

KENSONIC INC.,
Opposer,

-versus-

VERONICA D. TENG,
Respondent-Applicant.

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IPC No. 14-2014-00037
Opposition to:

Appln. Ser. No. 4-2012-011845
Date Filed: 26 September 2012

TM: SAKURA LONGLIFE

NOTICE OF DECISION

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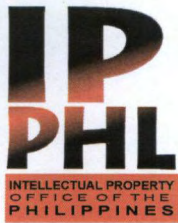
GREETINGS:

Please be informed that Decision No. 2017 - 157 dated 10 May 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL 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, 16 May 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



KENSONIC, INC.,
Opposer,

- versus -

VERONICA D. TENG,
Respondent-Applicant.
X ----- X

IPC No. 14-2014-00037
Opposition to:

Appln. No. 4-2012-011845
Date Filed: 26 September 2012
Trademark: **"SAKURA
LONGLIFE"**

Decision No. 2017 - 157

DECISION

KENSONIC, INC. ("Opposer")¹, filed a verified opposition to Trademark Application Serial No. 4-2012-011845. The application, filed by VERONICA D. TENG ("Respondent-Applicant")², covers the mark "SAKURA LONGLIFE" for use on the following goods: *"switches; switches with plate set; electrical outlets; outlets with plate set; telephone outlet with plate set; telephone outlet; weatherproof cover; pvc utility box; junction box, junction box cover; female plug base; adaptor plug flat pin to round tap; regular plug; rubber plug; waterproof rubber socket; budget wall-light; concealed receptacle; surface socket porcelain; keyless socket; push through socket; candelabra socket; batteries watt hour meters; meter sockets; meter boxes; meter covers; lighting fixtures; panel box, nema enclosure, electric circuit testers, multi testers, welding electrodes, and welding wire, welding mask, pull box, panel board, safety switch; circuit breakers; magnetic ballast, starters electrical device, receptacle, universal socket adaptors, chain pull socket, heavy duty rubber plug, extension cord, aircon tandem outlet, gang plate"* under class 9; and, *"exhaust fans, ventilating fans, insect killer bulbs, budget wall-light, flash lights, rechargeable lights, bulbs, led lights insect killers, led exit signs"* under class 11 of the International Classification of Goods and Services.³

The Opposer alleges that in various cases decided by the Bureau of Legal Affairs, it was settled that the Opposer is the owner and prior user of the SAKURA mark. The subject mark SAKURA LONGLIFE is therefore opposed on the ground that it is confusingly similar to the Opposer's mark SAKURA as to likely deceive or cause public confusion. The dominant element of Respondent-Applicant's mark - SAKURA - completely appropriates the Opposer's SAKURA mark. Moreover, the use of Respondent-Applicant's SAKURA LONGLIFE mark on goods in classes 9 and 11, which are identical and/or closely-related to the goods on which the Opposer's

¹ A corporation existing under and by virtue of the laws of the Philippines, with office address at Lot 3, T.S. Sarino Subdivision, Real Street, Pulang Lupa, Las Pinas City.
² With registered address at Unit A-4 No. 23 Sta. Rosa St., Manresa, Quezon City.
³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks, which was concluded in 1957 and administered by the World Intellectual Property Organization.

SAKURA mark extensively used and applied for registration, will deceive consumers by suggesting a connection, association or affiliation with the Opposer, thereby causing substantial damage to the goodwill and reputation of Opposer's SAKURA mark. The Opposer likewise avers that it has extensively promoted the SAKURA mark by maintaining websites where information about the Opposer and its SAKURA products may be found.

According to the Opposer, Respondent-Applicant's SAKURA LONGLIFE mark was applied for registration in evident bad faith, with prior knowledge of the Opposer's rights to the SAKURA mark and with the intention to ride on the fame, established reputation, and goodwill of the Opposer's SAKURA mark. In fact, Opposer has not consented to the Respondent-Applicant's use and registration of the SAKURA LONGLIFE mark or any other mark identical or similar to its SAKURA mark.

