

VISA INTERNATIONAL SERVICE)	INTER PARTES CASE NO. 3303
ASSOCIATION,)	
) Opposer,)	OPPOSITION TO:
))	Application Serial No. 50261
))	Filed : February 1, 1983
))	Applicant : Pan Pacific
))	Plastic Products
))	Inc.
))	Trademark : VISA
))	Used on : Shoes, sandals,
))	slippers
))	
PAN PACIFIC PLASTIC)	<u>DECISION NO. 91-17 (TM)</u>
PRODUCTS, INC.,)	
) Respondent-Applicant.)	November 8, 1991
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DECISION

On January 22, 1989, Visa International Service Association, a foreign corporation duly organized and existing under and by virtue of the laws of the United States of America, with principal offices at 3125 Clearview Way, San Mateo, California 94402, U.S.A. filed its Authenticated Verified Notice of Opposition (Inter Partes Case No. 3303) to Application Serial No. 50261 for the trademark "VISA" used in shoes, sandals, slippers which application was filed on February 1, 1983 by Pan Pacific Plastic Products, Inc. a domestic corporation duly organized and existing under and by virtue of the laws of the Philippines with Offices at University Avenue, Malabon, Metro Manila, Philippines, which was published for opposition on page 54, of the BPTTT Official Gazette, vol. 1, No. 9, issued on November 29, 1988.

The basis for the Opposition as stated by the Opposer are as follows:

1. The Opposer is the owner and prior user of the mark "VISA" and the BLUE WHITE GOLD BANDS DESIGN which are registered and used worldwide, including in the Philippines;
2. In the Philippines, the said mark have been used through opposer's member, the Equitable Banking Corporation since 1979, and are continuously used up to the present. Opposer has been issued by the BPTTT Office Certificates of Registration Nos. 27098 on March 7, 1979; 28319 on May 1980; 34784 on October 7, 1985; and 35602 on May 7, 1986, respectively, for the mark "VISA" and Certificates of Registration Nos. 18983 on May 16, 1973; 35047 on January 6, 1986; and 37971 on February 3, 1988, for the mark "BLUE, WHITE & GOLD BANDS DESIGN";
3. Opposer has not given respondent-applicant any authority to use "VISA" or apply for its registration. Respondent-Applicant's use of "VISA" has damaged opposer and its registration would further damage opposer, considering, among others, the following:
 - a. The mark "VISA" applied for by respondent-applicant is deceptively or confusingly similar to opposer's mark "VISA" so as to deceive the public, to opposer's and to the public's prejudice;
 - b. Purchasers buying respondent-applicant's goods in stores or shopping centers would likely be deceived into believing that the goods they are

buying are those of opposer and/or that respondent-applicant is subsidiary of, or is associated or connected with, opposer and/or opposer and sale of shoes, slippers and sandals, to opposer's prejudice;

c. The use and/or registration by respondent-applicant of "VISA" would weaken opposer's mark "VISA" and/or dilute the strength, distinctiveness, quality, reputation and goodwill of Opposer's "VISA" and its business;

d. The registration by respondent-applicant of the mark "VISA" would open the floodgates to the use, or application for registration of the mark "VISA" by all and sundry, by different persons or entities desiring to appropriate the mark "VISA" for all kinds and varieties of goods and services, until opposer would lose its property rights and the mark "VISA" would become a public commodity, to opposer's prejudice;

e. The registration of "VISA" by respondent-applicant would unfairly preclude opposer from using it on shoes, slippers, and sandals; on goods related thereto; and on other goods and services; and so on and so forth, in such a way as to deprive opposer of the right to branch out, and/or to establish subsidiaries manufacturing related goods or offering services, using the mark "VISA" to opposer's prejudice;

f. "VISA" also forms part of opposer's corporate name, and respondent-applicant's registration of "VISA" would increase the likelihood of confusion or mistake on the part of the buying public not only as to the goods or services but as to the business or origin as well.

