



KENSONIC, INC.,
Opposer,

-versus-

VERONICA TENG,
Respondent-Applicant.

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} **IPC No. 14-2012-00150**
} Opposition to:
} Appln. Serial No. 4-2011-011669
} Date Filed: 29 September 2011
} **TM: "SAKURA & DEVICE"**

NOTICE OF DECISION

**NISCE MAMURIC GUINTO RIVERA
& ALCANTARA LAW OFFICES**

Counsel for the Opposer
8th Floor, 139 Corporate Center
No. 139 Valero Street, Salcedo Village
Makati City

SIOSON SIOSON & ASSOCIATES

Counsel for Respondent-Applicant
Unit 903 AIC-Burgundy Empire Tower
ADB Avenue corner Garnet & Sapphire Roads
Ortigas Center, Pasig City

GREETINGS:

Please be informed that Decision No. 2015 - 258 dated November 05, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 05, 2015.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs

KENSONIC, INC.,

Opposer,

- versus -

VERONICA TENG,

Respondent-Applicant.

IPC NO. 14 - 2012- 0150

Case Filed on: 5 May 2012

Opposition to:

Appln Serial No. 42011011669

Date filed: 29 September 2011

TM: "SAKURA & DEVICE"

DECISION NO. 2015 - 258

X-----X

DECISION

KENSONIC, INC. (Opposer)¹ filed an Opposition to Trademark Application Serial No. 4-2011-011669. The application filed by VERONICA TENG, (Respondent-Applicant)², covers the mark "SAKURA & FIVE PETAL FLOWER DEVICE," for use on "lights and lamps, namely: incandescent bulb, halogens, metal halides, mercury lamps, energy saving lamps (ESL), flourescent lamps, table lamps, Utype, emergency lights, compact flourescent, flood lights" under Class 11 of the International Classification of Goods³

The Opposer's pertinent allegations are quoted as follows:

"9. The allowance of the mark 'SAKURA & Device' subject of the instant Opposition will contravene Section 123.1, sub paragraph (d) of Republic Act No. 8293 x x x

"10. It is undeniable that the Opposed Mark (consisting of a large flower design on top of the word 'SAKURA') is substantially one and the same with the mark 'SAKURA', which has been used by Opposer since 1994 and which is already the subject of pending applications for registration before this Honorable Office, to wit: (a) Application No. 4-2001-005131 with a filing date of 18 July 2001; and (b) Application No. 4-2007-011902 with a filing date of October 2007. x x x

"10.1 The spoken element of the Opposed Mark is identical to the verbal portion of Opposer's 'SAKURA' mark. It is the spoken portion by which consumer would call for and refer to the goods. The identity between the two marks cannot be subverted by the mere expedient of adding the simple device of the flower or by the slight, almost unappreciable change in the letter font of the dominant portion of the mark which is the word 'SAKURA.' 'SAKURA' is a Japanese term for "cherry blossom." The flower design is the pictorial

¹ A corporation organized and existing under the laws of the Philippines with business address at Lot 3 T.S. Sarino Subdivision, Real St., Pulang Lupa, Las Pinas City.

² A Filipino with address at Unit A-4 No. 23 Sta Rosa Street, Quezon City.

³ *The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.*

representation of the Japanese word. Thus as a whole, the commercial impression generated and reinforced by the Respondent-Applicant's Mark is that of the term 'SAKURA', which is the Opposer's mark.

x x x

"12. Additionally, it has been held that if a mark comprises both a word and a design, and the design has not acquired a secondary meaning greater weight is often accorded to the word which would be used by purchasers in requesting the goods.

"13. Respondent-Applicant cannot lay claim to any alleged acquisition of secondary meaning, as there appears to be no semblance of use of the Opposed Marks by way of any sale or advertisement of the goods covered by the Opposed Application.

"14. Assuming arguendo that no such virtual identity exists, the possibility as to the likelihood of confusion or mistake in the public mind is still very real and apparent. Philippine jurisprudence has actually developed two (2) major test in determining similarity and likelihood of confusion of trademark resemblance x x x

"15. Applying the Dominancy Test to the instant case, Opposer emphasizes that, visually and/or aurally, there is no question that the essential and dominant feature of both marks is the word 'SAKURA.' x x x In the instant case, it cannot be denied that the marks 'SAKURA' and the 'SAKURA and Device' give the same visual and aural impressions to the public's mind in the light of the goods in which they are used by both the Opposer and the Respondent-Applicant. x x x The competing marks need only contain the main essential or dominant features of another and that confusion and deception are likely. x x x A consumer of goods at an electrical store will certainly ask for and will in all likelihood, refer to a product by name and will not be able to distinguish it from "the one with the flower device", considering that said flower device is merely a pictorial description of the word 'SAKURA.' x x x

