

MATTEL INC.,	}	INTER PARTES CASE NO. 3898
Opposer,	}	Opposition to:
	}	
	}	Serial No. : 78543
-versus-	}	Date Filed : November 14, 1991
	}	Trademark : "BARBIE"
	}	
JIMMY A. UY,	}	
Respondent-Applicant.	}	DECISION NO. 2000-05
x-----x		

DECISION

This pertains to the Notice of Opposition to the registration of the trademark "BARBIE" for confectionery products namely: milk, chocolate, candies, milkbar and chocolate candies under application Serial No. 78543 by Jimmy A. Uy of Malabon, Metro Manila, a Filipino citizen, which application was published for opposition on page 37, Volume Vi, No. 2 of the BPTTT Gazette, March-April 1993 issue, actually released for circulation on May 31, 1993.

The Opposer is Mattel Inc., a foreign corporation organized and existing under the laws of the State of Delaware, U.S.A. with offices at 333 Continental Blvd., El Segundo, California, U.S.A.

The grounds for opposition are as follows:

- "1. The registration of the trademark BARBIE in the name of the Respondent-Applicant will violate and contravene the provisions of Section 4(d) of Republic Act No. 166, as amended because said mark is identical to the trademark owned and unabandoned by the Opposer, as to be actually, when applied to or used in connection with the goods of Respondent-Applicant to cause confusion or mistake or deceive purchasers thereof;
- "2. The trademark BARBIE is known all over the world to be exclusively owned by the Opposer, hence, registration of the identical trademark BARBIE in the name of Respondent-Applicant will be a breach of the clear provisions of Article 6bis of the Paris Convention for the Protection of Industrial Property since 1965;
- "3. That the registration of Respondent-Applicant's trademark BARBIE will cause great and irreparable injury and damage to the business reputation and goodwill of the Opposer within the meaning of Section 8 of Republic Act No. 166, as amended.
- "4. That the trademark BARBIE is not only a trademark but also an intellectual creation of the Opposer duly protected under the Copyright Law, and no one can appropriate said property as a trademark be in any manner without the authentication of its lawful owner."

The Opposer relied on the following facts:

- "1. Opposer is the owner of the trademark BARBIE as used on dolls, doll clothes and doll accessories, costumes, toys and other similar commercial products;
- "2. Opposer is likewise the lawful owner of the creation BARBIE its stylized lettering style and variations thereof which are duly registered with the National Library's Copyright Office;

- “3. To protect its proprietary rights to the trademark BARBIE. Opposer have registered and/or applied for its registration worldwide including the Philippines;
- “4. Opposers have been using the trademark BARBIE extensively and continuously for many years now, long before Respondent-Applicant filed the instant application for the registration for the registration of the trademark BARBIE. Hence, the Opposer is a clear senior-user;
- “5. The trademark BARBIE has earned an immense and valuable goodwill as a result of the enormous sales generated by products bearing the said trademark, the vastly superior quality of its products and the large sums of money spent worldwide in advertising and promoting the products bearing the mark;
- “6. It is obvious that Respondent-Applicant, in adopting and using exactly the same and identical trademark BARBIE is intending to ride-on and cash-in on the international popularity of Opposer’s trademark BARBIE and to palm-off its goods as those of the Opposer;
- “7. The use and registration of the trademark BARBIE by the Respondent-Applicant will actually cause confusion, mistake and deception to the buying public on the origin and/or sponsorship of the goods and will definitely dilute the value of Opposer’s trademark BARBIE because the mark of Respondent-Applicant is exactly identical to that of the Opposer;
- “8. Further, the use and registration of the mark BARBISE by Respondent-Applicant will cause great and irreparable injury and damages to the Opposer’s within the meaning of the Trademark Law.”

On August 26, 1993, Jimmy A. Uy, the herein Respondent-Applicant filed his Answer denying the material allegations in the opposition, and raised the following as Special and Affirmative defense:

- “5. The application of Respondent-Applicant has been approved by the Examiner of this Honorable Office with the concurrence of the Director of Patents after having been found to have complied with the requirements of the Trademark Law, Republic Act No. 166, as amended.
 - “5.1 If the claim of Opposer that Respondent-Applicant’s mark “BARBIE” for use on Chocolate candies and milk bar is confusingly similar with it’s for dolls is correct, the application of Respondent would have been rejected outright. It wasn’t so.
 - “5.2 On the contrary, the application of Respondent was approved despite the subsisting registration of Opposer.
- “6. The copyright claim entitled “BARBIE” (milk chocolate) is the subject of Copyright Registration No. 0.11195 in the name of Respondent-Applicant issued by the National Library on November 15, 1991.
 - “6.1 If the claim of Opposer that Respondent’s “BARBIE” for chocolate is confusingly similar to its “BARBIE” for dolls is correct, the National Library would have rejected outright the application of Respondent. It was, not so despite the subsisting copyright registration of Opposer.
- “7. The trademark “BARBIE” for use on ladies and children’s t-shirts is duly registered with this Honorable Office under Certificate of Registration No. 29663

which will all the more confirm that Opposer has no exclusive right or monopoly to use the word "BARBIE".

