

SUN LIFE ASSURANCE COMPANY
OF CANADA,

Opposer,

-versus -

P.T. KOTAMAS JAYARAYA
Respondent-Applicant

x-----x

IPC 14-2005-00123

Opposition to:
TM Application No. 4-2003-010459
(Filing Date: 13 November 2003)

TM: "SUN LIFE & DEVICE"

Decision No. 2007-80

DECISION

This pertains to the Notice of Opposition to the registration of the mark "SUN LIFE & DEVICE" bearing Application Serial No. 4-2003-010459 filed on 13 November 2003 for goods falling under Class 21, used for plate, bowl, glass, cup, mug, small tray, spoon fork container, dish, glass lid and coaster for glass, drinking device, and plate rack, all of the aforesaid goods made of plastic, which application was published and released for opposition on June 29, 2004 of the Intellectual Property Office (IPO) Electronic Gazette.

The Opposer in the above-entitled case is SUN LIFE ASSURANCE COMPANY OF CANADA, a corporation organized and existing under the laws of Canada with office address at 150 King Street W., Suite 1400, Toronto, ON M5H 1 J9.

On the other hand, Respondent-Applicant is P.T. KOTAMAS JAYARAYA with address on record at JL. Bumi, Mas I No. 5 Kawasan Industri, Cikupa Mas II, Talaga, Cipuka Tangerang, Indonesia.

Accordingly, the grounds for opposition are as follows:

"1. The trademark "SUN LIFE & DEVICE" of the Respondent-Applicant so resembles the trademark "SUN LIFE" of the Opposer that the use of "SUN LIFE & DEVICE" on goods in Class 21 would indicate a connection between said goods and those of the Opposer to the damage and prejudice of the Opposer's goodwill and interests. In other words, the use of Respondent-Applicant's "SUN LIFE & DEVICE" will cause confusion or mistake upon, or deceive purchasers in that the purchasers will tend to believe that the Respondent-Applicant's goods are those of, or coming from the Opposer. Hence, under Section 123.1 (d), (e) and (f) and Section 147 of Republic Act No. 8293 (Intellectual Property code of the Philippines), the trademark "SUN LIFE & DEVICE" cannot be registered in favor of the Respondent-Applicant.

"2. Opposer has registered/applied for the registration of the trademark "SUN LIFE" and its variants in different countries of the world, including the Philippines, and has already spent much for the advertisement and promotion of the trademark "SUN LIFE" and its variants. Hence, Opposer's business and goodwill will clearly be damaged and will suffer irreparable injury by the registration and use of a confusingly similar mark "SUN LIFE & DEVICE" by the Respondent-Applicant.

"3. The Respondent-Applicant acted in bad faith when it filed its application for the registration of the mark "SUN LIFE & DEVICE" having been aware of the prior existence of the Opposer's mark and tradename "SUN LIFE". Because of the long, continuous, open and extensive use in the Philippines and several countries of the word "SUN LIFE" and its variants, Respondent-Applicant could not feign ignorance of the tremendous prestige and goodwill already amassed by the Opposer's marks and

tradename. Out of all the words in the English dictionary and the available design and devices, why did Respondent-Applicant choose "SUN LIFE" unless it intends to ride on the popularity of the Opposer's marks or to pass to the buying public its products as those of the Opposer?

"4. Canada, the country where Opposer is a subject, is a member of the Convention of Paris for the Protection of Industrial Property (Paris Convention) and the World Trade Organization (WTO). It is also a signatory to the Trade Related Aspects of Intellectual Property Rights Agreement (TRIPS). If Respondent-Applicant's Trademark Application Serial No. 4-2003-010459 is allowed to proceed to registration, it is not only the provisions of the Intellectual Property (IP) Code of the Philippines to the international community through its accession to the Paris Convention and membership with the World Trade Organization (WTO) and as signatory to the Trade Related Aspects of Intellectual Property Rights Agreement (TRIPS).

"5. That the subject mark "SUN LIFE" constitutes the tradename of herein Opposer. As such, this tradename should be protected pursuant to Art. 8 of the Paris Convention and Section 165 of the new IP Code.