"16. Assuming arguendo that the Totality or Holistic Test were to be applicable considering that the actual labels for either mark have not been submitted, a perusal of the marks (as contained in their respective application) will reveal that the word portion of the contending marks are exactly the same. Based on a holistic comparison of the marks, there is indeed a confusing similarity as the total impression conveyed by the Opposed Mark is that of 'SAKURA' flower, which is herein Opposer's word mark.

x x x

"18. Apart from the fact that the Respondent-Applicant's 'SAKURA & Device' mark is identical and/or confusingly similar to Opposer's mark 'SAKURA', it cannot likewise be denied that the goods intended to be covered by Respondent-Applicant's mark are related to herein Opposer's goods as to give rise to a likelihood of confusion. x x x

"20. The relatedness of Opposer's and Respondent-Applicant's respective goods is all too apparent. Opposer's goods include electronics goods and wares such as speakers, amplifiers, audio/video products, DVD and VCD players, equalizers, mixers, tape decks, tuners, video disc recorders, and other electronic goods, devices, equipment, accessories and products, all falling under International Class 9. Meanwhile, Respondent-Applicant's goods include lights and lamps, namely incandescent bulb, halogens, metal halides, mercury lamps, energy saving lamp, (esl) fluorescent lamps, table lamps, U type, emergency lights, compact fluorescent, flood lights under International Class 11. Although both groups of goods belong to different classes, it is undeniable that they are also both ordinary home retail electronic and/or electrical products. Both group of goods are usually sold through the same channels of trade, in the same home and/or electronic retail stores.

"21. Having confusingly similar marks on these goods will lead to confusion of goods and confusion of business. Being complimentary in nature, a likelihood of confusion is bound to occur as consumers will be led to believe that a single producer has produced both products, or that there is a connection between them, when in fact no connection whatsoever exists. It is settled that goods or services need not be identical or even competitive to support a finding that confusion is likely to result from the use of similar marks. It is sufficient that the goods are related to some manner as to give rise to the mistaken belief that they emanate from the same source. x x x

"22. Moreover, considering that herein Opposer has been found by this Honorable Bureau to have conclusively been in actual use of the 'SAKURA' mark since 1994 over electronic goods and devices (see Decision No. 2005-21), Opposer has the ineluctable right to enjoy protection in product and market areas that are within the normal potential

expansion of his business (McDonald's Corp and McGeorge Food Inc. vs. L.C. Big Mak Inc. 437 SCRA 10 [2004]). Respondent-Applicant's goods being complementary products to herein Opposer's goods, Opposer must be protected against possible invasion of his right to expand his business. x x x

"29. In the instant case, Opposer has clearly shown that confusion between the two mark is a very likely, if not a dangerous, possibility. Considering the confusing similarity (if not identity) of the two marks, and the close relation of the goods on which these marks are used, it is all too easy for the public to assume that herein Opposer has explained its business to include Respondent-Applicant's goods. Thus, Respondent-Applicant's use of the mark 'SAKURA & Device' will necessarily imply a connection or raise a plausible relation between Respondent-Applicant's goods and those of Opposer's and therefore greatly mislead the purchasing public and potential consumers into believing that Respondent-Applicant's goods are actually being offered by, originate from, or are under the sponsorship of herein Opposer, to the prejudice of both Opposer and its unsuspecting customers. x x x

"32. By virtue of Opposer's prior and continuous use of the 'SAKURA' mark in its own name and for its own behalf, Opposer is the party entitled to the registration of the said Mark, and not herein Respondent-Applicant.

"34. Under the former Philippine Trademark Law, the law in force at the time of Opposer's first use of the 'SAKURA' Mark in 1994, it is actual use in commerce which vest ownership over the mark. x x x

Therefore, by virtue of its actual and continuous use of the 'SAKURA' Mark since 1994, Opposer has already appropriated the said mark for its own.

