COPPERWELD BIMETALLICS LLC.,
Opposer,

- versus -

JOHNSON C. TAN,
Respondent-Applicant.
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IPC NO. 14-2009-00231
Opposition to:
Appln. Serial No. 4-2007-009767
(Filing Date: 05 September 2007)

TM: COPPERWELD

Decision No. 2012- 49

DECISION

COPPERWELD BIMETALLICS LLC. ("Opposer")[1], filed on 24 September 2009 an opposition to Trademark Application Serial No. 4-2007-009767. The application of JOHNSON C. TAN ("Respondent-Applicant")[2] covers the mark "COPPERWELD" for use on welding machines under Class 07 of the International Classification of Goods[3].

The Opposer alleges that the registration of COPPERWELD in favour of the Respondent-Applicant is proscribed under Sec. 123.1, pars. (d), (e) and (f) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). According to the Opposer, the mark applied for registration by the Respondent-Applicant is confusingly similar to the Opposer's internationally well-known mark "COPPERWELD". The Opposer's evidence[4] consists of the certified copy of Cert. of Reg. No. 013500, authenticated affidavit of its Vice-President for Operations Michael R. Beddoe, list of worldwide active registration of its mark, sample trademark registration information in some countries[5], statement from Rocis, Inc. and Sample Invoice and Product Shipping Documents, "power point presentation" featuring "COPPERWELD" branded products and the company's worldwide customers, and various printouts from its website.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 22 October 2009. The Respondent-Applicant, however, did not file an Answer.

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

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[1] A corporation organized and existing under the laws of the State of Delaware, U.S.A., with principal office address at 254 Cotton Mill Road, Fayetteville, Tennesee, 37334, U.S.A.
[2] With address at 801 Tayuman Street corner Perfecto Street, Tondo, Manila, Philippines.
[3] The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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] Exhibits "A" to "D", (inclusive).
[5] Australia, Indonesia, Japan, Taiwan, New Zealand, France, South Africa, United Kingdom, Mexico and the United States.

fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.[6] Thus, Sec. 123.1(d) of the IP Code provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services of if it nearly resembles such mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its trademark application on 05 September 2007, the Opposer has an existing registration for the mark "COPPERWELD" which is used for "*nails, staples, fence, tensions bar for fence, barbed wire, revetment fabrics in class 6, compression sleeves therefore, ground rods, clamps, couplings, and railway signal bonds*" under Class 06, and "*electrical wires and cables*" under Class 09. Comparing the parties' respective goods, this Bureau finds the Opposer's goods under Class 06 closely related to the Respondent-Applicant's. The Respondent-Applicant's welding machines are under Class 07 which includes

> "*Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.*"

while the Opposer's are under Class 06, which covers

> "*Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.*"

The root word of "welding" is "weld" which is defined as follows:

> *a*: to unite (metallic parts) by heating and allowing the metals to flow together or by hammering or compressing with or without previous heating *b* : to unite (plastics) in a similar manner by heating *c*: to repair (as an article) by this method *d* : to produce or create as if by such a process.[7]

The Opposer's products under Class 06 are metal products and hardware the fabrication process of which includes welding. Both parties' respective goods are used in industries and works that utilizes or dependent on metals, the Opposer's as materials or components, the Respondent-Applicant's as tools.

Considering therefore that the competing marks are not only similar - they are identical – and are used on closely related goods, deception or confusion is likely to occur. Just by looking at the Respondent-Applicant's goods bearing the "COPPERWELD" mark would likely create an impression that this is owned by the Opposer. The consumers may assume that the Respondent-Applicant's goods originate from or sponsored by the Opposer or believe that there is a connection

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[6] *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.
[7] See website: www.merriam-webster.com/dictionary/weld

between them, as in a trademark licensing agreement. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:[8]

> 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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

The field from which a person may select a trademark is practically unlimited. As in all other cases of colourable imitation, the unanswered riddle is why, of the millions of terms and combination of letters and designs available, the Respondent-Applicant had to come up with a mark identical to the Opposer's mark if there was no intent to take advantage of the goodwill generated by the other mark.[9]

Accordingly, Trademark Application Serial No. 4-2007-009767 is proscribed by Sec. 123.1(d) of the IP Code. With this finding, this Bureau sees no need to delve on the issue of whether or not the Opposer's mark is internationally well-known.

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

WHEREFORE, premises considered, the instant opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2007-009767 be returned, together with a copy of this Decision, to the Bureau of Trademarks, for information and appropriate action.

SO ORDERED.

Taguig City, 05 March 2012.

ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

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[8] See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.
[9] *American Wire & Cable Company v. Dir. of Patents*, G.R. No. L-26557, 18 Feb, 1970.