

BELEN W. ONGKIKO,	}	IPC No. 14-2006-00152
Opposer,	}	Opposition to:
	}	Serial No. 4-2005-003396
-versus-	}	Date Filed: 14 April 2005
	}	
ZHONGSHAN OKES LIGHTING	}	Trademark: "OKES (STYLIZED)
PRODUCTS LIMITED,	}	AND CHINESE
Respondent-Applicant.	}	CHARACTERS"
x-----x	}	Decision No. 2007-43

DECISION

This pertains to an Opposition filed on 16 October 2006 by herein opposer, BELEN W. ONGKIKO, with business address at Bug 50 & 52, Divisoria Mall, Manila, Philippines, against the application for registration of the trademark "OKES (STYLIZED) AND CHINESE CHARACTERS" bearing Application Serial No. 4-2005-003396 filed on 14 April 2005 for goods falling under Class 11 of the Nice Classification of Goods, for use on lighters, light bulbs, lamps, lighting apparatus and installation, ceiling lights, globes for lamps, safety lamps, lamp hanging supports, energy saving lamps, emergency lights (lights with storage battery), by ZHONGSHAN OKES LIGHTING PRODUCTS LIMITED, respondent-applicant, with office address on record at Huayi Lamp Market, The 3rd Industrial Zone, Gangdong, Guzhen, Guangdong, Peoples Republic of China.

The subject trademark application was published for opposition in the Intellectual Property Office Official Gazette which was officially released for circulation on 18 August 2006.

The grounds for opposition are as follows:

"1. The approval of the application in question is contrary to Section 123.1 (d) of Republic Act No. 8293, said mark being identical to the trademark OKES (Stylized with the Representation of a bulb as the letter O) which is duly registered in favor of opposer under registration No. 4-2002-004254."

"2. The approval of the application in question has caused and will continue to cause great and irreparable damage and injury to herein Opposer."

In support of the above opposition, Opposer relied on the summary of antecedent facts, to wit:

1. Opposer's trademark OKES (Stylized with the representation of a bulb as the letter O) is duly registered with Registration No. 4-2002-004254 effective January 6, 2006 for the following goods, namely: fluorescent lamps, bulbs, emergency lights, and other lighting fixtures namely: energy conservation lights, lamp shades, dome lights and night lights, falling under Class 11, which was issued originally in favor of Tenon Import & Export Corporation and subsequently assigned in favor of Opposer.

A certified copy of Certificate of Registration No. 4-2002-004254 is attached as Exhibit "A" of the Opposition.

2. Respondent-applicant did not oppose Application Serial No. 4-2002-004254.

3. Opposer and her predecessor-in-interest have not abandoned the use of the trademark OKES (Stylized with the Representation of a bulb as the letter O).

The duplicate original of the Declaration of Actual Use filed on April 20, 2005 by Tenon Import & Export Corporation is attached as Exhibit "B" of the Opposition.

After the assignment to Opposer, she has continued the use up to the present of the trademark OKES (Stylized with the Representation of a bulb as the letter O) as shown in Opposer's affidavit as Exhibit "C" of the Opposition.

4. The trademark OKES (Stylized) and Chinese Characters being applied for registration by respondent-applicant is identical to the trademark OKES (Stylized with the Representation of a bulb as the letter O) by Opposer.

5. The goods covered by respondent-applicant's application are almost identical to, and are included in opposer's registered mark.

6. Accordingly, the approval of the application in question is contrary to Section 123.1 (d) of Republic Act o. 8293.

7. The approval of the application in question is violative of the right of opposer to the exclusive use of her registered trademark OKES on goods listed in the registration certificate, provided for under Section 138 of the IP Code.

8. The approval of the application in question has caused and will continue to cause great and irreparable damage and injury to opposer.

9. Respondent-applicant is not entitled to register the trademark OKES (Stylized) and Chinese Characters in its favor. It is now estopped to challenge the validity of opposer's earlier filed and earlier approved application and earlier issued registration. Four (4) labels showing the trademark OKES (Stylized with the Representation of a bulb as the letter O) as actually being used by opposer is attached to the Opposition.

In Compliance to Office Order No. 79, series of 2005 (Amendments to the Regulations of Inter Partes Proceedings), prescribing the summary rules, listed hereunder are the evidence submitted by Opposer in support of the Opposition, and admitted by this Office, to wit:

Exhibit	Description
"A"	Certified true copy of Registration Certificate No. 4-2002-004254 for OKES (Stylized with the Representation of a bulb as the letter O)
"B"	Duplicate original of the Declaration of Actual Use filed on 20 April 2005
"C"	Affidavit of opposer Belen W. Ongkiko
"D"	Certified true copy, Certificate of Incorporation of Angel's Bhoom Enterprises, Inc.
"E"	Representative commercial invoices of Angel's Bhoom Enterprises, Inc.

A Notice to Answer dated 20 October 2006 was issued by this Office requiring respondent-applicant, through PATENTPROSE, the appointed representative or attorney to file the application, transact all business with the IPO in connection therewith, and to receive the

certificate of registration, with address on record at 1013-A EDSA, Veterans Village, Project 7, Quezon City Answer within fifteen (15) days from receipt. However, despite proof of receipt, evidenced by the Registry Return Receipt dated 03 November 2006, no Answer not any pleading related thereto was filed.

