



**YAZAKI CORPORATION,**  
Opposer,

**-versus-**

**ALEX TAI,**  
Respondent-Applicant.

x-----x

} **IPC No. 14-2010-00279**  
} Opposition to:  
} Appln. Serial No. 4-2009-003279  
} Date Filed: 30 March 2009  
} TM: "YAZAKI"

### NOTICE OF DECISION

#### FEDERIS & ASSOCIATES LAW OFFICES

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#### MR. ALEX TAI


Respondent-Applicant  
35-B, 8<sup>th</sup> cor. 10<sup>th</sup> Avenue  
Grace Park, Caloocan City

#### GREETINGS:

Please be informed that Decision No. 2015 - 78 dated May 07, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 07, 2015.

For the Director:

  
**Atty. EDWIN DANILO A. DATING**  
Director III  
Bureau of Legal Affairs



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} **IPC NO. 14-2010-00279**

} Opposition to:

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} Date Filed: 30 March 2009

} Trademark : "YAZAKI"

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### DECISION

**YAZAKI CORPORATION**, (Opposer)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2009-003279. The application, filed by **ALEX TAI** (Respondent-Applicant)<sup>2</sup>, covers the mark "YAZAKI", for use on "Welding machine, air compressor, power tool, drill, heat gun, planer, angle grinder, bench grinder, cutting machine, drill bit, grinding machine, plasma welding machine, impact drill" under Class 7 of the International Classification of Goods<sup>3</sup>.

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

"a. The opposed trademark 'YAZAKI' is identical and therefore confusingly similar to Opposer's already registered and well-known 'YAZAKI AND DEVICE' and 'YAZAKI' trademarks which have registration and filing dates earlier than that of the subject application, and to Opposer's other 'YAZAKI' trademarks subject matter of application filed earlier than the subject application, and hence, the registration of the opposed trademark can be validly prevented by the Opposer under Sec. 147.1 and 147.2 of the IP Code, and must be denied under Sections 123.1 (e), and 123.1 (of the IP Code).

"b. 'YAZAKI' is Opposer's corporate name, and hence, under Section 165 of the Intellectual Property Code ('IP Code'). It can no longer be appropriated, used and registered as a trademark by Respondent-Applicant.

<sup>1</sup> A foreign corporation organized and existing under the laws of Japan, with address at 4-28 Mita 1-chome, Minato-Ku, Tokyo 108-8333, Japan.

<sup>2</sup> Filipino with address at 35 B 8<sup>th</sup> cor 10<sup>th</sup> Ave., Grace Park, Caloocan City

<sup>3</sup> The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

"c. Opposer is a holder of numerous certificates of registration for the 'YAZAKI' trademarks issued in various countries and hence, the registration of the opposed trademark which also uses the 'YAZAKI' word will damage Opposer whose foreign registration is protected under Section 134 of the IP Code.

"d. Opposer has already identified its goods and services in the mind of the public through the well-known goods and services bearing the 'YAZAKI' trademarks and hence, it is entitled to protection under Section 168.1 of the IP Code.

"e. The use of 'YAZAKI' by the Respondent-Applicant on the goods described in the subject application will inevitably indicate an association by the public with the goods of Opposer under the same trademark and thus, its registration is proscribed under 147 of IP Code.

"f. The subject application is filed in bad faith because there can be no reasonable explanation to the adoption and coinage of the word 'YAZAKI' by Respondent-Application, whose name, Alex Tai, precisely has no connection in any way with 'YAZAKI' as to merit the coinage by Alex Tai, and hence, the interference, as held in McDonald's Corp. vs. MacJoy Fastfood Corp. and Converse Rubber Corporation v. Universal Rubber Products, Inc. is that 'YAZAKI' was chosen deliberately by Respondent-Applicant to deceive the public and, as held in Shangri-La International Hotel Management Ltd. Vs. Developer's Group of Companies, Inc. to take advantage of the goodwill of Opposer's well-known 'YAZAKI' trademarks.

