

SONG FO & CO., PLAINTIFFS AND APPELLANTS, VS. TIU CA SIONG, DEFENDANT AND APPELLEE.*G.R. No. 5007. March 11, 1909*

Ponente: WILLARD, J.

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This is an action for an injunction and damages brought under the provisions of Act No. 666 relating to trade-marks, and apparently it is based on section 7 of that Act, concerning unfair competition. The plaintiffs' marks were registered on the 25th of August, 1903, and consequently under the provisions of section 15 of the Act they, prima facie, have the exclusive right to use them. The defendant claims that his two marks are not imitations of the plaintiff's marks. Exhibits A and B, the two marks of the plaintiffs, are as follows: [See 13 Phil. Rep., pages 144, 145.]

NOTE.—In the original designs, plaintiffs' exhibits A and B, the words "Ginebra Ginete" and "Ginebra Honrada" are in white upon a black ground. The single horse and rider are in black and white, and on the mark showing two horses, one is white and the other black, both on a red ground with the words "Marca Registrada" in white letters. The words "Superior Calidad," "Clase Superior," and "Song Fo y Ca." are in white letters on a red field. "S. F. & Co." and "Dos Caballos" are in black letters upon a strip of white, and "Manila" in white upon a black scroll. The two groups of medals are in gold with black inscriptions, with the words immediately surrounding them in black. The whole lower section of the two marks is in red with white letters. The outside borders of both designs are in gold upon black.

One of the marks of the defendant is Exhibit D, which is as follows: [See 13 Phil. Rep., page 147.]

NOTE.—In the original design, the single horse and rider, the back grounds, the lettering and the bolder are in the same colors as those of plaintiffs' Exhibits A and B, with the exception of the words "Garantiza su bondad" and "Por eminencia de la ciencia," surrounding the group of medals, which are in red letters.

The bottles used by the plaintiffs and the defendant are the same. They are black glass bottles, quadrangular in shape, smaller at the bottom than at the top.

In the case of the United States vs. Manuel (7 Phil. Rep., 221), this court said at page 225:

"The true test of unfair competition is whether certain goods have been clothed with an appearance which is likely to deceive the ordinary purchaser exercising ordinary care, and not whether a certain limited class of purchasers with special knowledge not possessed by the ordinary purchaser could avoid mistake by the exercise of this special knowledge."

The court below held that Exhibit D, defendant's mark, came within this rule, and was so close an imitation of the plaintiffs' marks, especially Exhibit A, as to deceive the ordinary purchaser.

Exhibit C, the other mark of the defendant is as follows: [See 13 Phil. Rep., page 148.]

NOTE.—In the original design the grounds are in black, red and white, with lettering in white, black and red.

The court held that this was not so close an imitation of the plaintiffs' marks as to deceive the ordinary purchaser. We agree with the view of the court as to both marks. In *Liggett & Meyers Tobacco Co. vs. Finzer* (128 U. S., 182), the court, considering a similar case, said at page 184:

"The judgment of the eye upon the two is more satisfactory than evidence from any other source as to the possibility of parties being misled so as to take one tobacco for the other."

The principal defense, however, was a claim that the plaintiffs themselves are not entitled to relief by reason of the provisions of section 9 of Act No. 666. That section is as follows:

"No action, or suit, or criminal prosecution shall be maintained under the provisions of this Act in any case where the violation of the trade-mark or trade name or the unfair competition complained of has been in any unlawful business, or with respect to any article, trade in which is unlawful, or is against public policy, or in any case where the trade-mark, trade name, or the indicia of origin, ownership, or manufacture have been used by the complaining and injured party for the purpose of himself deceiving the public with respect to the character of the merchandise sold by him or of the business or profession or occupation carried on by him."

The defendant proved that the firm of Daniel Visser & Zonen, of Schiedam, had for more than fifteen years used in trade in these Islands a mark of which the marks of the plaintiffs are, he claims, imitations, and he offered in evidence one of these labels which was marked Exhibit 1, and is as follows: [See 13 Phil. Rep., page 150.]

NOTE.—In the original mark the colors are: Black letters upon a white ground, with the exception of the words "Calidad Superior," and "Schiedam" which are in red letters, and the shield beneath the words "Unica medalla de oro," which is in black, white and red, and partly encircling the words "Ginebra de Holanda" is a heavy red line.

While the words "Ginebra Honrada" at the top of Exhibit B are suspiciously similar to the phrase "Ginebra de Holanda" at the top of Exhibit 1, yet to our minds the existence of any fraud on the part of the plaintiffs is completely rebutted when it is considered that the bottles in which the Schiedam gin is always imported and sold in these Islands are entirely different from the bottles used by the plaintiffs. The Schiedam gin always comes in a long, stone bottle of cylindrical shape. The plaintiffs had never used such a bottle and it would be impossible for any purchaser buying one of the black bottles of the plaintiffs to believe that he was buying Schiedam gin, which never came in any such shape.

In the case of *Ubeda vs. Zialcita*,^[1] No. 4392, decided February 17, 1909, a similar defense was considered and sustained, but in that case it was very clear that the plaintiffs were attempting to pass off their goods as the goods of the importer.

The court below, while allowing an injunction against the use of Exhibit D, refused to allow the plaintiffs any damages, and they assign that refusal as error. The testimony showed that the defendant commenced to use these marks about July, 1907, and also showed the number of sales by the plaintiffs during each month of that year. According to this showing, the sales in April were 313 cases, in May 255, in June 372, in July 212, in August 204, in September 196, in October 201, in November 185, and in December 215, and the plaintiffs claim that the falling-off in the sales from June was due to the unfair competition of the defendant. The evidence, however, is not sufficient in our opinion to show that this was the cause of the decrease, and this is made more apparent when we consider the proof as to the sales made by the defendant during that same time. There was a decrease from June to July in the plaintiffs' sales of 160 cases, but during the month of July the defendant sold only six cases. There is, therefore, no basis for determining what would have been the reasonable profits which the plaintiffs would have made had the defendant not sold the goods with the trade-mark aforesaid. Section 3 of the Act, however, provides that the plaintiff may recover the profits which the defendant actually made out of the sale of

the goods with the trade-mark. While there is proof of the number of cases which the defendant sold during this time, there is no proof as to the profit which the defendant made on each case. There was, therefore, no basis for allowing damages upon that ground.

The result is that the judgment of the court below is affirmed, without costs to either party.

Arellano, C. J., Torres, Mapa, and Carson, JJ., concur.

[1] Page 11, *supra*.

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