



DAIDO KOGYO CO., LTD.,
Opposer,

-versus-

JAMES YOUNG TAN,
Respondent-Applicant.

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IPC No. 14-2012-00189

Opposition to:

Appln. Serial No. 4-2011-007382

Date Filed: 27 June 2011

TM: D. T. D. AND DESIGN

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 402 dated 07 November 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 07 November 2016.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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} **IPC NO. 14-2012-00189**

} Opposition to:

} Appln. Ser. No. 4-2011-007382

} Date Filed: 27 June 2011

} Trademark: **D.T.D AND DESIGN**

} Decision No. 2016- **402**

DECISION

DAIDO KOGYO CO. LTD., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2011-007382. The application, filed by JAMES YOUNG TAN, (Respondent-Applicant)², covers the mark “D.T.D AND DESIGN”, for use on “motorcycle parts namely: handle grips, brake disc, brake linings, amplified horns, drive chains, gears, brakes shoes, drive shafts, handle bars, license plate frames R& holders, luggage console, kickstands, kick start handles, mudguards, radiator shrouds, brake hose & cables, clutch cables, fork, fork dust boots & seal control lever or trottle handles, brake calipers, shocks, front dash panels & gauges, brake master assemblies, rims, mag wheels, clutch assemblies, headlight mounts, tire inner tubes, body cover & motorcycle parts & accessories” under Class 12 of the International Classification of Goods³.

The Opposer anchors its opposition on the grounds that the proposed registration of the mark “D.T.D” will run counter to the provisions of Section 122 and 123 (d) of the Intellectual Property Code (“IP Code”), which protects previously registered marks and will cause great and irreparable damage and injury to the Opposer. The Opposer also alleges to be the owner of the internationally well-known mark “D.I.D” with the right to prevent the registration of similar marks under Section 147.2 of the IP Code. It further alleges that if allowed registration, the Respondent-Applicant’s mark will dilute the goodwill of the Opposer’s well-known mark.

The Opposer alleges, among other things, the following facts:

“(a) The opposer previously obtained registration from the Intellectual Property Office of the Philippines (IPOPhil) for the following mark:

(i) ‘D.I.D’ under Registration No. 4-1993-092354 issued on August 26, 1999;

¹ A private corporation duly organized and existing under the laws with principal address at 1-197, Kumasaka-Cho Kaga Ishikawa Prefecture

² Filipino with address at No. 261, between 7th and 8th Ave., Rizal Avenue Ext. Grace Park Caloocan City

³ 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.

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- (ii) 'D.I.D' under Registration No. 4-1993-092354 issued on August 26, 1999;
- (iii) 'D.I.D' under Registration No. 4-1993-092354 issued on August 26, 1999;
- (iv) 'D.I.D' under Registration No. 4-1993-092354 issued on August 26, 1999;

- (b) The opposer has used and is using its 'D.I.D.' Trademarks in business through manufacture, sale, marketing and distribution of its products falling under class 12, in many countries across the world including the Philippines and the registration of the identical mark 'D.T.D.' will greatly damage and prejudice opposer's rights over its above named marks.

- (c) By virtue of opposer's prior and continued use of its trademarks in many countries in the world including the Philippines, 'D.I.D' trademarks have become popular and internationally well-known and have established goodwill for the opposer with the public which has identified the opposer as the source of the goods bearing the marks. The long use of and the large amounts spent by the opposer in popularizing the marks has generated immense goodwill for said marks in the Philippines and many other countries of the world, and has acquired general international consumer recognition as belonging to the one owner and source, i.e., the oppose herein, and opposer's products have acquired the reputation of high quality reliable products with the general public so that the opposer's marks have become strong and distinctive and are not, therefore, ordinary, common or weak marks.xxx

- (g) The applicant's mark 'D.T.D' so closely resembles, and is visually and aurally similar to the opposer's 'D.I.D.' Trademarks, as to cause confusion, mistake and deception by creating a false connection between respondent's products and those of the opposer's, thus damaging the latter's interest.xxx"

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

1. Certified true copies of the Philippine trademark registrations for the mark "D.I.D";
2. Copies of trademark registrations of the mark "D.I.D"/ "DID" issued in foreign countries;
3. List of sales figures ; and
4. Representative sales invoices and sample print advertisement.⁴

⁴ Exhibits "A" to "E"

The Respondent-Applicant filed his Answer on 10 August 2012, alleging among other things, the following:

“I. There will be no confusion there are vast dissimilarities between the contending trademarks as regards the visual attributes specifically the representation style, size in the lettering.

“II. The trademark is not confusingly similar with that of the Opposer. The spelling, sound and meaning of the trademark is different from the Appellant.

“III. The trademark ‘D.T.D AND DESIGN’ is a fanciful and arbitrary trademark which has no dictionary meaning and should be treated in its entirety and not dissected word for word. It is neither generic or descriptive.

“IV. The goods involved are different. Respondent-Applicant goods are motorcycle parts and accessories while opposer’s goods are bicycle chains and automotive chains.

The Respondent-Applicant alleges that:

“6. The trademarks involved should be considered as a whole ‘D.T.D and DESIGN’ is not confusingly similar to opposer’s ‘D.I.D. Trademark. It should also be emphasized that the respondent-applicant’s trademark contains a stylized oval laced with shadowed outline.

