

EMI LIMITED,)	INTER PARTES CASE NO. 3427
)	
Opposer,)	OPPOSITION TO:
)	
)	Application Serial No. 64593
)	Filed : May 4, 1988
- versus -)	Applicant : Breman Magnetics,
)	Inc.
)	Trademark : BMI
)	Used on : Blank and pre-
)	recorded tapes and
)	discs
)	
)	<u>DECISION NO. 92-28 (TM)</u>
)	
BREMEN MAGNETICS, INC.,)	November 12, 1992
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DECISION

On October 5, 1989, EMI LIMITED, a corporation duly organized under the laws of the United Kingdom, with principal Office at Blyth road, Hayes, Middlesex, England, filed its Verified Notice of Opposition (IPC No. 3472) to Application Serial No. 64593 for the trademark "BMI" used on blank and pre-recorded tapes and discs filed on May 4, 1988 by Bremen Magnetics, Inc. a corporation organized under the laws of the Philippines with address at No. 211 Mariveles Street, La Loma, Quezon City, and which application was published on page 9, Volume 11, No. 6, June 30, 1989 issue of the Official Gazette, officially released for circulation on July 3, 1989.

The grounds for the opposition are as follows:

1. The trademark "BMI" so resembles Opposer's registered trademark "EMI" which has been previously used in commerce in the Philippines and other parts of the world and not abandoned, as to be likely, when applied to or used in connection with the goods of Applicant, to cause confusion, mistake and deception on the part of the purchasing public;
2. The registration of the trademark "EMI" in the name of the Applicant will violate Section 37 of Republic Act No. 166, as amended, and Section 6bis and other provisions of the Paris Convention for the Protection of Industrial Property to which the Philippines and the United Kingdom are parties;
3. The registration and use by Applicant of the trademark "BMI" will diminish the distinctiveness and dilute the goodwill of Opposer's trademark "EMI";
4. The registration of the "BMI" in the name of the Applicant is contrary to other provisions of the Trademark Law."

Opposer relies on the following facts to support its application.

1. Opposer is a manufacturer of a wide range of products, including goods bearing the trademark "EMI" which have been marketed and sold in the Philippines and in other parts of the world. Opposer has been commercially and in the Philippines prior to the use of "BMI" by Applicant;
2. Opposer is the owner of the trademark "EMI" which was registered with the Bureau of Patents, Trademarks & Technology Transfer under

Registration Certificates No. 21113 for phonograph records. "EMI" is also registered and is used as a trademark for phonograph records in the United Kingdom and in other countries;

3. Opposer is the first user of the trademark "EMI" on the goods included under the above-described registration which have been sold and marketed in various countries worldwide, including the Philippines;

4. By virtue of Opposer's prior and continued use of "EMI" in the Philippines and in other parts of the world, said trademark has become popular and internationally well-known and has established valuable goodwill for Opposer among consumers who have identified Opposer as the source of the goods bearing said trademark;

5. The registration and use of a confusingly similar trademark by the Applicant for use on identical or related goods will tend to deceive and/or confuse purchasers into believing that Applicant's products emanate from or are under the sponsorship of Opposer. Applicant obviously intends to trade, and is trading on, Opposer's goodwill;

6. The registration and use of a confusingly similar trademark by Applicant will diminish the distinctiveness and dilute the goodwill of Opposer's trademarks."

On March 19, 1990, a Notice to Answer was sent to Respondent-Applicant by registered mail with Return Card No. 1469 requiring Respondent to file its Answer to the Notice of Opposition within fifteen (15) days from receipt thereof; that said Notice was received by Respondent on March 23, 1990. Despite notice, Respondent did not file its Answer. For failure to file its Answer, and upon Motion of the Opposer, Respondent-applicant was declared in Default (Order No. 90-596 dated December 3, 1990).

Opposer, on April 5, 1991, in open court submitted its evidence ex-parte, consisting of Exhibits "A" to "DD" and their corresponding submarkings.

The issue to be resolved is whether or not the mark "BMI" used on blank and pre-recorded tapes and discs, applied for by Respondent is confusingly similar to the trademark "EMI" of the Opposer used on phonograph records.

