



**UNI-LINE MULTI-RESOURCES
INC. (PHILS.),**

Opposer,

-versus-

YAO HUANG CAI,

Respondent-Applicant.

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IPC NO. 14-2008-00029

Case Filed: 11 Feb. 2008

Opposition to:

Appln. Serial No. 4-2006-007729

Date Filed: 17 July 2007

Trademark: SAKURA

Decision No. 09-143

DECISION

For decision is the Opposition filed by Uni-Line Multi-Resources Inc., (the "Opposer") against Application Serial No. 4-2006-007729 filed by Yao Huang Cai (the "Respondent-Applicant") on 17 July 2007 for the registration of the mark SAKURA covering goods in class 08 specifically for cutlery (other than surgical); knives, forks and spoons; hand implements for kitchen use, upon the ground that the mark SAKURA is identical with and/or confusingly similar with its registered trademarks SAKURA and SAKURA & FLOWER DESIGN.

Opposer, UNI-LINE MULTI-RESOURCES, INC. (PHILS.) (hereafter, the "Opposer") is a Philippine corporation with principal place of of business at MO3 Prince Juan Condominium, No. 42 Timog Avenue, Quezon City.

Respondent-Applicant, YAO HUANG CAI, a Chinese citizen, has its business address in the Philippines at R-602 Pince Tower Numancia Street, Binondo, Manila.

On 11 February 2008, Opposer filed the instant Opposition against Respondent-Applicant's Application for registration of the mark SAKURA for goods under Class 08.

Grounds for Opposition

Opposer filed the instant Opposition and alleged as follows:

1. "The approval of the application in question is contrary to Sections 123.1 (d) and 138 of Republic Act No. 8293;

2. "As registered owner of the trademarks SAKURA and SAKURA & FLOWER DESIGN, the approval of the application in question will violate its right to the exclusive use of said registered trademarks SAKURA and SAKURA & FLOWER DESIGN and the extension of their use to other goods;

3. "The approval of the application in question has caused and will continue to cause great and irreparable damage and injury to herein Opposer;

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4. "Respondent-Applicant is not entitled to register the trademark SAKURA in his favor.

Opposer relied on the following facts to support their opposition:

5. "The trademark SAKURA is duly registered in favor of Opposer under Registration No. 4-2002-004572 effective March 18, 2006 for the following goods, namely: washing machines, high pressure washers, vacuum cleaners, floor polishers, blender, electric mixer, electrical juicer. Television sets, stereo components, DVD/VCD players, voltage regulators, portable generators, switch breakers, fuse. Refrigerators, air conditioners, oven toaster, turbo broiler, rice cooker, microwave oven, coffee maker, sandwich/waffle maker, electric stove, electric fan, hot and cold water dispenser, airpot, electric griller and electric hot pot, falling under Classes 7, 9 and 11.

Registration No. 4-2002-004572 was issued in favor of Opposer after its Application Serial No. 4-2002-004572 was found allowable under the provisions of the IP Code and its implementing Rules and Regulations, and is now in full force and effect.

A certified copy of Certificate of Registration No. 4-2002-004572 is hereto attached as Exhibit "A" and made an integral part hereof.

Registration No. 4-2002-004572 continues to be in full force and effect.

6. "The trademark SAKURA & FLOWER DESIGN is also duly registered in favor of Opposer under Registration No. 4-2000-003083 effective March 20, 2005 for use on recordable compact disc (CD-R), computer, computer parts and accessories falling under Class 9.

Registration No 4-2000-003083 was issued in favor of Opposer after its Application Serial No. 4-2000-003083 filed on April 14, 2000 was found allowable under the provisions of the IP Code and its Implementing Rules and Regulations, and is now in full force and effect.

A certified copy of Certificate of Registration No. 4-2000-003083 is hereto attached as Exhibit "B" and made an integral part hereof.

Registration No. 4-2000-003083 continues to be in full force and effect.

7. "Opposer has not abandoned the use of the trademarks SAKURA and SAKURA & FLOWER DESIGN. On the contrary, Opposer has continued their use up to the present not only on goods listed in Exhibits "A" and "B", but is has also extended their use on other related goods.

Thus, Opposer has filed the following applications for the registration of the trademarks SAKURA and SAKURA & FLOWER DESIGN, namely:



- a) Application Serial No. 4-2006-001378 for the trademark SAKURA & FLOWER DESIGN filed on February 7, 2006.

