

Republic of the Philippines
 Ministry of Trade and Industry
 PHILIPPINE PATENT OFFICE
 403 Midland Building
 Buendia Ext., Makati, MM.

STANLEY WORKS,) INTER PARTES CASE NO. 1501
 Opposer,)
) OPPOSITION TO:
)
) Appln. Serial No. 31128
) Filed: November 17, 1976
) Applicant: Stanley Electric
 - versus -) Co., Ltd.
) Trademark: STANLEY
) Used on: Measuring and
) scientific appliances
)
) DECISION NO. 84-77 (TM)
 STANLEY ELECTRIC CO., LTD.,)
 Respondent-Applicant.) August 28, 1984
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D E C I S I O N

This case is an Opposition made by Stanley Works (Opposer) against the application for registration of the trademark "STANLEY" for use on measuring and scientific appliances in Class 27; for use on heating, lighting and ventilating apparatus in Class 35; for use on prints and publications in Class 39; for use on dental, medical and surgical appliances in Class 45; for use on communication instruments and appliances in Class 64; and for use on education and entertainment machines, apparatuses and instruments in Class 67 under Application Serial No. 31128 filed with this Office on November 17, 1976 by Stanley Electric Co., Ltd. (Respondent-Applicant), published on Page 8414, No. 44, Vol. 76, November 3, 1980 issue of the Official Gazette, officially released for circulation on March 2, 1981.

The records show that Opposer is a foreign corporation of the State of Connecticut, U.S.A., with principal place of business at 195 Lake Street, New Britain, Connecticut,

U.S.A., while herein Respondent-Applicant is likewise a foreign corporation of Japan, with business address located at No. 9-13, 2-chome, Nakameguro, Meguro-ku, Tokyo, Japan.

On March 30, 1981, Opposer, through counsel filed a Motion for Extension of Time to File Opposition to herein subject application, which was granted under an Office Order dated April 20, 1981 and was given thirty (30) days from April 1, 1981 within which to file its Notice of Opposition. Unable to file immediately the aforesaid Opposition, Opposer's counsel meantime filed an Unverified Notice of Opposition on April 30, 1981 and, on June 26, 1981, filed the verified Notice of Opposition, the grounds of which are as follows:

"1. The Applicant's trademark STANLEY is identical to the trademark STANLEY owned by Opposer and not abandoned, as to be likely, when applied to or used in connection with the goods of the applicant, to cause confusion or mistake or to deceive purchasers thereof. Further, the use of the mark STANLEY by the applicant will dilute the value of Opposer's trademark.

2. The registration of trademark STANLEY in the name of Stanley Electric Company, Limited will cause great and irreparable injury and damage to the Opposer within the meaning of Section 8 of R.A. No. 166, as amended."

In support of the foregoing grounds, the herein Opposer has relied on the following facts:

"(1) Opposer is the registered owner of the trademark STANLEY under the following registrations issued by the Philippine Patent Office:

a. Registration No. R-1262 issued on August 22, 1973 for twenty years period from October 22, 1971 for the following goods: Hinges, hasps and staples used with hasps, sash and clothes line pulleys; table and chair brands; door hardware comprising holders, bars, braces, couplings, guards, padlock eyes, turn buttons, handles, pulls and sliding rails; chest handles, corner irons

and mending plates, box strapping and fasteners, wrought steel washers and burrs, hooks, blind and shutter hardware; closet hardware comprising hat holders, show racks, hanger bars, and hooks; window and screen hardware comprising hangers, lifts, and poles; lid supports; hardware for swinging, rolling, sliding, and upward acting doors comprising tracks, hangers, brackets, guides, rollers, stays and operators; wardrobe hardware, and shelf brackets.

