

OSRAM, GmbH
Opposer,

PETITION FOR CANCELLATION

INTER PARTES CASE NO. 1191

- versus -

Cert. of Regn. No. SR-2704
Issued : December 16, 1976
Registrant : Tri-Lux Manufacturing Corporation
Trademark : OSRAM-PHILIPS
Used on : Ballasts, fuses, transformers, soldering iron and starters

-versus-

-and-

INTER PARTES CASE NO. 1295

- versus -

Cert. of Regn. No. SR-850
Issued : June 17, 1977
Registrant : Tri-Lux Manufacturing Corporation
Trademark : OSRAM-PHILIPS
Used on : Buzzers, bells, switches, outlets, wires and cables, plates and plugs

TRI-LUX MANUFACTURING CORPORATION,
Respondent-Registrant.

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DECISION NO. 88-84(TM)
August 18, 1988

DECISION

Captioned cases pertain to Petitions for Cancellation filed by Osram GmbH (Petitioner), a corporation duly organized under the laws of the Federal Republic of Germany and doing business at 16, Oudenarder Strasse D-1 Berlin 65, and 1, Hellabrunner Strasse D-8, Munchen 90, Federal Republic of Germany, seeking the cancellation of Certificates of Registration Nos. SR-2704 and SR-2850 issued on December 16, 1976 and June 17, 1977 for the registration of the trademark "OSRAM-PHILIPS" used on ballasts, fuses, transformers, soldering iron and starters in Class 20 and 16; and buzzers, bells, switches, outlets, wires and cables, plates and plugs in Classes 6 and 9, respectively, both issued in favor of Tri-Lux Manufacturing Corporation (Respondent-Registrant), a corporation organized under the laws of the Philippines and with business address at 631 Muelle de Binondo, Manila.

The common grounds alleged in the Petition are:

"1. That the registration of the trademark "OSRAM-PHILIPS" for 'ballast, fuse, transformer, soldering iron and starter' is contrary to the provisions of Section 4(d) Chapter II of Republic Act No. 166, as amended.

2. That the petitioner is the owner of the following Philippine Certificate of Registration:

- a. Certificate of Registration No. 9751 B.C issued on October 1, 1929, and 1980 under the Certificate of Renewal Registration No. 24 for OSRAM (Label), for 'lighting, heating and ventilating apparatus, electric lamps of all kinds, their parts and accessories', in Class 35;
- b. Certificate of Registration No. 11729 B.C issued on May 15, 1934, and which was renewed on May 6, 1965 under Certificate of Renewal Registration No. 225-A for OSRAM Label, for 'lighting, heating and ventilating apparatus, electrical lamps of all kinds, their parts and accessories, in Class 35; and
- c. Certificate of Registration No. 8296 issued on June 2, 1960 for OSRAM (word) for 'heating, lighting, and ventilating apparatus, electric lamps of all kinds, their parts and accessories', in Class 35.

3. that the trademark "OSRAM-PHILIPS" of TRI-LUX MANUFATURING CORPORATION, when applied to or used in connection with the goods of the Petitioner causes or shall cause confusion and mistake, and deceives or shall deceive purchasers as to the source and origin of the goods, and enables or shall enable unscrupulous dealers to pass of the goods of TRI-LUX MANUFACTURING CORPORATION for those of the Petitioner herein to the injury of both the Petitioner and the buying public."

Upon receipt of the verified Petitions for Cancellation on December 20, 1978 and July 26, 1979, which were denominated as Inter Partes Cases Nos. 1191 and 1295, respectively, the Office sent separate copies of the said Petitions to Respondent-Registrant requiring an Answer to same within fifteen (15) days from receipt thereof.

Respondent-Registrant filed its Answers seasonably denying all the material allegations made in said Petitions.

The pre-trial conference of Inter Partes Case No. 1191 was deferred because of a pending case between the parties on the same subject in the Court of First instance of Manila, Brach XIII.

Later, the two cases (Inter Partes Cases Nos. 1191 and 1295), upon motion of the parties, were consolidated on Office Order No. 82-221 dated June 21, 1982.

Thereafter, the Withdrawal of Appearance filed by Attys. Ferrer and Magno as counsel for Respondent-Registrant with the Conforme of Tri-Lux Manufacturing Corporation was made of record, per Office Order No. 82-246 dated June 30, 1982. In subsequent hearings, Respondent-Registrant or its counsel did not appear any more.

Petitioner was thus allowed to present its evidence ex parte consisting of Exhibits "A" to "K".

As these to cancellation cases (Inter Partes Cases Nos. 1191 and 1295) were being heard, another opposition case (Inter Partes Case No. 1197) for the same trademark "OSRAM-PHILIPS" involving the same parties (Tri-Lux Manufacturing Corp. as Respondent-Applicant vs. N.V. Philips Gloelampenfabiken as Opposer and Osram GmbH as Intervenor/Opposer) and the same issues (confusing similarity) was filed, heard and decided on the merits ahead of the herein said two (2) cases.

In said case (Inter Partes Case No. 1197), this Bureau found that:

"Intervenor-Opposer (OSRAM GmbH) also obtained Philippine Certificate of Registration No. 24 issued on January 14, 1960 which was renewed under Certificate of

Renewal No. 2572 (Exh."A") for Osram label for electric lamps of all kinds, their parts and accessories in International Class 9; Philippine Certificate of Registration No. 11729-B.C. issued on May 15, 1934 but renewed on April 10, 1964 under Certificate of Renewal Registration No. 225 with a new Certificate No. 225-A issued on May 6, 1965 and renewed once more under Certificate of Renewal No. 3394 issued on September 7, 1984 (Exh. 'B') likewise for OSRAM label for lighting, heating and ventilating apparatus, electric lamps of all kinds, their parts and accessories in International Class 9.

Respondent-Applicant's mark 'OSRAM-PHILIPS' under Application Serial No. 30980 filed on October 25, 1976 for soldering iron, transformers and ballasts is evidently a combination of two registered marks "OSRAM" and "PHILIPS" belonging to Intervenor and the Opposer herein. This is a clear deception committed by Respondent-Applicant designed on the buying public which will consequently inflict damage to the business of the Opposer and the Intervenor.

Respondent-Applicant's mark is clearly unregistrable under Section 4(d), supra.

WHEREFORE, in view of the foregoing, Inter Partes Case No. 1197 (Opposition) is GRANTED. Accordingly, Application Serial No. 30980 filed on October 25, 1976 by the herein Respondent-Applicant for the trademark "OSRAM-PHILIPS" for use on soldering iron, transformers and ballasts under International Class 9 is REJECTED." (Decision No. 88-39-TM, June 29, 1988)

The subject of Inter Partes case No. 1197 was an attempt of herein Respondent-Registrant to raise its mark from Supplemental Register to the Principal Register Category. The decision in Inter Partes Case No. 1197 has already become final.

WHEREFORE, the elements of res judicata clearly obtaining herein, these two (2) Petitions for cancellation cases (Inter Partes Cases Nos. 1191 and 1295) are hereby GRANTED. Accordingly, Certificates of Registration Nos. SR-2704 and AR-2850 for the trademark "OSRAM-PHILIPS" issued in favor of herein Respondent-Registrant are hereby ordered CANCELLED from the Trademark Registry of this Bureau.

Let the records of these cases be forwarded to the Patent/Trademark Registry and EDP Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director