

**SHARP KABUSHIKI KAISHA
(SHARP CORPORATION),**
Opposer,

-versus-

LG ELECTRONICS, INC.,
Respondent- Applicant.

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IPC No. 14-2014-00035
Opposition to:
Appln. Serial No. 4-2012-004273
Date Filed: 04 April 2012
TM: "PLASMASTER"

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 230 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 01, 2016.

For the Director:

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

**SHARP KABUSHIKI KAISHA
(SHARP CORPORATION),**

Opposer,

-versus-

LG ELECTRONICS, INC.,

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X ----- X

IPC No. 14-2014-00035

Opposition to Trademark
Application No. 4-2012-004273
Date Filed: 04 April 2012

Trademark: **"PLASMASTER"**

Decision No. 2016- 230

DECISION

Sharp Kabushiki Kaisha (Sharp Corporation)¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-004273. The contested application, filed by LG Electronics, Inc.² ("Respondent-Applicant"), covers the mark "PLASMASTER" for use on *air cleaners; air washer; air ionizer; humidifiers; electric refrigerators; kimchi refrigerators; lightwave ovens; electric wine cellars for household purposes; electric ovens; electric freezers; electric laundry dryers; gas range [cooking apparatus]; microwave ovens [cooking apparatus]; gas cooktop; electric ranges for household purposes; air purifiers; air conditioners; hot air apparatus; electric dehumidifiers for household purposes; gas grills; dish disinfectant apparatus; water purifiers for household purposes; water purifiers for household purposes [electric]; water ionizing apparatus; water ionizers for household purposes; water purifiers for household purposes [non-electric]; water purifying apparatus; electric footwarmers; water purification installations; water purification apparatus; precision filters for water treatment; desalination plants; membrane apparatus for water purification; non-electric membrane filters for water purifier for household purposes; electric membrane filters for water purifier for household purposes; membrane filters for water purifier for industrial use; membrane filters for water purification apparatus; water purification installations/apparatus using membrane filters; water purification machines using membrane filters; membrane for water treatment; membrane filter apparatus for water treatment; purification installations for sewage; purification apparatus for graywater; apparatus for waste water purification; filters for waste water; water purifiers for industrial use; filters for water purification installations; membrane for water purifying apparatus; solar collectors [heating]; solar water heaters; street lamps; safety lamps for underground use; germicidal lamps for purifying air; neon lamps; lanterns; dynamo lamps; implements for discharge lamps; incandescent lamps; incandescent lamp implements; ultraviolet ray lamps, not for medical purposes; germicidal lamps; chandliers; water surface lamps; mercury lamps; aquarium lights; spotlights; arc lamps; safety lamps; diving lights; decoration*

¹ A corporation organized and existing under the laws of Japan with address at 22-22, Nagaike-Cho, Abeno-ku, Osaka, 545-8522, Japan.

² A corporation organized and existing under the laws of Korea with address at 20 Yeouido-Dong, YeongDeungPo-Gu, Seoul, 150-721, Republic of Korea.

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

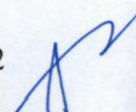
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lamps; infrared lamps; torches for lighting; fish gathering lamp; ceiling lights; fairy lights for festive decoration; electric lights for christmas trees; standard lamps; searchlights; artificial solar lamp; floodlights; fluorescent lamps; flashlights [torches]; lights for motorcycles; automobile lights; reflectors for automobiles; lamps for directional signals of automobiles; light bulbs for directional signals of automobiles; anti-dazzle devices for automobiles [lamp-fittings]; fittings for lights; defrosters for automobiles; air conditioners for automobiles; headlights for automobiles; ventilation [air-conditioning] installations and apparatus for automobiles; heaters for automobiles; branching pipes for air cooling apparatus; branching pipes for air conditioner; flexible hoses for air cooling apparatus; flexible hoses for air conditioner; ionization apparatus for the treatment of air; air deodorizing apparatus; ion generators; heat exchangers" under Class 11 of the International Classification of Goods³.