"35. Opposer's ownership of the 'SAKURA' Mark is clearly recognized under the Intellectual Property Code. Under Section 236 thereof x x x

"36. The aforementioned Section 236 of the Intellectual Property Code draws conclusion that the rights of owners and prior users of unregistered trademark that were acquired in good faith prior to the Intellectual Property Code, which include the right to appropriate exclusive use of the trademark (Sec 2-1, Republic Act No. 166), the right to oppose or prevent the registration of the trademark in favor of others (Sec. 4(d), Republic Act No. 166) and more importantly, the right to file a petition for the cancellation of a registered mark which may cause undue damage to such owner or prior user (Section 17, Republic Act No. 166)"

In support of its Opposition, the Opposer submitted the following evidence:

1. Exhibit A – Secretary Certificate authorizing Ms. Nenita K. Tsang to sign Verification of the Notice of Opposition;
2. Exhibit B – Certification by IPOPHIL that the attached Decision dated 21 August 2008 is a true copy of the original document on file with IPOPHIL;
3. Exhibit B-1 – Decision Dated 21 August 2008 of BLA in IPC No. 14-2007-00177;
4. Exhibit C – Certification by the IPOPHIL that the attached Decision dated 29 November 2005 is true copy of the original on file with the IPOPHIL;
5. Exhibit C-1 – Decision dated 29 November 2005 of the BLA in IPC No. 14-2004-00160;
6. Exhibit D - Certification by the IPOPHIL that the attached Entry of Judgment/Execution of Decision dated 9 August 2006 is true copy of the original on file with the IPOPHIL;
7. Exhibit D-1 – Entry of Judgment / Execution of Decision in IPC No. 14-2004-00160;
8. Exhibit E – Decision dated 7 August 2008 of the BLA in IPC No. 14-2006-00183;
9. Exhibit F – Certification by the IPOPHIL that the attached Decision dated 21 August 2008 is a true copy of the original document on file with IPOPHIL;

10. Exhibit F-1 – Decision dated 11 August 2008 rendered in IPC No. 14 – 2006 – 00139;
11. Exhibit G – Certification by the IPOPHIL that the attached Decision dated 24 October 2008 is a true copy of the original document on file with IPOPHIL;
12. Exhibit G-1 – Decision dated 24 October 2008 of the BLA in IPC No. 14 – 2006 – 00126;
13. Exhibit H – Certification by the IPOPHIL that the attached Opposer Application for Registration No. 4-2001-005131 for Sakura mark with filing date of 18 July 2001 is a true copy of the original on file;
14. Exhibit H-1 – Opposer’s Application No. 4-2001-005131;
15. Exhibit I – Certification by the IPOPHIL that the attached Application No. 4-2007-011902 for registration of the Sakura mark is a true copy of the original on file with IPOPHIL;
16. Exhibit I-1 – Opposer’s Application No. 4-2007-011902;
17. Exhibit J – Certification by the IPOPHIL that the copy of the opposer’s Declaration of Actual Use annexed thereto is a true copy of the original on file with the IPOPHIL;
18. Exhibit J-1 – Opposer’s Declaration of Actual Use of the mark “SAKURA” from 22 October 1994 dated 22 October 2002;
19. Exhibit K – Duly notarized Affidavit of Ownership executed by Nenita Tsang, President of Kensonic, Inc;
20. Exhibit L – Copy certification issued by a Notary Public certifying that the attached Certificate of Registration is a true, accurate and complete copy of the original;
21. Exhibit L-1 – DTI Certificate of Registration of Audio Crown Enterprises dated 5 July 1991;
22. Exhibit M – Certification by the IPOPHIL that the attached Sales Invoice No. 7643 issued by Audio Crown Enterprises dated 14 December 1993 is a true copy of the original on file with IPOPHIL;
23. Exhibit M-1 – Sales Invoice No. 7643 issued by Audio Commercial Enterprises dated 14 December 1993;
24. Exhibit N – Certification by the IPOPHIL that the various Bills of Lading and Societe Generale de Surveillance Clean Report of Findings showing importation by Audio Crown Enterprises of various electronic and audio equipment annexed thereto are true copies of the original on file with IPOPHIL;
25. Exhibit N-1 to N-24 – Various Bills of Lading and Societe Generale de Surveillance Clean Report of Findings showing importation by Audio Crown Enterprises of various electronic and audio equipment;
26. Exhibit O – Articles of Incorporation of Kensonic, Inc;
27. Exhibit O-1 – Certified true copy of the General Information Sheet filed by Kensonic Inc. with the SEC on 3 May 2010;
28. Exhibit P to P-5 – Affidavits executed by the proprietors of Master Fix General Merchandise Lights & Sounds, Solid Electronics, Martcom Cellular & Electronics, Unitronic Marketing, Newport electronic Center, and Electrocom Electronic Supply;
29. Exhibit Q – Certification issued by the IPOPHIL that the various newspaper articles, their respective translations, and the certifications annexed thereto are true copies of the original on file with IPOPHIL as part of the records of IPC No.14-2010-00108;

