

Twentieth Century Fox Film Corporation  
Opposer,

-versus-

Synchro Industrial Corporation  
Respondent-Applicant,

x-----x

Inter partes Case No. 3943  
Opposition to :  
Serial No. : 81117  
Filed on : 10 June 1992  
Trademark : "UNIVOX"  
For : loudspeakers

DECISION NO. 99-45

## DECISION

This case pertains to an Opposition filed by Twentieth Century Fox Film Corporation against the application for registration of the Trademark "UNIVOX" of Synchro Industrial Corporation, herein Respondent based on the following grounds:

- "1.) The registration of the mark "UNIVOX" in the name of Respondent-Applicant is proscribed by Section 4 (d) of the Republic Act No. 166."
- "2.) Opposer is the registered owner of the marks "TWENTIETH CENTURY FOX" word, logo and design, having been the first to adopt and used the same in actual trade and commerce. Registrations in countries all over the world have been obtained, including the Philippines."
- "3.) The marks where Opposer herein originated and adopted are known and used in the Philippines and elsewhere. Its products and services carried under said marks had, through the years, earned international acclaim as the distinct reputation of high quality products and services."
- "4.) The mark "FOX" forms part of the tradename of Opposer thus, is accorded due protection under Article of the Paris Convention."

Opposer relied on the following facts to support its opposition:

- "1. Opposer was issued by this Honorable Office Certificates of Registration Nos. 39221, 43180, 45279, 41649 and R-305 covering Classes 9 and 41 for the marks "TWENTIETH CENTURY FOX" word, logo and design. Copies of said registration certificates are hereto attached and made parts hereof as Annexes "A", "B", "C", "D" and "E".
- "2. The mark "UNIVOX" of the Respondent-Applicant is a flagrant and veritable imitation of herein Opposer's marks as likely to cause confusion, mistake and deception to the buying public as to source and origin of the Respondent-Applicant's goods/services."
- "3. Opposer has invested tremendous amount of resources in the promotion of the "TWENTIETH CENTURY FOX" marks, i.e., advertisements in well-known newspapers, magazines, and other publications around the world. It is the resultant goodwill and popularity of Opposer's marks that Respondent-Applicant wishes to exploit and capitalize. Accordingly, the use and approval for registration of respondent-Applicant's mark will constitute an infringement or invasion of Opposer's property rights to its registered "TWENTIETH CENTURY FOX" marks which are protected by law. Such will most assuredly cause the dilution and loss of distinctiveness of Opposer's marks."

Twentieth Century Fox Film Corporation, herein Opposer, is a foreign corporation engaged in the business of production and distribution of motion picture films and television

programs. On January 31, 1936, it registered the trademark "Twentieth Century Fox" for its films with the Patent and Trademark Office of the United States (Exhibits "H", "H-1", and "H-2"). For more than fifty-five (55) years, said trademark has been used worldwide by Opposer in its products, by virtue of which the mark has acquired international notoriety and recognition. To protect its rights to the exclusive use of its trademark, Opposer registered the same mark with other countries of the world including the Philippines (Exhibits "C", "D", "P", "Q", "R", "S", "T", "U", and "V").

Opposer claims it has a better right to the exclusive use of the "FOX" mark being the prior user thereof. Opposer alleges that Respondent's trademark "UNIVOX" is confusingly similar to its "FOX" mark, both as to sound and style. According to Opposer, the separate "VOX" word of Respondent's "UNIVOX" is similarly pronounced as Opposer's "FOX" word, which is the dominant element of its "FOX" marks. Besides, considering that both of them deal with related goods, the buying public is likely to be misled or deceived as to the true origin of the goods.

Synchro Industrial Corporation, on the other hand, is a domestic corporation engaged in the business of manufacturing and distributing loudspeakers under the trademark "UNIVOX", which was registered in the Philippine Patent Office on September 15, 1975 (Exhibit "5"). Sometime in 1992, however, a notice of abandonment of its trademark was issued by this Office to the Respondent. In view thereof, Respondent re-filed the registration of its trademark "UNIVOX", which became the subject of this Opposition.

