

MITSUBISHI JIDOSHA KOGYO,
KABUSHIKI KAISHA,

Opposer,

-versus-

IGRI INDUSTRIES, INC.,

Respondent-Applicant.

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INTER PARTES CASE NO. 3572

Opposition to :

Serial No. : 68068

Date Filed : 1 December 1988

Trademark : "ATENDIDO PAREJO"

Goods : motor vehicles parts and
accessories thereof

Decision No. : 2001-05

DECISION

A Verified Notice of Opposition was filed by Opposer Mitsubishi Jidoshi Kogyo Kabushiki Kaisha against the application for registration of the trademark "ATENDIDO PAREJO" with Serial No. 68068 used for utility vehicles and SUVs filed by Igri Industries, Inc., the Respondent-Applicant. The trademark application was published for opposition on page 12 of vol. III of the Official Gazette issued No. 3 and officially released for circulation on May-June, 1990.

Opposer Mitsubishi Jidoshi Kogyo Kabushiki Kaisha is a corporation duly organized and existing under the laws of Japan with principal offices at 33-8, Shiba 5-Chome, Minato ku, Tokyo, Japan, on the other hand, the Respondent is a domestic corporation and doing business at San Juan, Metro Manila.

The grounds for the present opposition are as follows:

"1. The mark Atendido Parejo under Serial No. 68068 of Respondent-Applicant is not only confusingly similar but deliberately identical to Opposer's registered trademark "PAJERO" which the Opposer has not abandoned;

"2. The Opposer will be damaged and prejudiced by the registration of the mark "ATENDIDO PAREJO" in the name of Respondent-Applicant, and its business reputation and goodwill will suffer great and irreparable injury."

Opposer relied on the following facts to support this Opposition:

"1. Opposer is the registered owner of the trademark " PAJERO" for use on motor vehicles and parts and accessories thereof under Registration Certificate No. 46412 issued on September 11, 1989, a copy of which is hereto attached as Annex "A" and made an integral part hereof;

"2. Opposer has been using the aforesaid trademark "PAJERO" in the Philippines since June 1, 1982 continuously up to the present. Thus, the actual number of "PAJERO" vehicles exported by Opposer to the Philippines in the last four (4) years are as follows:

April/86-March/87-168
April/87-March/88-751
April/88-March/89-1,314
April/89-March/90-852

"3. Opposer's trademark "PAJERO" is well-known throughout the world and in the Philippines and said mark has become distinctive of Opposer's goods;

"4. Opposer's trademark "PAJERO" has obtained general international consumer recognition and goodwill;

"5. The trademark "ATENDIDO PAREJO" of Respondent-Applicant is not only confusingly similar but deliberately identical to Opposer's trademark " PAJERO" which Opposer has not abandoned;

"6. Considering that the goods upon which Respondent-Applicant uses its trademark " ATENDIDO PAREJO" are identical to the goods upon which Opposer uses its trademark " PAJERO", likelihood of confusion, deception or mistake as to the actual source or origin of the goods of Respondent-Applicant is likely, so much so that the unwary public may be mistaken to think Respondent-Applicant's goods as coming from, or related to, the products manufactured and sold by Opposer;

"7. The allowance of Application Serial No. 68068 is violative of the treaty obligations of the Philippines under the Paris Convention for the Protection of Industrial Property, to which both the Philippines and Japan are signatories;

"8. The allowance of Application Serial No. 68068 will damage and prejudice Opposer and its business reputation and goodwill will suffer great and irreparable injury.