A photocopy of the duplicate original of Application Serial No. 4-2006-001378 is marked as Exhibit "c" and made an integral part thereof.

- b) Application Serial No. 4-2007-009013 for the trademark SAKURA & DEVICE filed on August 21, 2007.

A photocopy of the duplicate original of Application Serial No. 4-2007-009013 is marked as Exhibit "D" and made an integral part thereof.

- c) Application Serial No. 4-2007-009014 for the trademark SAKURA & DEVICE filed on August 21, 2007.

A photocopy of the duplicate original of Application Serial No. 4-2007-009014 is marked as Exhibit "E" and made an integral part thereof.

- d) Application Serial No. 4-2007-009015 for the trademark SAKURA & DEVICE filed on August 21, 2007.

A photocopy of the duplicate original of Application Serial No. 4-2007-009015 is marked as Exhibit "F" and made an integral part thereof.

- e) Application Serial No. 4-2007-009016 for the trademark SAKURA & DEVICE filed on August 21, 2007.

A photocopy of the duplicate original of Application Serial No. 4-2007-009015 is marked as Exhibit "G" and made an integral part thereof.

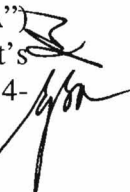
The duplicate original copies of Exhibits "C", "D", "E", "F" and "G" will be presented for comparison during the preliminary conference.

Representative labels/photographs of Opposer's goods bearing its trademarks SAKURA and SAKURA & FLOWER DESIGN, including representative commercial invoices evidencing such use, are attached as Exhibits "H" to "H-7" and made integral parts hereof.

8. "The trademark SAKURA being applied for registration by Respondent-Applicant is identical to the trademarks SAKURA and SAKURA & FLOWER DESIGN owned by Opposer and duly registered in its favor.

A print-out of Respondent-Applicant's mark as published, is hereto attached as Exhibit "I", and made an integral part hereof.

9. "The goods covered by Respondent-Applicant's application are closely related to the goods covered by Opposer's Registration No. 4-2002-004572 (Exhibit "A") and Registration No. 4-2000-003083 (Exhibit "B") as well as, Respondent-Applicant's Applications Serial No. 4-2006-001378, No. 4-2007-009013, No. 4-2007-009014, No. 4-2007-009015, and No. 4-2007-009016 (Exhibits "C", "D", "E", "F", and "G").



10. "Accordingly, the approval of the application in question is contrary to Section 123.1 (d) of Republic Act No. 8293, which provides:

"Section 123. Registrability. – 123.1. A mark cannot be registered if it :

xxx

- (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;"

11. "The approval of the application in question is violative of the right of Opposer to the exclusive use of its registered trademarks SAKURA and SAKURA & FLOWER DESIGN on goods listed in the registration certificates issued to it and the right to extend the use thereof to other related goods.

SECTION 138 of the IP Code provides:

"Section 138. Certificates of Registration. – A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate."

12. "Not being entitled to the registration of the mark SAKURA in his favor, the approval of the application in question has caused and will continue to cause great and irreparable damage and injury to Opposer.

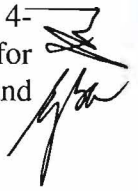
Attached herewith are four (4) labels showing how the trademarks SAKURA and SAKURA & FLOWER DESIGN are actually being used by Opposer and a check for P 8,686.00 for filing fee, legal research, and processing and hearing fees.

The Notice to Answer dated 03 March 2008 directed Respondent-Applicant to file her Verified Answer. For failure of Respondent to file the required Answer within the 30-day period, this Bureau issued Order No. 2009-984 which considered the instant case submitted for decision based on the Opposition, affidavits of the witnesses and documentary evidence submitted by the Opposer, pursuant to Section 11 of the amended Rules on Inter Partes Proceedings.