The Opposer alleges, among others, that "PLASMACLUSTER" is a technology that works to remove bacteria and bacteria by-products, even the unpleasant smell that they give off. This technology first saw light in 1998 through the efforts of its researcher, Kazuo Nishikawa, who realized that the state of air purification technology at that time had reached the limits of their effectiveness. The inspiration of the "PLASMACLUSTER" technology was derived from the human's natural defenses and immune systems. In 2000, "PLASMACLUSTER" made a world debut. For customers increasingly concerned about dead dust mites, dust mite feces and other allergens, a purifier with such effectiveness was an instant hit. In 2008, Nishikawa was able to increase the effectiveness of this technology with higher densities of ions. In this way, he was able to suppress mold on walls and floors. In the same year, Japan Institute of Invention and Innovation awarded the "Invention Prize" for "Air Purification using PLASMACLUSTER ions" at the National Commendation for Invention Prize Winners. In 2010, it was able to obtain Patent No. 3680121 issued by the Patent Office of Japan. The said technology was also verified and tested by various institutions. To date, "PLASMACLUSTER" technology and trademark are used and installed in various Sharp products and are available in countries around the world.

According to the Opposer, it secured registration for "PLASMACLUSTER" all over the globe for goods under Classes 7 and 11. In the Philippines, it registered the said mark under Certificate of Registration Nos. 4-2004-001866 and 4-2004-007510 issued on 15 January 2007 and 06 November 2006, respectively. In 1992, it entered into a joint venture agreement with Pilipinas Development Corporation, which led to the establishment of Sharp (Phils.) Corporation. The Opposer claims that the filing of the contested application is in bad faith and for the purpose of riding on the goodwill

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

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and allegedly well-known status of its mark "PLASMACLUSTER". In support of its opposition, the Opposer submitted the affidavit-testimony of Kiyoshi Yonetsu, with annexes, and the affidavit of Diana F. Rabanal, with annexes.⁴

The Respondent-Applicant filed its Answer alleging, among others, that its company established in 1958. One of its innovative products being offered is the core technology of its LG Split Type Air Conditioners, i.e. PLASMASTER 4S, which provides enhanced skin care and an air purification system to improve the quality of the air we breathe. To solidify its right over "PLASMASTER", it applied and secured various registrations worldwide in addition to its international registrations filed under the Madrid Protocol.

The Respondent-Applicant denies that "PLASMASTER" is confusingly similar with "PLASMACLUSTER" explaining that the dominant feature of its mark is the distinctive "P" device. It asserts that even the word portion of its mark is distinct from the Opposer as its mark merges in the syllable "ma" the words "PLASMA" and "MASTER" while that of the latter's is a combination of "PLASMA" and "CLUSTER". It elaborates that perusing the webpage for the Opposer's products, it observed that the latter uses labels that a particular product has "plasmacluster ion technology", which are prominently displayed, whereas it also prominently displays its "PLASMASTER" marks on its products. According to the Respondent-Applicant, "PLASMA" is defined as "a collection of charged particles (as in the atmospheres of stars or in a metal) containing about equal numbers of positive ions and electrons and exhibiting some properties of a gas but differing from a gas in being a good conductor of electricity and in being affected in the magnetic field." As such, the term "ions" is inseparable from the term "plasma", and therefore, descriptive. It likewise points out the technology is likewise adopted by other manufacturers of air conditioners such as Toshiba and Samsung. It further asserts that the products on which it will use the "PLASMASTER" mark may be considered luxury goods and therefore, confusing similarity should be determined by applying the standards of a discriminating purchaser. The Respondent-Applicant's evidence consists of the following:⁵

1. list of applications and registrations of "PLASMASTER";
2. international registrations of "PLASMASTER";
3. advertising and promotional materials used in various countries to promote its products;
4. "LG" marks registered in the Philippines;
5. printout of relevant pages of other manufacturers showing the details of their respective air conditioning units with plasma filter technology; and
6. pricelist of third parties selling its air conditioners.

⁴ Maked as Exhibits "A" to "P".

