

PROCTER & GAMBLE PHILS., INC.)	INTER PARTES CASE NO. 3340
Opposer,)	
)	OPPOSITION TO:
)	
)	Application Serial No. 64054
)	Filed : March 3, 1987
)	Applicant : Jimmy Ching
)	Trademark : SUNSHINE
- versus -)	Used on : Cooking oil
)	
)	<u>DECISION NO. 91-19 (TM)</u>
JIMMY CHING,)	
Respondent-Applicant.))	November 29, 1991
x-----x)	

DECISION

On February 27, 1989 Procter and Gamble Philippines, Inc. filed a Notice of Opposition against the registration of the trademark SUNSHINE and DEVICE used on cooking oil applied for by Jimmy Ching on March 03, 1987 under Application Serial No. 64054, published on Page 32, Vol. II, No. 1 of the BPTTT Official Gazette, which was released for circulation on January 30, 1989.

Opposer is a corporation duly organized and existing under the laws of the Philippines with principal office located at No. 777 Solid Bank Building, Paseo de Roxas, Makati, Metro Manila; while Respondent-Applicant is a Filipino citizen doing business at No. 25-A Duhat Road, Portero, Malabon, Metro Manila.

The grounds alleged by Opposer in its opposition are as follows:

"1. The opposer is the owner of the trademark SUNSHINE for margarine which was originally registered on June 24, 1948 under Reg. No. 424 and renewed on June 24, 1968 under Reg. No. R-732. The said mark was initially used in the Philippines on June 21, 1922 and show commercial use in the same year.

"2. The trademark SUNSHINE sought to be registered by respondent-applicant is identical to the unabandoned mark of the opposer such that the use of the respondent-applicant's subject mark on its good or products will cause confusion or mistake in the minds of the public, or will deceive purchasers thereof such that the public may be led to believe that the product of respondent-applicant bearing the subject mark are those of opposer originated from or related with the opposer therein.

"3. The trademark SUNSHINE is, and ever since its adoption has been, continuously applied to products of opposer, to the package and containers of said products and the labels affixed to said packages and containers. The trademark SUNSHINE has come to be and is now popularly known throughout the Philippines such that opposer's products bearing the mark SUNSHINE has become identified as coming from opposer herein. Hence, the tremendous goodwill established by the mark SUNSHINE nurtured through its long use, the superior is an invaluable asset of the opposer which must be protected from trademark poachers like respondent-applicant herein.

"4. The opposer herein believes that the registration of the mark SUNSHINE in the name of the respondent-applicant will cause great irreparable injury and

damage to herein opposer pursuant to Section 8 of Republic Act 166, as amended.

Opposer relied on the following facts to support its opposition:

“a) That the mark SUNSHINE of the respondent-applicant is identical to opposer’s trademark SUNSHINE. A visual comparison of the respective marks of the parties hereto will readily support the likelihood of confusion not only as to the mark themselves but also as to their source. Further, it is apparent that the mark SUNSHINE is an imitation of opposer’s mark SUNSHINE calculated to ride on or cash-in on the popularity of the opposer’s mark SUNSHINE.

“b) That the registration of the mark SUNSHINE in the name of respondent-applicant will only serve to dilute the advertising value of opposer’s SUNSHINE which is notoriously well-known throughout the Philippines.

“c) That the opposer’s SUNSHINE which as been continuously in use in the Philippines since and until the present has already acquired a considerable amount of goodwill long before the application for registration of the mark SUNSHINE was filed by respondent-applicant.

“d) That the mark applied for registration with the Bureau of Patents, Trademarks & Technology Transfer by the respondent-applicant is used on goods closely related to those of opposer’s mark SUNSHINE.

In his Answer, Respondent-Applicant specifically denied all allegations in Opposer’s Notice of Opposition and argued that there is dissimilarity of the two trademarks; that the trademarks are used on different classes of goods and that there was abandonment of trademark SUNSHINE by the Opposer. The issues having been joined, pre-trial of the case was set and was subsequently terminated upon failure of the parties to amicably settle the case.

On August 31, 1989, Opposer submitted the sworn statement of its witness, Atty. Edmundo Imperial, including its annexes. Respondent-Applicant, unaccompanied by his lawyer, received a copy of the Sworn Statement with annexes. Hearing was then reset to October 03, 1989 for the cross-examination of the Opposer’s witness.