30. Exhibit Q-1 – Certified true copy of the news article published by Kensonic, Inc. in page 10 of the September 2008 edition of the Gold Star Daily Cebu as part of advertising and publicity campaign;
31. Exhibit Q-2 – Certified True Copy of the news article published by Kensonic, Inc. in page B-6 of the 12 August 2008 issue of the Philippine Star as part of its advertising and publicity campaign;
32. Exhibit Q-3 – Certified true copy of the news article published by Kensonic, Inc. in page 16 of the 23 August 2008 issue of the Philippine Chinese Daily as part of its advertising and publicity campaign;
33. Exhibit Q-3a – Certified True Copy of the Certification issued by Ms. Magdalena Uy attesting that Exhibit “Q-3b) is a true, complete and accurate English translation of Exhibit “Q-3”;
34. Exhibit Q-3b – Certified true copy of the English translation of the news article published by Kensonic, Inc. in page 16 of the 23 August 2008 issue of Philippine Chinese Daily;
35. Exhibit Q-4 – Certified true copy of the news article published by Kensonic, Inc. in page 25 of the 14 August 2008 issue of the World News as part of its advertising and publicity campaign;
36. Exhibit Q-4a – Certified true copy of the Certification issued by Ms. Magdalena Uy attesting that Exhibit Q-4b is a true, complete and accurate English translation of Exhibit “Q-4”;
37. Exhibit Q-4b – Certified true copy of the English translation of the news article published by Kensonic, Inc. in page 25 of the 14 August 2008 issue of the World News;
38. Exhibit Q-5 – Certified true copy of the news article published by Kensonic, Inc. in page 9 of the 18 August 2008 issue of the United Daily News as part of its advertising and publicity campaign;
39. Exhibit Q-5a – Certified true copy of the Certification issued by Ms. Magdalena Uy attesting that Exhibit Q-5b is a true, complete and accurate English translation of Exhibit “Q-5”;
40. Exhibit Q – 5b – Certified true copy of the English translation of the news article published by Kensonic, Inc. in page 9 of the 18 August 2008 issue of United Daily News;
41. Exhibit R – Curriculum Vitae of Ms. Magdalena Uy;
42. Exhibit S – Certification by IPOPHL that the attached sales invoices nos. 6632, 6648, 19292, 4585, 4598, 7002, 8526, 71005, 83362, 97550, 97896, 01027, 00002, 00361, 01138 and 16990 are true copies of the original on file as part of the records of IPC No. 14-2009-00065;
43. Exhibit S-1 – Certified true copy of the Sales Invoice No. 6632 dated 16 September 1995 issued by Kensonic, Inc. for the sale of “Sakura TM -88” (a product under Exhibits “BB-8” and “CC-3”);
44. Exhibit S-2 – Certified true copy of the Sales Invoice No. 6648 dated 16 September 1995 issued by Kensonic, Inc. to Audio Tech Electronics for the sale of “Sakura TM -89 and Sakura – TC-88” (a product under Exhibits “BB-7” and “CC-2”);
45. Exhibit S-3 - Certified true copy of the Sales Invoice No. 19392 dated 7 December 1996 issued by Kensonic, Inc. to Sound Quest for the sale of “Sakura EQ133”;