⁵ Marked as Exhibits "1" to "6".

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. This Bureau's Alternative Dispute Resolution Services submitted a report that the parties refused to mediate. Accordingly, the Hearing Officer conducted and terminated the preliminary conference on 24 June 2015 wherein the parties were directed to submit their respective position papers. After which, the case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the mark "PLASMASTER" in its favor?

Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that a mark cannot be registered if it:

- "(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:***
- (i) The same goods or services, or***
 - (ii) Closely related goods or services, or***
 - (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion; x x x"***

Records reveal that at the time the Respondent-Applicant filed an application for registration of the mark "PLASMASTER", the Opposer already has valid and existing registrations for the mark "PLASMACLUSTER" under Certificate of Registration Nos. 4-2004-001866 and 4-2004-007510 issued on 15 January 2007 and 06 November 2006, respectively.

To determine whether the competing marks are confusingly similar, the two are reproduced below:



Plasmacluster

Opposer's mark

Plasmaster

Respondent-Applicant's mark

It is unquestionable that both marks appropriate the word "PLASMA". Be that as it may, the same is insufficient to draw a conclusion that the two are confusingly similar. As explained by the Respondent-Applicant, "PLASMA" is defined as "a collection of charged particles (as in the atmospheres of stars or in a metal)

containing about equal numbers of positive ions and electrons and exhibiting some properties of a gas but differing from a gas in being a good conductor of electricity and in being affected in the magnetic field." The Opposer, on the other hand, explained that its researcher, Nishikawa, derived inspiration of the "PLASMACLUSTER" technology from the human's natural defenses and immune systems such that when bacteria invade a person's bloodstream, the germ-fighting white blood cells that attack the microbes and other foreign matter by releasing positive H⁺ and negative O²⁻ ions.⁶ Therefore, the term "PLASMA" merely describes the technology used in the opposing parties' products. The Supreme Court explained in *Societe des Produits Nestle vs. Court of Appeals*⁷ that:

"Generic terms are those which constitute 'the common descriptive name of an article or substance,' or comprise the 'genus of which the particular product is a species'" or are 'commonly used as the name or description of a kind of goods,' or 'imply reference to every member of a genus and the exclusion of individuating characters,' or 'refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular product,' and are not legally protectable. On the other hand, a term is descriptive and therefore invalid as a trademark if, as understood in its normal and natural sense, it 'forthwith conveys the characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is,' or 'if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods,' or if it clearly denotes what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination." (Emphasis supplied.)

The so-called descriptive terms, which may be used to describe the product adequately, cannot be monopolized by a single user and are available to all. It is only natural that the trade will prefer those marks which bear some reference to the article itself.⁸ Therefore, what will determine whether the marks are confusingly similar are the words and/or device that accompany "PLASMA". In this case, the Opposer's mark is a combination of the words "PLASMA" and "CLUSTER". This can be easily differentiated from the Respondent-Applicant's mark can be appreciated as a combination of the words "PLASMA" and "MASTER". More importantly, the prevalent feature of the Respondent-Applicant's mark is actually the device consisting of a letter P with a star design enclosed in a square. No such similar element can be found in the Opposer's registered marks.

Noteworthy, the products involved in the case at bar are not your ordinary household items. Accordingly, the casual buyer is predisposed to be more cautious

⁶ See Verified Opposition, p. 6.

⁷ G.R. No. 112012, 04 April 2001.

⁸ *Ong Ai Gui vs. Director of Philippines Patent Office*, G.R. No. L-6235, March 28, 1955.

and discriminating and would prefer to mull over his purchase. Confusion and deception is less likely.⁹

Finding no confusing similarity between the marks, there is no to determine whether the Opposer's mark is well-known and is protected under Section 123.1 (e) of the IP Code.

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; 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.¹⁰ It is found that Respondent-Applicant's mark sufficiently met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application No. 4-2012-004273 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 30 JUN 2016


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

⁹ Victorio P. Diaz vs. People of the Philippines, G.R. No. 180677, 18 February 2013.

¹⁰ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.