In Respondent's Answer, it alleged inter alia, the following:

"1. The Opposition is pro-forma and is without merit; the grounds mentioned therein do not exist;

"2. The trademark " ATENDIDO PAREJO" is not identical and cannot be confusingly similar to the trademark " PAJERO" and no damage or prejudice can be suffered by Opposer, nor will the use thereof cause confusion or mistake, or be deceptive to purchasers as to source or origin and as to use for the following reasons:

"(1) The trademark "ATENDIDO PAREJO" clearly connotes local origin while Opposer's trademark "PAJERO" is known to be of Japanese origin;

"(2) The goods covered by the two distinct and different trademarks are not even competitive; " ATENDIDO PAREJO" vehicles are priced lower than "PAJERO" vehicles;

"(3) As a matter of fact the goods are clearly different since:

"a.) The engines used are different including the front and rear axle;

"b.) the front suspension of " ATENDIDO PAREJO" is leaf spring while "PAJERO" is torsion bar;

"c.) No Mitsubishi part is being used on "ATENDIDO PAREJO"

"d.) The interiors are different;

e.) The overall length (dimensions) are not the same;

"f.) The overall design are, likewise, different;

"g.) Various government agencies in the Philippines have knowledge and have approved various applications filed and submitted by "ATENDIDO PAREJO" such as the Board of Investments, Department of Public Highways, the Land Transportation Office, and the Quezon City government.

The parties were called for Pre-Trial conference but were not able to reach an amicable settlement. Thus, this Office ordered the presentation of the parties' respective evidences and witnesses in a series of hearing called for that purpose.

The issues to be resolved by this Office are

1. whether or not Respondent-Applicant's trademark "ATENDIDO PAREJO" is confusingly similar to Opposer's trademark PAJERO";
2. whether or not the registration and use by Respondent-Applicant of the trademark "ATENDIDO PAREJO" damage and prejudice Opposer.

Republic Act No. 166 as amended, which was the law in force and effect at the time the trademark application of Respondent-Applicant was filed and the corresponding Opposition thereto of the herein Opposer was filed should govern in the resolution of the instant Opposition proceeding:

Under the said R.A. 166, as amended, more particularly Sec. 4 (d) it said that:

"Sec. 4.-Registration of trademarks, tradenames and service marks on the principal register. There is hereby established a register of trademarks, tradenames, or service-mark used to distinguish his goods, business or services from the goods, business, or services of others shall have the right to register the same on the principal register, unless it:

xxx

"(d) Consists of or comprises a mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename 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 the purchasers: or

On the basis of the evidence presented, Opposer's mark "PAJERO" as used on motor vehicles and parts and accessories thereof, (Exhibits "A", "A-1", "A-2", "A- 3" inclusive of sub-markings) and Respondent-Applicant's "PAREJO" mark as used on motor vehicles, parts and accessories thereof, (Exhibit "1"-"14" inclusive of sub markings) would show that the products bearing the subject marks are similar, related, competitive and flow on the same channel of trade.

In its overall appearance, the mark PAREJO of Respondent-Applicant can easily be mistaken as similar to Opposer's PAJERO since they consist of six (6) identical letters and three (3) syllables and to create some variations which is not distinctive, Respondent-Applicant opted to transpose the letters R and J. However, the difference is not glaring and striking to the eye and the six (6) silver-plated letters remained written in elaborated Gothic (Tahoma) lettering as can be gleaned from the evidence presented (Exhibits 10, 12 and 13 and correspondingly marked as Exhibits FFF, GGG, HHH during the cross-examination). Likewise, the style in which both capital 3 are written are similar, thus, similarities in the dominant feature of both marks are not completely lost. It is noteworthy to cite at this juncture the ruling of the Supreme Court in the cases of Co Tiong Sa v. The Director of Patents (95 Phil 1 (1954); Sapolin Corp. vs. Balmaceda (67 Phil. 705); and Forbes Nurma & Co. vs. Ang San To (40 Phil 272) which applied the dominance test in determining the existence of confusing similarity between trademarks, that "if there is similarity with the essential or dominant feature of the trademark, despite some differences or variations in detail, *there is infringement.*"

With the words "PAJERO" and " PAREJO" being the dominant features of both marks, consumers and patronizers alike would be confused as to the origin or source of these

trademarks if they would be sold commercially in the market altogether. The infringement arising out of this confusing similarity is inevitable.

