VICENTE SY SENG HO. Opposer,	)	INTER PARTES CASE NOS. 3257 & 3260
	)	OPPOSITION TO:
	)	Application Serial No. 60188 Filed : October 21, 1986 Applicant : Jardine Davies, Inc. Trademark : SUPER ROYAL TRITON Used on : Lubricating oil
	)	- and -
- versus -	)	
	)	Application Serial No. 60182 Filed : October 21, 1986 Applicant : Jardine Davies, Inc. Trademark : TRITON Used on : Lubricating oil
	)	DECISION NO. 92-33 (TM)
JARDINE DAVIES INC., Respondent-Applicant.	)	November 18, 1992

x----------x

DECISION

This is an Opposition filed by VICENTE SY SENG HO, a citizen of the Philippines with business address at c/o Roosevelt Chemical Inc., Mariano Ave., Bo. dela Paz, Pasig, M.M. against Application Serial No. 60188 for the trademark SUPER ROYAL TRITON for lubricating oils filed by Respondent-Applicant JARDINE DAVIES, INC., which Application was published for Opposition on p. 61 of the BPTTT Official Gazette No. 7, vol. 1 and officially released for circulation on 20 September, 1988 and Application Serial No. 60182 filed on 21 October, 1986 by the same applicant JARDINE DAVIES, INC., for the trademark TRITON used on lubricating oils docketed as IPC 3257 and IPC 3260.

The Opposer filed separate but simultaneous Notices of Opposition to the above-mentioned Application alleging as common grounds the following:

1. The mark TRITON/SUPER ROYAL TRITON under Ser. No. 60182 and Ser. No. 60188 respectively, of Respondent-Applicant is identical and/or confusingly similar to the trademark TRITON of Opposer, which Opposer owns and has not abandoned;

2. The Opposer will be damaged and prejudiced by the registration of the mark TRITON/SUPER ROYAL TRITON in the name of Respondent-Applicant, and his business and goodwill will suffer great and irreparable injury;

3. Respondent-Applicant's use of the mark TRITON/SUPER ROYAL TRITON for lubricating oil so resembles and are identical to the trademark owned and used by Opposer, which constitutes an unlawful appropriation of a trademark owned and currently used by Opposer.

The Opposer relied on the following facts to support his Notice of Opposition:

1. The trademark TRITON/SUPER ROYAL TRITON of Respondent-Applicant is identical to Opposer's trademark TRITON as to be likely, when applied to the goods or when used in connection with the goods of the Respondent-Applicant, to cause confusion or to deceive purchasers as to the actual source or origin of the goods/products of Respondent-Applicant to such an extent that they may be mistaken by the unwary public as related to the products manufactured and sold by Opposer.

2. Opposer's trademark TRITON is well-known throughout the Philippines and said mark has become distinctive of Opposer's goods having long been established and obtained general consumer recognition and goodwill as belonging to one owner or origin, the Opposer herein through his manufacturing and marketing arm Roosevelt Chemical, Inc.

3. The unauthorized use and adoption of the trademark TRITON/SUPER ROYAL TRITON by Respondent-Applicant pre-empts the right of the Opposer to expand his business with the use of his trademark on or in connection with the goods or products identical and/or confusingly similar to those of the Respondent-Applicant which Opposer is very much in a position and capable of doing through his manufacturing and marketing arm Roosevelt Chemical, Inc.

4. Opposer has much earlier adopted, used and registered the trademark TRITON with Certificate of Registration No. 28127 dated April 23, 1980, SR-2803 dated 6 April 1977 and Copyright Registration PD 4624 dated 19 August 1983 which registrations are attached and made integral parts hereof as Annexes "A", "B" and "C", respectively.

Despite completed service of the Notice to Answer on Respondent-Applicant, it filed a Motion dated 25 November 1988 for annexes "A", "B" & "C" to the Opposition to be furnished to the Respondent-Applicant which was duly complied with by Opposer on 06 December 1988.

