

|                        |   |                                |
|------------------------|---|--------------------------------|
| SCHOTT GLASWERKE,      | ) | INTER PARTES CASE NO. 3293     |
| Opposer,               | ) |                                |
|                        | ) | OPPOSITION TO:                 |
|                        | ) |                                |
|                        | ) | Application Serial No. 55899   |
| - versus -             | ) | Filed : March 7, 1985          |
|                        | ) | Applicant : Visayan Glass      |
|                        | ) | Factory, Inc.                  |
|                        | ) | Trademark : "DURA GLASS"       |
|                        | ) | Used on : Cup & Saucer set     |
|                        | ) | tumbler, pitcher               |
|                        | ) | set, salad bowl set            |
|                        | ) |                                |
| VISAYAN GLASS FACTORY  | ) | <u>DECISION NO. 91-14 (TM)</u> |
| INCORPORATED,          | ) |                                |
| Respondent-Applicant.) | ) | September 27, 1991             |
| x-----x                | ) |                                |

DECISION

On February 15, 1989, Schott Glaswerke, a foreign corporation with business address at D-6500 Mainz, Hattenbergstrasse 10, Germany filed a Verified Notice of Opposition (Inter Partes Case No. 3293) to Application Serial No. 55899 for the trademark "DURA-GLASS" filed on March 7, 1985 by Visayan Glass Factory, Inc., of Cebu city covering the goods cup and saucer set, tumbler set, pitcher set, salad bowl set falling under class 21 of the international classification of goods, which was published for opposition on page 30, No. 8, Volume I of the Bureau of Patents, Trademarks and Technology Transfer Official Gazette and officially released for circulation on October 21, 1988.

The grounds for the opposition are as follows:

1. The mark "DURA-GLASS" under Serial No. 55899 of Respondent-Applicant is confusingly similar to the trademark "DURAN" of the Opposer registered with the Bureau of Patents, Trademarks and Technology Transfer under Certificate of Registration No. 33825 covering classes 9, 10 & 12, issued on November 14, 1984 which Opposer owns and has not abandoned;
2. The Opposer will be damaged and prejudiced by the registration of the mark "DURA-GLASS" in the name of Respondent-Applicant and its business reputation and goodwill will suffer great & irreparable injury;
3. Respondent-Applicant's use of the mark "DURA-GLASS" for saucer set, tumbler set, pitcher set, salad bowl set (SCI) in class 21 constitutes an unlawful and currently used by Opposer" (P-1-2. "Opposition").

In support of its opposition, Opposer has relied on the following facts to wit:

1. The trademark "DURA-GLASS" of the Respondent-Applicant is identical to Opposer's trademark "DURAN" as to be likely, when applied to the goods or when used in connection with the goods of Respondent-Applicant, to cause confusion or mistake or to deceive purchases as to the 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's;

2. Opposers' trademark "DURAN" is well-known throughout the world and in the Philippines and said mark has become distinctive of Opposer's goods and business;
3. Opposer' mark "DURAN" has long been established and obtained general international consumer recognition and goodwill as belonging to one owner or origin, the Opposer herein.

After a Notice to Answer was sent, Respondent-Applicant filed its Answer on August 14, 1989 stating therein the following:

1. The opposition is pro forma and is without merit, the grounds mentioned do not exist;
2. The registered trademark "DURAN" is not identical and cannot be, confusingly similar to the trademark "DURA-GLASS" under serial Number 55899 and no damage or prejudice can be suffered by the Opposer, nor will the use thereof constitute unlawful appropriation of Opposer's trademark nor cause confusion or mistake or be deceptive to purchases as to source or origin for the following reasons:
  - a) The trademark "DURAN" covers goods under classes 9, 10, and 12; the trademark "DURA-GLASS" covers goods under class 21; the two trademarks therefore refer to different classes of goods.
  - b) Even a cursory reading of the trademarks (from the letters alone) will easily distinguish and differentiate DURAN from DURA-GLASS:
  - c) Since it is not Opposer's trademark that is being used but a totally different trademark, and the different trademarks are applied to or used on different classes of goods there can be no unlawful appropriation of trademark;
  - d) Obviously, Opposer's goods bearing the trademarks "DURAN" are foreign in origin or source whereas Respondent-Applicant's goods using the trademarks "DURA-GLASS" are of local origin or source; hence there can be no confusion on origin or source;
  - e) The goods covered by the two distinct and different trademarks are not even competitive, there can, therefore, be no damage or prejudice to Opposer.

No amicable settlement having been reached, the case proceeded to trial on the merits. The parties presented and subsequently formally offered their respective testimonial and documentary evidence.