Filed as evidence for the Opposer, based on the records, are the following:

1. *A certified copy of Opposer's Certificate of Registration No. 4-2002-004572 for the trademark SAKURA issued on March 18, 2006* - Exhibit "A"
2. *A certified copy of Opposer's Certificate of Registration No. 4-2000-003083 for the trademark SAKURA & FLOWER DESIGN issued on March 20, 2005* - Exhibit "B"
3. *A photocopy of the duplicate original of Application Serial No. 4-2006-001378 for the trademark SAKURA & FLOWER DESIGN filed on February 7, 2006* - Exhibit "C"
4. *A photocopy of the duplicate original of Application Serial No. 4-2007-009024 for the trademark SAKURA & DEVICE filed on August 21, 2007* - Exhibit "D"
5. *A photocopy of the duplicate original of Application Serial No. 4-2007-009014 for the trademark SAKURA & DEVICE filed on August 21, 2007* - Exhibit "E"
6. *A photocopy of the duplicate original of Application Serial No. 4-2007-009015 for the trademark SAKURA & DEVICE filed on August 21, 2007* - Exhibit "F"
7. *A photocopy of the duplicate original of Application Serial No. 4-2007-009016 for the trademark SAKURA & DEVICE filed on August 21, 2007* - Exhibit "G"
8. *Representative labels/photographs of Opposer's goods bearing its trademarks SAKURA and SAKURA & FLOWER DESIGN, including representative commercial invoices* - Exhibits "H" to "H-7"
9. *Print-out of Respondent-Applicant's mark SAKURA as published in the e-Gazette last October 19, 2007* - Exhibit "I"
10. *Duly notarized affidavit of Enrique Y. Co* - Exhibit "J"

The issue for this Bureau's resolution is the propriety of Application Serial No. 4-2006-007729; whether or not Respondent-Applicant's trademark application for SAKURA for use on cutlery (other than surgical); knives, forks and spoons; hand implements for kitchen use under Class 08 should be granted registration.



A cursory reading of paragraph (d) of R.A. 8293 with emphasis on prior registration and/or application of the same mark involving same or similar goods/services provides that :

“Section 123. Registrability. – 123.1. A mark cannot be registered if it :

xxx

- (e) *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;”*

xxx

The preceding section provides that it is the owner of a registered mark or an owner of a mark with an earlier filing date or priority date that can oppose an application for registration of another mark involving the same or related goods or services. The purpose of the Trademark Law is to provide protection not only to the owner of the trademark or proprietor of a mark with an earlier filing or priority date in exact adherence to the First-to-First Rule as one important factor of registrability under R.A. 8293 , likewise, and more importantly, to the unwary public that they may not be confused, mistaken or deceived by goods they buy or services they avail.

On the basis of the evidence presented, there is shown clear and convincing proofs that the two (2) competing trademarks, SAKURA marks of Opposer and Respondent-Applicant’s SAKURA are similar, in fact obviously identical, in almost all of their essential or prevalent features. Both marks are printed in horizontal form using bold and upper case letters. Opposer has other variations of the same trademark SAKURA with a device or flower design, some of which Opposer were able to obtain registration dating back as in the year 2000.

Below is a side-by-side comparison between Opposer's SAKURA trademark and Respondent-Applicant’s SAKURA mark, subject of this instant suit and/or opposition. Quite evident is the font used using bold letters and in horizontal form. Applicant copied the style of Opposer in printing the word SAKURA, thus :

SAKURA SAKURA

Opposer’s SAKURA trademark

Respondent-Applicant’s SAKURA mark

Hence, comparing both marks in plain view there certainly is obvious, if not perfect similarity. Anyone is likely to be misled by the adoption of the same SAKURA mark, which is known and identified to be Opposer's labels for different classes of goods under Classes 07, 09, 07 and 11.

The court observed in the case of Philippine Refining Co, Inc., vs. Dir. of Patents and Sparklets Corp. vs. Walter Kidde Sales Co., 104 F. 2d 396, that " a trademark is designed to identify the user. But it should be so distinctive and **sufficiently original** as to enable those who come into contact with it to recognize instantly the identity of the user. It must be affirmative and definite, significant and distinctive, capable to indicate the origin. Likewise, our trademark law does not require identity, confusion is likely if the resemblance is so close between two trademarks. Bolstering this observation is the pronouncement by the court in the case of Forbes, Munn & Co. (Ltd.) vs. Ang San To, 40 Phil. 272, 275 where it stated that *the test was similarity or "resemblance between the two (trademarks) such as would be likely to cause the one mark to be mistaken for the other. . . . [But] this is not such similitude as amounts to identity."* On the contrary, as happened in this case, there was no similitude but an exact replica of SAKURA trademark that was applied.

