



SOLAR TURBINES, INCORPORATED,
Opposer,

-versus-

MARVIN VILLAFLORES,
Respondent-Applicant.

x-----x

} **IPC No. 14-2012-00261**
}
} Opposition to:
} Appln. Serial No. 4-2011-003641
} Date Filed: 30 March 2011
} TM: "SOLAR"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 202 dated September 28, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 28, 2015.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



SOLAR TURBINES, INCORPORATED,

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-versus-

MARVIN VILLAFLORES,

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IPC No. 14-2012-00261

Opposition to Trademark

Application No. 4-2011-003641

Date Filed: 30 March 2011

Trademark: **"SOLAR"**

Decision No. 2015- 202

DECISION

Solar Turbines, Incorporated¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-003641. The contested application, filed by New Standards Holdings, Ltd.² ("Respondent-Applicant"), covers the mark "SOLAR" for use on *"oil seal, valve seal, full-set overhauling gasket (oil seal, valve seal, copper washer, valve cover gasket, cylinder head gasket, oil fan gasket, manifold gasket, o-rings, collar packing), piston rings, engine valve, engine valve seal, engine o-rings, engine oil seal, engine hydraulic & pneumatic seal", "lamps and lights for automobiles; sealed beam, head lamp, fog lamp, corner lamp, halogen bulb, auto bulb, plug in bulb, peanut bulb, colored auto bulb, head light bulb, tail lamp, high intensity discharge (HID)" and "brake master assembly, brake master cylinder, clutch master assembly, wheel cylinder, clutch operating assembly, clutch cover, clutch operating kit, clutch disc, cv joint, piston assembly, tie rod end, engine valve, cylinder liners, water pump assembly, brake shoe, brake pads, ball joint, idler arm, pitman arm, rack end, bell crank, center link, drag link, suspension shaft kit, piston liners, stabilizer link, steering boots, cv brense, stabilizer link, muffler support, spring bushing, stabilizer bushing, suspension arm assembly, suspension arm bushing, shock mounting, control arm bushing, center bearing assembly, engine mount, transmission mount, shock mounting stopper, cab cushion stabilizer bushing, suspension bushing, bumper support, radiator support, full-set overhauling gasket (oil seal, valve seal, copper washer, valve cover gasket, cylinder head gasket, oil fan gasket, manifold gasket, o-rings, collar packing), engine seal kit, engine hydraulic and pneumatic seal, hose & tubing, packing & sealant, fan belt, timing belt, rubber belt, transmission belt, fuel & oil hose, brake hose, clutch hose, alternator hose, air pressure, pneumatic hose, engine support, transmission support, beak master repair kit, oil filter, fuel filter, cv boots, engine liner"* under Classes 07, 11 and 12, respectively, of the International Classification of Goods³.

¹ A corporation duly organized and existing under the laws of United States of America, with business address at 2200 Pacific Highway, San Diego, California 92101, United States of America.

² With address at 3230 Narra St., Brgy. Obrero, Tondo, Manila.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

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The Opposer alleges, among other things, that the Respondent-Applicant completely appropriates its own registered mark "SOLAR", which is covered by Certificate of Registration No. 4-2009-012204 issued on 21 October 2009. According to the Opposer, the Respondent-Applicant's application covers goods which it also deals in with its marks. In support to its Opposition, the Opposer submitted the affidavit of Frederick I. Jose, together with the annexes thereto, and the certified true copy of Certificate of Registration No. 4-2009-012204.⁴

The Respondent-Applicant filed his Answer on 14 January 2013 alleging that the controversy is whether there exists infringement or unfair competition, not simply whether the marks are similar. According to the Respondent-Applicant, its mark is not similar to the Opposer's claiming that product classification alone is not a decisive factor in determination thereof. It asserts that his goods are inexpensive items while the Opposer's are not. The Respondent-Applicant's evidence consists of a matrix of his and the Opposer's goods and class enrolled in the "SOLAR" mark.⁵

Pursuant to Office Order No. 154, s. 2010, the case was referred to mediation. The parties, however, refused to mediate. Accordingly, the Hearing Officer conducted a preliminary conference and the same was terminated on 04 February 2015. Thereafter, the parties submitted their respective position papers and the case was deemed submitted for decision.

The issue to be resolved is whether the mark "SOLAR" should be registered in favor of the Respondent-Applicant.

Prefatorily, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁶

Records show that the Opposer has a valid and existing registration for the mark "SOLAR" (Certificate of Registration No. 4-2009-012204 issued on 21 October 2009). On the other hand, Respondent-Applicant filed its application only on 30 March 2011.

⁴ Marked as Exhibits "B" to "C", inclusive.

⁵ Marked as Exhibit "1".