Hence, this instant case is deemed submitted for the resolution of the issue posed, to wit:

WHETHER OR NOT RESPONDENT-APPLICANT'S MARK "OKES (STYLIZED) AND CHINESE CHARACTERS" UNDER CLASS 11 IS CONFUSINGLY SIMILAR TO OPPOSER'S REGISTERED TRADEMARK "OKES (STYLIZED WITH THE REPRESENTATION OF A BULB AS THE LETTER O)" UNDER THE SAME CLASS.

The trademark application subject of opposition was filed during the effectivity of Republic Act No. 8293 otherwise known as the Intellectual Property Code of the Philippines. Thus, the applicable provision of law in resolving the issue involved is Sec. 123.1 (d) of R.A. 8293, which provides:

"Sec. 123. *Registrability.* – 123.1 A mark cannot be registered if it:

xxx

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or
- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

xxx

(Emphasis Ours.)

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner or display. Inspection should be undertaken from the viewpoint of prospective buyer. The trademark complained or should be compared and contrasted with the purchaser's memory (not in juxta position) of the trademark said to be infringed (87 C.J.S., pp. 288-291). Some factor such as sound, appearance, form, style, shape, size or format, color; ideas connoted by the marks, the meaning, spelling and pronunciation of the words used; and the setting in which the words appear may be considered, (87 C.S. pp. 291-292). For indeed, trademark infringement is form of unfair competition. (CLARKE VS MANILA CANDY CO., 36 PHIL. 100, 106; CO TIONG SA VS DIRECTOR OF PATENTS, 95 Phil. 1, 4)

Confusion is likely between trademarks only if their over-all presentation in any of the particular of sounds, appearance or meaning are such as would lead the purchasing public into believing that the products to which are applied emanated from the same source.

Firstly, let use examine the over-all presentation of the contending marks. The two trademarks in question as shown in the submitted drawings and documents on record by respondent-applicant and as appearing in the Certificate of Registration issued in favor of the opposer (Exhibit "A"), palpably shows that the two marks are identical in all aspect: as to sound, spelling, pronunciation, the manner of display, the font and the design contained therein as part of the mark. The presence of "Chinese characters" in respondent-applicant's subject mark does not prove any remarkable distinction vis-à-vis opposer's registered trademark.

Second point, the contending marks *like peas in a pod*, have identical goods. Opposer's goods, as provided for under the Certificate of Registration (Exhibit "A") fall under Class 11 which

includes fluorescent lamps, bulbs, emergency lights, and other lighting fixtures namely: energy conservation lights, lamp shades, dome lights, and night lights.

Respondent-applicant's goods on the other hand, as indicated in the application for registration likewise fall under Class 11 and includes lighters, light bulbs, lamps, lighting apparatus and installation, ceiling lights, globes for lamps, safety lamps, lamp hanging supports, energy saving lamps, emergency lights (lights with storage battery).

Thus, the goods of the opposer and the respondent-applicant serve the same purpose and flow through the same channels of trade. They are considered identical and competing goods.

Thirdly, another vital consideration is the fact that the herein opposer has filed with the Intellectual Property Philippines, this Office, the registration of the mark "OKES (Stylized with the Representation of a bulb as the letter O)" on 28 May 2002 which application matured to Registration No. 4-2002-004254.

On the other hand, respondent-applicant filed its trademark application for the registration of the mark "OKES (STYLIZED) AND CHINESE CHARACTERS", subject of the instant opposition proceedings only on 14 April 2005, much later than the filing date of the opposer's application.

Verily, from the circumstances as stated, it can be concluded that the respondent-applicant copied and adopted the trademark of the opposer.

In connection with the use of a confusingly or identical mark, both foreign authority and our most honorable Supreme Court in several occasions ruled, thus:

"Those who desire to distinguish their goods from the goods of another have a broad field from which to select a trademark for their wares and there is no such poverty in the English language or paucity of signs, symbols, numerals etc., as to justify one who really wishes to distinguish his products from those of all others entering the twilight zone of a filed already appropriated by another." (WECO PRODUCTS CO. VS MILTON RAY CO., 143 F. 2d 985, 32 C.C.P.A. Patents 1214.)

"Why of the million of terms and combinations of letters and designs available, the appellee had to choose those closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark."
(AMERICAN WIRE & CABLE CO. VS DIRECTOR OF PATENTS, 31 SCRA 544)

Furthermore, "a boundless choice of words, phrases and symbols is available to one who wishes a trademark sufficient unto itself to distinguish his products from those of others. When, however, there is no reasonable explanation for the defendant's choice of such a mark though the field for his selection was so broad, the inference is inevitable that it was chosen deliberately to deceive." (III, Callman, Unfair competition, 2nd Ed., pp. 1527-1528)

Ergo, considering that the trademark applied for by the respondent-applicant is the very same word and has exactly the same appearance as that of opposer's mark over the same goods and that the choice and adoption of which has no reasonable explanation, hence, confusing similarity among the buying public is necessarily be expected.

In the light of the foregoing and under the language of the applicable law and rules, this Bureau finds that the respondent-applicant is not entitled to register the mark "OKES (STYLIZED) AND CHINESE CHARACTERS".

WHEREFORE, the Opposition is hereby SUSTAINED. Consequently, trademark application serial no. 4-2005-003396 for the trademark "OKES (STYLIZED) AND CHINESE CHARACTERS" under Class 11 filed on 14 April 2005 is hereby REJECTED.

Let the filewrappers of the trademark "OKES (STYLIZED) AND CHINESE CHARACTERS" subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 4 April 2007.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office