Respondent-Applicant failed to file its Answer to both Notices of Opposition hence, upon motion of the Opposer, Respondent-Applicant was declared IN DEFAULT under Order No. 89-647 and Order No. 89-648 both dated 18 August, 1989 and Opposer was thereafter allowed to present its evidence ex-parte.

This Office then conducted a joint hearing on the above case whereby the Opposer presented its documentary evidences consisting of Exhibits "A" to "E" as well as the testimony of Opposer-Affiant VICENTE SY SENG HO appearing in Exhibit "A", an Affidavit which is in lieu of his direct testimony for both cases. The said exhibits were all admitted as evidence for the Opposer under Order No. 91-144, dated 13 February, 1991.

The sole issue involved in this case is the determination of whether or not Respondent-Applicant's trademark TRITON & SUPER ROYAL TRITON is confusingly similar to Opposer's registered trademark TRITON & DEVICE.

As shown by the evidence presented, the mark TRITON & SUPER ROYAL TRITON of Respondent-Applicant and that of Opposer's TRITON & DEVICE are confusingly similar as they contain the dominant word TRITON written in similar styles of lettering. Moreover, the goods on which both trademarks are being used i.e. lubricating oils for Respondent-Applicant and paints, paint thinner and lacquer thinner are similar and/or related to each other.

In Co Tiong SA vs. Director of Patents (95 Phil.1) our Supreme Court has held:

"It is thus not necessary that the matter sought to be protected be literally copied. Differences or variations or similarity in the details of one device or article and those of another are not the legally accepted tests, whether an action based

on wrongful imitation exists. Dissimilarity on the size, form, color of the device be it a trademark, a label, a wrapper, a package, etc. – and the place where the same applied are, while relevant, is not conclusive. It is sufficient to constitute a cause of action for either infringement or unfair competition or, in proper cases, denial or cancellation of registration of trademark or tradename that the substantial and distinctive part, the main or essential or dominant features of one device or article is copied or imitated in another."

The trademark "TRITON & DEVICE" of the Opposer was first used on 17 January 1976 and registered under Certificate of Registration Nos. 28127 and SR-2803 dated 13 April 1980 and 6 April 1977, respectively, for paints, paint thinner and lacquer thinner. The trademark was likewise registered with the Copyright Office under Certificate No. PD 4624 dated 19 August 1983. Opposer has likewise submitted in evidence Exhibit "E" which is a leaflet showing the products to which the use of its duly registered trademark "TRITON & DEVICE" was extended to oil and other products.

In his testimony, Opposer testified that he has long been using his trademark for diverse products other than those for which it has been originally registered and this includes oils much earlier than the alleged use of Respondent-Applicant's trademark for lubricating oil. Such unauthorized use by Respondent-Applicant of the confusingly and/or identical trademark "SUPER ROYAL TRITON" for lubricating oil unfairly pre-empts the right of the Opposer to expand his business with the use of his trademark in connection with the goods or products that are related to that for which the mark is registered.

Section 4(d) of the Trademark Law provides that:

> "Section 4. Registration of trademarks, tradenames and service-marks on the principal register. There is hereby established a register of trade-marks, trade-names and service-marks which shall be known as the principal register. The owner of a trade-mark, trade-name or service-mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register, unless it:
>
> xxx
>
> "(d) Consists of or comprises a mark or trade-name which so resembles a mark or trade-name registered in the Philippines or a mark or trade-name previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchaser". (Underscoring ours)

Therefore, the registration of respondent-applicant's mark would be contrary to the provisions of Sec. 4 (d) of the Trademark Law.

In view of the foregoing, the Notice of Opposition filed by herein Opposer, VICENTE SY SENG HO is, as it is hereby, SUSTAINED. Appln. Ser. Nos. 60182 and 60188 filed 21 October, 1986 and 21 October, 1986 respectively by JARDINE DAVIES, INC., for the registration of trademarks TRITON and SUPER ROYAL TRITON respectively both used on lubricating oils are, as they are hereby, REJECTED.

Let the filewrapper of the subject application be forwarded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision. Likewise, let a copy of this Decision be furnished the Trademark Examining Division for information and to update its own record.

SO ORDERED.

IGNACIO S. SAPALO
Director