-

Application Serial No: 35401
(now Cert. of Regn. No. 32216
issued August 2, 1983)

Filed : June 6, 1978
Applicant : Atendido Heavy
Industries Inc.
Trademark : AHI-MIKASA & DEVICE
Used on : Construction
equipment, such as
concrete vibrator,
concrete mixer, etc.

DECISION NO. 89-12 (TM)
February 15, 1989

ATENDIDO HEAVY INDUSTRIES INC.,
Senior Party-Registrant.

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DECISION

This is an interference case declared between the above-mentioned application for the registration of trademarks "MIKASA & DEVICE" and "AHI-MIKASA & DEVICE" of the herein Junior Party-Applicant and Senior-Party Registrant, respectively.

Junior Party-Applicant is a Japanese corporation with principal place of business at No. 4-3, 1-chome, Sarugkucho, Chiyoda-ku, Tokyo, Japan, while Senior Party-Registrant is a domestic corporation with business address at 484 Araneta Avenue, Quezon City, Philippines.

Despite proper receipt of the Notice of the Declaration of Interference, parties opted not to file with this Bureau motions to dissolve interference or other motions of similar character, pursuant to Rule 183, of the Rules of Practice in Trademark Cases.

On January 4, 1985 a Notice setting the pre-trial conference of the case on January 21, 1985 was sent to the parties but since Senior Party-Registrant did not receive the notice, the pre-trial conference was reset on March 22, 1985. On said date, neither Senior Party-Registrant nor its counsel appeared, thus Order No. 85-138 declaring Senior Party-Registrant in default was issued by this Bureau and Junior Party-Applicant was allowed to present its evidence ex-parte.

Admitted as evidence for Junior Party-Applicant are documentary exhibits consisting of exhibits "A" to "M", inclusive of their submarkings.

Evidence show that Junior Party's mark "MIKASA & DEVICE" is confusingly similar to the Senior Party-Registrant. The similarity lies in the spelling, sound and appearance of the two marks. The only difference is the word "AHI" appended to the word "MIKASA". This difference does not disturb the findings of confusing similarity. In Inter Partes Case No. 1864, an opposition filed by Mikasa Sanyo Co., the herein Junior Party-Applicant, against the application for registration of trademark "IGRI-MIKASA &DEVICE" by Atendido Heavy Industries, Inc., the herein Senior Party-Registrant, the Director of Patents, Trademarks and Technology Transfer, declaring the marks "MIKASA & DEVICE" and "IGRI MIKASA & DEVICE" as confusingly similar (Decision No. 88-70, August 9, 1988) ruled:

"Respondent-Applicant may not appropriate Opposer's trademark in toto and avoid likelihood of confusion by adding the word "IGRI" thereto. Thus, in Continental Connector Corp., 207 USPQ 60, it has been ruled that 'Courts have repeatedly held that confusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term'. Examples: 'MISS USA and 'MISS USA WORLD' (Miss Universe, Inc. vs. Patricelli, 161 USPQ 129); 'GUCCI' and 'GUCCHI-GOO' (Gucci Shops vs. R.H Macy & Co., 446 F. Supp. 838); 'COMFORT' and 'FOOR COMFORT' (Scholl, Inc. vs. Tops, EH.R. Corp., 185 USPQ 754); 'WASHINGTON MINT' and 'GEO WASHINGTON MINT' (George Washington Mint, Inc. vs. Washington Mint, Inc., 176 USPQ 251); and 'ACE' and 'TEN-ACE" (Becton, Dickinson & Co. vs. Wigwam Mills, Inc., 199 USPQ 607)."

Moreover, both parties' goods belong to the same class (Class 7; see records of the two applications) and, therefore, flow through the same channels of trade. Hence, there is factual basis to hold that Junior Party-Applicant's mark is confusingly similar with Senior Party-Registrant's trademark.

Considering, however, that Junior Party Applicant's trademark "MIKASA & DEVICE" is registered in the United States of America, Australia and Korea (Exhs. "C-5", "C-6" and "C-7"; used in the Philippines for almost 21 years (first use in the Philippines on September 7, 1967 – Exhs. "D", "E", "F" and "F-1"), and Opposer participated in the Japan Industrial Exposition sponsored by the Tradefair Department of the Japan External trade Organizations from March 3 to 17, 1968 at the Loyola Center, Katipunan Road, Quezon City (Exhs. "H", "H-1" and "H-2"), Junior Party-Applicant deserves protection under Section 4(d) of the Rules of Practice in Trademark Cases, which provides:

"SEC. 4. Registration of trade-marks, trade-names and service marks on the principal register. – x x x The owner of the trade-mark trade-name or service mark used to distinguish his goods, business or services from the goods, business or services of other shall have the right to register the same on the principal register, unless it:

x x x

(d) Consists of or comprises a mark or trade-name which so resembles a mark or trade-name registered in the Philippine or mark or trade-name previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers;

x x x

WHEREFORE, premises considered, the herein interference case is TERMINATED in favor of the Junior Party-Applicant. Accordingly, this Bureau gives due course to application Serial No. 38494 for the trademark "AHI-MIKASA & DEVICE" in favor of the Junior Party-

Applicant and orders Certificates of Registration No. 32216 for the trademark "AHI-MIKASA & DEVICE" CANCELLED.

Let the file wrapper of Application Serial No. 38494 of the Junior Party-Applicant be remanded to the Application, Issuance and publication Division, and the remaining records of the case be forwarded to the Patent/Trademark Registry & EDP Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director