- "8. The reliance of the Opposer on the provisions of Article 6bis of the Paris Convention is self-defeating since the said provision applies only to use for identical on similar goods.
- "9. The Opposer has no legal capacity to sue in the Philippines since there is absolutely no allegation to that effect in the notice of opposition. Hence, the opposition must perforce be dismissed."

The issues having been joined, this Office called this case for pre-trial. Failing to reach an amicable settlement, parties went into trial, adduced testimonial and documentary evidences and, together with their respective memoranda, submitted the case for decision.

Going to the substantive issue of this case which is whether or not there exists confusing similarity between Respondent-Applicant's trademark and that of the Opposer, the applicable provision is Section 4(d) of R.A. No. 166, as amended which provides:

"SEC. 4. Registration of trade marks, trade names and service mark on the principal register. – there is hereby established a register of trade marks, trade names and service marks which shall be known as the principal register. the owner of a trade mark, trade name or 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 of or comprise 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 services of the applicant, to cause confusion or mistake or to deceive consumers". (Underscoring ours)

In the situation before us, the goods covered by the competing marks are obviously different from each other with absolutely no iota of similitude. They are so foreign to each other that it is unlikely that purchasers would think that Opposer is the manufacturer of the Respondent's goods even if they have identical trademark "BARBIE".

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.

Opposer is the registered owner of the mark "BARBIE" in the Philippines under Certificate of Registration No. 28555 for dolls, dolls clothes, while Respondent-Applicant's goods are solely for confectionery products namely: milk chocolate candies. Milkbar and chocolate candies falling under class 30 of the International Classification of goods which is totally unrelated to Opposer products.

The Supreme Court in the case "George W. Luft Co. Inc. vs. Ngo Guan, 18 SCRA 944 (1966), ruled that no serious objection was posed by the Petitioner therein since the Applicant utilized the emblem "TANGO" for no other product than hair pomade in which the Petitioner does not deal.

Applying the doctrine above-mentioned, Respondent-Applicant's trademark is registrable as there is no confusing similarity with that of the Opposer.

In this regard, the Supreme Court in the case of “Esso Standard Eastern, Inc., vs. The Hon. Court of Appeals and United Cigarette Corporation (116 SCRA 336 1982) 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 were 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 products (Arce 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)”

It is clear therefore that the goods for which the Opposer-Registrant obtained the registration for the mark “BARBIE” consisting of “dolls, dolls clothes” are unrelated to confectionery products namely: milk chocolate candies, milkbar and chocolate candies for which Respondent-Applicant’s trademark “BARBIE” is being used.

As to the issue that the trademark “BARBIE” of the Opposer is an internationally well-known mark having been registered in the country of origin which is the United States of America and in many countries of the world, hence registration of the same in the name of the respondent is a breach of the provisions of the Article 6 bis of the Paris Convention for the protection of industrial property, the evidences on record are not sufficient to support Opposer’s claim.

Under the Memorandum of the then Minister, Luis R. Villafuerte dated 20 November 1980, directing the Director of Philippine Patent Office to reject all the pending registration of signature and other world famous trademarks by applicant other than its original owner’s or users, the trademark “BARBIE” of the herein Opposer is not one of those internationally known trademark enumerated therein.

Further, it must be noted that as shown by the evidence presented, although the trademark “BARBIE” of the Opposer has been registered in its own Country of origin, the United States of America and in many countries of the world, such registration only pertain to doll, clothes, doll accessories and the like; toilet soap, bubble bath, bath beads, moisturizing lotion, cologne and hair shampoo, Halloween costumes and masks, toy vehicles, dresses, shorts, t-shirts, blouse, shirts, pants, leggings, jackets, sweatshirts, t-shirts, jeans, skirts, jewelry, namely earrings, bracelets, necklaces, charms, facial tissues, stickers for fingernails, etc., falling under Classes 2, 3, 14, 22, 25, 27, 28, 32, 37, 38, 40, etc. (Exh. “A-2” to “A-4-t” and did not include goods falling under Class 30 of the International classification of goods particularly confectionery products namely: milk chocolate candies and milkbar. Neither was Opposer able to prove that the use of the mark in relation to Respondent-Applicant’s confectionery products would indicate a connection to Opposer’s goods or services.

Section 123, 123.1 and 123(f), R.A. 8293 provides as follows:

“Sec. 123. Registrability. 123.1. A mark cannot be registered if it:

“x x x

“123(f) Is identical with, or confusingly similar to, or constitute a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use.” (Underscoring provided)

IN VIEW OF THE FOREGOING, this Office concludes that there is no confusingly similarity between the two competing marks. Accordingly, the Notice of Opposition is, as it is hereby DENIED. Consequently, Application Serial No. 78543, filed by Respondent-Applicant for the registration of the trademark “BARBIE” used on confectionery products namely: milk chocolate candies, milkbar, chocolate candies, is hereby GIVEN DUE COURSE.

Let the filewrapper of this case be forwarded to the Administrative, Financial and Human Resource Development Services Bureau for appropriate action in accordance with this Decision with a copy of this Decision to be furnished the Bureau of Trademarks for information and to update its record.

SO ORDERED.

Makati City, May 18, 2000.

ESTRELLITA BELTRAN-ABELARDO
Director