

AMERICAN STANDARD INC.,)	INTER PARTES CASE NO. 3389
Opposer,)	
)	OPPOSITION TO:
)	
)	Application Serial No. 59377
)	Filed : July 15, 1986
)	Applicant : Ramon Young
- versus -)	Trademark : STANDARD
)	Used on : Sewing machines
)	
)	DECISION NO. 94-41 (TM)
)	
RAMON YOUNG,)	November 14, 1994
Respondent-Applicant.)	
x-----x)	

DECISION

This pertains to an opposition filed by American Standard, a corporation duly organized under the laws of the State of New York, U.S.A., with principal office at 40 West 40th Street, New York City against the application for the registration of the trademark "STANDARD" for sewing machines filed on July 15, 1986 under Serial No. 59377 in the name of RAMON YOUNG which was published on page 17, Volume 11, No. 4, April 28, 1989 issue of the Official Gazette, officially released for circulation on May 3, 1989.

The grounds for the opposition to the registration of the mark are as follows:

1. The trademark "STANDARD" is an exact copy of Opposer's trademark "STANDARD", which has been previously used in commerce in the Philippines and other parts of the world and not abandoned, and is likely, when applied to or used in connection with the goods of Applicant, to cause confusion, mistake and deception on the part of the purchasing public.
2. The registration of the trademark "STANDARD" in the name of the Applicant will violate Section 37 of Republic Act No. 166, as amended, and Section 6bis and other provisions of the Paris Convention for the Protection of Industrial Property to which the Philippines and the United States of America are parties.
3. The registration and use by Applicant of the trademark "STANDARD" will diminish the distinctiveness and dilute the goodwill of Opposer's trademark "STANDARD".
4. The registration of the trademark "STANDARD" in the name of the Applicant is contrary to other provisions of the Trademark Law.

To support this opposition, Opposer will rely upon, among other facts, the following:

1. Opposer is a manufacturer of a wide-range of Chinaware products, including goods bearing the trademark "STANDARD" which have been marketed and sold in the Philippines and in other parts of the world. Opposer has been commercially using the trademark "STANDARD" internationally and in the Philippines prior to the use of "STANDARD" by Applicant.

2. Opposer is the owner of the trademark "STANDARD" which was registered with the Bureau of Patents, Trademarks & Technology Transfer under Registration Certificate No. R-1890 for bathroom equipment and No. 353 for metal bathtubs, among others. "STANDARD" is also registered and is used as a trademark for the same products in the United States of America and in other countries.

3. Opposer is the first user of the trademark "STANDARD" on the goods included under the above-described registration which have been sold and marketed in various countries worldwide, including the Philippines.

4. By virtue of Opposer's prior and continued use of "STANDARD" in the Philippines and other parts of the world, said trademark has become popular and internationally well-known and has established valuable goodwill for Opposer among consumers who have identified Opposer as the source of the goods bearing said trademark

5. The registration and use of a copy of a confusingly similar trademark by the Applicant for use on his goods will tend to deceive and/or confuse purchasers into believing that Applicant's products emanate from or are under the sponsorship of Opposer. Applicant obviously intends to trade, and is trading on, Opposer's goodwill.

6. The registration and use of a confusingly similar trademark by Applicant will diminish the distinctiveness and dilute the goodwill of Opposer's trademarks.

The main issue to be resolved in this case is:

Whether or not Respondent-Applicant's trademark "STANDARD" is confusingly similar to Opposer's trademark "STANDARD".

Our Trademark Law, particularly Section 4(d) thereof provides as follows:

"Sec. 4. Registration of trademarks, tradenames and service marks on the principal register. There is hereby established a register of trademarks, tradenames and service marks which shall be known as the principal register. the owner of a trademark, tradename or service mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register unless it:

x x x

(d) Consists of or comprises a mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or service of the applicant, to cause confusion or mistake or to deceive purchasers".

On July 3, 1989, Opposer American Standard filed its verified and authenticated Notice of Opposition thereby this Office issued a Notice to Answer requiring the Respondent Mr. RAMON YOUNG to file his Answer within fifteen (15) days after the receipt of said Notice.

On April 10, 1990, Respondent-Applicant filed an Ex-Parte Motion for Extension of Time to File Answer for a period of thirty (30) days from April 17, 1990 which was granted by this Office (ORDER NO. 90-232) dated April 19, 1990.

On June 20, 1990, Opposer through Counsel filed a Motion to declare Respondent-Applicant in Default for failure to file the required Answer which was likewise granted (ORDER NO. 90-448) dated August 24, 1990.

Pursuant to the Order of Default, Opposer presented its evidence Ex-Parte consisting of Exhibits "A" to "D" and their corresponding submarkings.

In view of the defendant's failure to contest Opposer's allegations were supported by documentary evidence, we are constrained to accept as true Opposer's claim that Opposer's trademark is well known throughout the world, including the Philippines having been registered with the Bureau of Patents, Trademarks and Technology Transfer such as the following:

MARK	REGN. NO.	ISSUED
Standard	R-1890	July 21, 1973
American Standard	R-1174	July 13, 1973
Philippine Standard	19476	July 10, 1973

It is also established that subject trademark is also the tradename of the Opposer and such being the case, it is protected against appropriation by unauthorized users not only under Article 6bis of the Paris Convention but also under Section 37(e) of the Trademark Law, which provides:

x x x

(e) A mark duly registered in the country of origin of the foreign applicant may be registered on the principal register if eligible, otherwise on the supplemental register herein provided. The application thereof shall be accompanied by a certified copy of the application for or registration in the country of origin of the applicant.

The registration of a mark under the provisions of this section shall be independent of the registration in the country of origin and the duration, validity or transfer in the Philippines of such registration shall be governed by the provisions of this Act.

In Ang vs. Teodoro, 74 Phil. 50, the Supreme Court has ruled that:

"xxx The Courts have come to realize that there can be unfair competition or unfair trading even of the goods are non-competing, and that such unfair trading can cause injury or damage to the first user of a given trademark, first, by prevention of the natural expansion of his business reputation confused with and put at the mercy of the second user. When non-competitive products are sold under the same mark, the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark created by its first user, inevitably results xxx Experience has demonstrated that when a well-known trademark even for a totally different class of goods, it is done to get the benefit of the reputation and advertisements of the originator of said mark, to convey to the public a false impression of same supposed connection between the manufacturer of the article sold under the original mark and the new articles being tendered to the public under the same or similar mark. xxx The owner of a trademark or tradename has a property right in which there is damage to him, from confusion of reputation or goodwill in the mind of the public as well as from confusion of goods. The modern trend is to give emphasis to the unfairness of the acts and to classify and treat the issue as a fraud."

WHEREFORE, premises considered the opposition to the registration of the trademark "STANDARD" is hereby GRANTED. Accordingly, trademark Application Serial No. 59377 for the trademark "STANDARD" filed on July 15, 1986 by RAMON YOUNG is hereby REJECTED.

Let the filewrapper of this case be forwarded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision. Likewise, let a copy of this Decision be furnished the Trademark Examining Division for information and to update its record.

SO ORDERED.

IGNACIO S. SAPALO
Director