- b. Registration No. R-1263 issued on August 22, 1973 for twenty years period from October 22, 1971 for the following goods; Electric tools, consisting in drills, hammers, screw drivers, grinders (bench, aerial, and pedestal), saws, shears, sanders, and electric soldering irons.
- c. Registration No. R-1619, issued on December 16, 1975 for twenty years period from October 22, 1971 for the following goods; Planes, fibre board cutters, scrappers, spoke shaves, bit braces, hand drills, breast drills, bit extensions, countersinks, doweling jigs, screw drivers, screwdriver bits, mallets, chisels, hollow handle tool sets comprising gimlet, file, saw chisels, reamer, scratch awl, brad awl, screw driver and tack puller; vises, saw sets, nail sets, center punches, ice picks, awls, bench stops, hammers, hatchets; mitre vises, mitre cutters, mitre sanders, butt mortisers, and wood weed cutters; rules, levels, plumbs, trammel points, level sights, bit gauges, squares, bevels, angle dividers, marking gauges, butt gauges and odd jobs being a combination

tool used for level plumb, try square, mitre square, bevel, scratch awl, depth gauge, marking gauge, mortise gauge, beam compass and rule; plumb bobs and mitre boxes.

d. Registration No. 23955 - issued on September 7, 1976 for twenty years period from issuance of title, for the following goods; Pliers, bolt cutters and surface forming tools particularly planes and files.

e. Registration No. 24884 issued on June 30, 1977 for twenty years period from issuance of title for the following goods; Drapery hardware.

(2) Registration Nos. R-1262, R-1263 and R-1619 are renewals of Registration Nos. 13884, 13882 and 13883, respectively, all issued by the Bureau of Commerce on October 22, 1941 for a term of 30 years from date of issuance.

(3) The application subject of opposition was filed only on November 17, 1976 on the basis of Japanese registrations.

(4) Opposer has used the trademark STANLEY in the Philippines as early as 1902 and is using said trademark in the Philippines up to the present.

(5) By reason of superior quality of its goods and advertisements, Opposer had established a valuable goodwill in the Philippines for its mark STANLEY long prior to November 17, 1976.

(6) The marks of the applicant and the Opposer are identical. The use and registration of trademark STANLEY by the applicant for its goods is likely to cause confusion, mistake and deception of the public as to the origin of the goods and/or will dilute the value of Opposer's trademark STANLEY.

(7) The use and registration of the mark STANLEY by Applicant will cause to the Opposer irreparable damage or injury."

Respondent-Applicant, on the other hand, was required by this Office on July 8, 1981 to file his Answer to the Notice of Opposition within fifteen (15) days from receipt thereof. After granting Respondent's Motion for extension of time to file his Answer within fifteen (15) days from August 2, 1981, Respondent-Applicant indeed filed his Answer on August 14, 1981 denying specifically all the material averments in this Opposition and raising its special and affirmative defenses as contained in the said Answer.

After receipt of the said Answer and, issues having been joined, a Pre-Trial Conference was called for the purpose of threshing out the possibility of an amicable settlement or simplification of the issues involved in this case. Incidentally, both parties have signified in their respective Pre-Trial Briefs that they are each open to an amicable settlement and, in fact, in RespondentApplicant's Pre-Trial Brief, last paragraph, Page 5 thereof, it indicated that "negotiations were being undertaken abroad by the parties who are non-residents".

Several resettings of the scheduled hearings of this case have been made since September 28, 1981, all alleging as common ground for such postponements the fact that there was a pending negotiation abroad between the parties themselves for the amicable settlement of this case.

In the hearing of July 17, 1984, a Compromise Agreement signed by their respective counsels, substantially based on the Undertaking (Annex "A") and duly signed by the authorized officers of the real parties herein -- Stanley Works and Stanley Electric Company, Limited -- was submitted to this Office, the pertinent provisions of which are quoted hereunder, to wit:

"1. That Respondent-Applicant STANLEY ELECTRIC CO., LTD., recognizes and respects the prior rights of Opposer, THE STANLEY WORKS in connection with the use of the trademark STANLEY in the Philippines.

2. That Respondent-Applicant STANLEY ELECTRIC CO., LTD. has agreed as it hereby agrees

to amend its Application Serial No. 31128 for trademark STANLEY, by limiting the goods applied for to only the following articles:

DIODES, ELECTROLUMINESCENT DIODES, CYCLISTA, TRANSISTORS, INTEGRATED CIRCUITS, HYBRID CIRCUITS, PHOTO DIODES, PHOTO TRANSISTORS, PHOTO CAPLER, CELLENIUM RECTIFIERS, RESISTERS, ELECTROLUMINESCENCES, ELECTROPHOTOPHOTOGRAPHIC LIGHT-SENSITIVE MEMBERS; INDICATING MACHINERY AND IMPLEMENTS USED FOR LIQUIDS CRYSTAL, SOUND, AUTOMOBILES AND PANEL; ELECTRIC SOURCES SUCH AS COMPUTERS, OFFICE MACHINES, RAIL SIGNALS, TOOL MACHINES, DUST COLLECTOR AND COATING AND PAINTING MACHINES; CONSTANT VOLTAGE AND ELECTRIC IMPLEMENTS OR APPARATUS FOR INDUSTRY AND AUTOMOBILES; COMMUNICATION MACHINERY AND IMPLEMENTS INCLUDING ELECTRONIC APPARATUS FOR TOOL AND MICROCOMPUTER APPLIED PRODUCTS; ELECTRONIC WELDERS, APPARATUS FOR REMOVING MOLTEN SOLDER FROM A SOLDERED JOINT, DISCHARGE COATING APPARATUS, ULTRASONIC ABRASIVE APPARATUS, CHARGERS, NOICE FILTERS, TRANSFORMERS, PREPARING MACHINE FOR PRINT BASIC PLATE; DISTRIBUTING INSPECTION APPARATUS, CABLE TESTERS, AUTOMATIC INSPECTION APPARATUS, PHOTO RELAY, TRAFFIC SIGNALS, PLASTIC MOLDING MACHINES; AUTOMOBILES PART SUCH AS SPEED METER, FUEL METER, WARNING SYSTEMS, INDICATOR SYSTEMS, BATTERY-VOLTAGE INDICATOR SYSTEMS, REGULATORS; LIGHTER, OIL EXCHANGING MACHINES; LIGHTING FOR DUS DISHBOARD INSTRUMENTS; AIRCONDITIONER, WIRE HARNESS AND FUSE FOR AUTOMOBILES; ELECTRIC BULBS, SMALL ELECTRIC BULBS, SPECIALIZED BULBS, HALOGEN BULBS, NEON LAMPS, MERCURY LAMPS, NATRIUM LAMPS, ROAD LIGHTING LAMPS, HALOGEN LAMPS FOR AIRCRAFTS, RAILWAY AND AUTOMOBILES; FLASH LIGHTS, MEASURING APPARATUS OF LUMINOUS INTENSITY FOR FIXING A SHUTTER SPEED OR A DIAPHRAM VALUE OF CAMERAS, CAMERA METER, FILM EDITOR MACHINE AND VTR AUTOMATIC IRIS

APPARATUS; SPHYGMOMANOMETER, STETHOS-
COPE, THERAPEUTIC LIGHTING MACHINE,
LOWER FREQUENCY THERAPEUTIC MACHINE.

3. That Respondent-Applicant Stanley Electric Co., Ltd. shall execute any and all documents necessary to effect the above amendment to Application Serial No. 31128 for the trademark STANLEY;

4. That by this Compromise Agreement, all the disputes and issues between the parties as are or could have been raised in this opposition case are considered fully and finally settled, waived or otherwise put an end;

5. That opposer, The Stanley Work, has agreed to withdraw as it hereby withdraws its Notice of Opposition to Application Serial No. 31128 as amended, of the Stanley Electric Co., Ltd. for the trademark STANLEY;

6. That it has been mutually agreed by both parties that this Compromise Agreement and the Undertaking (Annex 'A') shall be submitted to this Honorable Office for its approval and jointly pray for a judgment based on its terms."

The purpose of the foregoing Compromise Agreement and Undertaking is to limit the products or goods of Respondent-Applicant, Stanley Electric Co., Ltd., upon which its trademark "STANLEY" may be used in this jurisdiction.

It appearing that the above Compromise Agreement is not contrary to law, public customs and morals, and public policy, the same is, as it is hereby, APPROVED.

WHEREFORE, foregoing premises considered, this Opposition filed by Stanley Works of U.S.A. against the registration of the trademark "STANLEY" in the Philippines by Stanley Electric Co., Ltd. of Japan is, as it is hereby, DISMISSED. Accordingly, Application Serial No. 31128 for the registration of the trademark "STANLEY" by Respondent-Applicant should be given due course, subject to the terms and conditions set forth in the attached Compromise Agreement.

Let the records of this case be transmitted to the Trademark Examining Division for appropriate action.

SO ORDERED.

(SGD.) CESAR C. SANDIEGO

Director