

A. NATTERMANN & CIE, GMBH
Opposer,

INTER PARTES CASE NO. 3837
Opposition to:

- versus-

Serial No.: 74963
Date Filed: February 08, 1991
Trademark: "ESSENTIALS"

SABRINA CHUA
Respondent-Applicant.
x-----x

DECISION NO. 97-20

DECISION

This case involves an opposition to registration of the mark "Essentials", application for which was filed by SABRINA CHUA on February 08, 1991, and bearing Serial No. 74963, for household, kitchenwares and electrical appliances, namely dinnerware, glasswares, tumblers, cups and saucers, electric fan, electric iron, turbo broilers, lamps, plastic rice, spoon, ladle, table cloth, rechargeable emergency light, utility rack, in classes 8, 21 and 11, International Classification of goods. The trademark application was published for opposition in the Bureau of Patents and Trademarks Official Gazette (Vol. V, No. 4 at pg. 13) and which was released for circulation on September 11, 1992.

Opposer, NATTERMANN & CIE, GMBH is a corporation duly organized under the laws of Germany doing business at Nattermannellee 1, 5000 Koln 30 (Bocklemund), Germany filed its verified Notice of Opposition docketed as IPC NO. 3837 on January 11, 1993.

The grounds of the opposition are as follows:

1. Opposer is the owner of trademark ESSENTIALS 303 NATTERMANN which also forms part of its corporate name, which it has been granted by the Philippines Patent Office Certificate of Registration No. 17587 on August 4, 1972 and has applied for renewal of registration of said mark per Serial No.81977 filed on August 4, 1992,
2. Opposer as owner of the trademark ESSENTIALS 303 NATTERMANN has used the same on its products long prior to respondent-applicant's above indicated application.
3. Respondent-Applicant's alleged mark ESSENTIALS is deceptively or confusingly similar to Opposer's trademark ESSENTIALS 303 NATTERMANN in all aspects.
4. As owner and prior user of the trademark ESSENTIALS 303 NATTERMANN which is a well-known trademark and tradename worldwide of Opposer. Opposer has the exclusive right to use not only the trademark ESSENTIALS 303 NATTERMANN but also to exclude any other person or entity from using any similar trademark ESSENTIALS 303 NATTERMANN of Opposer. Consequently, the registration of respondent-applicant's alleged mark ESSENTIALS would violate Opposer's right and interest in its trademark ESSENTIALS 303 NATTERMANN because ESSENTIALS is deceptively or confusingly similar to that of Opposer's mark and/or the use by respondent-applicant of ESSENTIALS would likely cause confusion or deception in the public, so as to cause prejudice to Opposer; and weaken and/or dilute the strength, distinctiveness, quality, reputation and goodwill of Opposer's trademark.
5. The registration of respondent-applicant's alleged mark ESSENTIALS will violate provisions of the Paris Convention, of which Opposer's domicile country and the Philippines are members, and of Republic Act No. 166 as amended, particularly Section 4 thereof because ESSENTIALS is a mark which so resembles Opposer's

mark which is used in the Philippines and not abandoned, as to be likely, when applied to or used in connection with the goods of respondent-applicant, to cause confusion or mistake or to deceive purchasers, and respondent-applicant's application for registration of ESSENTIALS should accordingly be denied.

To support its claim, Opposer presented as evidence the sworn copy of an Affidavit executed by Balthasar Gasgonia, the Assistant to the President of Natrapharm, Inc. (Exhibit "D") and Certificate of Registration No. 17587 issued on August 4, 1992 and renewed for another twenty years effective August 4, 1992 for the goods under international class 5 and said mark was likewise registered in Western Germany with Certificate of Registration No. 639493, issued on the 8th day of June 1953.

On the part of the Respondent-Applicant, a Notice to Answer the authenticated opposition was duly served on him on February 1, 1993 and that notwithstanding the lapse of more than 15 days given for a period to file the required Answer, he failed to do so hence, she was declared in DEFAULT upon Motion of the Opposer (ORDER NO. 93-279) dated April 23, 1993.

Pursuant to the Order of Default, Order No. 93-279, Opposer presented its evidence Ex-Parte on July 30, 1993 consisting of Exhibits "A" to "D" inclusive of submarkings. 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 she wanted to, but did nothing.

Thus, this case has to be decided upon the evidence presented by herein Opposer.

The main issue to be resolved in this particular case is whether or not Respondent-Applicant's trademark "ESSENTIALS" is confusingly similar to Opposer's trademark "ESSENTIALS 303 NATTERMANN" and that the registration of which is violative to Sec. 4 (d) of R. A. 166 as amended.

