

DANONE ASIA PTE LTD.,	}	Inter Partes Case No. 4168
Opposer,	}	Opposition to:
	}	
-versus-	}	Serial No. : 60910
	}	Date filed : 02-09-87
	}	Trademark : "AMOY BIHON"
JIDIN FOOD PROCESSING CORP.,	}	Used On : Bihon
Respondent-Applicant }		

x-----x Decision No. 2003 - 01

DECISION

This pertains to the Opposition filed by DANONE ASIS PTE LTD., a corporation duly organized under the laws of Singapore, with principal office address at No. 1 Temasek Avenue, #34-02, Millenia Tower 039192, Singapore, against the registration of the trademark "AMOY BIHON" for goods under Class 30 with Application Serial No. 60910 and filed on 09 February 1987 in the name of JIDIN FOOD PROCESSING CORPORATION with address at Tanay, Rizal, Philippines.

The subject application was published on page 93, Volume 1, No. 3, 1998 issue of the Official Gazette, which was officially released for circulation on November 09, 1998. Opposer filed Verified Notice of Opposition on March 09, 1999, having been granted by this Office an extension of time to do so, upon Motion for Extension filed by the Opposer on 09 December 1998.

The grounds for the opposition the registration of the trademark AMOY BIHON are as follows:

- "1. The trademark AMOY BIHON so resembles Opposer's trademark AMOY and AMOY Logo 95, which have been previously used in commerce in the Philippines and other parts of the world and not abandoned, as to be likely, when applied to or used in connection with the goods of Respondent-Applicant, to cause confusion, mistake and deception on the part of the purchasing public as to the origin or sponsorship of the goods on which the marks are used.
- "2. The registration of the trademark AMOY BIHON in the name of the Applicant will violate Section 37 of Republic Act No. 166, as amended, and Section 147 and other provision of Republic Act No. 8293 and the provisions of international conventions to which the Philippines and Singapore adhere.
- "3. The registration and use by Applicant of the trademark AMOY BIHON will diminish the distinctiveness and dilute the goodwill of Opposer's trademarks AMOY and AMOY Logo 95.
- "4. The registration and use by Applicant of the trademark AMOY BIHON violate Opposer's right as the first user and lawful owner of the trademarks AMOY and AMOY Logo 95.
- "5. The registration of the trademark AMOY BIHON in the name of the Applicant is contrary to the other provisions of the Trademark Law and the Intellectual Property Code and international conventions to which the Philippines and Singapore adhere."

Opposer relied on the following facts to support its contentions in this Opposition:

- “1. Opposer is a manufacturer of a wide range of products under Classes 29 and 30 all bearing the trademarks AMOY and AMOY Logo 95 which have been marketed and sold in many countries worldwide, including the Philippines. Opposer has been commercially using the trademarks AMOY and AMOY Logo 95 on goods falling under Classes 29 and 30 prior to the use of AMOY BIHON for bihon by Applicant.
- “2. Opposer is the owner of the trademark AMOY under Registration Certificate NO. 33638 for goods in classes 29 and 30, which it acquired from The AMOY Canning Corporation (Hong Kong) Limited, and is the applicant for AMOY Logo 95, which is pending with the Bureau of Patents, Trademarks and Technology Transfer under Application No. 03543 dated May 14, 1998 for goods falling in Classes 29 and 30.
- “3. Opposer and its predecessor, The Amoy Canning Corporation (Hong Kong) Limited, are the first users since 1958 of the trademark AMOY under Registration Certificate No. 33638 and of the trademark AMOY Logo 95 on the goods specified under the above-described application, which Opposer has sold and marketed in various countries worldwide.
- “4. By virtue of Opposer’s prior and continued use of AMOY and 95 as trademarks in the Philippines and other parts of the world, said trademark gave become popular and internationally well-known and have established valuable goodwill for Opposer among consumers who have identified Opposer as the source of the goods bearing said trademark.
- “5. The registration and use of a confusingly similar trademark by the Applicant will tend to deceive and/or confuse purchasers into believing that Applicant’s products emanate from or are under the sponsorship of Opposer, for the following reasons:
 - a) the marks are visually and phonetically identical and are confusingly similar in terms of pronunciation, spelling and other particulars;
 - b) the marks are applied on identical and/or related goods;
 - c) the parties are engaged in competitive business; and
 - d) the goods on which the marks are used are brought by the same class of purchasers and flow through the same channels of trade.

