

J. CORDON COMMERCIAL CORP.,  
Opposer,

INTER PARTES CASE NO. 3984  
Opposition to:

-versus-

Appln. Serial No.: 78992  
Date Filed: 26 December 1991  
Trademark: "VIDEORCHE &  
DESIGN"

SAMSUNG ELECTRONICS CO., LTD.,  
Respondent-Applicant.

DECISION NO. 98-03

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## DECISION

This pertains to an opposition filed by J. Cordon Commercial Corp., a corporation organized and existing under the laws of the Philippines, with offices at Room No. 607, Executive Building Center, Gil J. Puyat Avenue, Makati City, against application for registration of the trademark "Videoke and Design" on television receivers, audio cassette tape players with microphone, videotapes, compact disc players with microphone, computers, radio receivers, transistors, electric vacuum cleaners and videotape recorders filed on December 26, 1991 under Serial No. 78992 in the name of Gazette of the then Bureau of Patents, Trademarks and Technology Transfer (BPTTT) and released for circulation on November 23, 1998.

The herein Respondent-Applicant Samsung Electronics Co., Ltd., is a Korean corporation with business address at 416 Mactendong, Kuronsum-Ko, Suwon, Kyunggido, Korea.

The grounds for opposition to the registration of the mark "Videoke and Design" are as follows:

- "1. The Opposer is the owner of the trademark "Videoke and Design" covered by Registration No. 48223 issued on May 29, 1990 based on Application Serial No. 65876 filed on September 28, 1998;
- "2. On December 26, 1991 Respondent-Applicant filed with the BPTTT an application for registration of the trademark "Videorche and Design" for television receivers, audio cassette tapes with microphones, video tapes, compact disc players with microphones, computers, radio receivers, transistors, electric vacuum cleaners and video tape recorders, under Application Serial No. 78992. The application was duly published on the Official Gazette;
- "3. The registration of the trademark "Videorche and Design" in the name of Respondent-Applicant is in violation of the runs counter to Section 4(d) of Republic Act No. 166, as amended, because it is confusingly similar, if not identical to the above trademark of Opposer J. Cordon Commercial Corp., as registered and previously used in the Philippines as to be likely when applied to or used in connection with the goods of Respondent-Applicant, to cause confusion or mistake or deception to the purchasing public;
- "4. Opposer believes and therefore alleges that the registration of the mark "Videorche and Design" in the name of Respondent-Applicant will cause irreparable injury and damage to Opposer, as provided under Section 8 of Republic Act No. 166, as amended;
- "5. Registration of the mark "Videorche and Design" of Respondent-Applicant is in violation of the provisions of Section 37 of R.A. 166, as amended;

To support this Opposition, Opposer relied on the following facts:

- “a. Opposer’s mark “Videoke and Design” has been used in trade and commerce in the Philippines since before the filing of its application for registration and the issuance of the certificate of registration above-mentioned, and all prior to the date of filing of the application for registration on December 26, 1991 of the mark “Videoke and Design” by Respondent-Applicant;
- “b. The mark “Videorche and Design” appearing on the drawings and facsimiles submitted by Respondent-Applicant in its application for registration are confusingly similar, if not identical to Opposer’s aforementioned registered mark as used on the goods of the Opposer;
- “c. Opposer has been manufacturing and selling in the Philippines goods bearing the mark “Videoke and Design” which is similar if not identical to the alleged products of Respondent-Applicant bearing the mark “Videoke and Design” under Application No. 78992;
- “d. The long use of, and the large amounts spent by Opposer for popularizing its trademark “Videoke and Design” has generated an immense goodwill for said trademark in the Philippines and elsewhere and Opposer’s goods have acquired the reputation of high quality products by the purchasing public;
- “e. The use and adoption by Respondent-Applicant of the mark “Videorche and Design” which is confusingly similar if not identical to Opposer’s mark would tend falsely suggest a connection with the business of Opposer and therefore constitute an intend to defraud Opposer;
- “f. The similarity of the trademark “Videorche and Design” subject of Application No. 78992 to the trademark of Opposer betrays Respondent-Applicant’s intention to ride on the goodwill and popularity of Opposer’s trademark “Videoke and Design”

On February 7, 1994, Samsung Electronics Co., Ltd., the herein Respondent-Applicant filed its Answer denying the material allegations in the opposition.

The issue having been joined, this Office set this case for the pre-trial. There being no amicable settlement reached, the parties proceeded to trial, adduced testimonial and documentary evidences and, together with their respective memoranda, submitted the case for decision.

