

TECHNICOLOR,  
Opposer,

-versus-

TONSON MANUFACTURING CORP. LTD.,  
Respondent- Applicant.

X-----X

}  
} IPC No. 14-2014-00059  
} Opposition to:  
} Appln. No. 4-2013-502523  
} Date Filed: 04 September 2013  
} TM: "TONSON"  
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}  
}  
}

**NOTICE OF DECISION**

**ORTEGA BACORRO ODULIO CALMA & CARBONELL**

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**GREETINGS:**

Please be informed that Decision No. 2017 - 93 dated March 27, 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOP HL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, March 27, 2017.

  
**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs

**TECHNICOLOR,**  
Opposer,

-versus-

**TONSON MANUFACTURING CORP. LTD.,**  
Respondent-Applicant.

IPC No. 14-2014-00059

Opposition to Trademark  
Application No. 4-2013-502523  
Date Filed: 04 September 2013  
Trademark: "**TONSON**"

X ----- X Decision No. 2017- 93

### DECISION

Technicolor<sup>1</sup> ("Opposer") filed an opposition to Application No. 4-2013-502523. The contested application, filed by Tonson Manufacturing Corporation Limited<sup>2</sup> ("Respondent-Applicant"), covers the mark "TONSON" for use on "*vacuum pumps (machines); compressed air pumps; spray guns for paint; painting machines; mixing machines; starters for motors and engines; driving motors other than for land vehicles; vacuum cleaners; compressors (machines); pistons for cylinders*" under Class 07 of the International Classification of Goods<sup>3</sup>.

The Opposer alleges, among others, that its company, formerly known as Thomson, was originally named after the electric engineer, Elihu Thomson. It has used, registered and/or applied for registration of the mark "THOMSON" for a variety of consumer and industrial machines, apparatus and/or appliances in Classes 07, 09 and 11 in more than one hundred (100) countries worldwide. It was in France, on 27 February 1893 that Compagnie Francaise Thomson-Houston, active in the field of electric power, was born. The first use of the "THOMSON" mark was for heating and kitchen equipment in 1920. In the Philippines, it has been using the mark since 1997.

The Opposer avers that it has filed earlier applications for its "THOMSON" mark. It objects the registration of the Respondent-Applicant's mark on the ground of confusing similarity; especially that "TONSON" is used for products similar to that covered by its own "THOMSON" mark. It claims to have encountered an entity in China, Neumak (Shanghai) Corporation, which also adopts the "TONSON" mark. Since the said company and the Respondent-Applicant have the same address, it believes that the two may be in collusion in filing the contested mark. In support of

<sup>1</sup>A corporation organized under the laws of France with address at 1-5, Rue Jeanne d' Arc, Issy-Les-Moulineaux, France.

<sup>2</sup>With known address at 59 Xu-Wang Rd., Qing Pu District, Shanghai 20170.

<sup>3</sup> 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.

its opposition, the Opposer submitted the affidavit of Emmanuelle Petit, with attachments.<sup>4</sup>

A Notice to Answer was issued and served upon the Respondent-Applicant on 02 June 2014. The latter, however, failed to comply. The Adjudication Officer thus issued Order No. 2016-481 on 18 March 2016 declaring the Respondent-Applicant in default and the case submitted for decision.

The issue to be resolved is whether the trademark application of Respondent-Applicant for "TONSON" should be allowed.

Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that:

***"123.1. 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"***

The Trademark Registry reveals that at the time Respondent-Applicant applied for registration of its mark on 04 September 2013, the Opposer has valid and existing registration of the trademark "THOMSON" issued on 31 December 1995 under Certificate of Registration No. 4-1997-124916.

To determine whether the competing marks are confusingly similar, the same are reproduced below for comparison:

**THOMSON**

*Opposer's mark*

**TONSON**

*Respondent-Applicant's mark*

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<sup>4</sup> Marked as Exhibit "A", inclusive.

Aside from the fact that the word "TONSON" in the Respondent-Applicant's mark is slanted and enclosed in a rectangular design, the two differ in their respective first syllable "THOM" and "TON". These notwithstanding, the competing marks are confusingly similar. Unquestionably, both marks have identical ending syllable "SON". The first syllables thereof, although differently spelled, also resemble in appearance and pronunciation. The presence or absence of the letter "H" is immaterial as the said letter is silent when pronounced. In addition, the letters "M" and "N" are also phonetically similar. Therefore, the Respondent-Applicant's applied mark closely resembles the Opposer's mark visually and aurally. After all, 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 purchased as to cause him to purchase the one supposing it to be the other.<sup>5</sup>

Succinctly, since the Respondent-Applicant will use or uses the mark "TONSON" to goods that are similar and/or closely related to that of Opposer's registered mark "THOMSON" marks, the slight differences will not diminish the likelihood of the occurrence of confusion, mistake and/or deception. It is highly probable that the purchasers will, at the very least, be reminded of the Opposer's marks when they encounter the Respondent-Applicant's. Withal, the protection of trademarks as intellectual property is intended not only to preserve the goodwill and reputation of the business established on the goods bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods.<sup>6</sup>

Moreover, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."<sup>7</sup>

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<sup>5</sup> Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

<sup>6</sup> Skechers, USA, Inc. vs. Inter Pacific Industrial Trading Corp., G.R. No. 164321, 23 March 2011.

<sup>7</sup> Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.



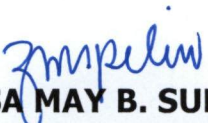
Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market 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.<sup>8</sup> Based on the above discussion, Respondent-Applicant's trademark fell short in meeting this function. The latter was given ample opportunity to defend its trademark application but Respondent-Applicant failed to do so.

Accordingly, this Adjudication Officer finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-502523 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 27 MAR 2017

  
**ATTY. Z'SA MAY B. SUBEJANO-PE LIM**  
Adjudication Officer  
Bureau of Legal Affairs

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<sup>8</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.