The Opposer's evidence consists of the following:

1. Original notarized verified Secretary's Certificate;
2. Certified true copy (Ctc) of Decision No. 2005-21 dated 29 November 2005 by the Bureau of Legal Affairs (BLA);
3. Ctc of Entry of Judgment/Execution of Decision dated 09 August 2006 by the BLA;
4. Ctc of Decision No. 2008-113 dated 07 August 2008 by the BLA;
5. Ctc of notarized Declaration of Actual Use of Appln. No. 4-2001-005131 for SAKURA;
6. Ctc of notarized Affidavit of Ownership of Ms. Nenita K. Tsang;
7. Ctc of Copy Certification by Atty. Shirley G. Velasquez;
8. Ctc of Certificate of Registration of Business Name of Audio Crown Enterprise;
9. Ctc of Sales Invoice No. 7643 of Audio Crown Enterprises;
10. Ctcs of Bills of Lading;
11. Ctcs of notarized Affidavits of Mr. Johnny F. De La Cruz, Mr. James Co Lim, Ms. Betty Go Santos, Ms. Conchita Tan Ong, Ms. Jennifer C. Ong, Mr. Robin Omlang De Guzman, and Mr. Tsang Wing Kuen;
12. Ctcs of published advertising and publicity materials of SAKURA products;
13. Ctc of the Resume of Ms. Magdalena G. Uy;
14. Ctcs of various Sales Invoices issued by Ken sonic, Inc.;
15. Ctcs of Memoranda of Agreement;
16. Ctcs of Kavin Lines Bill of Lading, Packing List, SGS Advance Clearance Report and Certificate of Origin;
17. Ctcs of various letters and communications;
18. Ctcs of Copies of Certification and the documents all entitled SAKURA THE FUTURE OF ENTERTAINMENT;
19. Ctc of Copy Certification and the document NEW GENERATION DVD PLAYER SAKURA;
20. Original Brochure for SAKURA Sound Enhanced to Perfection;
21. Trademark detail report for SAKURA under Trademark Application No. 4-2001-005131;

22. Decision Nos. 2013-169 dated 14 August 2013, 2008-152 dated 11 August 2008, 2008-172 dated 24 October 2008, downloaded from Intellectual Property website;
23. Original notarized Officer's Certificate and Power of Attorney by Mr. Kristoffer Tsang, Corporate Secretary of Opposer; and,
24. Original notarized Secretary's Certificate on the authority of Mr. Kristoffer Tsang.

On 05 August 2010, Respondent-Applicant filed an Answer. By way of Affirmative and/or Special Defenses, Respondent-Applicant asserts that her applied mark SAKURA Longlife and Device is neither identical nor confusingly similar to Opposer's mark SAKURA. It does not include goods falling under Class 11. It has also no application covering goods falling under Class 11. Thus, insofar as Respondent-Applicant's goods falling under Class 11 are concerned, there is no likelihood of them being confused as coming from Opposer. Although Respondent-Applicant's applied mark also covers goods falling under Class 9, said goods are clearly not identical nor closely related, in fact, not even competing with the goods covered by the Opposer's. Respondent-Applicant further avers that Opposer cannot invoke Section 123.1 (e) and (f), absent a declaration by competent authority that Opposer's SAKURA mark is a well-known mark internationally and in the Philippines.

According to Respondent-Applicant, the Decisions invoked by the Opposer are neither binding nor do they constitute a bar to the approval of the subject mark, as she is not a party to the inter partes cases mentioned. These Decisions are not even persuasive since the goods of the subject mark are not the same, nor closely related to the goods specified in the registration certificates or applications involved in the mentioned inter partes cases where the cited decisions were promulgated. Moreover, the other Decisions mentioned with Respondent-Applicant as the losing party, are not yet final and executory. Since not all the requisites for the application of the principle of res judicata are present, Respondent-Applicant's subject mark application cannot be rejected.

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

1. Application SN 4-2012-011845 covering the above-mentioned goods;
2. Registrability Report dated 26 November 2012;
3. Response to Registrability Report dated 15 January 2013 deleting the goods "electric tapes under Class 17;
4. Subsequent Action dated 29 May 2013 and Response thereto;
5. Another Subsequent Action dated 02 August 2013, Response dated 05 August 2013, and a further Response dated 23 October 2013;
6. Notice of Allowance dated 06 December 2013;
7. Print-out of e-Gazette release for circulation on 06 January 2014 showing publication of Application SN 4-2012-011845;
8. Order No. 2011-105(D) dated 25 November 2011 in IPC No. 14-2007-00177; and,
9. Duly notarized affidavit of Ms. Veronica D. Teng.

In this connection, the Preliminary Conference was held and terminated on 24 June 2015. The parties submitted their respective Position Papers. Hence, this case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark SAKURA Longlife?