"g. The registration of 'YAZAKI' in favor of Respondent-Applicant will result to Trademark Dilution affecting the distinctiveness of Opposer's well-known 'YAZAKI'."

The Opposer relies on the following facts in support of its Opposition:

"8. Opposer, Yazaki Corporation, is an independent automotive component maker founded in 1941. Apart from automotive wire harnesses, the Opposer's core business for which it commands a top share in the global market, it develops and manufactures meters, electronic components, airconditioning equipment, and a host of other products for automotive use. Opposer has developed and produced a long line of eco-friendly and energy saving products, starting with the world's first solar thermal powered air conditioning system in 1974, to the world's first wood biomass energy air conditioning system in 2008.

"9. Yazaki Corporation was founded in 1941 as an automotive company. The Yazaki Group now comprises 172 companies, 91 of which are outside of Japan, dotting 38 countries. It employs more than 156,000

people globally, about 22,000 in Japan, 24,000 in Europe, 35,000 in America, and 75,000 in Asia.

"10. Yazaki Corporation is the world's largest manufacturer of wire harnesses (the central nervous system for vehicles) in the automotive industry. Its products include electrical cables, meter and auto instruments, gas equipment and air conditioning and solar powered systems. Yazaki Corporation sells chiefly to auto makers, and, to a lesser extent, electric power, gas, and general construction companies. Among its clients are Toyota, Volvo, General Motors, Ford, DaimlerChrysler, among others.

"11. Opposer ranks among the top 100 companies receiving the most US patents. The companies headquarters is in Tokyo, Japan, regional headquarters are located in Cologne, Germany (for Europe) and for America in Canton, MI, USA.

"12. Opposer is active in numerous countries in the world. Through its business model, it maintains leadership by supplying products and services that meet the challenging needs of customers throughout the world. It has also earned a global reputation for the quality of its products.xxx"

To support its opposition, the Opposer submitted as evidence the following:

1. Authenticated and notarized Affidavit of Yoshihito Katsumata dated 26 October 2010;
2. Notarized Affidavit of Amando Aumento Jr. dated 9 November 2010;
3. Authenticated and notarized Special Power of Attorney dated 26 October 2010;
4. Photocopies of certificates of registration in Indonesia, Singapore, Vietnam, Japan, United States of America, Great Britain and France;
5. Print-out of web pages showing trademarks and products of bearing YAZAKI;
6. Certified true copy of Securities and Exchange Commission General Information Sheet and Amended Articles of Incorporation of Yazaki-Torres Manufacturing, and
7. Database print-out of pending applications and registrations of YAZAKI & DEVICE.<sup>4</sup>

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 12 March 2010 and was received on 15 March 2012. The Respondent-Applicant, however did not file an Answer. Thus, the Hearing Officer issued on 19 September 2012 Order No. 2012-1236 declaring the Respondent-Applicant to have waived his right to file an Answer.

Should the Respondent-Applicant be allowed to register the trademark YAZAKI?

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

Sec. 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides:

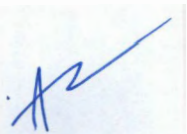
Sec. 123.1. Registrability. A mark cannot be registered if it:

- (d) is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:
  - (i) the same goods or services; or
  - (ii) closely related goods or services; or
  - (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The records show that when the Respondent-Applicant filed its application on 30 March 2009, the Opposer already has an existing registrations for the trademark YASAKI & DEVICE<sup>5</sup> under Registration no. 024281 issued on 29 October 1976 covering goods under class 1 namely: *"vinyl tape (tape made from vinyl), meter and gauges, namely; oil pressure, ammeter, volt meter, water temperature, oil pressure and volt meter, oil pressure and ammeter, oil pressure-ammeter and water temperature, oil pressure-ammeter and auto clock, electric tachometer, cam dwell tester, coil tester, alternator diode and ignition cable tester, idle tachometer, compress tester, engine vacuum and fuel pump tester, timing light, remote control starter switch, regulator generator, odometer, light source kit consisting of a bracket, bulb, bulb socket and electric wire and electric lamp and bulb sending unit pipe for temperature gauge, installation parts for oil pressure gauges and ammeters"* and class 9, namely; *"vinyl tape (tape made from the vinyl), meter and gauges, namely, oil pressure, ammeter, volt meter, water temperature, oil pressure and volt meter, oil pressure and ammeter, oil pressure meter and water temperature, oil pressure-ammeter and auto clock, electric tachometer, cam dwell tester, coil tester, alternator diode and ignition cable tester, idle tachometer, compression tester, engine vacuum and fuel pump tester, timing light, remote control starter switch, regulator generator, odometer, light source kit consisting of a bracket, bulb, bulb socket and electric wire, electric lamp or bulb sending unit pipe for temperature gauge, installation parts for oil pressure gauges and ammeters"*; Registration No. 42008011923 issued on 5 November 2009 covering goods under class 9, namely; *"wire harness for automobiles, wire harness, battery cables, spark plug wires/cables, ignition wires/cables, high voltage resistance wires/ cables or anti-noise high voltage wires/cables, high voltage cables for electric vehicles, electric wires and cables for automobiles, connector housings to insulate electric terminals, electric connectors, holders for connector housings, spacers for connector housings, molded plastics for protecting wire harness, tubes for protecting wire harness, clamps for fastening wire harness, bands for binding wire harness, tubes for protecting wire harness, junction boxes for automobiles, steering wheel rotary connector, optical fiber cables, optical connectors, driving cables for meters, bare wires, coaxial cables, electric power lines, electric wires and cables for communication, fire-proof electric wires and cables, heat resistance electric wires and cables, electric wires and cables for alarm, pre fabricated wire harness for building and/or housing, building/housing wire harness,*

<sup>5</sup> Exhibits "H"-2 and "H"-3

*electric wires and cables, electric terminals, electric relays, electrical fuses, electrical fusible links, fuse boxes, relay boxes, electric control units, steering column switches, automotive door control units, kerosene level switches, power distribution or control machines and apparatus, rotary converters, phase modifiers, tachographs, taximeters, fuel consumption indicators, fuel consumption meters, load meters, center console display for automobiles, speedometers, tachometers, odometers, tripmeters, fuel gauges, water temperature gauges, oil pressure gauges, oil temperature gauges, fuel sensors, pressure sensors, temperature sensors, meters for recording operation, temperature recorders for refrigerator trucks, gas meters, gas pressure regulators, pressure chart recorders, pressure recording gauges, measuring or testing machines and instruments, printers for taxi meter, etc vehicle units, digital cameras, traffic accident data recorders, vehicle positioning system, data recorders and analyzers for construction equipment, gas leakage detectors and alarms, co-gas detectors and alarms (carbon monoxide detectors and monoxide detectors), liquefied petroleum gas carburetors, automatic switch over-gas regulators, bulk supply engine for lpg, telecommunication devices and apparatus, computer programs, electronic circuits, magnetic disks, magnetic cards, magnetic sheets, magnetic tapes recorded with computer programs, electronic machines, apparatus and their parts, lpg bulk storage tanks, gas cock valve"; class 17 namely: "grommets, bushes, rubber plugs for waterproof connectors, gas pipe fittings, junctions for pipes (not of metal), packing, gas shut-off valves, two-way gas valves, gas bottle valves, gas valves, gas hoses, hoses of rubber, hoses of plastics, gas pipes, (gas collecting pipes, gas manifold pipes), plastic pipes and tubes, rubber tubes and pipes, LPG bulk storage tank, gas cock valves; Registration No. 42010002311 issued on 2 March 2010 covering for goods under class 17, namely: "electrical insulating tapes, grommets, bushings, rubber plugs for waterproof connectors, in international class 17"; class 9, namely" wire harness for automobiles, wire harness, battery cables, spark plug wires/cables, ignition wires/cables, high voltage resistance wires/ cables or anti-noise high voltage wires/cables, high voltage cables for electric vehicles, electric wires and cables for automobiles, connector housings to insulate electric terminals, electric connectors, holders for connector housings, spacers for connector housings, molded plastics for protecting wire harness, tubes for protecting wire harness, clamps for fastening wire harness, bands for binding wire harness, junction boxes for automobiles, electrical relays, electrical fuses, electrical fusible links, fuse boxes, relay boxes, electric control units, steering column switches, steering wheel rotary connector, automotive door control units, optical fiber cables, optical connectors, computer programs, telecommunication devices and apparatus, electronic circuits, magnetic disks, magnetic cards, magnetic sheets, magnetic tapes recorded with computer programs, electronic machines apparatus and their parts, tachographs, taximeters, printers for taxi meter, etc. vehicle units, fuel consumption indicators, fuel consumption meters, load meters, driving cables for meters, meter cluster for automobiles, speedometers, tachometers, odometers, tripmeters, fuel gauges, water temperature gauges, oil pressure gauges, oil temperature gauges, fuel sensors, pressure sensors, temperature sensors, meters for recording operation, digital cameras, ccd cameras, traffic accident data recorders, vehicle positioning system, temperature recorders for refrigerator trucks, data recorders and analyzers for construction equipment, bare wires, electric wires, electric cables, coaxial cables, electric power lines, electric wires and cables for communication, fire-proof electric wires and cables, heat resistance electric wires and cables, electric wires and cables for alarm, pre-fabricated wire harness for building and/or housing,*



