NITTO BOSEKI CO., LTD.,
Opposer,

INTER PARTES CASE NO. 2055

OPPOSITION TO:

Appln. Serial No. 52545
File : October 27, 1983
Applicant : Wilson Lagamayo
Trademark : NITTOBO
Used on : T-shirts, polos, pants, etc.

- versus -

WILSON LAGAMAYO
Respondent-Applicant.
x----------x

DECISION NO. 88-26 (TM)
May 20, 1988

DECISION

This is an Opposition filed by the herein Opposer, Nitto Boseki Co., Ltd., against the registration of Application Serial No. 52545 for trademark "NITTOBO" for use on T-shirts, polos, pants, socks and sandos in favor of the herein Respondent-Applicant, Wilson Lagamayo.

Opposer is a foreign corporation organized and existing under the laws of Japan with office and business address at No. 1 Higashi Gonome, Tuhushima, Japan, while Respondent-Applicant is a Filipino businessman with address at 959 Ilaya Street, Binondo, Manila.

The Petition is based on the grounds that Opposer is the owner of the trademark "NITTOBO" for rayon, staple, rock wools, glass fiber rovings and glass fiber chopped strand mats, cotton fabrics and chemical fiber fabrics, registered under Certificate of Registration No. 14120 issued on September 5, 1968 by the Patent Office; and that the registration of the trademark "NITTOBO" in the name of Respondent-Applicant is in violation of and runs counter to Section 4(d) of Republic Act No. 166, as amended.

A Notice to Answer was sent on June 1, 1987 to Respondent-Applicant which the latter received on June 6, 1987, per registry return receipt on file in the Bureau.

For failure to file an Answer within the prescribed period, Respondent-Applicant was declared in default, per Order No. 87-177 dated August 5, 1987 and thereafter, Opposer was allowed to present ex-parte its evidence.

Opposer's evidence consists of documents Exhibits "A" to "M", inclusive of all submarkings which after formal offer were admitted by this Bureau under Order No. 88-45 dated February 3, 1988.

The sole issue to be resolved is whether or not Respondent-Applicant's trademark "NITTOBO" be allowed registration.

Admitted evidence indisputably show that Opposer registered the mark "NITTOBO" in the Philippines as early as September 3, 1968 under Certificate of Registration No. 14120. That one of the goods covered by said registration is cotton fabric, now classified under Class 24 of the International Classification of Goods and Services. Opposer likewise acquired registration of the same mark in various countries, namely, France (Exh. "D-1"), United Kingdom (Exh. "D-3"), United States (Exh. "D-4"), West Germany (Exh. "D-6"), Hong Kong (Exh. "D-8"), Korea (Exh. "D-12"), Taiwan (Exh. "D-17"), Thailand (Exh. "D-21") and Japan (Exh. "D-23") and made extensive

advertisements of the said mark as shown by Exhibits “F-1” to “I-1” inclusive of their submarkings.

Respondent-Applicant on the other hand applied for the registration of identical mark “NITTOBO” on October 27, 1983 under Application Serial No. 52545 for T-shirts, polos, pants, socks and sandos which are classified under Class 25 of the International Classification of Goods and Services.

Comparing the mark of the respective parties, one can readily conclude that they are identical to each other. That Respondent-Applicant’s goods, although belonging to a different class are closely related to one of the goods covered by the Opposer’s mark which is cotton fabric.

In the case of Ang vs. Teodoro (74 Phil. 50), the Supreme Court held:

> “Although two non-competing articles may be classified under two different classes by the Patent Office because they are deemed not to possess the same descriptive properties, they would, nevertheless, be held by the courts to belong to the same class if the simultaneous use on them of identical or closely similar trade-marks would be likely to cause confusion as to the origin, or personal source of the second user’s goods. x x x
>
> Such construction of the law is induced by cogent reason of equity and fair dealing.”

The Court further ruled:

> “When non-competitive products are sold under the same mark, the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark created by its first user, inevitably results. The original owner is entitled to the preservation of the valuable link between him and the public that has been created by his ingenuity and the merit of his wares or services. Experience has demonstrated that when a well-known trade-mark is adopted by another even for a totally different class of goods, it is done to get the benefit of the reputation and advertisements of the originator of said mark, to convey to the public a false impression of some supposed connection between the manufacturer of the article sold under the original mark and the new articles being tendered to the public under the same or similar mark.”

If non-competing goods under the same mark owned by different parties can cause confusion, more so with goods bearing identical marks that are closely related as in the instant case.

With the foregoing pronouncements and consideration, Respondent-Applicant is not entitled to register the mark subject of this opposition.

Further, the failure of Respondent-Applicant to file his Answer rendering him in default is indicative of Respondent-Applicant’s lack of interest in pursuing his application.

WHEREFORE, premises considered, herein Opposition is hereby GRANTED. Accordingly, Application Serial No. 52545 for the registration of the trademark “NITTOBO” is REJECTED.

Let the records of this case be remanded to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director