

PAGODA PHILIPPINES, INC.,)	INTER PARTES CASE NO. 3778
Opposer,)	
)	OPPOSITION TO:
)	Application Serial No. 73282
)	Filed : September 14, 1990
)	Applicant : Family Products
- versus -)	Sendirian Berhad
)	Trademark : FAMILY
)	Used on : Mosquito coils,
)	mosquito mats and
)	insecticides
)	<u>DECISION NO. 93-8 (TM)</u>
FAMILY PRODUCTS SENDIRIAN)	
BERHAD,)	November 9, 1993
Respondent-Applicant.))	
x-----x)	

DECISION

On April 30, 1992, Pagoda Philippines, Inc. a corporation duly organized and existing under the laws of the Philippines, with business address at 2626 Valenzuela Street, Old Sta. Mesa, Manila, filed with this Bureau its verified Notice of Opposition (Inter Partes Case No. 3778) to Application Serial No. 73282 for the trademark "FAMILY" used on mosquito coils, mosquito mats and insecticides (Class 5) which application was filed on September 14, 1990 by Family Products Sendirian Berhad, a corporation of Malaysia, which was published for opposition on page 10 of Volume V, Issue No. 1 of the BPTTT Official Gazette and officially released for circulation on March 10, 1992.

Opposer stated as basis for its opposition the following grounds:

1. The approval of the application in question is contrary to Section 4(d) of R.A. No. 166 as amended;
2. The approval of the application in question will violate opposer's right to the exclusive use of the trademark "FAMILY" which is duly registered in its favor and the extension of the sue of said registered mark to other goods;
3. The approval of the application in question has caused and will continue to cause great and irreparable damage and injury to herein opposer;
4. Respondent-Applicant is not entitled to register the trademark "FAMILY" in its favor.

Opposer will rely on the following facts to support its opposition.

1. That long before September 14, 1990 when respondent-applicant filed its application in question for the registration of the trademark FAMILY. Opposer had adopted and since then, has been using the trademark FAMILY for a variety of goods;
2. That Opposer has not abandoned the use of the trademark FAMILY. On the contrary, it has continued such use up to the present and has, in fact

extended the sue thereof to other goods, including TOOTHPASTE and MOSQUITO COILS, among others;

3. That the trademark FAMILY was first registered in favor of Opposer's predecessor-in-interest on April 13, 1981 under Registration Certificate No. 29065, a copy of the which is hereto attached as Annex "A" and made an integral part thereof;
4. That at present, the trademark FAMILY is duly registered in favor of Opposer for rubbing alcohol under Registration Certificate No. 51745 issued on November 5, 1991, which registration continue to be in full force and effect. A copy of said registration certificate is hereto attached as Annex "B" and made an integral part hereof;
5. That Opposer has also applied for the registration of the trademark FAMILY for use on Toothpaste, which application has been assigned Serial No. 71221;
6. That Opposer has likewise applied for the registration of the trademark FAMILY for use on Mosquito Coil, which application has been assigned Serial No. 80068;
7. That the trademark FAMILY being applied for registration by respondent-applicant is identical to the trademark FAMILY duly registered in favor of opposer and which Opposer has been using since long before September 14, 1990 and which use has been continuous up to the present;
8. That the approval of the application in question is contrary to Section 4(d) of Republic Act No. 166, as amended;
9. That the approval of the application in question is violative of the right of Opposer to the exclusive use of the trademark FAMILY and the right to extend the use of said mark to other goods;
10. That Opposer has spent a substantial amount of money to popularize and promote its FAMILY branded products;
11. That through extensive advertising and promotional campaigns and because of the high quality of Opposer's products bearing the trademark FAMILY, said mark FAMILY has become distinctive of Opposer's products and establishing valuable goodwill in favor of Opposer;
12. That the approval of the application in question has caused and will continue to cause great and irreparable damage and injury to Opposer;
13. That respondent-applicant is not entitled to register the trademark FAMILY in its favor.

