

CANON KABUSHIKI KAISHA,)	INTER PARTES CASE NO. 3404
Opposer,)	
)	OPPOSITION TO:
)	
)	Application Serial No. 55441
)	Filed : January 15, 1985
- versus -)	Applicant : NSR Rubber Corporation
)	Trademark : CANON
)	Used on : Sandals
)	
)	<u>DECISION NO. 92-24 (TM)</u>
)	
NSR RUBBER CORPORATION)	November 10, 1992
Respondent-Applicant.)	
x-----x)	

DECISION

This Inter Partes Case refers to an Opposition to the Application for Registration of the trademark CANON for sandals filed by Respondent-Applicant, NSR RUBBER CORPORATION, of 7379 Mendez St. Baesa, Quezon City, under application Serial No. 55441 dated 15 January, 1985 which was published for Opposition on 31 May, 1989 (Official Gazette of the Bureau of Patents, Trademarks and Technology Transfer, p. 30 Vol. II, No. 5).

The records show that a Verified Notice of Opposition was filed by CANON KABUSHIKI KAISHA, a foreign corporation duly organized and existing under the laws of Japan with principal address at 30-2, 3 Chome, Shinomaruko, Ohta-ku, Tokyo Japan, hereinafter referred to as the Opposer, alleging among others that it will be damaged by the registration of the trademark CANON in the name of the Respondent-Applicant. The Notice to Answer the said Opposition was sent on 07 August, 1989 by Registered Mail and was received by the Respondent-Applicant on 12 August, 1989 as shown by the return card.

On 20 November, 1989 the Opposer filed a Motion to Declare the Respondent IN DEFAULT on the ground of the latter's failure to file an Answer within the reglementary period to do so. Consequently, this Office issued Order No. 89-929 granting the said Motion and allowed the Opposer to present its evidence ex-parte.

In the course of the trial, the Opposer presented Exhibits "D" to "T" consisting of its registrations for the mark CANON in various countries covering goods belonging to Class 2 (paints, chemical products, toner dyestuff). Philippine Trademark Registration No. 39398 marked in evidence as Exhibit "U" was also presented to show ownership over the trademark CANON also under Class 2.

On the other hand, the mark CANON under Application Serial No. 55441 which is the subject of this Opposition is being used by the Respondent-Applicant on his goods belonging to Class 25 (sandals).

In the case of Esso Standard vs. Court of Appeals, 116 SCRA 336, the Supreme Court held that a trademark used by another as a trademark for cigarettes as because the two classes of products flow through different channels of trade. Petroleum products are distributed principally through gasoline service and lubricating stations, auto shops and hardware stores while cigarettes are sold in Sari-sari stores, grocery stores and other small distributor outlets.

Following the ruling laid down in the Esso case, this Office is of the opinion that the trademark CANON as used by the Opposer for its chemical products can be used by the

Respondent-Applicant for its sandals because the two classes of products flow through different trade channels. While the products of the Opposer are sold through special chemical stores or distributors, the products of the Respondent-Applicant are sold in grocery stores, sari-sari stores and department stores.

Furthermore, it is an established doctrine that in cases of conflict between trademarks, emphasis should be given on the similarity of the products involved. The mere fact that one person has adopted and used a trademark on his goods, does not prevent adoption and use of the same trademark by others on unrelated articles of a different kind (please see Hickok Manufacturing Co. vs. Court of Appeals, 116 SCRA 387; Acoje Mining vs. Director of Patents 38 SCRA 480).

For this purpose, goods are said to be related when they belong to the 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. Thus, soap and perfume, lipstick and nail polish are held to be related because they are common household items nowadays (please see Chua Chee vs Philippine Patent Office, 13 SCRA 72). On the other hand, petroleum products and cigarette are held to be unrelated goods and the public cannot be deceived as to which product they are buying (please see Esso case, supra.).

Regarding the applicability of Article 8 of the Paris Convention, this Office believes that there is no automatic protection afforded an entity whose tradename is alleged to have been infringed through the use of that name as a trademark by a local entity.

In *Kabushiki Kaisha Isetan vs. The Intermediate Appellate Court, et.al.*, G.R. No. 75420, 15 November 1991, the Honorable Supreme Court held that:

“The Paris Convention for the Protection of Industrial Property does not automatically exclude all countries of the world which have signed it from using a tradename which happens to be used in one country. To illustrate – If a taxicab or bus company in a town in the United Kingdom or India happens to use the tradename: “Rapid Transportation”, it does not necessarily follow that “Rapid” can no longer be registered in Uganda, Fiji, or the Philippines.

This Office is not unmindful that in the Treaty of Paris for the Protection of Intellectual Property regarding well-known marks and the possible application thereof in this case. Petitioner, as this office sees it, is trying to seek refuge under its protective mantle, claiming that the subject mark is well known in this country at the time the then application of NSR Rubber was filed.

However, the then Minister of Trade and Industry, the Hon, Roberto V. Ongpin, issued a memorandum dated 25 October 1983 to the Director of Patents, a set of guidelines in the implementation of Article 6bis of the Treaty of Paris. These conditions are:

- a) the mark must be internationally known or well known;
- b) the subject of the right must be a trademark, not a patent or copyright or anything else;
- c) the mark must be for use in the same or similar kinds of goods; and
- d) the person claiming must be the owner of the mark (The Parties Convention Commentary on the Paris Convention. Article by Dr. Bogsch, Director General of the World Intellectual Property Organization, Geneva, Switzerland, 1985)

From the set of facts found in the records, it is ruled that the Petitioner failed to comply with the third requirement of the said memorandum that is the mark must be for use in the same or similar kinds of goods. The Petitioner is using the mark “CANON” for products belonging to

class 2 (paints, chemical products) while the Respondent is using the same mark for sandals (class 25). Hence, Petitioner's contention that its mark is well-known at the time the Respondent filed its application for the same mark should fail.

Although the Respondent-Applicant was declared in default for failure to File an Answer to the Notice of Opposition, the Petitioner is still bound to discharge and continues to bear the burden of proof to establish his claim (Please see *Pascua vs. Florendo* 136 SCRA 208; Rule 18 Sec I of the Rules of Court). Not having done so, this Office is constrained to give due course to the Application for Registration of the Respondent-Applicant.

WHEREFORE, premises considered, the herein Notice of Opposition is hereby DISMISSED and Respondent's Application Serial No. 40013 for the registration of the trademark CANON is hereby, GIVEN DUE COURSE.

Let the records of this case be forwarded to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director