Applicant obviously intends to trade, and is trading on, Opposer’s goodwill.

- e) The registration and use of a confusingly similar trademark by Applicant will diminish the distinctiveness and dilute the goodwill of Opposer’s trademark.
- f) The trademark AMOY BIHON has been abandoned by the dissolution of Applicant Jidin Food Processing Corporation and its non-use by its successor, Hocbee Food Line Company.”

The Notice to Answer dated October 27, 1999 was sent to Respondent-Applicant and based on the notation on the registry return receipt, for failure to locate the addressee, the notice returned unclaimed. Finding the necessity to send the summons anew, service of an Alias Notice was effected twice, first by registered mail on December 01, 1999 but it returned with the notation "unclaimed", and second by personal delivery on November 29, 2000 and received by one Frances Hanika B. Bergantin for the Respondent. For failure of the Applicant to file the required Answer within the prescribed period or within fifteen (15) days from receipt of aforesaid notice, this Office per Order No. 2001-146 declared Respondent-Applicant IN DEFAULT on this score and Opposer was allowed to present its evidence ex-parte.

Admitted in evidence for the Opposer based on the records are Exhibits "A" to "D" inclusive of submarkings which consisted, among others, of Certificate of Registration for the trademark AMOY and pending application for the trademark AMOY Logo 96, sample labels and the uncontradicted affidavit of Edouard Maruani, Legal Counsel for Asia Pacific and Director of DANONE ASIA PTE LTD.

For consideration in particular is the propriety of Application Serial No. 60910. The issue hinges on the determination of whether or not Respondent-Applicant is entitled to register the trademark AMOY Bihon on goods belonging to Class 30 for use specifically on bihon.

Considering that the Application subject of the instant opposition was filed under the old Trademark Law (R.A. 166, as amended), this Office shall resolve the case under said law so as not to adversely affect rights already acquired prior to the effectivity of the new Intellectual Property Code (R.A. 8293).

The applicable provision of the Trademark Law, Section 4(d) provides:

"Section 4. Registration of trademarks, trade-names and service-marks on the principal register --- xxx The owner of a trademark, trade name or service mark used to distinguished his goods, business or services from the goods, business or service of others shall have a right to register the same on the Principal Register, unless it:

xxx

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

It is clear from a reading of the preceding section that the purpose of the Trademark Law is to provide protection not only to the owner of the trademark, likewise, and more importantly, to that of the buying public that they may not be confused, mistaken or deceived on the goods they are buying.

The style of lettering of the mark AMOY Bihon of Respondent-Applicant as well the mark's spelling and pronunciation is unquestionable identical of not an exact replica to the mark used and not abandoned by Opposer. Observe how the letters A, M, O were printed in the AMOY. This mark was written using an oriental stroke in the style used. There is a seeming variation in the manner the letter Y is written but in their entirety and overall presentation, the labels of Opposer and Respondent when compared, appear the

same. Both marks are written in stylized letters and in all approach are evidently identical, in spelling, pronunciation and sound. That being so, the issue is narrowed down in resolving the first user of the mark.

In this instant Opposition, it is sufficiently established by the Opposer when it presented Exhibit "B" showing Certificate of Registration No. 33638, which application was filed on January 10, 1978 and registered by the Philippine Patent Office for a term of 20 years from September 3, 1984 that is the first user of the mark AMOY. Opposer first used its mark in Hong Kong in 1952 and in the Philippines in 1958 or almost three (3) decades earlier than the stated date of first use of Respondent's mark in the Philippines. Likewise, to sustain Opposer's position that they are the prior user of the trademark, sample labels (Exhibit "B-1 to B-6") used in the Philippines were offered and presented as evidence. On the other hand, there being no testimony taken as to the date of first use except that made in its application for registration, Respondent-Applicant's first use of the mark AMOY on the goods was on 02 January 1986.

