

EVEREADY BATTERY CO. INC.,
Opposer,

Inter Partes Case No. 3860
Opposition to:

-versus-

EVERLITE ELECTRIC IND.,
Respondent-Applicant,

Serial No. : 71170
Date Filed : March 6, 1990
Trademark : "EVERLITE"
Goods : lamp, gas, lamp
and decorative
bulb

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DECISION NO. 98-35

DECISION

This pertains to the Opposition to the Application for Registration of the mark "EVERLITE" in favor of EVERLITE ELECTRIC IND., filed by EVEREADY BATTERY COMPANY, INC.

Eveready Battery Company, Inc. (hereafter referred to as EBCI) is a foreign corporation duly organized and existing under the laws of the State of Missouri, United States of America, with offices at Checkerboard Square, St. Louis, Missouri, U.S.A., engaged in the manufacture of lamps, lanterns, flashlights and batteries while Everlite Electric Ind. (hereafter referred to as EEI), also a foreign corporation duly organized and existing under the laws of the Republic of China, with offices at No. 200, Sec. 2 Kuang Fu Road, Hsinchu, Taiwan, produces gas lamps, lamps and decorative bulbs.

On 06 March 1990, Respondent-Applicant EEI applied for the registration of the mark "EVERLITE" for lamp, gas, lamp and decorative bulbs. Said application was published for opposition on 28 October 1992 and on 19 February 1993, herein Opposer filed with this Office a Notice of Verified Opposition. This Office notified the Respondent-Applicant thereof, giving it fifteen (15) days from receipt thereof on March 13, 1993 within which to file an Answer. However, despite receipt of said notice on March 16, 1993, Respondent-Applicant did not file its Answer nor manifested any interest in this case. Consequently, Respondent-Applicant was declared in default and the Opposer was allowed to present its evidence ex-parte, per Order No. 93-65 dated 13 September 1993.

EBCI alleges that as original and lawful owner of various EVEREADY marks, it would suffer damages by the registration of Respondent-Applicant's EVERLITE trademark.

Opposer relied on the following facts to support its opposition:

- "1. Opposer is the owner and rightful proprietor of various internationally known "EVEREADY" trademarks (the "EVEREADY Marks") which are used on Opposer's products consisting of lanterns, lamps, flashlights, and batteries. As the owner of the EVEREADY Marks, Opposer caused the registration of the same in the Principal Register as indicated in the listing of such registration attached thereto and made an integral part hereof as Annex "A";
- "2. The EVEREADY Marks have been registered and used worldwide, including the Philippines, and such registration and use was prior to Respondent-Applicant's registration of his trademark in the Peoples Republic of China on January 20, 1991. By reason of Opposer's worldwide, prior and continuous use of the EVEREADY marks, the same have acquired a meaning exclusively identified with Opposer's goods.
- "3. To promote Opposer's goods in the Philippines and to ensure the quality thereof, Opposer maintains an advertising campaigns and promotion of

the Opposer's goods. By reason of Opposer's worldwide and extensive promotional campaign and the registrations of its trademarks, the EVEREADY Marks has become internationally famous;

- "4. On March 6, 1990, respondent-applicant fraudulently applied for registration of the trademark "EVERLITE" for lamp, gas and decorative bulb in the same class as the goods covered by the EVEREADY Marks, undoubtedly to take advantage of the popularity and goodwill generated by the EVEREADY Marks. There are limitless names available to respondent-applicant, but it ventured to adopt the mark "EVERLITE" undoubtedly to confuse, mislead or deceive purchasers into believing that the goods of respondent-applicant are those of, or are sponsored by, the Opposer;
- "5. The use and adoption in bad faith by respondent-applicant of the trademark "EVERLITE" would not only falsely tend to suggest a connection with Opposer and, therefore, constitute a fraud on the general public, but would also cause the dilution of the distinctiveness of the registered EVEREADY Marks to the prejudice and irreparable damage of Opposer;
- "6. The use and adoption by respondent-applicant of the trademark "EVERLITE" which is confusingly similar to and resembles the EVEREADY Marks constitutes an unlawful appropriation of a mark previously used in the Philippines and not abandoned. Accordingly, Application Serial No. 71170 filed by respondent-applicant for the registration of the trademark "EVERLITE" is in violation of Section 4(d) of Republic Act no. 166, as amended."

The issue now raised by the Opposer is whether or not the prior and exclusive use and adoption by EBCI of the "EVEREADY" marks on its products would preclude EEL from adopting and using the trademark "EVERLITE".

Opposer contends that pursuant to Section 4(d) of Republic Act 166, as amended, otherwise known as the Trademark Law, and settled jurisprudence on the matter, where the mark sought to be registered so resembles the registered mark it will likely cause confusion on the part of the purchasers, therefore, it shall not be allowed registration in the Principal Register.

According to Opposer, the trademarks "EVEREADY" and "EVERLITE" contain the same first two syllables "EVER", and the Respondent-Applicant's use of "LITE" instead of "READY" did not make "EVERLITE" any less confusingly similar with "EVEREADY".

