

KAMAYAN PRODUCTS, INC.,
Opposer,
- versus -

IPC 14-2006-00141

Opposition to:
TM Application No.4-2004-000514
(Filing Date: 19 January 2004)

SAINT-GOBAIN ABRAISIVES, INC.
(formerly SAINT-GOBAIN
ABRAISIVES
(Singapore)PTE. LTD.,
Respondent-Applicant.

TM: "NORTON and DESIGN"

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Decision No. 2007 – 129

DECISION

For decision is the Notice of Opposition filed by Kayamanan Products, Inc. with address at Kayamanan Building., Km. 14, South Superhighway, Edison Avenue, Paranaque City against Application Serial No. 4-2004-000514 for the mark NORTON AND DESIGN for use on power operated grinding wheels under class 7 and hand operated grinding tools under class 8 and filed on January 19, 2004 by Saint-Gobain Abrasive (Singapore) Pte., Ltd., with address at 15 Bench Road, No. 04-03 Beach Centre, Singapore 189677; which later assigned its rights to Saint-Gobain, Inc., a corporation duly organized and existing under the law of he USA with address at 1 New Bind Street, Worcester, Massachusetts,01615-0008,United States of America, hereinafter referred to as respondent-applicant.

The grounds for the opposition are as follows:

1. The approval of the application in question is contrary to Section 123.1 (d) of Republic Act 8293;
2. As registered owner of the trademark NORTON the approval of the application will violate its right to the exclusive use of said registered trademark NORTON;
3. The approval of the application in question has caused and will cause great and irreparable damage and injury to herein opposer;
4. Respondent-applicant is now stopped to register the trademark NORTON AND DESIGN in its favor."

In support of its allegations, opposer attached the following documentary evidence:

Exhibit "A"	Certified true copy of Certificate of Registration No. 4- 2001-005727 for the trademark NORTON in favor of Kayamanan Products, Inc.
Exhibit "B"	Order No. 2006-36 (D)
Exhibit "C"	Duly notarized affidavit of Peter C. Uy
Exhibit "D"	Declaration of Actual Use
Exhibit "E"	Commercial invoices showing sales of goods bearing NORTON

The Notice to Answer was sent to Saint – Gobain Abrasives, (Singapore) Pte., Ltd. on 25 October 2006. In a manifestation dated January 2, 2007, the Bureau was informed that Saint –

Gobain Abrasives, Inc. was assigned the rights to the trademark application by the respondent-applicant, Saint – Gobain Abrasives, (Singapore) Pte., Ltd. which assignment was duly recorded with the Bureau of Trademarks. Thereafter, Notice to Answer was sent to the assignee of the application, herein respondent-applicant yet no answer was filed.

The only issue is whether the respondent-applicant is entitled to the registration of the NORTON and design mark.

The marks of the contending parties are reproduced hereunder for easy reference:

“Section 123. Registrability. 123.1 A mark cannot be registered if it:

(d) Is identical with a registered mark, belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of;

- (i) The same goods or services, or
- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion

Evidence show that opposer is the owner of the registered mark NORTON under Certificate of registration No. 4-2001-005727 issued on September 11, 2006 and used on goods under Class 7, or grinding wheel. (Exhibit “A”). The afore quoted provision of law states that a mark cannot be registered if it is identical with a mark that has been previously registered.

“Sec. 138. Certificate of Registration. – A Certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.”

A comparison of the mark reveal that they are identical words. The only difference is that respondent-applicant’s mark is encased in a parallelogram. The mark of the respondent-applicant is for use on the same goods of that of opposer Class 7, namely grinding wheels. Respondent-applicant also seeks to register the same for hand operated grinding tools under Class 8, which we believe is closely related to the goods of opposer which bear the NORTON mark. Hence, this Bureau concludes that there is likelihood of confusion among he buying public by the use respondent-applicant of the mark NORTON.

The Supreme Court in Etepha v. Director of Patents and Westmont Pharmaceuticals, Inc., No. L-20635, March 31, 1966 defines colorable imitation, it held:

“The validity of a cause for infringement is predicated upon colorable imitation. The phrase “colorable imitation” denotes such “close imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive an ordinary purchaser giving such attention as a purchaser usually gives, and to cause him to purchase one supposing it to be the other.

xxx

Confusion is likely between trademarks only if their over-all presentations in any of the particulars of sound, appearance, or meaning are such as would lead the purchasing public into believing that the products to which the marks are applied emanate from the same source.”

NORTON, being the dominant feature of the mark, the Court’s pronouncement in American Wire & Cable Co. vs. Director of Patents, 31 SCRA 544 is also applicable. The Supreme Court held:

“The question is, when is a trademark likely to confuse or to cause the public to mistake one for another. Earlier rulings of the Court seem to indicate its reliance on the dominance test or the assessment of the essential or dominant features in the competing labels to determine whether they are confusingly similar. xxx

In fact, even their similarity in sound is taken into consideration, where the marks refer to merchandise of the same descriptive properties, for the reason that the trade idem sonans constitutes violation of trade mark patents

In addition, opposer has adequately shown proof of its use in the Philippines of the goods bearing the NORTON mark. It showed its declaration of the actual use (Exhibit “D”) attaching therewith several sales invoices dated invariably between 2001 to 2003 to show the use of the commercial use of its mark. Opposer likewise submitted actual stickers and packaging of its goods bearing the NORTON mark.

It is basic in trademark jurisprudence that ownership of the mark grows out of its actual use in territory where it conducts its trade. The right to exclusive use of a trademark grows out of its actual use. (CIA General de Tabacos v. Alhambra & Cigarretes Manufacturing Co. 38 Phil 485). The exclusive right to a trademark grows out of their actual use, fro trademark is a creation of use. (Sterling Products International, Inc. v. Farbenfabrieken Bayer aktiengesellschaft, L-19906, April 30, 1969, 27 SCRA 1214).

WHEREFORE, premises considered the OPPOSITION filed by Kayamanan Products, Inc. against Application Serial No. 4-2004-000514 is, as it is hereby, SUSTAINED. Accordingly, Application Serial No. 4-2004-000514 for the registration of the mark NORTON AND DESIGN for use on power operated grinding wheels under class7 and hand operated grinding tools under class 8 and filed on January 19,2004 by Saint-Gobain Abrasives (Singapore) Pte., Ltd., which application was alter assigned to Saint –Gobain, Inc., is, as it is hereby, REJECTED.

Let the filewrapper of NORTON AND DESIGN, subject matter of this case be forwarded to the Bureau of Trademarks (BOT) for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, 24 September 2007

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office