

PHILIPS EXPORT B.V.,	)	INTER PARTES CASE NO. 3101
Opposer,	)	
	)	OPPOSITION TO:
	)	
	)	Application Serial No. 56288
	)	Filed : April 30, 1985
	)	Applicant : Standard Philips Corporation
	)	Trademark : STANDARD PHILIPS & GLOBE DEVICE
- versus -	)	Used on : Toys, paper fasteners, dry seal, staple removers, stapler, paper puncher, calculator ribbon, typewriter ribbon, hanging folders
	)	
	)	<u>DECISION NO. 93-11 (TM)</u>
	)	
STANDARD PHILIPS CORPORATION,	)	December 7, 1993
Respondent-Applicant.)	)	
x-----x	)	

DECISION

This is an Opposition to the application for registration of the trademark "STANDARD PHILIPS & GLOBE DEVICE" for toys, paper fasteners, dry seal, staple remover, stapler, paper puncher, calculator ribbon, type writer ribbon, hanging folders, filed on April 30, 1985 by the Standard Philips Corporation under Application Serial No. 56288 published in the Official Gazette on May 23, 1988, Vol. 1, No. 3 and officially released on same date.

Opposer is a foreign corporation organized under the laws of the Netherlands with business address at Groenewoudseweg 1, Eindhoven. The Netherlands, while the Respondent-Applicant is a domestic corporation organized under the laws of the Philippines with business address at Valenzuela, Bulacan, Metro Manila, Philippines.

The grounds for Opposition are as follows:

1. The Opposer is the owner-assignee of the trademark "PHILIPS" covered by, among others, Certificate of Renewal Registration No. R-1651 issued on October 28, 1976, as well as Applications Serial Nos. 50471 and 50471 for the trademarks "PHILIPS" and 50470 for the trademarks "PHILIPS" and "PHILIPS" (Shield Emblem), respectively, both filed on February 24, 1983 under Classes 7,8,9,10,11,14,16 based on Benelux Registrations Nos. 377,599 and 377,600 respectively, which applications have already been allowed for publication on February 6, 1985 much earlier than the filing of the application subject of opposition.
2. The trademarks "PHILIPS" and "PHILIPS (SHIELD EMBLEM)" which opposer owns have been used in the Philippines by it and its predecessors in interest, N.V. Philips Gloslampenfabrieken, on electric lamps of all types, machines, machine tools, parts and fitting thereof, welding devices, instruments and apparatus, shaving apparatus, hair clippers, scientific, electronic photographic, weighing, measuring, signaling and checking machines, cash

registers, calculating machines, computers, etc., surgical, medical and dental instruments, etc., installation devices, apparatus and articles for lighting, heating cooking, refrigerating and many others, long prior to the alleged date of first use by respondent-applicant of its mark "STANDARD PHILIPS & GLOBE DEVICE" on November 5, 1984.

3. The name "PHILIPS" is the dominant word and "PHILIPS (Shield Emblem)" is likewise one of opposer's trademarks. Hence, the trademarks of respondent-applicant "STANDARD PHILIPS & GLOBE DEVICE" is confusingly similar to the trademark of opposer "PHILIPS" and "PHILIPS (SHIELD EMBLEM)" which were duly registered with this Honorable Office since as early as April 23, 1956 per Certificate of Registration No. 5212 for "PHILIPS" and April 23, 1956 per Certificate of Registration No. 5213 for "PHILIPS" (Shield Emblem) and because of such confusion similarity between the trademark applied for and those belonging to opposer, the same will cause confusion or mistake as to opposer's corporate name "PHILIPS EXPORT B.V." the word "PHILIPS" being the dominant portion thereof, and with such similarity to its corporate name, the public will be misled into believing that the business of respondent-applicant is related to that of opposer.

The Office furnished Respondent-Applicant on September 15, 1988 a copy of the herein Notice of Opposition and required it to file an Answer thereto within fifteen (15) days from receipt of the same.

In its Answer filed on October 3, 1988 Respondent-Applicant denied all the material allegations made therein and invoked thereby the following affirmative defenses:

1. That the Opposer has no legal capacity to sue;
2. The trademark "STANDARD PHILIPS & GLOBE DEVICE" is strikingly different in construction, color scheme, design and overall appearance from the trademark "PHILIPS" and "PHILIPS SHIELD EMBLEM" and that the products are unrelated and non-competing and there is no likelihood of confusion and deception on the part of the purchasing public as to the source or origin of the goods;
3. That Respondent-Applicant's tradename "STANDARD PHILIPS CORPORATION" has been duly registered and approved by the Securities and Exchange Commission. As such, it has a right to use the same on the goods it manufactures in relation to its business;
4. That opposer has no exclusive right to the use of the mark "PHILIPS" on any an all goods, especially when such mark is well-known both locally and internationally only for ELECTRIC LAMPS;

During the trial on the merits that followed, the parties presented and formally offered their respective testimonial and documentary evidence which were admitted by this Office through its ORDER dated March 20, 1990 and ORDER dated October 29, 1990.