46. Exhibit S-4 - Certified true copy of the Sales Invoice No. 4585 dated 30 October 1999 issued by Kensonic, Inc. to Kids Amusement 2000 for the sale of 5 pieces of "AM AV-2210" (a product under Exhibit "BB-1");
47. Exhibit S-5 - Certified true copy of the Sales Invoice No. 4598 dated 30 October 1999 issued by Kensonic, Inc. to Berkly Electronics for the sale of 2 pieces of "AM-AV318" (a product under Exhibit "BB-3");
48. Exhibit S-6 - Certified true copy of the Sales Invoice No. 7002 dated 22 September 1998 issued by Kensonic, Inc. to ITL Audio Electronics for the sale of "AV 2100";
49. Exhibit S-7 - Certified true copy of the Sales Invoice No. 8526 dated 13 January 2000 issued by Kensonic, Inc. to Berkly Electronics for the sale of "AM AV-2080", "AM AV-2000B", "AM AV-858" and "AM AV-810." (a product under Exhibits "AA-7", "AA-6", "AA-2" and "AA-2");
50. Exhibit S-8 - Certified true copy of the Sales Invoice No. 71005 dated 19 December 2003 issued by Kensonic, Inc. to Getz Electronics Sales Center for the sale of "AM AV-388" (a product under Exhibit "BB-5");
51. Exhibit S-9 - Certified true copy of the Sales Invoice No. 83362 dated 15 December 2005 issued by Kensonic, Inc. to SanJun Electronics for the sale of "AM AV 5020" (a product under Exhibit "AA-10");
52. Exhibit S-10 - Certified true copy of the Sales Invoice No. 97550 dated 20 December 2005 issued by Kensonic, Inc. to Deeco Electronics - Alabang for the sale of "AM AV-5023", "AM AV-387A", "AM AV-3022", "AM AV-389" and AM AV-732" (a product under Exhibits "AA-8", "AA-4", "AA-9", "AA-5" and "AA-1");
53. Exhibit S-11 - Certified true copy of the Sales Invoice No. 97896 dated 26 December 2005 issued by Kensonic, Inc. to SanJun Electronics for the sale of "AM AV-5021";
54. Exhibit S-12 - Certified true copy of the Sales Invoice No. 01027 dated 15 January 2007 issued by Kensonic, Inc. to Milysa Electronics for the sale of "AV-732" (a product under Exhibit "AA-1");
55. Exhibit S-13 - Certified true copy of the Sales Invoice No. 00002 dated 22 December 2006 issued by Kensonic, Inc. to Picsound Electronics Parts for the sale of "AV-5023" (a product under Exhibit "AA-8");
56. Exhibit S-14 - Certified true copy of the Sales Invoice No. 00361 dated 30 December 2006 issued by Kensonic, Inc. to RMJ Elec & Gen Mdse for the sale of "AV-5023" (a product under Exhibit "AA-8");
57. Exhibit S-15 - Certified true copy of the Sales Invoice No. 01138 dated 17 January 2007 issued by Kensonic, Inc. to Sound Quest Electronic Centre for the sale of "AV-733" (a product under Exhibit "AA-2");
58. Exhibit S-16 - Certified true copy of the Sales Invoice No. 16990 dated 29 January 2008 issued by Kensonic, Inc. to Bataan Trading for the sale of "AV-735" (a product under Exhibit "AA-2");
59. Exhibit T - Certification by IPOPHL that the attached sales invoices nos. 8386, 19436, 19408 and 4554 are true copies of the original on file as part of the records of IPC No. 14-2004-00160;
60. Exhibit T-1 - Certified true copies of the Sales Invoice No. 8386 dated 20 November 1995 issued by Kensonic, Inc. for the sale of "TC-89" (a product under Exhibit "CC-2");



61. Exhibit T-2 - Certified true copy of the Sales Invoice No. 19436 dated 14 December 1996 issued by Kensonic, Inc. to Berkly Electronics for the sale of "AV-2100" and "EQ -144";
62. Exhibit T-3 - Certified true copy of the Sales Invoice No. 19408 issued by Kensonic, Inc. to Pennylane Gen. Merchandise for the sale of "TM-88" and "TC-89" (a product under Exhibits "CC-2" and "CC-3");
63. Exhibit T-4 - Certified true copy of the Sales Invoice No. 4554 dated 29 October 1999 for the sale of "AV-810", "AV-2800", and "AV - 358" (a product under Exhibits "BB-2", "BB-1", and "BB-4");
64. Exhibit U - Affidavit executed by Tsang Wing Kuen, Vice President and Treasurer of Kensonic, Inc.;
65. Exhibit V - Certification issued by IPOPHL that the Memorandum of agreement dated 8 August 1994 and the corresponding English translation are true copies of the originals as part of the records of IPC No. 14-2010-00108.;
66. Exhibit V-1 - Certified true copy of the Memorandum of Agreement dated 8 August 1994 between Kensonic Inc. and Foshan Shaw Audio Electric Co. Ltd.;
67. Exhibit V-2 - Certified true copy of the certification of Ms. Magdalena Uy attesting that Memorandum of Agreement dated 8 August 1994 between Kensonic Inc. and Foshan Shaw Audio Electric Co. Ltd. are true complete and accurate English translation.;
68. Exhibit V-3 - Certified true copy of the English translation of the Memorandum of Agreement dated 8 August 1994 between Kensonic Inc. and Foshan Shaw Audio Electric Co. Ltd.;
69. Exhibit W - Certification issued by IPOPHL that the Memorandum of Agreement between Kensonic, Inc. and Xi Hua Audio Equipment Factory, the corresponding English translation are true copies of the originals as part of the records of IPC No. 14-2010-00108;
70. Exhibit W-1 - Certified true copy of the Memorandum of Agreement between Kensonic Inc. and Xi Hua Audio Equipment Factory;
71. Exhibit W-2 - Certified true copy of the certification of Ms. Magdalena Uy attesting that Memorandum of Agreement between Kensonic Inc. and Xi Hua Audio Equipment Factory are true complete and accurate English translation;
72. Exhibit W-3 - Certified true copy of the English translation of the Memorandum of Agreement between Kensonic Inc. and Xi Hua Audio Equipment Factory;
73. Exhibit X - Certification issued by IPOPHL that the Memorandum of Agreement between Kensonic, Inc. and Fine Star Acoustic Installation Factory Ltd, the corresponding English translation and certification annexed thereto are true copies of the originals as part of the records of IPC No. 14-2010-00108;
74. Exhibit X-1 - Certified true copy of the Memorandum of Agreement between Kensonic Inc. and Fine Star Acoustic Installation Factory Ltd.;
75. Exhibit X-2 - Certified true copy of the certification of Ms. Magdalena Uy attesting that Memorandum of Agreement between Kensonic Inc. and Fine Star Acoustic Installation Factory Ltd are true complete and accurate English translation;
76. Exhibit X-3 - Certified true copy of the English translation of the Memorandum of Agreement between Kensonic Inc. and Fine Star Acoustic Installation Factory Ltd.;
77. Exhibit Y - Bill of Lading No. HKMN /CFS-1022 dated 12 January 1994;
78. Exhibit Y-1 - Packing List No. 93CMS067 dated 12 January 1994;

