

RE: APPEAL TO THE DIRECTOR  
FROM FINAL REFUSAL OF  
THE EXAMINER TO ALLOW  
REGISTRATION OF MARK

EX PARTE CASE NO. 209

Appln. Serial Nos. 48326  
and SR-9082  
Filed : May 19, 1982  
Applicant : Holland Systems, Inc.  
Trademark : HOLLAND PHILIPS  
Used on : Electrical ballasts

HOLLAND SYSTEMS, INC.,  
Appellant-Applicant.  
x-----x

DECISION NO. 88-9 (TM)  
February 3, 1988

### DECISION

This ex-parte appeal to the Director pertains to the final rejection of the Chief Trademark Examiner of Application Serial Nos. 48326 and SR-9082 for the registration of trademark "HOLLAND PHILIPS AND DEVICE LABEL" used on electrical ballasts. The two applications were filed on May 19, 1982 by the herein Appellant-Applicant, Holland Systems, Inc., of 160 Balingasa Street, Quezon City, Philippines.

The applications were finally rejected on the ground that Appellant-Applicant's mark "HOLLAND PHILIPS" is confusingly similar with the marks "PHILIPS" for television (electric) apparatus and "PHILIPS SHIELD EMBLEM" for electric lamps of all types, etc. registered, respectively, under Certificate of Registration Nos. R-2946 and 1674 in favor of Philips Export B. V. of Netherlands.

Section 4(d) of Republic Act 166, as amended, reads:

"Registration of trade-marks, trade names and service marks on the Principal Register. - The owner of a trademark 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:

x

x

x

d) Consists of or comprises a mark or trade-name which so resembles 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 goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers."

Appellant-Applicant alleges that in resolving cases of confusing similarity, marks should be viewed in their entirety and not dissected into elemental parts as applied in the following cases:

"In determining this matter, the marks must be considered as a whole and not dissected (Apex Elec. Mfg. Co. v. Landers, et al., 41 F /2/; B. F. Goodrich Co. vs. Hookmeyer, et al., 40 F /2/ 99). The buyer will not stop to dissect the marks. If he is

deceived, he will be deceived by the mark as a whole, and not by any particular part of it (Celotex vs. Millington, 49 F /2/ 1053) –”

Appellant-Applicant likewise invoked:

“A mark is not confusingly similar if a purchaser, practicing ordinary care, will not be deceived. That is, a manufacturer is not required to prevent careless buyers from being mistaken.” (Amdur, Trademark Law and Practice, pp. 432-433)

Appellant-Applicant also maintains that the goods of the subject mark are non-competitive and, therefore, its mark should have been allowed registration. It cited the cases of Acoje Mining Co. vs. Director of Patents, G.R. No. L-28744 for the mark “LOTUS”, Phil. Refining Co., Inc. vs. Ng Sam and Director of Patents for the trademark “CAMIA”; Hickock Mfg. Co., Inc. vs. The Hon. Court of Appeals, et al., G.R. No. L-4407; and the Esso Standard Eastern, Inc. vs. The Hon. Court of Appeals, et al., G.R. No. L-29971 for the mark “ESSO”.

Appellant-Applicant likewise assailed as error the non-application of the principles laid down by this Bureau in allowing the registration of trademark “DUNHILL” of A. G. United Company for hosiery for men (Regn. No. 2201 issued July 18, 1975) notwithstanding the existing registration of “DUNHILL” for clothing, including boots, shoes and slippers (Regn. No. SR-255); as used on cigarettes (Regn. No. 1723); as used on boxes and cases made of leather for holding articles of personal wear (Regn. No. 1443), etc.

An examination of the drawings of the mark “HOLLAND PHILIPS” shows that the word Holland is printed in very small letters, while the word Philips is printed boldly in the same style and manner with the mark “PHILIPS” in the cited references. An objective comparison of the three marks, i.e., “HOLLAND PHILIPS”, “PHILIPS” and “PHILIPS SHIELD EMBLEM” would right away show that their dominant and identical feature is the word Philips.

Applying the “test of dominancy”, the Supreme Court in American Wire and Cable Co. vs. The Director of Patents, L-26557, Feb. 18, 1970, 31 SCRA 544 held:

“Whether or not a trademark causes confusion and is likely to deceive the public is a question of fact which is to be resolved by applying the ‘test of dominancy’, meaning that if the competing trademarks contain the main or essential or dominant feature of another by reason of which confusion and deception are likely to result infringement takes place; that duplication or imitation is not necessary, a similarity in the dominant feature of the trademark would be sufficient.” (Phil. Nut Industry, Inc. vs. Standard Brands, Inc., 1975, 65 SCRA 579-580)

Furthermore, the goods belong to the same class of goods, are intended for the same industrial purpose, and pass through the same channel of trade. The clincher is the use by Appellant-Applicant, a domestic entity, of the word Holland as part of his mark. It establishes the factual basis of a calculated and deliberate intent to confuse the consumers as to the source of his mark and ride on the popularity and goodwill of well-known Philips products which are acquired by the Registrant thereof through long worldwide use and wholesome investment. Thus, the “LOTUS”, “CAMIA” and “ESSO” cases do not apply.

The Examiner did not err in not applying the Director's finding in allowing the Dunhill application because the facts of the case at bar are dissimilar. “PHILIPS” is considered a well-known mark in the Philippines for electric lamps and internationally as well. The rejection by the Examiner is clearly in keeping with the Memorandum-Circulars issued by the then Ministry of Trade and industry to the Director of Patents on November 20, 1980 and October 25, 1983, which in essence directed the Director of Patents to comply with our commitment to the Paris Convention in giving protection to signature and other world famous trademarks. Article 6bis of the Convention of Paris for the Protection of Industrial Property provides:

“The countries of the Union undertake, either administratively if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration and to prohibit the use of a trademark which constitutes a reproduction, imitation or translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well-known in that country as being already the mark of a person entitled to the benefits of the present Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

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x”

WHEREFORE, premises considered, the Examiner's final rejection is hereby AFFIRMED. Accordingly, Appellant-Applicant's Application Serial Nos. 48326 and SR-9082 are hereby REJECTED.

Let the records of this case be remanded to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO  
Director