On November 14, 1990 and October 24, 1990 Respondent-Applicant and Opposer respectively filed their memorandum, after which the case was submitted for decision. From the records and evidence, the only issue to be resolved in the instant case is whether or not the trademark "STANDARD PHILIPS & GLOBE DEVICE" which is used on toys, paper fasteners, dry seal, staple remover, paper puncher, calculator ribbon, typewriter ribbon, hanging folders and sought to be registered by Respondent-Applicant is confusingly similar to the trademarks "PHILIPS" and "PHILIPS (Shield Emblem)" registered in the name of the opposer.

In other words, should respondent's trademark application for "STANDARD PHILIPS & GLOBE DEVICE" be denied registration on the ground that it is an unregistrable mark under the provisions of Sec. 4(d) of R.A. No. 166 as amended, which provides:

"xxx (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 services of the applicants, to cause confusion or mistake or to deceive purchasers."

Opposer insists that this case should be decided in its favor as a matter of course on the basis of res judicata, i.e. the same parties contesting rights over the same trademark in Inter Partes Case No. 2010 decided on June 17, 1988. (Decision No. 88-35 [TM]) While the same parties and the same trademark (STANDARD PHILIPS AND DEVICE) were involved in the cited case, the goods involved in that case consist of chains, rollers, belts, bearings and cutting saw. On the other hand, the goods involved in the present case consist of toys, paper fasteners, dry seal, staple remover, stapler, paper puncher, calculator, ribbon, typewriter ribbon, and hanging folders. Necessarily, there has to be a separate determination of likelihood of confusion between the mark PHILIPS of Opposer and the mark STANDARD PHILIPS & GLOBE DEVICE of Respondent in relation to their respective goods, thus res judicata does not apply.

In IPC No. 2010, we held that:

As a consequence of the finding that "PHILIPS" has achieved a high degree of reputation and goodwill in the Philippines, its incorporation as part of a trademark of another person, as in this case, on the basis of the test of dominance applied in similar cases, would arrive at the same result.

(p. 7, Decision No. 88-35) (Underscoring supplied). In view of the entire exhibits submitted in evidence by Opposer in the present case, we do not now disturb our earlier holding. (see also Philips Export B.V. vs. Court of Appeals, 206 SCRA 457 [1992] citing Decision No. 88-35 on this point.

Having resolved the dominance of the word-mark "PHILIPS", the only question left to be resolved is whether Respondent's goods are related to Opposer's goods to the extent that the purchasers are likely to be deceived and misled that they came from one manufacturer. (Esso Standard Eastern Inc. vs. Court of Appeals, 116 SCRA 337, 342 [1982])

On this issue, Opposer submitted in evidence Certificate of Registration No. 42271 (exhibit "D", et. seq.) of the trademark PHILIPS covering goods under Class 16, namely, "printed matter, periodicals, books, catalogues, brochures, folders and posters, typewriters and office requisites (other than furniture); parts and accessories of the said articles not included in other classes". The application for this registration was filed February 24, 1983 and the certificate was issued December 12, 1988. (For comparison, the application now being opposed was filed April 30, 1985 claiming date of first use on November 5, 1984)

Clearly, Opposer's goods mentioned above are closely related, if not identical to Respondent's goods, to wit:

- |                       |   |  |
|-----------------------|---|--|
| Office requisites     | - | paper fasteners, dry seal, staple remover, paper puncher, calculator ribbon, and typewriter ribbon |
| Folders               | - | hanging folders  |
| Parts and Accessories | - | typewriter ribbon  |

Thus, it is very reasonable, if not certain, to conclude that purchasers are likely to be deceived and misled by Respondent's use of the mark STANDARD PHILIPS and GLOBE DEVICE on the goods applied for, in view of the prior registration of the mark PHILIPS by opposer on the same line of goods.

At this point, it is worth mentioning the case of Philips Export B.V. vs. Ca, supra, at 463, to wit:

A corporation acquires its name by choice and need not select a name identical with or similar to one already appropriated by a senior corporation while an individual name is thrust upon him. A corporation can no more use a corporate name in violation of the rights of others than an individual can use his name legally acquired so as to mislead the public and injure another.  
(underscoring supplied; citations omitted)

The dispositive portion of the cited Supreme Court decision provides, "a new one entered ENJOINING private respondent [same as herein respondent STANDARD PHILIPS CORPORATION] from using 'PHILIPS' as a feature of its corporate name". We echo the same rationale in this case. Respondent, after being enjoined by the Supreme Court from using the word "PHILIPS" as part of its tradename, has no right using the same as part of its trademark so as to misled the public and injure another.

WHEREFORE, this Notice of Opposition is GRANTED. Accordingly, Application Serial No. 56288 for the application of the mark STANDARD PHILIPS and GLOBE DEVICE in the name or Respondent-Applicant is DENIED.

Let the filewrapper of this case be forwarded to the Trademark Examining Division for appropriate action.

SO ORDERED.

IGNACIO S. SAPALO  
Director