*building/housing wire harness, optical fibers, optical connectors, in international class 9.*" The Respondent-Applicant's trademark application therefore indicates goods that are similar and/or closely related to those covered by the Opposer's trademark registration. The Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's, particularly, Welding machine, air compressor, power tool, drill, heat gun, planer, angle grinder, bench grinder, cutting machine, drill bit, grinding machine, plasma welding machine, impact drill, which flow through the same channels of trade. In *Mighty Corporation and La Campana Fabrica de Tabaco, Inc. v. E. & J. Gallo Winery and the Andresons Group, Inc.*<sup>6</sup>, the Supreme Court held:

"In resolving whether goods are related, several factors come into play:

- (a) the business (and its location) to which the goods belong
- (b) the class of product to which the goods belong
- (c) the product's quality, quantity, or size, including the nature of the package, wrapper or container
- (d) the nature and cost of the articles
- (e) the descriptive properties, physical attributes or essential characteristics with reference to their form, composition, texture or quality
- (f) the purpose of the goods
- (g) whether the article is bought for immediate consumption, that is, day-to-day household items
- (h) the fields of manufacture
- (i) the conditions under which the article is usually purchased and
- (j) the channels of trade through which the goods flow, how they are distributed, marketed, displayed and sold."

The competing marks, depicted below are identical.

Opposer's mark

Respondent-Applicant's mark

 YAZAKI

 YAZAKI

That the Opposer's mark is a composite mark which utilizes a device in addition to the word YAZAKI is of no consequence. When the marks are applied on related goods, confusion and deception is likely to result. Evidence shows that the Opposer has registered its mark under Registration No. 024281 issued on 29 October 1976; Registration No. 42008011923 issued on 5 November 2009; and Registration No. 42010002311 issued on 2 March 2010<sup>7</sup> in the Philippines and abroad. It has advertised its mark YAZAKI & DEVICE over the internet as evidenced by its web-pages.

Succinctly, because the Respondent-Applicant uses its mark on goods that are similar or closely related to the Petitioner's it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or

<sup>6</sup> G.R. 154342, July 14, 2004

<sup>7</sup> Exhibit "H"

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 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>8</sup>

In addition, the Opposer's corporate name, carries its trademark 'YAZAKI' and is also used as trade name and company name of its affiliates around the world. As such, it is entitled to protection under the IP Code, to wit:

**Section 165. Trade Names or Business Names.** - 165.1. A name or designation may not be used as a trade name if by its nature or the use to which such name or designation may be put, it is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.


165.2.(a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

The Respondent-Applicant despite the opportunity given, did not file an Answer in order to defend its trademark application and explain how it arrived at using a mark that is practically identical/confusingly similar to the Opposer's registered mark.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2009-003279 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 7 May 2015.

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

<sup>8</sup> *Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.