79. Exhibit Y-2 – SGS Advance Clearance Report No.CHN046681 dated 13 May 1998;
80. Exhibit Y-3 – SGS Advance Clearance Report No.CHN043106 dated 13 February 1998;
81. Exhibit Y-4 – Original Certificate of Origin dated 17 October 1994;
82. Exhibit Z - Certification issued by IPOPHL that the letters and communications annexed thereto are true copies of the originals submitted to IPOPHL;
83. Exhibit Z-1 to Z-20 – Copies of various letters and communications between Kensonic and Waterwell Trading Co of Hongkong regarding the details of the Sakura product manuals;
84. Exhibit AA – Copy certification issued by Notary Public certifying that the attached brochure is true, accurate and complete copy of the original;
85. Exhibit AA-1 to AA-10 – Sakura products as shown in Sakura the Future of Entertainment Manual Vol. 3;
86. Exhibit BB – Copy certification issued by Notary Public certifying that the attached brochure is true, accurate and complete copy of the original;
87. Exhibit BB-1 to BB-8 – Sakura products as shown in Sakura the Future of Entertainment Manual;
88. Exhibit CC – Copy certification issued by Notary Public certifying that the attached brochure is true, accurate and complete copy of the original;
89. Exhibit CC-1 to CC-3 – Sakura products as shown in Sakura the Future of Entertainment Manual;
90. Exhibit DD – Copy certification issued by Notary Public certifying that the attached brochure, Sakura New Generation DVD Flyer, is true, accurate and complete copy of the original; and
91. Exhibit DD-1– Sakura New Generation DVD Flyer;

This Bureau issued a Notice to Answer to the Respondent-Applicant on 7 June 2012. Subsequently, the Respondent-Applicant filed its Answer on 27 July 2012 denying the material allegations of the Opposition. Respondent-Applicant further argued, as follows:

“4.1. Respondent filed Application Serial No. 4-2011-011669 on 29 September in good faith after she voluntarily surrendered her Registration No. 4-2006-001055 on September 28, 2011.

“4.2. Decision No. 2008-152 issued by the BLA Director in IPC No. 14-2007-00177 never became final as the subject thereof, Registration No. 4-2006-001055, was voluntarily withdrawn.

In addition the goods covered by the present application are different from the goods covered by Registration No. 4-2006-001055.

“4.3. Application SN 4-2011-011669 was examined and approved for publication in accordance with the provisions of the IP Code x x x

“4.4. The four (4) applications of respondent being opposed by opposer cover goods other than the goods covered by opposer’s Application SN 4-2001-005131.

“4.5. The four (4) applications of respondent being opposed are still pending x x x

“5.1 Opposer does not have the exclusive right to register and use the trademark SAKURA for all classes of goods, including goods falling under Class 11.

“5.2. Opposer did not create nor coin the word SAKURA. SAKURA is a Japanese word which means ‘Cherry Blossom’ x x x

“5.3. SAKURA is a very weak mark registered and/or applied for registration by other persons or entities for numerous kinds of goods falling under various classes x x x

“5.4. Decision No. 2005-21 rendered in IPC No. 14-2004-00160 is not binding on herein respondent. x x x Respondent was not a party to said inter partes case.

