

ZENITH RADIO CORPORATION,
Opposer,

INTER PARTES CASE NO. 872

OPPOSITION TO:

- versus -

Application Serial No. 23218
Filed : January 19, 1973
Applicant : Jose Young
Trademark : Eastern ZENITH and
DEVICE
For : Gas stove

JOSE YOUNG,
Respondent-Applicant.

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DECISION NO. 88-1 (TM)
January 19, 1988

DECISION

Captioned case is an Opposition filed by Zenith Radio Corporation (hereinafter referred to as Opposer), a corporation organized and existing under the laws of the United States of America and doing business at 3620 Iron Street, Chicago, Illinois, U.S.A., against Application Serial No. 23218 filed on January 19, 1973 by Jose Young (hereinafter referred to as Respondent-Applicant), a Filipino citizen of Chinese origin, with business address at 555 Rosario Street, Binondo, Manila, Philippines, for the registration of the trademark "EASTERN ZENITH & DEVICE" for use on gas stoves.

According to the records, Opposer alleged the following as grounds for its Opposition:

"1. The Opposer is the owner of the trademark ZENITH, registered in the Philippine Patent Office with Certificate of Registration No. 6974 granted on November 21, 1958 claiming date of first use of the mark on October 31, 1918 and in trade and commerce in the Philippines on December 31, 1932 and is the owner of the trademark ZENITH in Lighting Flash Logo registered in the Philippine Patent Office with Certificate of Registration No. 6975 granted on November 21, 1958, claiming date of first use on October 31, 1918 and in trade and commerce in the Philippines on December 31, 1932, for, among other goods, 'electrical appliance'.

2. The trademark 'ZENITH' which the Opposer has created and adopted is so well-known in the Philippines and throughout the world that it is apparent that applicant had prior knowledge thereof and that applicant deliberately adopted a mark nearly identical to Opposer's mark in order to take advantage of the fame, reputation and goodwill of Opposer, which Opposer has created and established at great cost and by the superior quality of its products."

Pursuant to existing law and rules, a Notice to Answer was sent by the Office to Respondent-Applicant requiring the latter to answer the Opposition within fifteen (15) days from receipt thereof. Unfortunately, as borne out by the records, Respondent-Applicant failed to file his Answer within the prescribed time. Consequently, the Office, through an Urgent Ex-Parte Motion to Declare Respondent-Applicant in Default filed by the Opposer, issued an Order dated August 16, 1976 not only declaring Respondent-Applicant in default, but also allowing the Opposer to present its evidence ex-parte.

On October 5, 1976, the Opposer presented five (5) exhibits as its evidence, to wit:

Exhibits

- “All” - Certified true copy of Certificate of Registration No. 6974 for the trademark “ZENITH” issued in favor of the Opposer, Zenith Radio Corporation, in November 21, 1958. This exhibit is offered for the purpose of showing that the trademark "ZENITH" has been in use in commerce since October, 1918,
- “B” Another certified true copy of Certificate of Registration No. 6075 issued on November 21, 1958 for the trademark “ZENITH” issued in favor of Opposer, Zenith Radio Corporation for the purpose of showing that the trademark “ZENITH” has been in use since October, 1918 and was first used in commerce in the Philippines as early as December 31, 1982.
- “C” A brochure, entitled Zenith Solid State Radio showing the trademark “ZENITH” as used on radios, table clocks, television sets and others.
- “D” A brochure, entitled Zenith Black & White Television 1975 showing that the mark “ZENITH” is used on television, radios and wall clocks.
- “E” A brochure, entitled “ALLEGRO” showing the different uses of the trademark “ZENITH” as used on quality components and modular touch systems and amplifiers.

From the existing evidence and records, the only issue to be resolved in the instant case is whether or not Respondent-Applicant’s trademark “EASTERN ZENITH & DEVICE” is confusingly similar to Opposer’s trademark “ZENITH”.

At this juncture it is significant to state that since Respondent-Applicant failed to file his Answer he may be considered under the Rules of Court to have admitted the material allegations of the Opposer in its Opposition. Logically, the Office is inclined to resolve the case without dwelling at length on the merits of the Opposer's evidence and arguments. For purposes of emphasis, however, the Office deemed it appropriate to elucidate on some important points.

In considering the facts of the case in the light of the relevant and material trademark jurisprudence, the attention of the Office was directed to the so-called dominance theory which the Supreme Court has consistently applied in a host of similar cases. This theory provides in substance that if the competing trademarks contain the main or essential or dominant features of another by reason of which confusion and deception are likely to result, then infringement takes place. Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate.

Although there is no rule of thumb by which to determine whether the part of a trademark which has been copied is the salient or dominant part, the Supreme Court was prudent enough to come up with a declaration in the case of *Co Tiong Sa vs. Director of Patents*, 1954, 95 Phil. 1 that may serve as a guide for future decisions. In this case, the Supreme Court declared that “When an ordinary customer sees a label he retains in his mind the dominant characteristics or features or, central idea in the label and does not retain or simply forget the attendant discoloration, flourishes, or variations. The ordinary customer does not scrutinize the details of the label; he easily forgets and overlooks the details, but retains a general impression on the main features, the central figure on the striking characteristics.

Complementing the mentioned theory is the well-recognized trademark principle that in deciding whether one of two trademarks infringes the other, consideration should be given to the impression created by each mark as whole, not as dissected.

Applying the foregoing theory and principle to the instant case, the Office cannot help but focus its attention to the fact that both trademarks of the Opposer and the Respondent-Registrant possess the "ZENITH". At this point, it is well to note that the records will clearly bear out that the word "ZENITH" has been registered as a trademark under Certificate of Registration No. 6775 by the Opposer as early as November 21, 1958 for use on electrical appliances, machines and supplies. Records will further show that the said registration was renewed several times. It can thus be reasonably inferred that the Opposer has continuously used the trademark "ZENITH" for its goods. Because of the continuous use, it is not farfetched to say that the word of trademark "ZENITH" is already impressed in the minds of the purchaser as one which belongs to the Opposer.

Consequently, the use by Respondent-Applicant of the word "ZENITH" in his trademark is likely to cause confusion or deception on the part of the consuming public. Actually, even a cursory view of Respondent-Applicant's trademark "EASTERN ZENITH & DEVICE" will readily show that the Word "ZENITH" is prominently displayed. This enhances the possibility of confusion. Compounding this possibility is the fact that the goods upon which Respondent-Applicant's trademark is used are related to the goods of the Opposer.

In fine, the Office is of the opinion and so holds that the trademarks of Opposer and Respondent-Applicant are confusingly similar to each other. It necessarily follows that the allowance of Respondent-Applicant's Application Serial No. 23218 will run counter to the express provisions of Section 4(d) of the Trademark Law (Republic Act No. 166, as amended).

WHEREFORE, premises considered, this Opposition is, as it is hereby, SUSTAINED. Accordingly, Application Serial No. 23218 filed by Respondent-Applicant for the registration of trademark "EASTERN ZENITH & DEVICE" for use on gas stove is, as it is hereby, REJECTED.

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

SO ORDERED.

IGNACIO S. SAPALO
Director