

CANON KABUSHIKI KAISHA,)	INTER PARTES CASE NO. 3118
Opposer,)	
)	OPPOSITION TO:
)	
)	Application Serial No. 55446
)	Filed : February 16, 1985
- versus -)	Applicant : Dynex Industrial
)	Corp.
)	Trademark : CANNON
)	Used on : Acrylic thinner
)	
)	<u>DECISION NO. 94-4 (TM)</u>
)	
DYNEX INDUSTRIAL CORP.,)	January 12, 1994
Respondent-Applicant.))	
x-----x		

DECISION

This is an Opposition to the registration of the trademark CANNON used on acrylic thinner under Application Serial No. 55446 filed on 16 February 1985 in the name of the Respondent DYNEX INDUSTRIAL CORPORATION, a corporation organized and existing under the laws of the Philippines with principal office at 340 C. Don Carlos Revilla Street, Pasay City, which was published for Opposition page 10, Vol. I No. 3 of the Official Gazette of this Office on 23 May 1988.

Opposer, CANON KABUSHIKI KAISHA, a foreign corporation duly organized and existing under the laws of Japan with principal office at 30-2, 3-chome, Shimomaruko, Onta-ku, Tokyo, Japan, believing it will be damaged if the mark will be registered, opposed the foregoing application on the following grounds:

- “(i) The registration of the trademark CANNON in the name of respondent-applicant will mislead the purchasing public and make it convenient for respondent-applicant to pass off its goods as those of the opposer, resulting in damage to both the public and the opposer;
- (ii) The trademark CANNON is, if not identical, so confusingly similar to the trademark CANON owned and being used by the opposer, such that the registration of the trademark CANNON in the name of respondent-applicant will run counter to Section 4(d) of R.A. No. 188;
- (iii) The registration of the trademark CANNON in the name of respondent-applicant will violate the proprietary rights and interests of the opposer over its trademark CANON and will therefore cause great and irreparable injury to the latter.”

In its Answer, Respondent denied the allegations of the Opposition and further alleged that the trademarks in question are distinctly different not only in sound but also in spelling, design lettering and meaning. Respondent also claims that there can be no confusing similarity between the two trademarks because respondent’s trademark is used on chemical products, dyestuffs, pigments toner and shoe polisher.

When no amicable settlement was reached between the parties, trial on the merits was conducted.

The lone issue here is whether or not the trademark CANNON could be registered despite the registration of the trademark CANON for the same class of goods.

In determining contests involving trademark registration, actual confusion is not necessary. The determinative factor is whether the challenged mark could likely to cause confusion or mistake on the part of the buying public. In short, to constitute an infringement of an existing trademark registration and warrant the denial of an application for another person, the law does not require that the competing marks must be so identical as to produce actual error or mistake. It would be sufficient for the purpose of the law that similarities between two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the new brand for it (American Wire Cable vs. Director of Patents, 31 SCRA 544).

To ascertain whether the two marks would create a likelihood of confusion on the part of the purchasers, it is but proper to shift our attention to the pertinent rules laid down by the Supreme Court in a long line of cases. In Kee Bok vs. Director of Patents, 34 SCRA 10, it has been held that the trademarks RACE and RAYS for clothings have been declared to be confusingly similar with one another based on the doctrine of IDEM SONAS or the doctrine of similarity in sound. The same conclusion was arrived at in the trademarks SALONPAS and LIONPAS were held to be confusingly similar.

Going back to the case at bar and applying the test of IDEM SONAS, it becomes evidence that the mark CANNON is confusingly similar with the trademark CANON as both marks are not only similar but identical in pronunciation. The only difference is that the former is spelled with a single "N". As held in the Marvex case, similarity in sound is a sufficient ground for holding that two marks are confusingly similar when applied to merchandise of the same descriptive properties.

The decision in the Marvex case brings us back to the incidental issue raised by the Respondent in its Answer that the products sold under the competing marks are different. It may be recalled that the Respondent claimed that Opposer's mark is used on chemical products, shoe polish, dye and the like while Respondent's mark is used on acrylic thinner. It may be further observed that in Class 2, the following products are listed: paints, varnish and lacquers which may be grouped into a single category and can be denominated as chemical products.

Plants, lacquers and varnishes on one hand and acrylic thinner on the other are used by painters together to come up with the desired mixture or consistency or shade.

Both products lines are therefore related or at least interrelated because they belong to the same class or have the same descriptive properties and possess the same physical attributes. They also flow from the same channels of trade in that they are bought from hardware and/or paint shops. In fact, the products are complementary to each other. There could be no question that they are related.

The vast majority of courts today follow the modern theory of related goods which the courts have likewise adopted and uniformly recognized (ESO Standard Eastern vs. Court of Appeals, 116 SCRA 336) where the scope of protection afforded to a registered mark should not be limited to the goods specified in the Registration certificate but should include related goods.

Having thus reviewed the laws applicable to the case before us, it is not difficult to discern that Respondent-Applicant is proscribed from registration of its mark CANNON for acrylic thinner by virtue of the registration of the mark CANON for the same line of goods in favor of the Opposer.

WHEREFORE, premises considered, this Opposition is hereby SUSTAINED. Application Serial No. 55446 is hereby REJECTED.

Let the filewrapper of this case be forwarded to the Trademark Examining Division for their appropriate action.

SO ORDERED.

IGNACIO S. SAPALO
Director