Having shown and proven resemblance of the two marks at issue, we now delve on the matter of priority in use and registration which certainly has decisive effect in the adjudication of the case. From evidence on record, Opposer is the registered owner in the Philippines of the SAKURA marks, as follows:

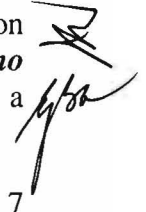
Trademark	Registration Number	Nice Classification
SAKURA & FLOWER DESIGN	42000003083	09
SAKURA	42002004572	09, 11 and 07

Opposer is also the applicant of the following pending trademark applications:

Trademark	Application Number	Nice Classification
SAKURA & FLOWER DESIGN	4-2006-001378	09
SAKURA & DEVICE	4-2007-009013	07
SAKURA & DEVICE	4-2007-009014	09
SAKURA & DEVICE	4-2007-009016	11

Opposer's mark, SAKURA & FLOWER DESIGN, was registered with the Intellectual Property Office and applied as early as 14 April 2000 for goods under Class 09 (*Exhibit "B", Opposer*). As held in the case of Unno Commercial Enterprises, Inc. vs. General Milling Corporation "*prior use by one will controvert a claim of legal appropriation by subsequent users*". Hence, it may be concluded inevitably that Respondent-Applicant's use of identical mark on the same or related goods will result in an unlawful appropriation of mark previously used by Opposer and not abandoned.

The right to register trademarks, trade names and service marks is based on ownership. Only the owner of the mark may apply for its registration (*Bert R. Bagano v. Director of Patents, et. al.*, G.R. No. L-20170, August 10, 1965). And where a



trademark application is opposed, Respondent-Applicant has the burden of proving ownership (*Marvex Commercial Co., Inc. v. Peter Hawpia and Co.*, 18 SCRA 1178). In the instant case, Opposer Uni-Line Multi Resources, Inc. (Phils.) on 14 April 2000 filed with the Intellectual Property Office an application for the registration of the mark SAKURA & FLOWER DESIGN for goods under Class 09 on 14 April 2000 and of the mark SAKURA on goods falling under Classes 09, 11 and 07 on 06 June 2002. Respondent-Applicant filed her application for registration of the mark SAKURA on 17 July 2006 which is more than six (6) years after Opposer filed their application for the trademark SAKURA. As it now stands, we may safely deduce that it is the Opposer, not the Respondent-Applicant, who can claim priority of an earlier filing date or registration date pursuant to Section 123 of R.A. 8293.

Having thoroughly discussed and resolved issues on confusion and priority in use and application, we shall now be delving on the goods involved. The goods involved in both competing marks are related. Specifically, Respondent-Applicant's goods under Application Serial No. 4-2006-007729 cover the following:

cutlery (other than surgical); knives, forks and spoons; hand implements for kitchen (Class 08).

While, Opposer's products under Classes 07 and 11 include the following:

07	<i>Washing Machines, High Pressure Washers, Vacuum Cleaners, Floor Polishers, Blender, Electric Mixer, Electrical Juicer</i>
11	<i>Refrigerators, Air-Conditioners, Oven Toaster, Turbo Broiler, Rice Cooker, Microwave Oven, Coffee Maker, Sandwich/Waffle Maker, Electric Stove, Electric Fan, Hot & cold Water Dispenser, Airpot, Electric Griller and Electric Hot Pots</i>

Obviously, they are the same household items. Confusion is likely and/or inevitable when identical or substantially similar marks are applied on same or related goods. It is expected that they will be sold commercially in the same market and have the same or common purchasers. Concomitantly the goods flow through the same channels of trade.

By appropriating a word which is identical or closely resembles that of Opposer, this Bureau holds that indeed there was a deliberate intent by Respondent-Applicant to ride on the goodwill and popularity of the mark of the Opposer.

In the case of *American Wire & Cable Co. vs. Director of Patents*, 31 SCRA 544, it was observed that:

"Why of the million of terms and combination of letters and designs available the appellee had to choose a mark so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark"

As the rightful owner of the trademark SAKURA, Opposer should be given protection against entities that merely wish to take advantage of the goodwill its SAKURA marks have generated.

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby **SUSTAINED**. Consequently, Application bearing Serial No. 4-2006-007729 filed by Yao Huang Cai on 17 July 2006 for the registration of the mark SAKURA for use on cutlery (other than surgical); knives, forks and spoons; hand implements for kitchen use under Class 08 is, as it is hereby, **REJECTED**.

Let the filewrapper of SAKURA, subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Makati City, 13 November 2009.



ESTRELLITA BELTRAN-ABELARDO

Director