The issue to be resolved is whether or not confusing similarity exist between the Respondent-Applicant applied mark Videoke and Design, and Opposer’s registered mark “Videoke and Design” and if so, which of the contending parties has the exclusive right to own, adopt and use the mark to the exclusion of others.

With the enactment of R.A. 8293, otherwise known as the “Intellectual Property of Code of the Philippines” which took effect on January 01, 1998, the application for registration of the mark “Videoke and Design” should have been prosecuted under the new law (R.A. 8293)

However, this Office takes cognizance of the fact that the herein Application Serial No. 78992 was filed on December 26, 1991 when the new law was not yet in force. Section 235.2 of R.A. 8293, provides, inter alia that: “All applications for registration of marks or trade names pending in the Bureau of Patents, Trademarks and Technology Transfer at the effective date of this Act may be amended, if practicable to bring them under the provision of this Act. x x x If such amended are not made, the prosecution of said application shall be PROCEEDED WITH and registration thereon granted in accordance with the ACTS UNDER WHICH SAID

APPLICATIONS WERE FILED AND SAID ACTS HEREBY CONTINUED IN FORCE TO THIS EXTENT ONLY NOTWITHSTANDING THE FOREGOING REPEAL THEREOF.

Considering however, that this application subject of opposition proceeding has been filed under the Old Law and this case is now for resolution, thereby rendering impractical to so amend it in conformity with R.A. 8293 without adversely affecting rights already acquired prior to the effectivity of the new law (Sec. 236, supra), this Office undertakes to resolve the case under the former law, R.A. 166 as amended, more particularly Section 4(d), which provided that:

“SEC. 4. Registration of trademarks, trade names and service mark on the principal register. There is hereby established a register of trademarks, trade names and service marks which shall be known as the principal register. The owner of a trademark, trade name or service mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register unless it:

x        x        x

- (d) Consists of or comprise 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 service of the applicant, to cause confusion or mistake or to deceive consumers”.

Perusing from the trademark facsimile of Opposer (Exh. “A-1”) and trademark drawing of Respondent-Applicant (Exh. “4”), it may be observed that the prefix “video” and the suffix letters “o” and “e” appear in the marks “Videorche” and “Videoke”. The only difference is the presence of the letters “c” and “h” for “Videocrche” and “k” for “Videoke”. These, however, are not a gauge to determine confusing similarity of trademarks. As held in Mead Johnson & Co., vs. N.Y. Van Dorf, Ltd. (7 SCRA 286), and Mead Johnson & Co. vs. Director of Patents (17 SCRA 128-129), the Supreme Court opined, thus: “In determining whether two trademarks are confusingly similar, the test is not simply to take their word and compare the spelling and pronunciation of said words. Rather it is to consider the marks in their entirety, as they appear in their respective labels in relation to the goods which they are attached.”

On examination of the two trademarks, it is noted that the letter “o” in both marks are concentrically designed. But this Office has noted some variations: firstly, the letter “o” in the mark “Videoke” is circular in shape whereas the letter “o” in the “Videorche” is oblong in shape with its tiptop pointing to the upper right and leaning toward the next letter “r”; secondly, the concentric circles in “Videoke” are numerous and unbroken, whereas those in “Videorche” consists of two layered broken circles; thirdly, the concentric circles in the mark “Videoke” is found in the inner circular space of the letter “o”, whereas those in the mark “Videorche” is composed of the layered broken circles comprising the letter “o” and lastly, the mark “Videorche” with the exception of letter “V” and “O” are inscribed in small letters, and the other mark “Videoke” are written in capital letters.

By looking in their entirety, however, the dissimilarities above-mentioned are so minuscule that they are lost in the substantial similarities in general appearance and features of the two trademarks. (Exh. “A-1” and “4”). For one, consumers tend to put emphasis on the prefix “Video” so that the above-indicated variations suffixes are not striking enough to make the purchasers conclude that the trademarks are different in source or origin. Even the presence of Opposer’s name “J Cordon” above the mark “Videoke” does not give such mark any distinguishing characteristics as the common dominant features of both marks are the ones that catch the attention of would-be purchasers.

