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<b>WANG RENGJIN,</b>	}	<b>IPC No. 14-2008-00209</b>
Opposer,	}	Opposition to:
	}	Appl. Serial No. 4-2005-005149
	}	Date filed: 03 June 2005
<b>-versus-</b>	}	<b>TM: "CATA and Device"</b>
	}	
	}	
<b>CATA ELECTRODOMESTICOS, SL.,</b>	}	
Respondent-Applicant.	}	
X-----X	}	

**NOTICE OF DECISION**

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ORTEGA, DEL CASTILLO  
BACCORO, ODULIO  
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**GREETINGS:**

Please be informed that Decision No. 2010 - 27 dated 15 June 2010 (copy enclosed) was promulgated in the above entitled case.

Makati City, 15 June 2010.

For the Director:



**ATTY. PAUL U. SAPAK**  
Hearing Officer, BLA



**WANG RENGJIN,**  
*Opposer,*

-versus-

**CATA ELECTRODOMESTICOS S.L.,**  
*Respondent-Applicant*

X-----X

**Inter Partes Case No. 14-2008-00209**

Case Filed : 11 September 2008

Opposition to:

Appl'n Serial No.. : 04-2005-005149

Date Filed : 03 June 2005

Trademark : "CATA and Device"

**Decision No. 2010- 27**

### DECISION

**WANG RENGJIN** ("Opposer"), a Chinese citizen, of legal age, and presently residing at Room 304, Maxim Building, No. 805 Masangkay Street, Binondo, Manila, filed on 11 September 2008, an opposition to Trademark Application No. 4-2005-005149<sup>1</sup>. The application, filed by **CATA ELECTRODOMESTICOS S.L.** ("Respondent-Applicant") of Angel Guimera 16, 08570 Torello (Barcelona) Espana, covers the mark "**CATA and Device**" for use on goods falling under class 11 of the International Classification<sup>2</sup> of goods namely "*apparatus for heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes*".

The Opposer alleges the following:

- "1. The approval of the application in question is contrary to Section 123.1 (d) and 138 of Republic Act No. 8293 (IP Code);
- "2. As registered owner of the trademarks **CATA**, **CATA Stylized Wordmark** and **Stylized CATA**, the approval of the application in question will violate Opposer's right to the exclusive use of his registered trademarks and the extension thereof to other related goods falling under Class 11, and cause him great and irreparable damage and injury.

Opposer will rely on the following facts x x x ....:

- "1. Opposer is the registered owner of the trademark **CATA** under Registration No. 4-2002-003413 issued on April 16, 2004 for the use on light bulb falling under Class 11.

Registration No. 4-2002-003413 continues to be in full force and effect.

<sup>1</sup> Application was published in the Intellectual Property Philippines (IPP) E-Gazette, officially released on 18 July 2008.

<sup>2</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

A certified copy of the Certificate of Registration No. 4-2002-003413 is hereto attached as Exhibit **A** and made an integral part hereof.

- "2. The trademark **CATA Stylized Wordmark** is duly registered in favor of Opposer under Registration No. 4-2002-004253 for use on fluorescent lamps, emergency lamps and other kinds of light bulbs for the houses, offices and motor vehicles falling under Class 11.

Registration No. 4-2002-004253 continues to be in full force and effect.

A certified copy of Registration No. 4-2002-004253 is hereto attached as Exhibit **B** and made an integral part hereof.

- "3. The trademark **Stylized CATA** is also registered in favor of Opposer under Registration No. 4-2005-003145 for use on electric bulb, white lamp, electric light socket, lighting appliance and installment, street lamp, fluorescent tube, water heater, refrigerator, air conditioner, drinking bowl falling under Class 11.

Registration No. 4-2005-003145 continues to be in full force and effect.

A certified copy of Certificate of Registration No. 4-2005-003145 is hereto attached as Exhibit **C** and made an integral part hereof.

- "4. Opposer has used and continues to use his registered trademarks **CATA**, **CATA Stylized Wordmark** and **Stylized CATA**. Submitted herewith as Exhibits **D** and **D-1** are the various Declaration of Actual Use submitted by Opposer in connection with Registration No. 4-2002-004253 (**Exhibit B**); and No. 4-2005-003145 (**Exhibit C**), and made an integral part hereof.

Likewise submitted herewith as Exhibits **E** to **E-6** and made an integral part hereof, are sales invoices of Opposer's company showing sales of products bearing the trademarks **CATA**".

The original certified copies of Exhibits **A**, **B** and **C** and the duplicate originals of Exhibits **D** and **D-1**, and **E** to **E-6**, will be presented for comparison during the preliminary conference.

- "5. The dominant feature of the trademark **CATA** and Device being applied for registration by Respondent-Applicant under Application Serial No. 4-2005-005149, namely, the word **cata**, is identical to Opposer's registered trademark **CATA** and the dominant feature of his two other existing registrations of the mark **CATA**.

A print-out of Respondent-Applicant's mark **CATA and Device** as published in the e-Gazette is marked as Exhibit **F** and made an integral part hereof.

