

STANDARD AMERICA COMPANY, INC.,
Opposer,

-versus-

QINGPO LIN,
Respondent -Applicant.

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}
} IPC No. 14-2014-00553
} Opposition to:
} Appln. Serial No. 4-2014-000262
} Date Filed: 07 January 2014
} TM: "STANDARD AMERICAN"

NOTICE OF DECISION

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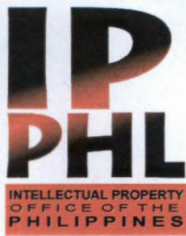
GREETINGS:

Please be informed that Decision No. 2016 - 197 dated June 27, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 27, 2016.

For the Director:

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



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 TM: "STANDARD AMERICAN"

 Decision No. 2016 - 197

DECISION

STANDARD AMERICA COMPANY, INC. ("Opposer"),¹ filed an opposition to Trademark Application Serial No. 4-2014-000262.² The application filed by QINGPO LIN ("Respondent-Applicant"),³ covers the mark "STANDARD AMERICAN" for use on *"hardware and hand tool products particularly, awls, bench stops, bit extensions, bolt cutters, drills, butt mortise, caulk guns, center punches, chalk line anchors, box, line and chalk line reels, chisels, clamps, hand saws, coping saws, counter sinks, demolition bar, dowelling jigs, files, grommet tools, hacksaws, hammers, hand drills, hand-operated shapers provided with cutting edges, hatchets, hex key wrenches, mallets, milter boxes, milter cutters, milter, sanders, milter vises, nail pullers, nail sets, nut drivers, planes, pliers, pocket knives, pry bars, punches, putty knives, rasps, ratchets, ratchet handles, and ratchet wrenches, ripping bars, rivet guns, saws, saw sets, scrapers, screwdriver bits, sharpeners, shears, snips, spoke shaves, spring clamps, squares, staple guns, straight edges, tackers, utility knives, wall paper knives, vises, multi angle vise, wire strippers, wood saws, wood working gauges, wrenches, wrench sets, wrecking bars"* under Class 8 of the International Classification of Goods.⁴

The Opposer alleges that Section 123.1 (d) of Republic Act No. 8293, as amended, otherwise known as the Intellectual Property Code of the Philippines proscribes the registration of STANDARD AMERICAN mark because it is confusingly similar to the STANDARD AMERICA trademark registered under its name and that the registration of the former will cause substantial damage and prejudice to the goodwill associated with the latter.

Opposer's evidence consists of the following:

1. Certificate of Registration No. 4-2004-003744 for the mark STANDARD AMERICA issued to Opposer;
2. Declaration of Actual Use filed on 09 May 2012 and 26 April 2007; and
3. Company letterhead of Opposer.

¹ A corporation organized and existing under the laws of the Philippines with business address at 4626 Valenzuela Street, Old Sta. Mesa, Manila
² The application was published in the Intellectual Property E-Gazette on 02 May 2011.
³ A domestic corporation with address at 56 Diamantina, Cabatuan, Isabela.
⁴ The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

This Bureau issued on 13 October 2015 a Notice to Answer and personally served a copy thereof upon the Respondent-Applicant's representative on 16 October 2015. However, Respondent-Applicant failed to file the Answer. On 25 April 2016, Respondent-Applicant was declared in default. Hence, this case is deemed submitted for decision on the basis of the opposition, affidavits of witnesses and documentary evidence of the Opposer.

Should the Respondent-Applicant be allowed to register the mark STANDARD AMERICAN?

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.⁵

Sec. 123.1 (d) of the IP Code provides:

SECTION 123. Registrability. — 123.1. A mark cannot be registered if it:

x x x

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;

The records of this case will show that at the time the Respondent-Applicant filed its application for the mark STANDARD AMERICAN for Class 8 on 04 January 2014, the Opposer already has an existing registration for the trademark STANDARD AMERICA issued on 30 July 2006, covering goods/service falling under Class 35, namely, "for the business of manufacturing, trading, importing, exporting, distributing, retailing, wholesaling, and indenting". As such, the parties goods are different or non-related.

But are the marks confusingly similar as to likely cause confusion, mistake or deception on the part of the public? The marks of the parties are reproduced below:

**STANDARD
AMERICA**

Opposer's Mark

STANDARD
American

Respondent-Applicant's Mark

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

A scrutiny of the marks of the parties would show that both Opposer's and Respondent-Applicant's marks contain two words. The first word "STANDARD" is both present in the contending parties' marks. As to the second word, Opposer adopted the word "AMERICA" in its mark while Respondent-Applicant used the word "AMERICAN". Opposer's mark is plainly written in upper case letters while in Respondent-Applicant's mark, the word "American" is written in stylized manner and in color blue. Further, it is worth to note that the Opposer disclaimed the word "AMERICA" and Respondent-Applicant also disclaimed the word "AMERICAN". A disclaimer indicates that a registrant or applicant does not claim an exclusive right to the specified element(s) of the mark by itself. It also enables the registration of a mark that is registrable as a whole, but contains matter that would not be registrable by itself. As such, both Opposer and Respondent-Applicant seek exclusive use of the word 'STANDARD' and how the composite mark appears as a whole. Based on the Trademark Database of this Office, Opposer has not solely appropriated the word "STANDARD" or the "AMERICA" to the exclusion of others. According to the Database, there are numerous registered marks using the words "STANDARD" as a standalone mark or in combination with another word as well as "AMERICA" or "AMERICAN" also as a standalone mark and in combination with other words, but NOT in the case of the combination of the composite mark "STANDARD AMERICA". As such, the allowance of registration of Respondent's mark "STANDARD AMERICAN" will likely cause confusion, mistake or deception to the public, into believing that STANDARD AMERICAN is just a variant of Opposer's mark or that the goods of Respondent is manufactured, sourced or originated from Opposer or vice versa. The difference in the stylized presentation of the word "AMERICAN" and its blue color in Respondent's 'STANDARD AMERICAN' mark is also trivial as to deviate a finding of confusing similarity with Opposer's mark especially when the marks are advertised in radio as the 'STANDARD AMERICAN' when pronounced produces identical sound as that of Opposer's "STANDARD AMERICA".

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other⁶. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article⁷.

It has been held time and again that in cases of grave doubt between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favour with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.⁸

⁶ See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

⁷ See *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

⁸ See *Del Monte Corporation et. al. v. Court of Appeals*, GR No. 78325, 25 Jan. 1990

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. . 4-2014-000262 , together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City **27 JUN 2016**


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