Another thing, the concentric design is found in the letter “O” of both marks that purchasers may be misled to believe that they are one and the same; lastly and most

importantly, the apparently dissimilar spelling suffixes “orche” and “oke” disappear in the pronunciation of the similar sounding word mark. Thus, the reasonable conclusion that may be derived therein is that the substantial similarities in general appearances and features far outweigh the slight variations in styles and spellings so that putting these marks side by side would likely cause confusion or mistake in the mind of the public as to deceive purchased as to origin or source of the commodity. (Phils. Nut Industry vs. Standard Brands [65 SCRA 675])

Implicit in this conclusion of confusing similarity in general appearance and features of the above-mentioned trademarks is the concept that the goods must be so related that there is likelihood of confusion of goods as to source or origin. In *Esso Standard Eastern, Inc., vs. Court of Appeals, et. al.*, L-29971, August 31, 1982, the Supreme Court said: Goods are related when they belong to the same class or have the same descriptive properties or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores. Thus, biscuits were held related to milk because they are both food products. Soap and perfume, lipstick and nail polish are similarly related because they are common household items nowadays.

In the case at bench, the marks “Videorche” and “Videoke” are used for audio/visual items (class 9). To be specific, “Videorche” is used for television receivers, audio cassette tapes, compact disc players with microphone, computers, radio receivers, transistors, electric vacuum cleaners and video tape recorders (Exh. “B”, “2”). On the therefore, very clear that those products bearing the subject trademarks are related, competitive and flow through the same channel of trade so that confusion of goods as to the source of origin will likely occur.

Confusingly similarity and relation of goods between the subject trademarks having been established, the remaining thing left for determination is which of the two parties should have utmost and sole right to adopt and use their respective trademarks. The records of this case show that Opposer was issued Certificate of Registration No. 48223 on May 29, 1990 for the trademark “Videoke” with date of first use in the Philippines on May 14, 1988 (Exh. “A-1”).

In contrast, Respondent-Applicant presented trademark application of the mark “Videorche” in the Philippines, which was filed on November 21, 1991, (Exh. “2”); certified copies of trademark Application No. 91-14719, filed on May 23, 1991, and corresponding trademark Registration No. 244898 of the same mark in the Republic of Korea (Exh. “3”). Respondent-Applicant did not submit proof of use of its mark in the Philippines. Under the Revised Rules of Practice in Trademark Cases, if an applicant failed to show any proof of use of its mark the date of filing should considered as the date of use of trademark. Hence, the date of filing of trademark application on November 21, 1991 in the Philippines is assumed as the date of use of the mark by Respondent-Applicant in the absence of proof of use.

Undoubtedly, Opposer which is the prior user of the mark “Videoke and Design” as shown hereinabove, has the exclusive right to adopt and use its mark. Consequently any application to register a similar or confusingly similar trademark by another person should be rejected; otherwise damages to the goodwill and reputation of the first user will arise. This conclusion would thus negate the contention of Respondent-Applicant that no damages will be incurred by the registration of the mark “Videorche and Design”. Its citation of several Supreme Court rulings would not alter our conclusion inasmuch as those cited jurisprudence (*Bristols Myers vs. Director* [17 CRA 178]; *Etepha vs. Director* [16 SCRA 496], *American Cyanamid Co. vs. Director* [76 SCRA 568], aside from being dispensed only through medical prescription, have manifestly dissimilar features and characteristics in their respective trademarks as unlike in this instant case.

And finally, the argument of Respondent-Applicant that Opposer’s mark “Videoke and Design” is a complex musical instrument commonly seen in restaurants, bars, clubs, and other entertainment circles and therefore incapable of exclusive appropriation is belied by the letters of Opposer requesting some of these establishments to cease and desist in the unauthorized use of the mark “Videoke” (Exh. “F”, “H”, “I”). This effort in prohibiting the unsolicited use of the mark is

an inherent exercise of the right to appropriate, adopt and use the mark to the exclusion of others, a privilege granted only to a person entitled thereto, which herein Opposer have convincingly manifested in this case.

WHEREFORE, premises considered the instant Notice of Opposition is hereby SUSTAINED. Accordingly, Application Serial No. 78992 for the trademark "Videorche and Design" filed on December 26, 1991 by Samsung Electronics Ltd., Respondent-Applicant, is hereby REJECTED.

Let the file wrapper of this case be forwarded to Administrative Financial and Human Resource Development Bureau for appropriate action in accordance with this DECISION with a copy thereof to be furnished the Bureau of Trademark for information and to update its records.

SO ORDERED.

Makati City, October 29, 1998

ESTRELLITA BELTAN-ABELARDO  
Caretaker/Officer-In-Charge