Invoking the test of dominancy, Opposer asserts that while "EVERLITE" and "EVEREADY" are not exactly identical in the spelling, the former mark so resembles the latter as would possibly cause confusion or mistake in the purchaser's mind, it appearing that "EVERLITE" was coined by joining the first two syllables of the trademark "EVEREADY" and the last syllable of the trademark "RADIOLITE", both registered in the name of the Opposer.

Opposer also contends that the trademark "EVEREADY" was coined by joining "EVER" and "READY", and by the long and exclusive use by EBCI of such trademark on its products, the same has acquired a secondary meaning solely indicating its own goods. Furthermore, Opposer asseverate, the trademarks "EVEREADY" and "EVERLITE" when uttered are similar in sound that mistake or confusion by the purchasers is not unlikely.

To support its claim, Opposer presented its certificates of registration of "EVEREADY" and "RADIOLITE" trademarks in the Philippines consisting of Exhibits "A" to "K-1".

Section 4(d) of Republic Act 166, as amended, otherwise known as Trademark Law provides:

“Section 4. *Registration of trademarks, tradenames and service marks on the Principal Register.* There is hereby established a register of trademarks, tradenames and services 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 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 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 used in connection with the goods, business or service of the applicant, to cause confusion or mistake or to deceive consumers.” (underscoring provided)

In interpreting said provisions in the case of American Wire and Cable Co. vs. Director of Patents, 32 SCRA 544, the Supreme Court declared –

“It is clear from afore-quoted provision that the determinative factor in a contest involving registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark would likely cause confusion or mistake on the part of the buying public. In short, to constitute an infringement of an existing trademark and warrant a denial of an application for registration, the law does not require that the competing marks must be identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.” (underscoring provided)

Moreover, Forbes Munn and Co. vs. Ang San To, 40 Phil. 272, the Supreme Court explained the kind of similarity that amounts to infringement. Thus, the Highest Tribunal said:

“Similarity, as we have said, is the test of infringement of a trademark. Moreover, this is not such similitude as amounts to identity. Exact copies could hardly be expected to be found. If the form, marks, contents, words, or other special arrangement or general appearance of the words of the alleged infringer’s device, are such as would be likely to mislead persons in the ordinary course of purchasing the genuine article, then the similarity is such as entitles the injured party to equitable protection, if he takes reasonable measures to assert his rights and prevent their continued invasion.”

Based on the foregoing, this Office arrived at the following conclusions:

“EVEREADY” and “EVERLITE” are not exactly similar in appearance and sound. However, likelihood of confusion is not a remote possibility considering that the Opposer been using “EVEREADY” and “RADIOLITE” marks since 1922 and 1988 respectively, as borne by the evidences presented by the Opposer, particularly Exhibits “J” and “K”.

As correctly pointed out by the Opposer, “EVEREADY” mark has acquired a secondary meaning exclusively identifiable with its products. While it may be conceded that that “EVER”, take separately from the coined word “EVEREADY” is a descriptive term meaning always; at all times (Third Edition, 1994 American Heritage Dictionary), by virtue of the exclusive and long use thereof on the Opposer’s products, it has already come to refer to Opposer’s goods.

In the case *Ang vs. Teodoro*, 74 Phil. 50, a registration of “ang tibay” mark, although descriptive, was allowed registration. The Supreme Court explained:

“x x x where a word or phrase originally incapable of exclusive appropriation with reference to an article in the market, because geographically or otherwise descriptive, might nevertheless have been used so long and exclusively by one producer with reference to his article that, in that trade and to that branch of the purchasing public, the word or phrase has come to mean that the article was his product.”

Inasmuch as both marks starts with a descriptive word “EVER” and considering that the Respondent-Applicant’s mark appears to be coined word between “EVER” and “LITE”, both of which form part of registered marks EVEREADY and RADIOLITE of Opposer used on almost the same products i.e. flashlights, lanterns and batteries by the Opposer, there is undeniably a very strong possibility that purchasers of the older brand could be mislead or deceived to buy the goods with newer brands, mistaking it for the other. This being the case, the existence of the “EVEREADY” and RADIOLITE marks must therefore preclude the registration of the Respondent-Applicant’s “EVERLITE” mark.

WHEREFORE, the instant Opposition should be, as it is hereby, SUSTAINED. Accordingly, Application Serial No. 71170 for the registration of the trademark “EVERLITE” used on lamps, gas and decorative bulb, filed by Respondent-Applicant Everlite Electric IND. Is, as it is hereby, REJECTED.

Let the filewrapper of EVERLITE subject matter of this case be forwarded to the Administrative, Financial, Human Resource and Development Bureau for appropriate action in accordance with this DECISION with a copy to be furnished the Bureau of Trademark for information and update of its records.

SO ORDERED.

Makati City, 28 December 1998.

ESTRELLITA BELTRAN-ABELARDO
Caretaker/Officer-In-Charge