"5.5. To date, opposer has no registration for the trademark SAKURA. Its application SN 4-2001-005131 for goods falling under Class 09 is still pending, while its application SN 4-2007-011902 (Exhibit "1-1") also for goods falling under Class 09 was refused x x x

"6. Respondent's Application SN 4-2011-011669 is not proscribed under Section 123.1 (d) of the IP Code.

x x x

"6.2 As alleged in paragraph 3 of its Notice of Opposition, opposer deals with goods falling under Class 09, but not with goods falling under Class 11.

Opposer does not deal with the goods covered by respondent's Application SN 4-2011-011669.

"6.3 Respondent's goods falling under Class 11 are not related to opposer's goods falling under Class 09.

"6.4. The goods covered by respondent's application falling under Class 11, are usually not found in the same store as the goods of opposer falling under Class 09, and even if they are available in the same establishment, they are displayed of its Application SN 4-2001-005131.

"7. Respondent is not a party to the inter partes cases cited by opposer, namely:

"7.1. IPC No. 14-2004-00160 entitled: "Kensonic, Inc. vs. Uni-Line Multi Resources Inc. (Phil)" xxx

"7.2. IPC No. 14-2006-0013 entitled: "Kensonic, Inc. vs. Uni-Line Multi Resources Inc. (Phils)" xxx

"7.3 IPC No. 14-2006-00139 entitled: Kensonic, Inc. vs. Uni-Line Multi Resources Inc. (Phils). xxx

"7.4 IPC No. 14-2006-00126 entitled: "Uni-Line Multi Resources Inc. (Phils) vs. Kensonic, Inc." xxx

"8. The following exhibits of opposer do not comply with Office Order No. 79, as amended, namely:

"8.1 Exhibit M-1, which is mere photocopy of Sales Invoice No. 7643, without the original being presented for comparison. In addition, it was presented in a case where respondent was not a party.

"8.2 Exhibit N-1 to N-26 which are mere photocopies of bills of ladings, without the originals being presented for comparison. In addition, they were presented in a case where respondent was not a party.

"8.3. Exhibit "P-1" to "P-6", are self serving and pure hearsay, typed identically and signed by the alleged proprietors of business establishments located in Manila and notarized on two (2) different dates and in cities other than where their business are located. In addition, they were presented in a case where respondent was not a party.

"8.4. Exhibit "S-1" to "S-16" which are mere photocopies, without the originals thereof being presented for comparison. In addition, they were presented in a case where respondent was not a party.

"8.5. Exhibit "T-1" to T-4" which are mere photocopies, without the originals thereof being presented for comparison. In addition, they were presented in a case where respondent was not a party.

"8.6. Opposer's exhibits refer only to "amplifiers" and therefore, they are clearly immaterial and irrelevant to this case."

The Respondent-Applicant's evidence consists of the following:

1. Exhibit 1 – A copy of respondent's letter dated 23 September 2011 to the Bureau of Trademarks voluntarily surrendering Registration No. 4-2006-001055;
2. Exhibit 2 to 8 – Certified copies of the Application Form for Application SN 4-2011-011669; Registrability Report; Reply dated 25 November 2011; Paper No. 04 bearing mailing date of 26 January 2012; Reply dated 30 January 2012; Notice of Allowance; and Print out of its publication in the Trademark Electronic Gazette;

3. Exhibit 9 – Print out of Wikipedia showing that the word “SAKURA” is a Japanese word which means “Cherry Blossom”;
4. Exhibit 10 – Print out of Trademark Search showing the various applications and registrations for the trademark SAKURA;
5. Exhibit 11 – Print out of Trademark Search showing that Kensonic’s Application SN 4-2007-011902 for goods falling under Class 9 was refused; and
6. Exhibit 12 – Duly notarized affidavit of respondent Veronica D. Teng.

After the termination of the Preliminary Conference, the parties submitted their respective position papers on 15 November 2013.

The issue to be resolve in the instant case is whether the trademark “SAKURA & DEVICE” should be allowed for registration.

Under Section 123.1 of the Intellectual Property Code, it specifically provided that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date with respect to the same goods or services or closely related goods or services, or if it is nearly resembles such a mark as to be likely to deceive or cause confusion.