“7. Respondent-Applicant’s trademark is the whole ‘D.T.D.’, the trademark should be considered as a whole and not piecemeal. The dissimilarities between the two marks become conspicuous, noticeable and substantial enough to matter especially in the light of the following variables being factored in. xxx

“9. First, the products involved in the case at bar are, in the main, various kinds of jeans. These are not your ordinary household items like catsup, soy sauce or soap which are of minimal cost. Maong pants are not inexpensive. Accordingly, the casual buyer is predisposed to be more cautious and discriminating in and would prefer to mull over his purchase. Confusion and deception, then, is less likely. xxx

“10. Second, like his beer, the average Filipino consumer generally buys his jeans by brand. He does not ask the sales clerk for generic jeans but for say, a levis, Guess, Wrangler, or even an Armani. He is, therefore, more or less knowledgeable and familiar with his preference and will not be easily distracted.

“11. Finally, in line with the foregoing discussions, more credit should be given to the ‘ordinary purchaser’. Cast in this particular controversy,

the ordinary purchaser is not the 'completely unwary consumer' but is the 'ordinarily intelligent buyer' considering the type of product involved. xxx

"10. The goods sought to be registered are motorcycle parts like brake shoes while the Opposer's goods are mainly just bicycle and automotive chains hence different from the respondent-applicant.

The Respondent-Applicant submitted as evidence, the following:

1. Copy of packaging with the mark "D.T.D" for motorcycle hub and brake shoe;
2. Copy of Declaration of Actual Use dated 2 March 2012; and
3. Picture of actual product with the mark "D.T.D."⁵

The Preliminary Conference was terminated on 3 April 2013 where both parties were directed to file their respective position papers. The Opposer and Respondent-Applicant filed their position papers on 19 April 2013 and 13 April 2013, respectively.

Should the Respondent-Applicant be allowed to register the trademark D.T.D?

The essence of trademark registration is to give protection to the owners of trademarks. 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 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 R. A. No. 8293, also known as The Intellectual Property Code of the Philippines ("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 or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

Records show that at the time Respondent-Applicant applied for registration of the mark "D.T.D AND DESIGN" the Opposer already registered the marks: "DID LOGO", under Certificate of Registration No. 4-1993-92354⁷ issued on 26 August 1999 for "chains for bicycles, chains for motorcycles, chains for automobiles, wheels, rims and spokes under class 12; "D.I.D" under Certificate of Registration No.4-1998-002798⁸ issued on 6 January 2006 for "chains for bicycles, chains for motorcycles, chains for automobiles, chains for other vehicles, wheels, rims, spokes" under class 12; and "D.I.D" under Certificate of Registration No. 4-2004-006557⁹ issued on 23 October 2006 for "paperboard boxes, for industrial packaging, paper bags and sacks, corrugated cardboard boxes, postcard paper, cards (stationary) etc" under class 16 and "working clothes or working uniform, jackets, trousers, polo shirts, socks and stockings bandanas

⁵ Annex "1"- inclusive of submarkings

⁶ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.

⁷ Exhibit "A-1"

⁸ Exhibit "A-2"

⁹ Exhibit "A-3"

(neckerchiefs), helmets (clothing), headgear for clothing, suspenders (braces), belts for clothing, slippers, wristbands" under class 25. The goods covered by the Opposer's trademark registrations include Class 12, same as the Respondent-Applicant's trademark application for "motorcycle parts namely: handle grips, brake disc, brake linings, amplified horns, drive chains, gears, brakes shoes, drive shafts, handle bars, license plate frames R& holders, luggage console, kickstands, kick start handles, mudguards, radiator shrouds, brake hose & cables, clutch cables, fork, fork dust boots & seal control lever or throttle handles, brake calipers, shocks, front dash panels & gauges, brake master assemblies, rims, mag wheels, clutch assemblies, headlight mounts, tire inner tubes, body cover & motorcycle parts & accessories".

The question is: do the competing marks closely resemble each other such that confusion or mistake is likely to occur?

The competing marks are reproduced below:

Opposer's mark

Respondent-Applicant's mark

D.I.D



Both marks consist of three letters, the first and last, is the letter "D". Although Respondent-Applicant's mark, "D.T.D" is encased in an oblong device, both marks predominantly use capital letters in block style which catches the eye of the buyer. The similarity is more apparent when examining the actual packages of both parties side by side, because the letters D-I-D and D-T-D, look almost the same. The middle letters "I" and "T" when compared, look similar, considering further that the Respondent-Applicant, like the Opposer, also uses a period, ".", after the letters, "D" and "T". Surprisingly, the Respondent-Applicant does not use a period after the last letter "D" in the actual packaging¹⁰, which is also how the Opposer's mark is depicted in its actual packaging¹¹ and in its earlier registrations¹². Visually and aurally, therefore, the marks are confusingly similar.

Succinctly, the public interest, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. The confusion or 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

¹⁰ Annex "1"

¹¹ Exhibit "E"

¹² Exhibit "A-2"; "A-3"

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.¹³

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-007382 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **07 NOV 2016**



Atty. ADORACION U. ZARE, LL.M.
Adjudication Officer
Bureau of Legal Affairs

¹³*Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.