Notice to Answer was sent to Respondent-Applicant and its Counsel through Registered Mail with Return Card on May 8, 1992.

On June 1, 1992, Respondent-Applicant through Counsel filed a Motion for Extension of Time to File Answer which was GRANTED (ORDER NO. 92-432) dated June 3, 1992.

For failure to file the required Answer within the reglementary period, Respondent-Applicant, upon motion of the Opposer, was declared in default and thereafter was allowed to present its evidence ex-parte (ORDER NO. 92-714)

Admitted as Opposer's evidence are documentary exhibits consisting of the following:

<u>EXHIBITS</u>	<u>DESCRIPTION</u>
Exhibit A	- Affidavit of Teofisto Malla, Jr.;
Exhibit B	- Registration Certificate No. 29065 for the trademark "FAMILY" issued on April 13, 1981;
Exhibit C	- Registration Certificate No. 51745 for the trademark "FAMILY" issued on November 5, 1991;
Exhibit D	- Application serial No. 71221 filed on March 12, 1990 for the registration of the trademark "FAMILY";
Exhibit E	- Application Serial No. 80068 filed on March 20, 1991 for the registration of the trademark "FAMILY";
Exhibit F	- Family label for mosquito killer actually used in commerce by the Opposer.

The main issue to be resolved in this particular case is whether or not registration of the trademark "FAMILY" bearing Serial No. 73282 filed by the herein Respondent-Applicant is contrary to Section 4(d) of R.A. No. 166, as amended.

Our Trademark Law, particularly Section 4(d) thereof provides as follows:

"SECTION 4. Registration of trademarks, 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 a trademark, tradename 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:

xxx

(d) Consists of 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".

The evidence show that Respondent-Applicant's trademark "FAMILY" is identical to Opposer's trademark "FAMILY" and both relate to goods that fall under Class (5) particularly mosquito coils. Hence, there is a factual basis to hold that Respondent-Applicant's trademark is confusingly similar with Opposer's trademark.

The trademark "FAMILY" was first registered in favor of Opposer's predecessor-in-interest on April 13, 1981 under Registration Certificate No. 29065 (Exhibit B) and at present, the same trademark "FAMILY" is duly registered in favor of opposer for rubbing alcohol under Registration Certificate No. 51745 issued on November 5, 1991 (Exhibit C). The Oppose has likewise applied for the registration of the trademark "FAMILY" for use on mosquito coils, insecticides, cosmetics and food products, which application has been assigned Serial No. 80068 (Exhibit E).

Considering that at the time Respondent-applicant filed Application Serial No. 73282 the trademark "FAMILY" was already registered in favor of the Opposer (Exhibits "B" and "C") and considering further that the trademark "FAMILY", subject of Respondent-Applicant's Application Serial No. 73282 is confusingly similar, if not outright identical to the trademark by Opposer being used for mosquito coils and insecticides, approval of said application is a clear violation of Section 4(d) of R.A. No. 166, as amended.

The herein Respondent-Applicant was declared in default (ORDER NO. 92-714) and the non-filing of the Answer and Motion to Lift the Order of Default despite notice is indicative of its lack of interest in its application; thus it is deemed to have abandoned the same. The Supreme Court held in DELBROS HOTEL CORPORATION vs. INTERMEDIATE APPELLATE COURT, 159 SCRA 533, 543 (1986), that –

"Fundamentally, default orders are taken on the legal presumption that in failing to file an Answer, the Defendant does not oppose the allegations and relief demanded in the complaint".

WHEREFORE, premises considered, the herein Notice of Opposition is hereby SUSTAINED. Accordingly, Application Serial No. 73282 for the trademark "FAMILY" in favor of the herein Respondent-Applicant is hereby REJECTED.

Let the filewrapper of this case be remanded to the Application, Issuance and Publication Division for appropriate action in accordance with this DECISION and furnished the Trademark Examining Division to update its records.

SO ORDERED.

IGNACIO S. SAPALO
Director