The Supreme Court in the case of Philippine Nut Inc., vs. Standard Brands Incorporated, et. al. 65 SCRA 575, 579, stated thus:

"In cases involving infringement of trademark brought before the Court, it has been consistently held that there is infringement of trademark when the use of the mark involved would be likely to cause confusion or mistake in the mind of the public or to deceive purchasers as to the origin or source of the commodity; whether or not a trademark causes confusion and is likely to deceive the public is a question of fact which is to be resolved by applying the "TEST OF DOMINANCY", meaning, if the competing trademarks contain the main or essential or dominant features of another by reasons of which confusion and deception are likely to result, then infringement takes place: that duplication or imitation is not necessary. A similarity in the dominant features of the trademarks would be sufficient." (CO TIONG SA vs. DIRECTOR OF PATENTS, 1954, 94 Phil 1, citing viz Clarks vs. Manila Candy Co. 36, Phil. 100; ALHAMBRA CIGAR & CIGARETTE CO. vs. 7AO OGE, 47 PHIL. 75, ETEPHA A.G. vs. DIRECTOR OF PATENTS and WESTMONT PHARMACEUTICALS INC., NO. L-20635, March 31, 1966, 16 SCRA 495)

The Respondent's contention that the Supreme Court ruling in the case of Asia Brewery, Inc., vs. C.A. serves to underscore the position that Respondent-applicant's trademark whether it be "PAJERO" or "ATENDIDO PAREJO" is not confusingly similar with that of the Opposer, to this, THIS OFFICE DO NOT AGREE.

The Supreme Court speaks unequivocally in the aforesaid principle that the word "BEER" does not appear in SMC's trademark, just as the words "SAN MIGUEL" do not appear in ABI'S trademark. Hence, there is absolutely no similarity in the dominant feature of both trademark neither in sound, spelling or appearance can "BEER PALE PILSEN" be said to be confusingly similar to "SAN MIGUEL PALE PILSEN", while in the case at bar, there is an existing dominant feature the words "PAJERO" and "PAREJO" which suggest an effort to imitate.

The main thrust of SMC's complaint is not infringement of its trademark but unfair competition arising from the alleged confusing similarity in the general appearance or trade dress of ABI'S PALE PILSEN beside SMC'S SAN MIGUEL PALE PILSEN while in the instant case the issue involved is whether or not there is confusing similarity on the subject trademark which would likely result to infringement of trademark.

In the instant case, notwithstanding the fact that the competing marks involve the same goods, they both pertain to motor vehicles falling under Class 12 of the International Classification of Goods (i.e., vehicles and apparatus for locomotion), the stylized lettering of Respondent-Applicant's trademark PARE 30 shown in Exhibit B-1 closely resembles that of the mark PAJERO of Opposer that despite difference in the pronunciation of the labels, similarity is evident in the dominant features and overall (sound, spelling, etc.) appearance of the marks.

In this wise, the Supreme Court has ruled that:

"In determining whether the two trademarks are confusingly similar, the two marks in their entirety as they appear in the respective labels must be considered in relation to the goods to which they are attached; the discerning eye of the observer must focus not only on the predominant words but also on the other features appearing on both labels. (Mead Johnson & Co., vs. N .V.J. Van Dorp Ltd., 7 SCRA 768) (underscoring ours)

Moreover, the likelihood of confusion cannot be avoided by mere addition of a word or mark. Thus, the mere addition of the word ATENDIDO in Respondent's mark PAREJO will not make any difference at all to the dominant words "PAJERO" and "PAREJO".

