

N.V PHILIPS GLOELAMPEN-
FABRIKEN,

Opposer,

INTER PARTES CASE NO. 1197

OPPOSITION TO:

- versus -

Application Serial No. 30980
Filed : October 25, 1976
Applicant : Tri-Lux Manufacturing
Corporation
Trademark : OSRAM PHILIPS
Used on : Soldering iron and
transformers

TRI-LUX MANUFACTURING
CORPORATION,

Respondent-Applicant.

x-----x

DECISION NO. 88-39(TM)

June 29, 1988

DECISION

This is an Opposition filed by N. V. Philips Gloelampenfabriken and Intervenor-Opposer, Osram G.m.b.H against Application Serial No. 30980 on October 25, 1976 by the herein Respondent, Tri-Lux Manufacturing Corporation for the trademark "OSRAM-PHILIPS" for use on soldering iron and transformers and starters for registration in the Principal Register.

Opposer is a foreign corporation organized and existing under the laws of the Federal Republic of Germany doing business at 16, Qudenarden Strasse, D-8 Munchen 30, Federal Republic of Germany.

Respondent-Applicant, Tri-Lux Manufacturing Corporation is a domestic corporation holding office at 631 Muelle de Binondo, Manila, Philippines.

The grounds for the said Opposition and Intervention are substantially the same based on the following statement of facts:

(a) For the Opposition:

"1. The Opposer has used the trademark PHILIPS in trade and in commerce in the Philippines since 30 September 1922. x x x

2. Opposer's trademark 'PHILIPS' is well-known in the Philippines and has excellent reputation in the Philippines because of the high and superior quality, as well as advertisements, of Opposer's products covered by said mark. x x x

3. Applicant's alleged mark "OSRAMPHILIPS" is confusingly similar to Opposer's trademark "PHILIPS". Moreover, the goods covered by both marks belong to the same class of goods, particularly International Class 9, of the Official Classification of Goods of the Patent Office, per Patent Office Administrative Order No. 20, dated 9 February 1978 amending Rule 15 and 82 of the Revised Rules of Practice in Trademark Cases.

4. The registration of applicant's alleged mark would violate Opposer's rights and interest in its trademark "PHILIPS" because the said marks are confusingly similar. Moreover, confusion between Opposer's and applicant's respective businesses and

product as well, as the dilution and loss of distinctiveness of Opposer's trademark is inevitable."

(b) For the Intervention:

"1. That the Intervenor-Opposer is the owner of the following Philippine Certificates of Registration:

- a. Certificate of Registration No. 9751 B.C. issued on October 1, 1929 and which was renewed on January 14, 1980 under Certificate of Renewal Registration No. 24 (now 2572) for OSRAM (label), for lighting, heating and ventilating apparatus, electric lamps, amps of all kinds, their parts and accessories in Class 35 (Intl. Class 9);
- b. Certificate of Registration No. 11729 B.C. issued on May 15, 1985 under Certificate of Renewal Registration No. 225-A (now 3394) for 'OSRAM' (label), for 'lighting, heating and ventilating apparatus, electric lamps of all kinds, their parts and accessories, in Class 35 (Intl. Class 9);
- c. Certificate of Registration No. 8296 issued on June 2, 1960 for, 'OSRAM' (word), for heating, lighting and ventilating apparatus, of all kinds, their parts and accessories, in Class 35 (Intl. Class 9).

2. That the trademark "OSRAM-PHILIPS" of TRI-LUX MANUFACTURING CORPORATION, when applied to or used in connection with goods of the Intervenor-Opposer causes or shall cause confusion and mistake and deceives or shall deceive purchasers as to the source and origin of the goods, and enables or shall enable unscrupulous dealers to pass off the goods of TRI-LUX MANUFACTURING CORPORATION for those of the Intervenor-Opposer herein to the injury of both, the Intervenor-Opposer and the buying public."