Our Trademark Law, particularly Section 4(d) thereof provides as follows:

Section 4. Registration of trademark, tradenames and service marks on the principal register. – There is hereby established a register of trademarks, tradenames and service marks which shall be known as the principal register. The owner of a trademark, tradename 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 tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename previously used in the Philippines by another and not abandoned, as to be likely when applied to or used in connection with the applicant, to cause confusion or mistake or to deceive purchasers."

Comparing the drawing of the mark "EMI" as shown in the Certificate of Registration No. 21113 issued in the name of the Opposer (Exhibit "B") and the drawing of the mark "BMI" as shown in the drawing submitted by the Respondent-Applicant with its application bearing Serial No. 64593, one can readily conclude that the trademarks in question are confusingly similar. "EMI" and "BMI" consist of three (3) letters and the only difference between the two is the presence of letter "E" in one and "B" in the other; likewise when pronounced, the sound of both marks are almost the same. Likewise the letter "B" and letter "E" are of the same in style and appearance. Therefore, there is no question that the two marks are confusingly similar.

The Court held in *Chuan Chow Soy & Canning vs. Director of Patents*, L-13947, June 30, 1960, which was reiterated in the case of *Lim Hoa vs. Director of Patents*, 100 Phil. 214, thus:

"When one applies for the registration of a trademark or label which is almost the same or closely resembles one already used and registered by another, the application should be rejected and dismissed outright even without any opposition on the part of the owner and user of a previously registered trademark, this is not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill."

The trademark "BMI" as stated in the application filed by the Respondent-Applicant with this Bureau which is subject of this opposition proceeding is being used on blank and pre-recorded tapes and discs (Class 9) and on the other hand the Opposer's trademark "EMI" is now being used on gramophone records, blank, pre-recorded audio and video tapes, hence, the goods covered by both marks are identical or related to each other and are goods falling under the same Class 9.

Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores. (*Esso Standard Eastern, Inc., vs. Court of Appeals*, 116 SCRA 336,337). Therefore, there is likelihood that the buying public will be confused or misled into believing that Respondent-Applicant's "BMI" products originated from the Opposer.

It must also be emphasized at this point that both trademarks are being used on the same goods and under the same Class 25, according to the international classification of goods and are therefore sold in the same channel of trade. Thus, the public may be led into believing that Respondent-Applicant's products are those of Opposer's or originated from Opposer.

Therefore, to allow Respondent-Applicant's application would be contrary to Section 4(d) of R.A. No. 166, as amended as it would result in a situation where the general buying public will be confused and/or mistaken into buying or believing that the products of Respondent-Applicant originated or came from Opposer's since the trademark being applied for by Respondent is confusingly similar to the trademark of Opposer, hence, the trademark applied for by herein Respondent must perforce be DENIED registration.

It may also be stated that Respondent-Applicant exerted no effort to defend its rights in this case. In fact, it did not file its Answer to the Opposition and allowed itself to be declared in DEFAULT (Order No. 90-596) and as held recently by the Supreme Court in "*DELBROS HOTEL CORPORATION vs. Intermediate Appellate Court*", 159 SCRA, 533, 543 (1988) that:

"Fundamentally, default orders are taken on the legal presumption that in failing to file an Answer, the Defendant does not oppose the allegations and relief demanded in the complaint."

Indeed, this Office cannot but notice the lack of concern the Respondent had shown in protecting the mark it had applied for registration contrary to the disputable presumption that a

person takes ordinary care of his “concern” enunciated in Sec. 3 (d) of Rule 131 of the Rules of Court.

WHEREFORE, premises considered, herein Notice of Opposition filed by Opposer “EMI Limited” is, as it is hereby SUSTAINED. Accordingly, application for the trademark “BMI” bearing Serial No. 64593 filed on May 4, 1988 used on clanks and pre-recorded tapes and discs is, as it is hereby, REJECTED.

Let a filewrapper of this case 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 records.

SO ORDERED.

IGNACIO S. SAPALO
Director