On April 19, 1990 and May 16, 1990, Respondent-Applicant and Opposer respectively filed their memorandum, after which the case was submitted for decision.

Should the trademark "DURA-GLASS" of Respondent-Applicant be denied registration for being contrary to the provisions of Sec. 4 (d) of R.A. No. 166 as amended? Said Section provides:

"Sec. 4 – Registration of trademarks, tradenames and servicemarks on the principal register. There is hereby established a register of trademarks, tradenames and servicemarks which shall be known as the principal register. The owner of a trademark, tradename or servicemark used to distinguish his goods,

business or services of other shall have the right to register the same on the principal register unless it:

xxx

d) Consist of or comprises a mark or tradename which so resembles, a mark or tradename registered in the Philippines or a mark tradename 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 applicants to cause confusion or mistake or to deceive purchases.”

As to the marks themselves, one of the applicable principles is that in determining confusing similarity, the marks must be considered as a whole. This principle has been recognized and applied in the Philippines as early as the year 1966 when the Supreme Court enunciated in the Case of ETEPHA vs. DIRECTOR OF PATENTS, et.al. (16 SCRA 499) that:

“A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of prospective buyer. The trademarks complained of should be compared and contrasted with the purchaser’s memory (not in juxtaposition) of the trademarks said to be infringed (87 C.F.S. 288-291). Some such factors as SOUND, APPEARANCE, FORM, STYLE, SHAPE, SIZE or FORMAT; Color ideas connoted by the marks, the MEANING, SPELLING and PRONUNCIATION of the words used and the setting in which the words appear may be considered” (87 C.F.S. 291-292).

It must be pointed out that Respondent’s trademark “DURA-GLASS” is enclosed in an artistic frame with a butterfly device. No such design exists with respect to the OPPOSER’S trademark “DURAN”. In fact, the latter has no background design whatsoever, it being evident that it consists merely of the word “DURAN” in simple lettering. From the appearance of the two trademarks taken as a whole, there exists substantial dissimilarities between them as aforementioned which serve to preclude any confusion on the part of an ordinary purchaser.

As to the goods the trademark “DURA-GLASS” is used on cup and saucer set, tumbler set, pitcher set, salad bowl set, while the trademark “DURAN” of the Opposer is registered with the Bureau of Patents, Trademarks and Technology Transfer under Certificate of Registration No. 33825 covering class 9 (Scientific, nautical, surveying, and electrical apparatus and instruments (including wireless), photographic, cinematographic, optical, weighing, signaling, checking (supervision), life-saving and teaching apparatus and instruments; coin or counter-reed apparatus; talking machine; cash registers; calculating machines; fire-extinguisher apparatus.); class 10 (surgical medical, dental, and veterinary instruments and apparatus (including artificial limbs, eyes and teeth); class 12 (vehicles; apparatus for locomotion by land, air or water) issued on November 14, 1984. Definitely the goods in connection with which the mark Dura-Glass is used and those which are indicated in the specification of goods in the certificates of registration of opposer for Duran are not identical or even related. The general rule is that the scope of protection to be afforded to a registered trademark should not be limited to the goods specified in the registration certificate but should include related goods. In Esso Standard Inc. v Court of Appeals (L-29971, Aug. 31, 1982, 116 SCRA 336) the court held:

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. Thus, biscuits were held related to milk because they are both food products. Soap and perfume, lipstick and nail polish are similarly related because they are common household items nowadays. The trademark

“Ang Tibay” for shoes and slippers and pants was disallowed to be used for shirts and pants because they belong to the same general class of goods. Soap and pomade, although non-competitive, were held to be similar or to belong to the same class, since both are toilet articles. But no confusion or deception can possibly result or arise when the name “Wellington” which is the trademark for shirts, pants, drawers and other articles of wear for men, women and children is used as a name of a department store. The trademark ESSO which the petitioner uses for its various petroleum products may also be used as a trademark for cigarettes by another, two products not being related and the public cannot be deceived as to which product they are buying.

From the foregoing, it is clear that the goods on which Dura-glass is used and those for which DURAN is registered are not related.

WHEREFORE, in view of the foregoing discussion, this Office holds that no confusing similarity exist between the marks “DURA-GLASS” and Opposer’s trademark “DURAN”. Hence, the Opposition filed by the Opposer is, as it is hereby DENIED. Accordingly, application Serial No. 55899 for the trademark “DURA-GLASS” of the Respondent-Applicant is, as it is hereby, GIVEN DUE COURSE.

Let the records of this case be remanded to Application, Issuance and Publications Division for proper action in accordance with this DECISION.

SO ORDERED.

IGNACIO S. SAPALO  
Director