A careful perusal of the records show that at the time Respondent-Applicant filed her application for registration of the trademark "SAKURA Longlife" on 26 September 2012⁴, herein Opposer has prior application filed for the trademark "SAKURA" on 18 July 2001 covering class 09 goods consisting of amplifiers, dvd player, vcd player, tape deck, tuner, equalizer, mixer, digital voice recorder, and video disc recorder⁵. To date, this application is still pending registration before the Bureau of Trademarks.⁶

This instant case involves the following marks for comparison:



Opposer's Trademark



Respondent-Applicant's Trademark

The competing marks contain the identical word SAKURA. The Respondent-Applicant's mark further contains the compound word "LONGLIFE" and the device of a "Five-Petal Flower on the left portion of the word mark. The marks are therefore, not identical nor similar because of the additional features mentioned. A further examination shows that the goods or products covered by each mark are different from each other. The Opposer's goods, as mentioned, are used for audio and/or audio-visual purposes; whereas, the Respondent-Applicant's goods are electrical wiring devices for residential, commercial and industrial use. While they belong to the same classification, they are unrelated in terms of their characteristics, nature, use and function. They are non-competing products and therefore, there is no possibility of confusion in the market. More so, Respondent-Applicant's goods in class 11 are far different from that of Opposer's goods. They belong to different classification of goods and are obviously intended for different purposes.

In one case, the Supreme Court ruled that, "The trademark 'CANON' as used by Petitioner for its paints, chemical products toner and dyestuff,⁷ can be used by private respondent for its sandals⁸ because the products of these two parties are dissimilar."⁹ In another case, the Supreme Court sustained the Director of Patents which allowed the junior user to use the Trademark of the senior user on the ground that the briefs manufactured by the junior user, the

⁴ Filewrapper records.

⁵ IPPHl Philippine Trademark Database, available at <http://www.wipo.int/branddb/ph/en/> (last accessed 05 May 2017).

⁶ Id.

⁷ Class 2.

⁸ Class 25.

⁹ Canon Kabushiki Kaisha v. Court of Appeals and NSR Rubber Corporation, G.R. No. 120900 promulgated 20 July 2000.

product for which the Trademark 'BRUTE' was sought to be registered, was unrelated and non-competing with the products of the senior user consisting of after shave lotion, shaving cream, deodorant, talcum powder, and toilet soap.¹⁰

Indeed, the Trademark Registry, the contents of which this Bureau can take cognizance of via judicial notice, consist of marks that contain the word SAKURA covering goods under the same and/or different classifications such as: *Sakura* [Reg. No. 42016003239 dated 21 July 2016 for class 31]; *Sakura* [Reg. No. 42014012843 dated 16 October 2014 for class 09]; *Sakura* [Reg. No. 42000003083 dated 20 March 2005 for class 9]; *Sakura & Sakura Flower* [Reg. No. 42006002385 dated 24 December 2007 for class 9]; *Sakura & Device* [Reg. Nos. 42007009012 dated 22 November 2008 for classes 9 and 11, and 42006001056 dated 31 January 2006 for class 9]; and, *Sakura & Flower* [Reg. No. 42009008535 dated 02 September 2010 for class 9].¹¹ Moreover, the Respondent-Applicant holds registration for *SAKURA LONGLIFE* [Reg. No. 5821 dated 17 November 2011 for class 11].¹² These marks are owned by entities other than the Opposer. Hence, to sustain this instant opposition solely on the grounds provided, would have the unintended effect of giving the Opposer exclusive use of the mark SAKURA, despite stark differences of its visual and aural appearance. Apparently, the Opposer failed to adduce substantial evidence to show that it will be damaged by the continued registration of the subject mark SAKURA Longlife in favor of Respondent-Appellant for the mentioned goods.

Corollarily, the enunciation of the Supreme Court in the case of *Mighty Corporation vs. E. & J. Gallo Winery*¹³ aptly states that:

"A very important circumstance though is whether there exists likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the source of the goods in question. The 'purchaser' is not the 'completely unwary consumer' but is the 'ordinarily intelligent buyer' considering the type of product involved. he is 'accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The situation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

Finally, it is important to note that the word SAKURA is not a coined or invented word mark by the Opposer. It refers to a Japanese Flowering Cherry.¹⁴ Therefore, it is not impossible for the Respondent-Applicant to have concocted the subject mark as part of its trademark without having the intent to copy that of Opposer's trademark.

¹⁰ *Faberge, Incorporated v. Intermediate Appellate Court*, 215 SCRA 326 (1992).

¹¹ *Id.*

¹² *Id.*

¹³ G.R. No. 154342, 14 July 2004.

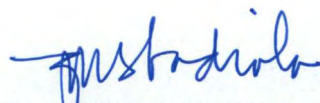
¹⁴ Merriam-Webster, available at <http://www.merriam-webster.com/dictionary/shell> (last accessed 05 May 2017).

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.¹⁵ This Bureau finds that the Respondent-Applicant's mark meets this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-011845 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 10 MAY 2017



Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs

¹⁵ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.