In support of the above opposition, Opposer relied on the following facts and circumstances:

"1. The trademark "SUN LIFE & DEVICE" of the Respondent-Applicant is confusingly similar with the trademark "SUN LIFE" of the Opposer in terms of their general appearance, overall impression, sound and pronunciation;

"2. The use by Respondent-Applicant of the confusingly similar mark "SUN LIFE & DEVICE" on its goods would indicate a connection between those goods and the Opposer, thereby damaging the interests of the latter;

"3. Opposer has obtained and filed several registrations and trademark applications, respectively, for the trademark/service mark "SUN LIFE" in different countries of the world and in the Philippines;

"4. The trademark "SUN LIFE" has been popularized and promoted internationally in different media of advertisement at the great expense of the Opposer;

"5. "SUN LIFE" is a recognized well-known mark of the Opposer not only in Canada and the United States of America, but also in most countries of the world that are member of the Paris Convention and the WTO like the Philippines. Hence, the Opposer is entitled to the mantle of protection afforded under the said Paris Convention and WTO/TRIPS;

"6. Considering that the Opposer's trademark "SUN LIFE" is known both locally and internationally, the Opposer deserves protection under the Intellectual Property (IP) Code of the Philippines, particularly Sections 123, 134, 147 and relevant Sections thereof; and

"7. The IP Code of the Philippines mandates the rejection of the Respondent-Applicant's Trademark Application Serial No. 4-2003-010459 under above circumstances."

On November 11, 2005, a Notice to Answer was sent to the Respondent-Applicant through registered mail requiring the latter to file its Verified Answer within thirty (30) days from receipt thereof.

On November 16, 2005, Respondent-Applicant received the Notice to Answer and despite receipt of the same, the latter neither filed its Verified Answer nor any motion relative thereto. Thus, considering that no Answer has been filed and that this case is mandatorily covered by the summary rules, Opposer was directed to file its evidences in the required form and duly marked in accordance with Section 7 and Subsection 7.1 of Office Order No. 79.

In a Manifestation of Compliance dated April 18, 2006, Opposer manifested that it has already submitted its evidences in compliance with Office Order No. 79 as early as October 26, 2005, together with the filing of the Verified Notice of Opposition, which includes the following exhibits:

Exhibit	Description
"A"	Affidavit of Esther C. Tan
"B"	Chart showing the trademark applications and registrations of Sun Life and its variants in the Philippines
"C"	Certified true copy of Trademark Registration No. 4-1999-007985 for the mark "SUN LIFE PROSPERITY BALANCED FUND"
"D"	Certified true copy of Trademark Registration No. 4-1999-007984 for the mark "SUN LIFE PROSPERITY BOND FUND"
"E"	Certified true copy of Trademark Registration No. 4-1999-007986 for the mark "SUN LIFE PROSPERITY PHILIPPINE EQUITY FUND"
"F"	Chart showing the worldwide trademark applications and registrations of the company
"F-1"	Certified copy of Canadian Trademark Registration No. TMA 519, 009 for "SUN LIFE" whose date of first use is 17 May 1882
"F-2"	Certified copy of U.S. Trademark Registration No. 2,760,810 for "SUN LIFE" whose date of first use is 1895

On May 15, 2006, Opposer filed its position paper hence, this case is now deemed submitted for decision.

The main issue presented to this Bureau for resolution is:

Whether or not Respondent-Applicant's "SUN LIFE & DEVICE" mark is confusingly similar to Opposer's mark "SUN LIFE" in respect of the classification of goods and of other relevant circumstances.

It should be noted that the trademark application being opposed was filed on November 13, 2003 or 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 Section 123.1 (d) of R.A. 8293, which provides that:

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

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

- a. The same goods or services, or
- b. Closely related goods or services, or
- c. If it nearly resembles such a mark as to be likely to deceive or cause confusion;

x x x

It is an established doctrine in Trademarks Law that in resolving issues of identical trademarks on products emphasis should be on the similarity of the products involved and not on the arbitrary classification or general description of their properties or characteristics. The mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on unrelated articles of a different kind.

In the present opposition proceeding, it is undeniable that the competing marks of Opposer and Respondent-Applicant both contain the word “SUN LIFE”. However, as established in several jurisprudence, the mere adoption and use of one person of a trademark as similarity and origin of the product as well as the target market are taken into consideration in determining whether likelihood of confusion is likely to arise by the adoption of the same trademark.

Applying the above tenets, the question now lies as to whether the goods of Respondent-Applicant under Class 21 is related or indicate a connection with the goods or services of the Opposer falling under Class 36.

For better appreciation of the contending marks, the goods/services of the Opposer for the trademark “SUN LIFE” as appearing in its Certificates of Registration are hereby reproduced to include the following services falling under Class 36, to wit:

“Mutual fund services”

On the other hand, Respondent-Applicant’s “SUN LIFE & DEVICE” mark includes the following goods falling under Class 21, namely:

“Plate, bowl, glass, cup, mug, small tray, spoon fork container, dish, glass lid and coaster for glass, drinking device, and plate rack, all of the aforesaid goods made of plastic”

Unquestionably, Opposer’s trademark “SUN LIFE” covers mutual fund services while that of Respondent-Applicant’s “SUN LIFE & DEVICE” trademark includes goods classified as small domestic utensils and containers made of plastic.