Records show that at the time Respondent-Applicant filed her trademark application on 29 September 2011, the Opposer has prior and existing trademark applications: application with serial no. 4-2001-0015131 filed on 18 July 2001 and application with serial no. 4-2007-011902 filed on 25 October 2007.

The Opposer’s applications covers “*amplifiers, DVD player, VCD Player, Tape Deck, Tuner Equalizer, Mixer, Digital Voice Recorder, Video Disc Recorder*” and “*Speaker, Baffles, Microphone, TV Wall Bracket, TV Booster Speaker Wire, Speaker Parts, Baffles Accessories, Car Security Devices, Headphone, Speaker Stand, Cable Wire, RCA Jack, Microphone Jack, Microphone Wire, Adaptor HDMI (High Definition Multi Video Interfacing) Speaker Wire, Digital Video Interfacing Cable, Crossover Network, Car Speaker, Television*” under Class 9.

The marks are depicted below:



Opposer’s Trademark



Respondent-Applicant’s Trademark

The marks are practically identical. The word “SAKURA” is the most prominent feature of both marks. The additional device containing a flower inside a box on the Respondent-Applicant’s mark is not sufficient to distinguish its mark from that of the Opposer. Furthermore, the “flower” device on the Respondent-Applicant is a mere

representation of the word mark itself and has no separate identity apart from the said word mark. Verily, the word "SAKURA", although written in different font-types, as reflected on both competing marks remains to be virtually the same and will leave similar impression on the buying public.

Corollary, this Bureau finds that the goods subject of the marks are closely related goods. They are electrical or electronic products that are usually found or sold through the same channel of trade or stores. It is not unusual to find electrical/electronic devices like video and music devices of the Opposer displayed together with the lights and lamp products of the Respondent-Applicant.

In this regard, this Bureau has consistently ruled in Inter Partes cases involving the herein parties and trademarks. In previous cases docketed as IPC No. 14-2007-00177, IPC No. 14-2010-00112 and IPC No. 14-2010-00108, this Bureau did not allow the registration of the Respondent-Applicant marks for being confusingly similar to the "SAKURA" mark of the Opposer who is the senior trademark-applicant. In those cases, the goods involve belong to Classes 9 and 11.

Moreover, this Bureau's decision in Inter Partes Case No. 14-2010-00112 was affirmed by the Director General on Appeal in Appeal Case No. 14-2013-0047. The Director General in that case sustained the right of Opposer Kensonic Inc. on goods falling under Class 9 and 11, and explicitly concluded that likelihood of confusion on the origin of the goods of the parties would likely subsist. The pertinent portion of the above Office of the Director General decision is quoted, to wit:

"It is noted that both parties deals with electrical and electronic products and devices. Thus, although the goods covered by the above-mentioned marks are different, they are not entirely unrelated. But even if this Office would agree to the proposition that there are differences in the nature of the goods of the Applicant and the Appellee, it is not farfetched that because of the similarity in these marks, there would be an impression that the Applicant's mark is owned by the Appellee or is just variation of the Appellee's mark. x x x

In this regard, the Appellant's goods may be assumed to originate with the Appellee and the public would then be deceived to believe that there is some connection between the Appellant and the Appellee, which, in fact does not exist. The likelihood of confusion would subsist not on the purchaser's perception of goods but on the origins thereof. Consequently, the registration of the Appellant's mark may cause damage to the Appellee which has no control over the Appellant's product covered by SAKURA & DEVICE.

The Appellee has shown that it has used its mark as early as 1994. Thus, it is not entirely remote that the Appellant knew of the mark SAKURA being used on electronic products. However, aside from alleging that she filed her trademark application in good faith, she did not explain how she arrived in using this mark."

Succinctly, because the Respondent-Applicant will use his mark on goods that are similar and/or closely related to the Opposer's, the consumer is likely to assume that the Respondent-Applicant's goods originate from or sponsored by the Opposer or believe that there is a connection between them, as in a trademark licensing agreement. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:⁴

⁴ Converse Rubber Corporation vs. Universal Rubber-Products, Inc. et. al. G.R. No. L27906, January 8, 1987

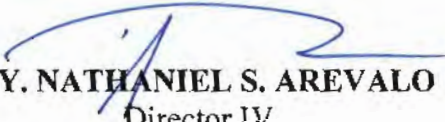
Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

It is emphasized that the essence of the trademark registration is to give protection to the owner of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; to secure to him who has been instrumental in bringing into the market a superior article of merchandise; the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁵ The mark applied for registration by the Respondent-Applicant does not serve this function.

WHEREFORE, premises considered the instant Opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-011669 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 5 November 2015


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

⁵ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, November 19,1999