Sec. 4 of R.A. 166, as amended, provides as follows:

"SEC. 4. Registration of trademark, tradenames, and service marks on the principal register. There is hereby established a register of trademarks, tradenames and service marks which shall be known as the principal register. The owner of the trademark, tradename and service mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register unless it:

x x x

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

In the case at bar, there is no difficulty in arriving at a conclusion that the products of the two parties connected with their respective trademarks are distinct and different from each other. The goods of the Respondent-Applicant pertains to household kitchenwares and electrical appliances, namely dinnerwares, glasswares, tumblers, cups and saucers, electric fan, electric iron, turbo broilers, lamps, plastic rice, spoons, ladle, table cloth rechargeable emergency light, utility rack which are products falling under classes 8, 21 and 11 of the international classification of goods, while the Opposer's products/goods pertain to hygienic products which are furthermore indisputably closely allied to the goods in class 3 -"bleaching preparations and other substances for laundry use; cleaning, polishing and abrasive preparations; soaps, dentifrice" - dietetic

products for children and sick people, plasters, material for bandaging, disinfectants; preparations to destroy weeds and damage animals (i.e. kill vermin).

From the goods alone of the competing parties or the products covered by the competing marks, which is clearly shown that they fall under different classes, they do not serve the same purpose nor flow through the same channel of trade, hence, they are neither competing nor can be considered as RELATED GOODS.

The Supreme Court in the case ESSO Standard Eastern, Inc. vs. The Honorable Court of Appeals and United Cigarette Corporation (116 SCRA 336, 342 [19821]) ruled that:

“The trademark “ESSO” which Petitioner uses for its various petroleum products may also be used as a trademark by a manufacturer of cigarettes, the two products not being related and the public cannot be deceived as to which product they are buying. The Court further stated that the two classes of products flow through different trade channels.

Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores. (2 Callman Unfair Competition & Trademarks, p. 1257). Thus, biscuits were held related to milk because they are both food products. (ARCS vs. SELECTA SUPRA) Soap and perfume, lipstick and nail polish are similarly related because they are common household items nowadays. (CHUA CHE vs. PHIL. PATENT OFFICE SUPRA)

Pursuant to the aforesaid Supreme Court ruling, the goods of the parties are obviously different from each other. They are so foreign to each other as to make it unlikely that the purchasers would think that Opposer is the manufacturer of Respondent's goods as they belong to different classes of goods. The mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on unrelated articles of a different kind. (American Foundries vs. Robertson 269 US -3721-381)

It is therefore clear that the goods on which the trademark "ESSENTIALS" is used by Respondent is non-competing not sold in the same channels of trade and entirely unrelated to the products of Opposer so that there is no likelihood of confusion or deception on the part of the purchasing public as to the origin or source of the goods.

Opposer A. Nattermarm & Cie, GmBh, likewise claims entitlement for protection of its registered trademark under the Convention of Paris for the Protection of Industrial Property. The relevant article thereof provides:

Article 6bis
[Marks: Well-Known marks]

“The countries of the Union undertake, ex-officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel registration and to prohibit the use of a trademark which constitute a reproduction, an imitation, or a transmission, liable to create confusion of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provision shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

To support its claim that the trademark “ESSENTIALS 303 NATTERMANN” had attained the status of a well-known mark, Opposer stated that its trademark owned by a Dermam Corporation has registered and used the same in Germany and worldwide. Likewise, it submitted

in evidence a Certificate of Registration No. 17587 on the Principal Register for goods in international class 5 issued on August 4, 1972 and renewed for another twenty years issued by the Bureau of Patents Trademarks and Technology Transfer (Exhibit "A"). This alone unquestionably demonstrate that the mark "ESSENTIALS 303 NATTERNMANN" in the name of the herein Opposer is not internationally well-known.

But even if "ESSENTIALS 303 NATTERMANN" is a well-known mark, thus deserves a broader scope of protection (see e.g. Kenner Parker Toys, Inc. vs. Rose Art Industries 22 USPQ 2d 1453 [Fed. Cir. 1992] and cases cited therein) such broader scope of protection may be invoked only when the latter is used for identical or similar goods by another and is liable to create confusion pursuant to Article 6 bis of the Convention. Here, none of the goods indicated in the certificate of registration submitted is related to the goods covered by the trademark of Respondent-Applicant which products are widely disparate as to avoid even an iota of confusion in the use of identical marks. Article 6 bis therefore, does not apply.

WHEREFORE, the opposition to the registration of the trademark "ESSENTIALS" is hereby DENIED. Accordingly, trademark Application Serial No. 74963 for the trademark "ESSENTIALS" in the name of Sabrina Chua is hereby GIVEN DUE COURSE.

Let the filewrapper of this case be forwarded to Application, Issuance and Publication Division for appropriate action in accordance with this Decision with a copy thereof to be furnished the Trademark Examining Division for information and to update their own records.

SO ORDERED.

City of Makati, October 27, 1997.

EMMA C. FRANCISCO
Director