Considering the goods covered by the contending marks and the target market of the Opposer and Respondent-Applicant there is no doubt that their goods are not competing and unrelated to each other and flow through different channels of trade. Basically, Opposer’s mark “SUN LIFE” caters services such as insurance generally offered to working professional while that of Respondent-Applicant’s “SUN LIFE & DEVICE” mark includes domestic utensils whose target market are usually the ordinary consumers. In addition, Opposer’s services are usually offered through an agent or person with knowledge or training in mutual fund services while Respondent-Applicant’s goods are generally offered and displayed in appliance center and sometimes in grocery or supermarkets.

Anent thereto, it has been held that goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes 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.

In general, Opposer's mark being engaged in mutual fund services has a different target market than that of Respondent-Applicant's trademark. From the viewpoint of an ordinary consumer, their goods/services cannot be confused with each other since they are not displayed or cannot be found on the same market.

The case of Canon Kabushiki Kaisha which basically presents the same scenario has resolved the issue of similar trademarks covering unrelated goods. In the said case, the Supreme Court has ruled that:

"Ordinarily, the ownership of a trademark or trade name is property right that the owner is entitled to protect as mandated by the Trademark Law. However, when a trademark is used by a party for a product in which the other party does not deal, the use of the same trademark on the latter's product cannot be validly objected to."

In the same case, the Supreme Court has the occasion to pronounce that, to wit:

"Undoubtedly, the paints, chemical products, toner and dyestuff of petitioner that carry the trademark CANON are unrelated to sandals, the product of private respondent. We agree with the BPTTT, following the Esso doctrine, when it noted that the two classes of products in this case flow through different trade channels. The products of petitioner are sold through special chemical stores or distributors while the products of private respondent are sold in grocery stores, sari-sari stores and department stores. Thus, the evident disparity of the products of the parties in the case at bar renders unfounded the apprehension of petitioner that confusion of business or origin might occur if private respondent is allowed to use the mark CANON".

Following the ruling of the Supreme Court in the above-mentioned case, it may be concluded that the exclusive right of Opposer in this case to use the trademark "SUN LIFE" is limited to the products covered by its certificate of registration. Thus, the adoption of the same mark by Respondent-Applicant will not cause confusion to the public considering that their marks unrelated goods or articles, hence, it will be moot and academic to discuss the claim of its mark SUN LIFE being internationally well-known mark.

In view thereof, the Opposer's Notice of Opposition must perforce be DENIED.

However, this Bureau cannot take for granted the inaction of Respondent-Applicant in defending its claim over the trademark "SUN LIFE & DEVICE". Such inaction of Respondent-Applicant is evidenced by its failure to file its Answer despite receipt of the Notice to Answer the Notice of opposition, contrary to the disputable presumption that "a person takes ordinary care of his concern", enunciated in Section 3 (d) of Rule 131 of the Rules of Court.

It was the Respondent-Applicant's option not to defend its case, contrary to the declared policy of the Supreme Court to the effect that "it is precisely the intention of the law to protect only the vigilant, not those guilty of laches."

Finally, as provided for under Sec. 230 of R.A. 8293, otherwise known as the Intellectual Property Code of the Philippines:

"Sec. 230. Equitable Principles to Govern Proceedings—

In all inter partes proceedings under this Act, the equitable principles of laches, estoppel, and acquiescence where applicable, may be considered and applied."

As defined in the dictionary, laches means "slackness or carelessness toward duty or opportunity or neglect to do a thing at the proper time."

WHEREFORE, premises considered, the Notice of Opposition is hereby DENIED. However, as enunciated in Sec. 3 (d) Rule 13 of the Rules of Court and the declared policy of the Supreme Court to protect only those who are vigilant not those guilty of laches pursuant to sec. 30 of R.A. 8293, Application bearing Serial No. 4-2003-010459 filed by Respondent-Applicant P.T. Kotamas Jayaraya on November 13, 2003 for the registration of the mark "SUN LIFE & DEVICE", under Class 21 used for plate, bowl, glass, cup, mug, small tray, spoon fork container, dish, glass lid and coaster for glass, drinking device, and place rack is, as it is, hereby considered ABANDONED by the Respondent-Applicant due to laches.

Let the filewrapper of the trademark "SUN LIFE & DEVICE" 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, 29 June 2007.

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