Thus, in continental USPQ 60, the oft-repeated rule was applied to wit: That the confusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term. Example: "Miss USA" and "Miss USA World" (Miss unive4rse, Inc., vs. Patricelli, 161 USPQ 129); GUCCI" and "GUCCI-GOO" (Gucci Shops vs. R.H. Macy & Co., 446 F. Supp 838); "Comfort" and Foot Comfort" (School, Inc., vs. Tops E.H.R. Corp., 185 USPQ 754); " ACE" and "TEN-ACE" (Becton, Dickinson & Co. vs. Uniquam Mills, Inc., 199 USPQ 607)

In connection with the use of a confusingly similar or identical mark, it has been ruled thus:

"Those who desire to distinguish their goods from the goods of another have a broad field from which to select a trademark for their wares and there is no such poverty in the English language or paucity of signs, symbols, numerals etc. as to justify one who really wishes to distinguish his product from the other entering the twilight zone of or field already appropriated by another (Weco Products Co., Milton Ray Co., 143 F. 2d. 985, 32 C.C.P.A. Patents 1214).

"why of the million of terms and combinations of letters and designs available, the appellee had to choose those so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark". (American Wire & Cable Co., vs. Dir. of Patents 31 SCRA 544)".

XXX "why, with all the birds in the air, and all fishes in the sea, and all the animal on the face of the earth to choose from, the defendant company (Manila Candy Co.) elected two roosters as its trademark. Although its directors and managers must have well been well aware of the long-continued use of a rooster by the plaintiff with the sale and achievement of its goods? Xxx a cat, a dog, a carabao, a shark, or an eagle stamped upon the container in which candies are sold would serve as well as rooster for the product of defendant's factory. Why did defendant select two roosters as its trademark? (Clarke vs. Manila Candy Co., 36 Phil. 100)."

Even the points stressed and argued by Respondent-Applicant in its Answer that the goods subject of this controversy are different and non-competitive because ATENDIDO PAREJO vehicles are priced lower than that of MITSUBISHI PAJERO vehicles, one is of local origin and the other foreign and that the engines, motor parts, overall length and dimension of the vehicles including the interiors are different from each other, are INSUBSTANTIAL to give distinctness to the mark ATENDIDO PAREJO. We upheld the ruling of the Supreme Court cited in the case of Co Tiong Sa vs. The Director of Patents 95 Phil 1 (1954) that, dissimilarity in size, form and color of the label and the place where applied are not conclusive. If the competing label contains the trademark of another, and confusion or deception is likely to result, infringement takes place *regardless of the fact that the accessories are dissimilar.*"

In the case at bar, there is no doubt that Respondent-Applicant's "ATENDIDO PAREJO" is indeed confusingly similar to Opposer's trademark "PAJERO" and that there is a clear indication that the herein Respondent merely adopted said trademark "PAREJO" from Opposer's mark "PAJERO". Hence, the inescapable conclusion is that he is merely riding on the reputation of the Opposer's mark, for in the unlimited field of choice, what could have been Respondent's purpose in selecting "PAREJO" if not for its fame?

As to whether or not there is damage, the use of the same trademark or name by Respondent for a related or similar line of product would create an impression that it originated from the herein Opposer or falsely suggest a connection therewith.

The risk of damage is not limited to a possible confusion of goods but also includes confusion of reputation if the public could reasonably assume that the goods of the parties originated from the same source.

This is what R.A. 166, as amended, sought to avoid because if the goods bearing the trademark of another turned out to be of inferior quality, the damages cause in terms of reputation and goodwill to the original bearer of this trademark would be irreparable.

Inversely, the law cannot and will never allow an infringing trademark whose goods are of equal or superior quality than that of the original to have an unwanted share in the accumulation of profit which otherwise would have appropriately belonged to the rightful owner thereof.

IN VIEW OF THE FOREGOING, the instant Notice of Opposition is hereby SUSTAINED. Accordingly, Application Serial No. 68068 for the registration of the trademark ATENDIDO PAREJO is hereby REJECTED.

Let the filewrapper of the mark ATENDIDO PAREJO subject of this case be forwarded to the Administrative Financial, and Human Resources Development Services Bureau for appropriate action in accordance with this Decision with a copy furnished the Bureau of Trademarks for information and to update its records.

SO ORDERED.

Makati City, 31 July 2001.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs