

GENERAL ELECTRIC COMPANY
Opposer,

INTER PARTES CASE NO. 3287

OPPOSITION TO:

- versus -

Application Serial No. 59385
Filed : July 16, 1986
Applicant : Arsenio de Guzman
Trademark : G E
Used on : Shoes and slippers

ARSENIO DE GUZMAN
Respondent-Applicant

x-----x

DECISION NO. 89-100 (TM)



December 15, 1989

DECISION

On November 2, 1988, General Electric Company filed an unverified Notice of Opposition against the registration of the trademark "GE" used on shoes and slippers applied for by Arsenio de Guzman on July 16, 1986 under application Serial No. 59385 published on Page 31, Volume I, No. 7 of the BPTTT Official Gazette dated September 27, 1988 and released for circulation on September 30, 1988.

Opposer is a foreign company organized and existing under the laws of United States of America, doing business at Fairfield, Connecticut, United States of America, while Respondent Applicant is a Filipino citizen residing at 95 H. Bautista Street, Concepcion, Marikina, Metro Manila, Philippines.

The grounds alleged in the opposition are:

"1. Opposer is the owner of the trade mark GENERAL  ELECTRIC , monogram, and GE (in block letters), hereinafter referred to as the 'GE Trademarks', covering a wide range of goods falling under International Philippine Classes 1, 2, 4, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 17, 19, 21, 23 and 28, among others. Such ownership subsists up to date and has never been abandoned.

2. Opposer's ownership of the GE Trademarks, as used on various goods, is evidence by Certificates of registrations which it obtained from, and applications for registration which it filled with, government offices in many countries, notably the United States, many European countries, Japan, South and Central American countries, African and Middle Eastern Countries.

3. The trademark GE applied for by herein respondent-applicant is identical to Opposers GE trademarks, and its registration will run counter to Section 4 (d) of Republic Act No. 166, as amended.

4. The GE Trademarks are world famous marks and deserves protection as such pursuant to the Convention of Paris for the Protection of Industrial Property (Lisbon version) to which the Philippines became a signatory since 1968.

5. The applicant's act of appropriating the trademark GE for its use and benefit, to the extent of claiming ownership over the same, constitutes a blatant and reprehensive

act of trade mark piracy, which is violative of the Philippine government's long standing policy against counterfeiting."

On November 11, 1988, Respondent-Applicant was notified of this opposition and was required to file its Answer thereto within fifteen (15) days from receipt of said notice.

On November 29, 1989, Respondent-Applicant filed a request for extension of thirty (30) days time within which to file his Answer which was granted in Order No. 88-549 dated December 1, 1988.

On January 19, 1989 after the lapse of the requested thirty-day period to file his Answer, Opposer file a Motion to declare Respondent-Applicant in default, which was granted in Order No. 89-081 dated January 26, 1989.

Opposer submitted its formal offer of evidence on August 21, 1989 consisting of Exhibits "A" to "L", inclusive, and were admitted in evidence for the opposer in Order No. 89-740 dated September 18, 1989.

The issue to be resolved in this case is which of the parties is the first adopter, user and real owner of the trademark "GE" in litigation.

Oppose submitted documentary evidence showing that as far back as September 18, 1900 it registered its name the trademark "GE" under U.S. Trademark No. 35,089 used on electrical machineries, electrical apparatus and supply parts therefore; U.S. Trademark No. 983013 issued on April 30, 1974 used on computers and accessories thereto; U.S. Trademark No. 1285847 issued on July 17, 1984 used on windshield scrappers, scissors, utility knives and pocket knives; U.S. Trademark No. 1,317,546 issued on February 5, 1985 for cleaning and polishing the preparations; secured registration of the trademark "GE" (block letters) in the United states (Exhs. "B" "B-2" and "B-3") 10 registrations in the Argentina (Exhs. "B-3" and "B-4"); one in Austria (Exhs. "B-5"); two in Benelux countries (Exhs. "B-6" and B-7"); 13 in Brazil (Exhs. "B-7" to "B-9"); one in Canada (Exhs. "B—9" to "B-10"); two in Chile (Exhs. "B-11"); 7 in Columbia (Exhs. "B-11" and "B-12"); 7 in Costa Rica (Exhs. "B-12" and "B-13"); one in el Salvador (Exhs. "B-13"); one in Greece (Exhs. "B—13" and "B-14"); 6 in Guatamela (Exhs. "B-14" and "B-15"); one each in Indonesia (Exhs. "B—15" and Iran (Exhs. "B-16"); 2 in Israel (Exhs. "B—17"); one in Italy (Exhs. "B-18"); 5 in Kuwait (Exhs. "B-19" and "13-20"); one each in Lebanon (Exh. "20") and Liberia (Exh. "B-21") 6 in Macao (Exh. "B-22"); 12 in Mexico (Exh. "B-23"); 6 in Nicaragua (Exhs. "B-23" and "B-24"); 2 in Peru (Exh. "B-24"); one in the Philippines (Exh. "B-24"); 6 in Portugal (Exhs. "B-25" and "B-26"); 7 in Puerto Rico (Exh. "B-26"); one in Saudi Arabia (Exh. "B-27"); 10 in Spain (Exhs. "B-27" and "B-28"; one each in Syria (Exh. "B-28") and Turkey (Exh. "B-29"); 2 in Uruguay (Exh. "B-30") 15 in Venezuela (Exhs. "B-30" and "B-31"); and one each in Yugoslavia (Exh. "B-32") and Republic of Korea (Exh. "B-33").

In addition, Opposer submitted a listing of numerous registrations of the trademark "GE" monogram, "GE" (in block letters) and "GENERAL (GE) ELECTRIC" in 148 countries and commercial centers all over the world (Exhs. "C", "C-1") to "C-129").

From the foregoing exhibits, Opposer clearly established that its marks (all with the letters "GE") are famous and internationally well known.

Opposer also submitted sufficient proofs of the use and registration of its trademarks in the Philippine, to wit: "GE" within a circle under Registration No. 32352 issued on August 5, 1983 used on a long list of products falling under Classes 1, 2, 4, 6, 7, 9, 10, 11, 14, 15, 19, 21 and 24 (Exh. "D-1"); and "GENERAL (GE) ELECTRIC" issued on August 18, 1983 used on goods falling under Classes 2, 7, 9, 14, 17, 10 and 21 (Exh. "D-2").

The Supreme Court, in Ang vs. Teodoro, 74 Phil. 50, held:

“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 the manufacturer of the article sold under the original mark and the new articles being tendered to the public under the same or similar mark. x x x The modern trend is to give emphasis to the unfairness of the acts and to classify and treat the issue as a fraud.”

In the recent case of Converse Rubber Corp. vs. Universal Rubber, G.R. No. L-27906, Jan. 8, 1987, the Supreme Court, in a more critical fashion, states:

“But even assuming arguendo, that the trademark sought to be registered by respondent is distinctively dissimilar from those of the petitioner, the likelihood of confusion would still subsist, not on the purchaser’s perception of the goods but on the origin thereof. By appropriating the word ‘CONVERSE’, respondent’s products are likely to be mistaken as having been produced by the petitioner. The risk of damage is not limited to a possible confusion of goods but, also includes confusion of reputation of the public could reasonably assume that the goods of the parties, originated from the same source. (Underscoring supplied)

On the other hand, Respondent-Applicant, except for his request for extension of thirty (30) days time to file an Answer, failed to file his answer or any other pleading in support of his claim of ownership over the contested mark “GE”.

WHEREFORE, this Notice of Opposition is SUSTAINED. Respondent’s Application Serial No. 59385 for the registration of the trademark “GE” in his name is REJECTED.

Let the records of the case be transmitted to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director