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

The competing marks are depicted below:

SOLAR

Opposer's mark



Respondent-Applicant's mark

The marks are practically identical. Any dissimilarity in presentation thereof, if any, does not eradicate the likelihood of confusion. As the marks are visually and phonetically identical, it is impossible not to remember or associate the Opposer's registered trademark "SOLAR" when one encounters the Respondent-Applicant's. This is so because the Respondent-Applicant will use the mark on goods that are similar and/or closely related to the Opposer's. The Respondent-Applicant's mark "SOLAR" is to be used on *"oil seal, valve seal, full-set overhauling gasket (oil seal, valve seal, copper washer, valve cover gasket, cylinder head gasket, oil fan gasket, manifold gasket, o-rings, collar packing), piston rings, engine valve, engine valve seal, engine o-rings, engine oil seal, engine hydraulic & pneumatic seal", "lamps and lights for automobiles; sealed beam, head lamp, fog lamp, corner lamp, halogen bulb, auto bulb, plug in bulb, peanut bulb, colored auto bulb, head light bulb, tail lamp, high intensity discharge (HID)" and "brake master assembly, brake master cylinder, clutch master assembly, wheel cylinder, clutch operating assembly, clutch cover, clutch operating kit, clutch disc, cv joint, piston assembly, tie rod end, engine valve, cylinder liners, water pump assembly, brake shoe, brake pads, ball joint, idler arm, pitman arm, rack end, bell crank, center link, drag link, suspension shaft kit, piston liners, stabilizer link, steering boots, cv brense, stabilizer link, muffler support, spring bushing, stabilizer bushing, suspension arm assembly, suspension arm bushing, shock mounting, control arm bushing, center bearing assembly, engine mount, transmission mount, shock mounting stopper, cab cushion stabilizer bushing, suspension bushing, bumper support, radiator support, full-set overhauling gasket (oil seal, valve seal, copper washer, valve cover gasket, cylinder head gasket, oil fan gasket, manifold gasket, o-rings, collar packing), engine seal kit, engine hydraulic and pneumatic seal, hose & tubing, packing & sealant, fan belt, timing belt, rubber belt, transmission belt, fuel & oil hose, brake hose, clutch hose, alternator hose, air pressure, pneumatic hose, engine support, transmission support, beak master repair kit, oil filter, fuel filter, cv boots, engine liner"* under Classes 07, 11 and 12, respectively. Similarly, Opposer's mark "SOLAR" cover goods and/or services for *"gas turbines and parts and equipment therefor; turbo machinery and parts and equipment therefor; enclosures to contain turbomachinery, ancillary equipment and gas compressors; gas compressors and parts and equipment therefore; gas compressors and parts and equipment therefor for oil and gas industry; gas turbine driven equipment; gas turbine packages; gas turbine modules; gear boxes, other than for land vehicles; internal combustion engines, other than for land vehicles, and*

parts and equipment therefor; power generation equipment power packages, and part therefor, excluding power generation equipment solely for harnessing energy from the sun; oil and gas production and exploration equipment modules", "computer hardware and software for controlling, managing, maintaining, remotely monitoring, diagnosing and communicating with gas turbines, gas compressors, internal combustion engines, power generation equipment, and power packages; computer hardware and software for controlling, managing, maintaining, remotely monitoring, diagnosing and communicating with gas turbines, gas compressors, internal combustion engines, power generation equipment, and power packages" and *"repairing, servicing, maintaining, inspecting, installing, remanufacturing, upgrading, and leasing of gas turbines, gas compressors, internal combustion engines, power generation equipment, and power packages, and of parts and equipment therefor, excluding power generation equipment solely for harnessing energy from the sun"* under Classes 07, 09 and 37. As the goods are similar and/or related, there is a possibility that the consumers will believe that the Respondent-Applicant's mark is affiliated to or sponsored by the Opposer and vice-versa.

Succinctly, confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.⁷

Moreover, any difference in the prices of the goods covered by the competing marks does not remove the possibility of mistake and/or confusion. In fact, modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trade-mark or trade-name is likely to lead to a confusion of source, as where prospective purchasers would be misled into thinking that the complaining party has extended his business into the field or is in any way connected with the activities of the infringer; or when it forestalls the normal potential expansion of his business.⁸

Furthermore, Callman notes two types of confusion. The first is the *confusion of goods* "in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other." In which case, "defendant's goods are then bought as the plaintiff's, and the poorer quality of the former reflects adversely on the plaintiff's reputation." The other is the *confusion of business*: "Here though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff, and

⁷ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁸ Skechers, USA, Inc. vs. Inter Pacific Industrial Trading Corp., G.R. No. 164321, 23 March 2011.

the public would then be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."⁹

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code, which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor with an earlier filing or priority date, with respect to the same or closely related goods or services, or has a near resemblance to such mark as to likely deceive or cause confusion.¹⁰

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-003641 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 28 September 2015.


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

⁹ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

¹⁰ Great White Shark Enterprises vs. Danilo M. Caralde, Jr., G.R. No. 192294, 21 November 2012.