On October 03, 1989 Respondent-Applicant was again unaccompanied by his lawyer, Opposer moved that the former be declared as IN DEFAULT and hence considered to have waived his right to cross-examine the latter’s witness. This was denied and hearing was reset to November 15, 1989.

On November 15, 1989, Respondent-Applicant and his Counsel did appear. Thus, Opposer reiterated its motion but the same was again denied. A Notice of Hearing was issued on November 16, 1989 resetting the hearing to December 19, 1989.

On December 19, 1989, Respondent-Applicant and his Counsel were again absent despite receipt of notice of the scheduled hearing. For the third time, Opposer moved to declare Respondent-Applicant as IN DEFAULT, which was granted. Opposer presented its evidence, and formally offered Exhibits “A” to “D” and their submarkings, which were all admitted as its evidence per Order No. 90-64 issued February 13, 1990. Opposer submitted its Memorandum on December 22, 1989.

The only issue to be resolved is whether or not Respondent-Applicant’s trademark “SUNSHINE” is confusingly similar with the trademark “SUNSHINE” registered in favor of the Opposer.

This Bureau resolves in the affirmative.

A side by side comparison of the labels of Respondent and Opposer's Exhibit "A" reveal that both bear the same identical word SUNSHINE AND DEVICE OF A SUN. Although there may be some differences in their respective labels, for example, the color background, the style of lettering and the representation of only half of the device of a sun, such variations are minor dissimilarities which are not enough to negate any likelihood of confusion, deception or mistake in the minds of the public or deceive purchasers.

The question of infringement of trademark is to be determined by the test of dominance.

Viewed in its entirety, the dominant feature in the contending marks is the word SUNSHINE.

The fact that Respondent-Applicant has incorporated in his mark a different color background, style of letter and a device representing half of a sun is not sufficient to avoid any likelihood of confusion, mistake or deception.

The Supreme Court has held in the case of Phil. Nut Industries, Inc. vs. Standard Brands, Inc. 65 SCRA 375 that –

"No producer or manufacturer may have a monopoly of any color scheme or form of words in a label. But when a competitor adopts a distinctive or dominant mark or feature of another's trademark and with it makes use of the same color ensemble, employs similar words written in a style, type and size of lettering almost identical with those found in another trademark, the intent to pass to the public his product as that of the other is quite obvious".

In *Co Tiong Sa vs. Director of Patents* (95 Phil.1) our Supreme Court has held:

"It is thus not necessary that the matter sought to be protected be literally copied. Differences or variations or similarity in the details of one device or article and those of another are not the legally accepted tests. Whether an action based on wrongful imitation exists. Dissimilarity in the size, form, color of the device be it a trademark, a label, a wrapper, a package, etc. – and the place where the same applied are, while relevant, not conclusive. It is sufficient to constitute a cause of action for either infringement or unfair competition or, in proper cases, denial or cancellation of registration of trademark or tradename that the substantial and distinctive part, the main or essential or dominant features of one device or article is copied or imitated in another".

The contending marks are confusingly similar to each other not only as to the marks themselves but also as to the products and source of the goods. Respondent-Applicant's SUNSHINE product is cooking oil while Opposer's trademark SUNSHINE is being used on butter. Both are classified under Class 29 of the Official Classification of Goods – Food and /Ingredients of Food. In fact, margarine may be used for cooking as an ingredient of for frying purposes just like cooking oil. Thus, cooking oil and margarine are related goods.

Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores. (*Esso Standard Eastern, Inc., vs. Court of Appeals*, 116 SCRA 336, 337).

Furthermore, cooking oil is well within Opposer's zone of potential or natural and logical expansion.

“Finally, the failure of Respondent-Applicant to refute opposer’s evidence despite several opportunities to do so, and its failure to attend scheduled hearings and present his own evidence are clear manifestation of Respondent-Applicant’s lack interest to pursue further the application for registration of its trademark and to defend its right under said application.”

WHEREFORE, the Notice of Opposition filed by herein Opposer, Procter and Gamble Philippines, Inc. is, as it is hereby SUSTAINED. Accordingly, Application Serial No. 64054 filed by Jimmy Ching on March 03, 1987 for the registration of the trademark SUNSHINE and DEVICE is, as it is hereby, REJECTED.

Let the filewrapper of the above-mentioned application be forwarded to the Application, Issuance and Publications Division for proper 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 own record.

SO ORDERED.

IGNACIO S. SAPALO
Director