Respondent-Applicant contends there is no confusing similarity between Opposer's "FOX" mark and Respondent's "UNIVOX" mark since the Opposer's mark is not registered as "FOX" alone, but as "TWENTIETH CENTURY FOX". Besides, Opposer's "FOX" mark refers to an animal while Respondent's "UNIVOX" mark means single voice. Respondent did not dispute Opposer's prior and actual use of the mark "FOX" but questioned the Opposer's legal capacity to sue in the Philippine courts. During pre-trial, both parties agree to limit the issues to whether or not there is confusing similarity and whether the Opposer's and Respondent's products are related.

The primary issue to be resolved here is whether or not there is confusing similarity between the Opposer's "TWENTIETH CENTURY FOX" mark and the Respondent's "UNIVOX", and finding similarity in the marks, whether the products of the parties are related to as to mislead or deceive the public as to their origin.

In determining whether colorable imitation exists, jurisprudence has developed two kinds of tests – the Dominancy Test and the Holistic Test. The test of dominancy focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception and thus constitutes infringement, while the holistic test mandates that the entirety of the marks in question must be considered in determining confusing similarity (*Emerald Garment Manufacturing Corporation vs. Court of Appeals*, 251 SCRA 600, December 29, 1995). In *Bristol Myers Company vs. Director of Patents and United American Pharmaceuticals Inc.*, 17 SCRA 128, the Supreme Court held that in determining whether two trademarks are confusingly similar, the test is not simply to take their words and compare the spelling and pronunciation of said words. Rather it is to consider the two marks in their entirety, as they appear in their respective labels, in relation to the good to which they are attached.

Opposer alleges that the separate word "VOX" of Respondent's "UNIVOX" mark is similarly pronounced as "FOX", which is a dominant element of the Opposer's trademark.

This Office finds otherwise, "VOX" is pronounced as VOX with short "o" while "FOX" is pronounced as FOX (fax) with short a. Besides, Opposer's mark is "TWENTIETH CENTURY FOX" and that word FOX is not a prevalent feature of Opposer's mark hence, assuming for the sake of argument that FOX and VOX which is the last word in Opposer's composite mark and the last syllable in the Respondent's mark maybe similarly pronounced, the same cannot be confused with each other. Moreover, the marks are entirely different in spelling, meaning and in

the way they are presented (See Respondent's trademark application and Opposer's Exhs. "J" to "V"). FOX may refer to an animal while UNIVOX may mean single or one voice. Even their style of lettering and the manner of presentation are different. The letters of the Opposer's "FOX" mark are written in advancing shape, while Respondent's "UNIVOX" mark are written in receding shape. Therefore the test of dominancy as invoked by Opposer cannot be applied in this case.

Furthermore, Respondent's UNIVOX loudspeakers cannot be mistaken for TWENTIETH CENTURY FOX cinematographic films, videotapes, pre-recorded video cassettes and video disc in Class 9; and production and distribution of motion picture films, television programs in Class 41 considering that they are different products.

Finally, as testified by Respondent's witness, UNIVOX loudspeakers are being sold in the Philippines to retailers, assemblers, and repair shops for radio and television and that loudspeakers are audio devices and are being used as such (TSN page 15, April 10, 1996). On the other hand, the trademark TWENTIETH CENTURY FOX in so far as the buying public is concerned is generally associated with cinematographic films and videos, hence, confusion, mistake or deception in the minds of the buying public is unlikely.

WHEREFORE, premises considered, the instant Opposition, as it is hereby DENIED and this case is, as it is hereby, DISMISSED. Accordingly, Application Serial NO. 81117 for the registration of the trademark "UNIVOX" for loudspeakers filed by Respondent-Applicant Synchro Industrial Corporation is GIVEN DUE COURSE.

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

SO ORDERED.

Makati City, 28 December 1998.

ESTRELLITA BELTRAN-ABELARDO  
*Caretaker/Officer-In-Charge*