

EVER ELECTRICAL MFG.
INC. AND EVER EMPORIUM
Opposer

INTER PARTES CASE NO. 3586
OPPOSITION:

- versus-

NOVA REPACKING COMPANY,

Respondent-Applicant.

x-----x

Serial No.: 68025
Filed: May 24, 1989
Applicant: Nova Repacking Co.
TM: EVER & E DEVICE

For: Solvent Cement

DECISION NO. 97-21

DECISION

Opposer EVER ELECTRICAL MANUFACTURING, INC., and its sister company, EVER EMPORIUM, INC., both corporations duly organized and existing under the laws of the Philippines with principal offices at Bo. Malanday, Marikina, Metro Manila and 1964-70 C. M. Recto Avenue, Manila, respectively believe that they would be damaged by the registration of Application Serial No. 68025 filed on May 24, 1989 by Respondent Nova Repacking Company for the trademark EVER & E DEVICE for solvent cement.

Respondent Nova Repacking Company on the other hand, is also a domestic company with principal business Quezon City. Its trademark application was published on page 46 of Volume III, No. 4 issue of the Official Gazette dated July-August 1990 and officially released for circulation on August 31, 1990.

The grounds relied upon by Opposers are herein reproduced to wit:

- "1. That the registration of the trademark ENTER & E DEVICE in favor of respondent-applicant is contrary to Section 4 of RA 166, as amended;
- "2. That the trademark EVER & E DEVICE which respondent-applicant seeks to register forms part of the business name, as well as the corporate name of both Opposers, and therefore, the use of said mark by respondent-applicant will falsely suggest that its products come from, or are authorized by, Opposers;
- "3. That the peculiar and distinctive style of lettering of respondent-applicant's EVER & E DEVICE violates the duly copyrighted peculiar and distinctive style of lettering of Opposer's trademark EVER & E DEVICE;
- "4. That respondent-applicant is not entitled to register the trademark EVER & E DEVICE in its favor;
- "5. That the registration of the trademark EVER & E DEVICE in favor of respondent-applicant will cause great and irreparable damage and injury to Opposers."

Opposers relied on the following facts to support the present Opposition:

"a.) That the trademark EVER & E DEVICE is duly registered in favor of Opposer EVER ELECTRICAL MANUFACTURING, INC. under Registration Certificate No. 24197 issued by this Office way back on October 29, 1976, which registration subsists up to the present. A xerox copy of said registration certificate is hereto attached as Annex "A" and made an integral part hereof,

"b) That the trademark E Device is also duly registered in favor of Opposer EVER ELECTRICAL MANUFACTURING, INC. under Registration Certificate No. 42544 issued by this Office last December 27, 1988. A xerox copy of said registration certificate is hereto attached as Annex "B" and made an integral part hereof;

"c.) That the trademark EVER & E DEVICE is likewise being applied for registration by Opposer EVER ELECTRICAL MANUFACTURING, INC. under Serial No. 70787 filed last February 7, 1990. A Xerox copy of said application is hereto attached as Annex "C" and made an integral part hereof,

"d.) That the peculiar and distinctive style of lettering of the word EVER & E DEVICE is duly copyrighted in favor of Opposer EVER ELECTRICAL MANUFACTURING, INC. A Xerox copy of Certificate of Copyright Registration No. 0-6350 is hereto attached as Annex "D" and made an integral part hereof;

"e.) That long before respondent-applicant filed its pending application for the registration of the trademark EVER & E DEVICE, both opposers had been using the, trademark EVER & E DEVICE for a wide variety of goods, which use has not been abandoned but continues up to the present;

"f.) That the trademark EVER & E DEVICE being applied for registration by respondent-applicant is identical or a carbon copy of the trademark EVER & E DEVICE registered in favor of Opposer EVER ELECTRICAL MANUFACTURING, INC. and previously used by both Opposers and not abandoned;

"g.) That the trademark EVER & E DEVICE which respondent-applicant seeks to register is the principal word in the business name, as well as in the corporate name, of both Opposers;

"h.) That the registration of the trademark EVER & E DEVICE in favor of respondent-applicant will violate Opposer's rights and interests to the trademark EVER & E DEVICE, as well as Opposer's rights and interests in their business names and corporate names;

"i.) That confusion between Opposers' and Respondent-Applicant's respective goods, as well as the dilution and loss of distinctiveness of Opposers' trademark EVER & E DEVICE is inevitable in the event that respondent's application be finally approved;

"j.) That respondent-applicant's adoption and use of the trademark EVER & E DEVICE is ostensibly for the purpose of riding on the goodwill of Opposers."

