SANSUI ELECTRIC CO., LTD.,
Also trading as Sansui
Denki Kabushiki Kaisha,
Opposer,

INTER PARTES CASE NO. 1870

OPPOSITION TO:

Application Serial No. 42109
Filed : August 4, 1980
Applicant : Victoriano Liu
Trademark : SANSUI
Used on : Rice cookers, electric fans and electric stoves

VICTORIANO LIU,
Respondent-Applicant.
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DECISION NO. 88-52 (TM)
July 20, 1989

DECISION

Before this Bureau is an opposition filed by Sansui Electric Co., Ltd. (herein Opposer) to the registration of the trademark “SANSUI” applied for by Victoriano Liu (herein Respondent-Applicant) under Application Serial No. 42109 for rice cookers, electric fans and electric stoves.

Opposer is a foreign company organized and existing under the laws of Japan and doing business at 14-1 Izumi 2-chome, Suginami-ku, Tokyo 168, Japan, while Respondent-Applicant is a Filipino citizen doing business at Room 1306 Don Isidro Yuyenco Building, 560 Q. Paredes, Binondo, Manila, Philippines.

The only issue advanced by the Opposer is whether or not it would be damaged by the registration of the said trademark “SANSUI” in the name of Respondent-Applicant.

To support its claim, Opposer presented as evidence a photocopy of an affidavit sworn to by Keizo Tujiwara, President of Opposer company. Attached thereto are copies of certificates of registration of the trademark “SANSUI” in over 100 countries, including the Philippines, all in the Opposer's name. In connection with the evidence presented, this Bureau takes notice of the Opposer's certificates of registration in the Philippines under Registration No. 14654 for amplifiers, tuners, speakers and transformers and Registration No. 23825 for encoders, decoders, transducers, channel dividers, head-phones, tapes, discs, record players, and tape recorders.

On its part, Respondent-Applicant in its Answer filed after four extensions relied upon the contention that goods sought to be covered by its mark-are “completely different” from the goods on which Opposer's trademark is applied. Thereafter, he failed to appear at the pre-trial and was declared in default. Although the Order of Default was set aside, Respondent-Applicant again failed to appear at the scheduled hearing. Consequently, Opposer was allowed to present its evidence ex-parte on August 23, 1985 but was able to only on September 5, 1986. Respondent-Applicant has had more than enough time to present evidence in his behalf or even just to contest the evidence of the Opposer had it wanted to, but did not. Thus, this case has to be decided upon the evidence presented.

The opposition has merit. The mere fact that the goods on which Opposer's trademark is applied are different from those of Respondent-Applicant, per se, is not determinative of the inexistence of confusing similarity. The Supreme Court has painstakingly discussed this point in the case of Ang vs. Teodoro, 74 Phil. 50, 54-55, thus:

"x x x the test employed by the courts to determine whether noncompeting goods are or are not of the same class is confusion as to the origin the goods of the second user. Although two noncompeting articles may be classified under two different classes by the Patent Office because they are deemed not to possess the same descriptive properties, they would, nevertheless, be held by the courts to belong to the same class if the simultaneous use on them of identical or closely similar trademarks would be likely to cause confusion as to the origin, or personal source, of the second user's goods. They would be considered as not falling under the same class only if they are so dissimilar or so foreign to each other as to make it unlikely that the purchaser would think the first user made the second user's goods."

x x x

"Such construction of the law is induced by cogent reasons of equity and fair dealing. The courts have come to realize that there can be unfair competition or unfair trading even if the goods are non-competing, and that such unfair trading can cause injury or damage to the first user of a given trademark, first by prevention of the natural expansion of his business and second, by having his business reputation confused with and put at the mercy of the second users. When non-competitive products are sold under the same mark, the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark created by its first-user, inevitably results. The preservation of the valuable link between him and the public that has been created by his ingenuity and the merits of his wares and services," (With emphasis)

Here, the Respondent-Applicant sought to use the trade-mark "SANSUI" for rice cookers, electric fans and electric stoves, while Opposer is using the same trade-mark for amplifiers, tuners, speakers, transformers, encoders, decoders, transducers, channel dividers, head-phones, tapes, discs, record players and tape recorders. It is of common knowledge that any of these goods of the parties may be purchased from a single appliance store, as such, the channel of trade is the same. And, as correctly observed by the Opposer, these goods are all electrically operated. What is more, the goods for the Respondent-Applicant's mark are very much within the zone of the potential or natural and logical expansion of the trade of the Opposer. Indeed, to allow the registration of Respondent-Applicant's mark and thereby allow its use on the goods sought to be covered, would be tantamount to allowing the prevention of the natural and logical expansion of the Opposer's trade and/or having his business reputation confused with and put at the mercy of Respondent-Applicant.

Moreover, the voluminous documents submitted by the Opposer consisting of photocopies of certificates of registration from many countries could amply qualify the trademark "SANSUI" in the ambit of well-known marks. On this regard, even for a totally different goods of Respondent-Applicant, the law still prohibits the use of a well-known mark. In the above-cited case of Ang vs. Teodoro, the Supreme Court said:

"(E)xperience has demonstrated that when a well-known trademark is adopted by another even for a totally different class of goods, it is done to get the benefit of the reputation and advertisements of the originator of said mark, to convey to the public a false impression of some supposed connection between the manufacturer of the article sold under the original mark and the new articles being tendered to the public under the same or similar mark." (With emphasis)

WHEREFORE, the opposition to the registration of the trademark "SANSUI" is hereby GRANTED. Accordingly, trademark Application Serial No. 42109 for the trademark "SANSUI" in the name of Victoriano Liu is REJECTED.

Let a copy of this Decision be forwarded to the Application, issuance & Publication Division for proper action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director