

SANSUI DENKI KABUSHIKI
KAISHA, d/b/a SANSUI
ELECTRIC CO., LTD.,
Opposer,

INTER PARTES CASE NO. 1796

OPPOSITION TO,

- versus

Application Serial No. 39442
Filed : September 18, 1979
Applicant : Victoriano Liu
Trademark : SANSUI & DEVICE
Used on : Lamps, table lamps,
reading lamps in Class 11

VICTORIANO LIU,
Respondent-Applicant.
x-----x

DECISION NO. 88-69 (TM)
August 8, 1988

DECISION

On December 27, 1983, Sansui Denki Kabushiki Kaisha, a Japanese corporation, filed an Unverified Notice of Opposition (Inter Partes Case No. 1796) to Application Serial No. 39442 for the trademark "SANSUI & DEVICE" used on lamps, table lamps and reading lamps (Class 11), which application was filed on September 18, 1979 by Victoriano Liu, a Filipino citizen, and published in the Official Gazette (Vol. 79, No. 35, Page 4908) which was released for circulation on October 28, 1983.

On February 27, 1984, opposer filed its Verified Notice of Opposition alleging the ground, among others, that the registration of Respondent-Applicant's trademark "SANSUI & DEVICE" would violate Section 4(d) of Republic Act 166, as amended.

For failure to file an Answer, and upon Opposer's motion, Respondent-Applicant was declared in default. Accordingly, Opposer was allowed to present its evidence ex-parte (Order No. 84-348).

Opposer alleges that Respondent-Applicant's trademark application should be denied registration under Section 4(d) of Republic Act 166, as amended, and Article 6bis of the Paris Convention for the following reasons (1) that Respondent-Applicant's trademark "SANSUI & DEVICE" (Exh. "B") is similar or identical to Opposer's trademark "SANSUI" (Exh. "A"); (2) that Respondent-Applicant's similar or related to Opposer's good (electronic equipment under Classes 9 and 15; Exh. "A"), and both goods are sold in the same channels of trade (Affidavit of Isamu Mitani, Exh. "C"); and (3) that Opposer's trademark "SANSUI" is well known throughout the world, including the Philippines (Exh. "C").

An examination of Respondent-Applicant's trademark "SANSUI & DEVICE" discloses that its dominant feature is "SANSUI" and the design portion is not significant. Thus:

"Word portion is generally dominant and most significant portion of composite mark since purchasers would normally call for goods by referring to word or words rather than to design element." (Inter National Cycle Service Inc., 194 USPQ 97)

"Word portion of mark that consists of both word and design features is portion utilized in calling for goods, and is most likely to be impressed upon purchaser's memory and to serve as indicium of origin." (In re Mack, 197 USPQ 755)

Although Respondent-Applicant's trademark "SANSUI & DEVICE" is used on lamps, table lamps and reading lamps under Class 11 (Exh. "B"), while Opposer's trademark "SANSUI" is used on encoders, decoders, transducers, channel dividers, head-phones, tapes, discs, record players and tape recorders under Classes 9 and 15 (Exh. "A"), the likelihood of confusion, mistake or deception upon purchasers as to the source or origin of Respondent-Applicant's goods cannot be avoided considering the identity of "SANSUI", the dominant feature in both marks, and that the goods are related because they flow through the same channels of trade.

Note that Section 4(d) of Republic Act 166 as amended, does not require that the goods of the previous user and later user of the mark should possess the same descriptive properties or fall under the same categories as to bar the registering of the later mark in the Principal Register. The likelihood of confusion, mistake or deception upon purchasers would suffice. (See *Sta. Ana vs. Maliwat*, 24 SCRA 67.) Thus, it has been ruled that:

"There is no requirement that goods or services be identical or even competitive in nature in order to find that likelihood of confusion exists; rather, it is sufficient that there be some relationship between involved goods or services and/or that circumstances surrounding their marketing would cause them to be encountered by same persons who might, because of similarity of marks, mistakenly believe that they have common origin or are somehow associated with the same producer." (*Mine Safety Appliances Co. vs. Management Science America, Inc.*, 212 USPQ 105)

Moreover, Opposer's trademark "SANSUI" is well known internationally and in the Philippines, as evidenced by its worldwide advertisements (Exh. "C") and continuous use in the Philippines for almost 24 years (first used in the Philippines on December 1, 1964; Exh. "A"). Therefore, Opposer deserves protection under Article 6bis of Paris Convention.

In *Ang vs. Teodoro*, 174 Phil. 50, the Supreme Court has ruled that:

"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 the 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 trend is to give emphasis to the unfairness of the acts and to classify and treat the issue as a fraud."

WHEREFORE, the Opposition is GRANTED; Application Serial No. 39442 filed by Victorino Liu is DENIED.

Let the records of this case be remanded to the Trademark Examining Division for appropriate action in accordance with this Decision

SO ORDERED.

IGNACIO S. SAPALO
Director