From the records available in this Office, it appears that a Notice to Answer was sent to Nova Repacking Company, herein Respondent-Applicant, at 118 P. dela Cruz Street, Novaliches, Quezon City through registered mail on October 8, 1990. Service to Respondent, however, failed as Nova Repacking Company cannot be found at the said address.

On motion of Counsel for Petitioner, this Office issued Order No. 91514 directing the Process Server to personally serve an Alias Notice to Answer to Respondent. The Alias Notice to Answer was likewise returned unserved due to the same reason.

To this, Opposer filed an Ex-Parte Manifestation with a Motion praying that Application Serial No. 68025 of Respondent be considered as having been abandoned and the Notice of Opposition dismissed and/or considered withdrawn for having become moot and academic.

In its Order No. 91-601 dated July 25, 1991, this Office denied the Motion and ordered service by publication as provided under Rule 14, Section 16, of the Rules of Court.

The Dispositive Portion of the said order reads:

“IN VIEW OF THE FOREGOING, Opposer's motion to consider Application Serial No. 68025 of Respondent abandoned is, as it is hereby, DENIED. Service may however be effected upon Respondent-Applicant by publication of the Notice to Answer and the Notice of Opposition in a newspaper of general circulation, as provided under Rule 14, Section 16, of the Rules of Court, which Opposer may avail of, upon motion, and on its own expense.”

Since the issuance of Order No. 91-601, no move was undertaken by Opposer to have the Notice of Opposition and the Notice to Answer published in any newspaper of general circulation. Consequently, due to such non-compliance with the said Order, then Director Ignacio S. Sapalo ordered the dismissal of the Opposition motu proprio on the ground of failure to prosecute and non-compliance with the directives of this Office as set forth in Order No. 91-601. Thereupon, Order No. 92-43 dated January 15, 1992 was issued giving due course to Application Serial No. 68028 of herein Respondent.

On Motion For Reconsideration filed by Opposer, Order No. 92-43 dismissing the Opposition was set aside and the same was reverted to its active status. Furthermore, considering that Respondent-Applicant has not filed any answer, motion or pleading relating to the Notice of Opposition and for its utter lack of interest in proving its right to registration, it was declared in default.

Section 4(d) of Republic Act No. 16 provides:

“(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 services of the applicant, to cause confusion or mistake or to deceive purchasers.”

In the case at bar, it is very apparent that the trademark of Opposer was copied to the last minute detail the type of lettering use. Respondent and the presentation of the mark itself is an absolute replica of Opposers' own mark which it uses both as its business and corporate name as well as its trademark for its line of products.

The trademark EVER & E Device is continuously being used by Opposer in a wide variety of its goods. Though one may say that solvent cement is not a related good vis-a-vis the goods of herein Opposers, it is not farfetched, however, that consumers may be deluded into believing that the solvent cement which bears the trademark EVER & E Device is being manufactured by Opposers.

The trademark subject of the Opposition proceedings is undeniably a perfect copy of a previously registered mark 'in the name of Opposers. There are no confusing similarities to speak of as the two marks do not vary at all. The marks are identical in all points: in the distinctive lettering used, the appearance, the sound, the word itself and in every other features available for scrutiny. The only thing that differs is in the goods to which the marks are attached. But this cannot justify the grant of registration in favor of Respondent.

As the Supreme Court held in the landmark case of Ang vs. Teodoro, No. 42226, December 14.,1942, 74 Phil. 50,:

“The courts have come to realize that there can be unfair trading that can cause injury or damage to the first user of a given trademark first, by prevention of the natural expansion of his business and second by having his business reputation confused with and out at the mercy of the second user. When the non-competing are sold under the same mark,

the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark created by the first user inevitably results.

Furthermore, in *Converse Rubber Corporation vs. Universal Rubber Products, Inc.*, L-27906, January 8, 1987, 147 SCRA 154, the Supreme Court said:

“But even assuming that the trademark sought to be registered by respondent is distinctively dissimilar from those of the petitioner, the likelihood of confusion would still subsists, not on the purchaser’s perception of the goods but on the origins thereof. By appropriating the word CONVERSE, respondent’s products are likely to be mistaken as having been produced by petitioner: The risk of damage is not limited to a possible confusion of goods but also includes confusion of reputation if the public could reasonably assume the goods of the parties originated from the same source.”

WHEREFORE, in view of the foregoing considerations, this Office finds for the Opposers. Consequently, the Opposition filed is given DUE COURSE and Application Serial No. 68025 filed by Nova Repacking Company for the trademark EVER & E DEVICE on solvent cement is, as it is, hereby REJECTED.

Let the filewrapper of this case be forwarded to the 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 update of its record.

SO ORDERED.

December 12, 1997. Makati City.

EMMA C. FRANCISCO
Director