

2. Opposer is the owner of the trademark "COLUMBIA" which was registered with the United States Patent Office under Registration Certificate No. 379020 for phonograph records and record blanks. "COLUMBIA" is also registered or applied for registration and is used as a trademark for said goods in other countries.

4. By virtue of Opposer's prior and continued use of "COLUMBIA" in many 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 confusingly similar trademark by the Applicant for use on identical or related 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.

On 9 August 1989 a Notice to Answer was mailed by this Office to herein Respondent-Applicant, however, such notice was returned unserved with notation stamped on the face of the envelope "RETURN TO SENDER, UNCLAIMED".

On 14 February 1991 an Alias Notice to Answer was mailed to Respondent-Applicant and such Alias Notice to Answer was duly received by a certain Emie Co. who claims to be an employee of Co Towings, on February 21, 1991. However, inspite such receipt of the Alias Notice, Respondent-Applicant still failed to file its Answer within the period set by the Rules, hence, a Motion to Declare the latter in Default was filed by herein Opposer for it to be allowed to present its evidence ex-parte.

The Motion to declare Respondent-Applicant in Default has been granted under Order No. 91-381 dated 24 November 1989.

Pursuant to the Order of Default, Opposer presented its evidence Ex-Parte consisting of Exhibits "A" to "UU" and its corresponding submarkings, and the testimony of its witnesses Ann Eichorst, Gerald T. Sun and Ricky R. Ilacad reduced into affidavit from duly legalized and authenticated.

The sole issue to be resolved in this case it:

Whether or not the trademark "COLUMBIA" sought to be registered by Respondent-Applicant is confusingly similar to the mark "COLUMBIA" of the Opposer as to be likely, when applied to or used in connection with the goods of Respondent, to cause confusion, mistake or to deceive purchasers pursuant to Section 4(d) of R.A. No. 166, as amended.

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

"SECTION 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 service form the goods, business or services of others shall have the right to register the same on the Principal Register unless it:

xxx

(d) Consists of or comprises 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 applicant, to cause confusion or mistake or to deceive purchasers.

The pieces of evidence presented show that Respondent-Applicant's trademark "COLUMBIA" is identical to Opposer's trademark as both trademarks contained the word "COLUMBIA" and considering further that the goods covered by the competing marks belong to the same Class 9, i.e., audio products including phonographs records, tape cassettes and compact discs for Opposer and audio and video cassettes for Respondent-Applicant. Hence, there is a factual basis to hold that Respondent-Applicant's trademark is confusingly similar with that of Opposer's.

Therefore, herein Opposer deserves protection under Section 4(d) of R.A. 166, as amended.

Moreover, it was held in the case of Esso Standard Eastern, Inc. vs. Court of Appeals, 116 SCRA 336, that:

"The test of whether trademark infringement exists depends for the most part upon whether or not the goods are so related that the public may be, or is actually, deceived or mislead into believing that they came from the same manufacturer. 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."

Furthermore, there is also sufficient evidence on file to show that there is a reasonable basis to make the conclusion that the mark "COLUMBIA" of Opposer is well-known, hence, maybe protected under Art, 6bis of the Paris Convention, particularly as follows:

- a) A duly authenticated Affidavit of Ann Eichorst, Assistant Secretary of Opposer proving that the products of Opposer bearing the trademark "COLUMBIA" have been commercially marketed for many years throughout the world, including the Philippines;
- b) List of Columbia Trademark Registrations owned by Opposer, proving that Opposer registered its "COLUMBIA" trademark in various countries including those which are members of the Paris Convention like France, Germany, Norway, Yugoslavia and Zambia;
- c) The Affidavit of Use filed by the Opposer with the Philippine Patent Office, proving that the trademark "COLUMBIA" has been used in the Philippines;
- d) Exhibit 6 of the Affidavit in Exhibits "O" to "O-21" (inclusive) consisting of certified copies of selected international trademark registrations proving that the Opposer's COLUMBIA trademark has been and is presently registered in countries and places like Great Britain, Hong Kong, Australia, Switzerland, Italy, Columbia, Puerto Rico, Peru, Saint Lucia and Nicaragua;
- e) Exhibit 7 of the Affidavit in Exhibits "P", "P-1", "P-2", "P-3" consisting of certified copies of pages of international music magazines showing recordings released under the COLUMBIA label as one of the top-selling audio musical recordings in various countries all over the world proving that Opposers

COLUMBIA products are being sold in various countries, hence, an internationally well-known mark; and

f) An Affidavit of Mr. Ricky Ilacad, International Division Manager of Octo Arts International, Inc., proving that products bearing the trademarks COLUMBIA has been and are being manufactured, marketed and sold in the Philippines, same mark is being used in the Philippines, said mark is well-known mark in the Philippines for phonograph records, cassette tapes and compact discs and that Filipinos have identified COLUMBIA products as originating from the Opposer.

WHEREFORE, the Opposition is, as it is hereby, SUSTAINED. Application Serial No. 47405 filed by CO TOWING for the registration of the trademark "COLUMBIA" used on audio and video cassettes 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