Respondent submitted its Answer denying specifically all the material averments of both the Opposition and the Intervention and raised several special/affirmative defenses.

During the trial on the merits, Opposer presented two witnesses who testified on the facts to support its Opposition. After Opposer rested its case, Respondent filed A Motion to Dismiss, which was denied.

In the meantime, the Motion for leave to file Intervention filed by Intervenor was granted and Respondent filed its Answer to the Complaint in Intervention. In the scheduled pre-trial conference on March 11, 1985, however, Respondent-Applicant and his counsel failed to appear despite prior notice. Thus, Intervenor's counsel moved that Respondent-Applicant can be declared as in default pursuant to the provisions of the Rules of Practice in Trademark Cases, as well as the provisions of the New Rules of Court. Accordingly, this Bureau issued, Order No. 85-211 dated March 12, 1985 granting said Motion and the Intervenor, on September 16, 1985, made its ex-parte presentation of evidence and, on September 25, 1986, formally offered the same. These evidences were admitted in open session for whatever worth they may have in the decision of this case.

The issue in this Opposition is whether Respondent-Applicant's mark "OSRAM-PHILIPS" and Opposer's mark "PHILIPS" and Intervenor-Opposer's mark "OSRAM" are confusingly similar. If so, then "OSRAM-PHILIPS" would not be registrable pursuant to Section 49d) of Republic Act 166, to wit:

"SEC. 4. Registration of trademarks, tradenames and service marks on the principal register. – x x x The owner of a trade-mark, trade-name or service mark used to

distinguish goods, business or services shall have the right to register the same on the principal register, unless it:

xxx

(d) Consists of or comprises mark or trade-name which so resembles a mark or trade-name registered in the Philippines or a mark or trade-name previously used in the Philippines by another and not abandoned, as to be likely, when applied to or connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers; “

As gathered from the evidences offered, Opposer (N.V Philips Gloelampenfabriken) was issued by this Bureau Certificate of Registration No. 4212 on April 23, 1956 and Renewal Certificate of Registration No. R-1651 dated September 9, 1976 but made effective on April 23, 1976 for use on goods falling under International Classes 9, 10 and 11 to which soldering iron, transformers and starters, the goods covered by Respondent's application likewise belong; and it had used "PHILIPS" in the Philippines continuously since 1922.

Intervenor-Opposer (Osram G.m.b.H) also obtained Philippine Certificate of Registration No. 24 issued on January 14, 1960, which was renewed under Certificate of Renewal No. 2527 (Exh. "A"). For "OSRAM" (label) for electrical lamps of all kinds, their parts and accessories in International Class 9; Philippine Certificate of Registration No. 11729-B.C. issued on May 15, 1934 but renewed on April 64 under Certificate of Renewal Registration No. 225 with a new certificate No. 225-A issued on May 6, 1965 and renewed once more under floats of Renewal No. 3394 issued on September 7, 19841 (Exh. "B") likewise for "OSRAM" label for lighting, heating and ventilating apparatus, electric lamps of all kinds, their parts and accessories in International Class 9.

Respondent-Applicant's mark "OSRAM-PHILIPS" under Application Serial No. 30980 filed on October 25, 1976 for soldering iron, transformers and ballasts is evidently a combination of two registered marks "OSRAM" and "PHILIPS" belonging to Intervor and the Opposer herein. This is a clear deception committed by Respondent-Applicant designed on the buying public which will consequently inflict damage to the business of the Opposer and the Intervenor.

Respondent-Applicant's mark is clearly unregistrable under Section 4(d), supra.

WHEREFORE, in view of the foregoing, Inter Partes Case No. 1157 (Opposition) is GRANTED. Accordingly, Application Serial No. 30980 filed on October 25, 1976 by the herein Respondent-Applicant for the trademark "OSRAM-PHILIPS" for use on soldering iron, transformers and ballasts under International Class 9 is REJECTED.

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

SO ORDERED.

IGNACIO S. SAPALO
Director