- "6. In addition, the goods covered by Respondent-Applicant's application are identical to and/or related to, the goods covered by Opposer's Registration No. 4-2002-003413 (**Exhibit A**); No. 4-2002-004253 (**Exhibit B**); and No. 4-2005-003145 (**Exhibit C**). The goods of both parties fall under Class 11. Thus, confusion, mistake and/or deception as to the origin/source of Respondent-Applicant's goods is likely.



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

Sec. 123. *Registrability* - 123.1. *A mark cannot be registered if it:*

x x x

“(d) Is identical with a registered mark belonging to a different proprietor or 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;

“7. The approval of the application in question violates the right of Opposer to the exclusive use of his registered trademarks **CATA** on goods listed in his certificates of registration and those related to them.

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.** (Emphasis supplied)

“8. The approval of the application in question has caused and will continue to cause great and irreparable damage and injury to Opposer as the consuming public will likely assume that Respondent-Applicant's goods come from, and/or authorized or licensed by Opposer. In addition, it will curtail Opposer's right to extend the use of her registered marks **CATA** to other goods falling under Class 11.

Attached herewith are four (4) labels showing how the trademarks **CATA** are actually being used by Opposer.

The Opposer's evidence consists of the following:

1. Exhibit “A” - Certified copy of Opposer's Certificate of Registration No. 4-2002-003413 issued on 16 April 2004 for the mark **CATA**;
2. Exhibit “B” - Certified copy of Opposer's Certificate of Registration No. 4-2002-004253, issued on 6 November 2006 for the mark **CATA Stylized Wordmark**;

3. Exhibit "C" - Certified copy of Opposer's Certificate of Registration No. 4-2005-003145 issued on 21 February 2007 for the mark **Stylized CATA**;
4. Exhibits "D" and "D-1" - Certified copy and duplicate original of the Declaration of Actual Use submitted by Opposer last 23 August 2004 and 19 March 2008, respectively, in connection with Application Serial No. 4-2002-004253 and NO. 4-2005-003145;
5. Exhibits "E" to "E-6" - Representative sales invoices of Opposer's company showing the sales of products bearing the trademark **CATA**;
6. Exhibit "F" - Print-out of Respondent-Applicant's mark **CATA and Device** as published in the Intellectual Property Office of the Philippines E-Gazette las 16 July 2008; and
7. Exhibit "G" - Duly notarized Affidavit of Opposer **WANG RENGJIN**.

In spite of the orders, and the grant of requests for extension of periods, to file answer, the Respondent-Applicant failed to do so. Hence, Rule 2, Section 11 of the Regulations on Inter Partes Proceedings, as amended, provides:

Section 11. *Effect of failure to file an Answer.* - In case the Respondent-Applicant fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the Petition or Opposition, the affidavit of the witnesses and documentary evidence submitted by the Petitioner or Opposer.

Should the Respondent-Applicant be allowed to register the mark **CATA**?

It is emphasized, that the essence of trademark registration is to give protection to the owners of the 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 products.<sup>3</sup>

Thus, Sec. 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), states that a mark shall not be registered if it:

- "(d) Is identical with a registered mark belonging to a different proprietor or 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;

<sup>3</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Etepha v. Dir. Of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), of the Trade Related Aspect of Intellectual Property (Trips Agreement).

The competing trademarks are reproduced below for comparison and scrutiny:



Reg. No. 4-2002-003413    Reg. No. 4-2002-004253    Reg. No. 4-2005-003145  
*Opposer's marks*



Respondent-Applicant's mark

The marks are obviously identical, visually and aurally. The font styles and the device in the Respondent-Applicant's mark are there for ornamental or aesthetic purpose only, and which fail to confer character on the marks that would intelligently distinguish one from the other.

In this regard, the Respondent-Applicant's mark cover goods under Class 11: "*apparatus for heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes*". The Opposer's registered trademarks, on the other hand, are used on fluorescent lamps and other kinds of light bulbs for house and motor vehicle, electric bulbs, white lamps, electric light socket, lighting appliances and installment, street lamps, fluorescent tube, water heater, refrigerator, air conditioner and drinking bowl.

The Respondent-Applicant's mark, thus, will be used on goods which are similar and closely related to the goods covered by the Opposer's registered marks. Thus, it is likely that the consumers will be confused or deceived. It is possible that there will not only be confusion of goods, but also as to the origin thereof. The consumers may assume that there is some association or connection between the parties, when actually there is none.

Accordingly, considering that at the time the Respondent-Applicant filed its application on 03 June 2005, there are already existing trademark registration issued to or application filed by the Opposer for the mark **CATA**, the Respondent-Applicant's application is proscribed by Sec. 123.1 (d) of the IP Code.

The Respondent-Applicant was given a chance or opportunity to explain or to air its side on the issue. However, it chose not to and did not file an answer nor submit evidence.



**WHEREFORE**, premises considered, as it is hereby **SUSTAINED**. Let the filewrapper of the trademark Application No. 4-2005-005149 subject matter of this case together with a copy of this **DECISION** be returned to the Bureau of Trademarks (BOT) for appropriate action.

**SO ORDERED.**

Makati City, 15 June 2010.



**Atty. NATHANIEL S. AREVALO**  
*Director*  
Bureau of legal Affairs

PUS//jojo  
/18-Jan-10