Because of this and of the face of prior use in 1958 of the mark by Opposer, the subsequent use and adoption by another of an identical mark on related goods must forthwith be refused. As held in the case on *Unno Commercial Enterprises, Inc. vs. General Milling Corporation* "*prior use by one will controvert a claim of legal appropriation by subsequent users*".

In the case of *HEIRS OF CRISANTA Y. GABRIEL-ALMORAIDE, et. al. vs. COURT OF APPEALS*, *the principle of "First to Use" was used as basis in resolving the case in favor of private respondent where it states the "Thus, all thing being equal, it is then safe to conclude that Dr. Perez had a better right to the mark "WONDER." The registration of the mark "Wonder GH" should have been cancelled in the first place because its use in commerce was much later and its existence would likely cause confusion to the consumer being attached on the product of the same class as that of the mark "WONDER."*

Another matter in point to ponder is the connection of the goods of the parties. Are the goods closely related to substantiate conclusion of this office that there is *confusing similarity* between the subject trademarks? The likelihood that purchasers may confuse the goods of the Applicant and Opposer to come from the same manufacturer or source or that these goods when placed alongside each other will suggest a connection or association of one with the other. We rule in the affirmative. Both goods are ordinary household items or commodities of relatively small value which maybe sold in a grocery store or nearby convenience store that an ordinary buyer will not mull over the description of the goods and compare the trademark attached to them. Hence, when a prospective buyer comes across the goods of Respondent with the mark attached to it, the likelihood that the public may be misled into thinking these items are products of Opposer or there is some connection or association or a slight nexus between Opposer that Respondent's goods, is not far-fetched.

Thus, in the case of *Chuanchow Soy & Canning Co, vs. the Director of Patents*, the principle is significantly in point where it held "When two competing labels are placed together for inspection and still they may confuse an ordinary person, specially cooks and maids, who as a rule are the ones in charge of buying such household article as soy sauce, there would be more confusion and doubt when the two labels are not placed together for comparison and the prospective purchaser is guided only by his memory or recollection that the soy sauce he or she planning to buy has as its label the drawing of a fish with letters and Chinese characters, written in a certain style of lettering and color".

Worth mentioning from a cursory reading if Opposer's Trademark application (Exhibit "C to C-6") that the Opposer has embarked in the production of noodles mixes which when match up with Respondent's *bihon*, confusion as to source is likely. Opposer

has as its current items for its new product launch, among others, the following: Sichuan spicy noodle soup mix, extra hot Sichuan spicy noodle soup mix, peking style sweet/sour noodle sauce.

Note should be take as well of the face that Respondent-Applicant was validly served with summons, and was afforded the opportunity to refute the claim of and/or controvert the allegation of prior use by Opposer of the subject trademark if he filed and Answer but he defaulted. Obviously, therefore, pursuant to Rule 2, Section 9 of the Rules of Procedure in Inter Partes Proceedings, and after Oppose was allowed to present and substantiate its claim ex-parte, the case shall be decided on the bases of the evidence thus presented. The Opposer having sufficiently corroborated its claim, there being evidence enough to convince this Office that Opposer is the prior user and first adopted the questioned mark used on related goods under Classes 29 and 30 long before Respondent-Applicant did and that its use has not been abandoned, for which reason it is Opposer and not Respondent-Applicant which is entitled to registration thereof.

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Consequently, application bearing Serial No. 60910 filed by JIDIN FOOD PROCESSING CORPORATION on 9 February 1997 for the registration of the mark "AMOY BIHON" used on bihon is hereby REJECTED.

Let the records of this case be forwarded to the Administrative, Financial and Human Resources Development Services Bureau (AFHRDSB) for appropriate action in accordance with this DECISION with a copy furnished the Bureau of Trademarks (BOT) for information and update of its records.

SO ORDERED.

Makati City, 14 January 2003.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal affairs
Intellectual Property Office