The main issue to be resolved is whether or not the use of the trademark "VISA" on Respondent-Applicant's goods would likely cause confusion, mistake or deception upon purchasers as to the source of origin thereof.

Our Trademark Law. Particularly Section 4(d) thereof provides as follows:

"Section 4. Registration of trademark, 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 of others shall have the right to register the same of the principal register unless it:

xxx

d) Consists of or comprises a mark or trade name which so resembles a mark or trade name registered in the Philippines or a mark or trade name 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."

On January 27, 1989, this Honorable Office issued a Notice to Answer addressed to Respondent-Applicant at its address of record. The Notice to Answer was returned unclaimed, apparently because applicant left its address of record without informing this honorable Office of its change of address.

On March 27, 1990, Opposer filed a Motion to Declare Respondent-Applicant in Default, and at the same time submitted its evidence consisting of the affidavit of Mr. Charles Paul Sammut, Assistant Secretary of Opposer with a number of attachments marked as Exhibits, apart from the various certificates of registration of Opposer of the mark "VISA" and the mark

"BLUE, WHITE AND GOLD BANDS DESIGN" as listed in its manifestation dated January 24, 1989.

On March 20, 1991, the Director of Patents issued an Order requiring publication of the Notice to Answer, which publication was done, and Respondent-Applicant having failed to file its Answer, the same was Declared in Default (Order No. 91-474) dated May 31, 1991.

It must be pointed out that the marks claimed by both Opposer and the Respondent-Applicant are confusingly similar with each other. A side-by-side comparison of the two contending marks readily show that they are identical in appearance, style of presentation, spelling and sound as shown in their respective labels.

The use and registration by Respondent-Applicant of an identical or confusingly similar mark is contrary to Sec. 4 (d) of R.A. No. 166 as amended. Although Respondent-Applicant's trademark is used on shoes, sandals, and slippers, while Opposer's trademark is used essentially for credit financing services and credit card services and to different classes of the international classification of goods, including golf balls, plastic drinking glasses, key-rings, pocket knives, ballpoint pins, cufflinks, desk calendar books, plastic letter bags, hand mirrors, cigarette lights, playing cards, rulers, balloons, sponges, first aid kits, pocket flashlights, luggage tags, hats and caps, travel bags, handkerchiefs, t-shirts, umbrellas, clocks and beach towels." (Mr. Charles P. Sammut's Affidavit) the likelihood of confusion, mistake or deception upon purchasers can not be avoided. This is because not only are the marks, but also due to the fact that opposer's trademark is well known internationally and in the Philippines as evidenced by its registrations in at least 150 countries in the world (Annexes "B" and "B-1") paragraph 6 of Mr. Charles P. Sammut's Affidavit.

Note that Section 4(d) of R.A. No. 166, as amended, does not require that the goods of the prior user and subsequent user of the mark should possess the same descriptive properties or fall under the same categories as to bar the registering of the latter mark in the Principal Register. The likelihood of confusion, mistake or deception upon purchasers would suffice (see Sta. Ana vs. Maliwat, 24 SCRA 1018, citing Chua Che vs. Phil. Patent Office, 13 SCRA 67).

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

"The courts have come to realize that there can be unfair competition even if 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; and second, by having his business reputation confused with and put at the mercy of the second user when non-competing products are sold under the same mark, x x x. Experience has demonstrated that when a well known trademark is adopted by another 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 some supposed connection between original mark and the new articles being tendered to the public under the same or similar mark. x x x The owner of a trademark or tradename has a property right in which he is entitled to protection since 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 unfairness of the acts and to classify and treat the issue as a fraud."

WHEREFORE, the herein Notice of Opposition is, as it is hereby, GRANTED and Respondent-Applicant's Application Serial No. 50261 for the mark "VISA" is REJECTED.

Let the records of this case be remanded to the Application, Issuance and Publications Division for proper action in accordance with this DECISION. Likewise, let a copy of this Decision be furnished Trademark Examining Division for information and to update its own record.

SO ORDERED.

IGNACIO S. SAPALO
Director