

FMC CORPORATION	}	Inter Partes Case No. 3582
Opposer,	}	Opposition to:
	}	
	}	Appln. Serial No. : 66877
-versus-	}	Date Filed : August 27, 1990
	}	Trademark : "FMC & Device"
	}	
FMC MANUFACTURING CO.,	}	
Respondent-Applicant	}	
x-----x		Decision No. 2005 - 12

DECISION

This pertains to the opposition for the registration of the mark "FMC & DEVICE" filed on August 27, 1990 for the goods ladies wear such as t-shirts, blouses, skirts, sweatshirts, panty, bra falling under Class 25 of the International Classification of goods bearing Serial No. 66877 which application was published for opposition in the Official Gazette, Volume III No. 3 page 20, released on June 29, 1990.

The herein Opposer is FMC Corporation a corporation duly organized and existing under the laws of the State of Delaware, United States of America, and doing business at 2000 Market Street, Philadelphia, Pennsylvania 19103, United States of America who filed the Opposition on October 22, 1990.

On the other hand, Respondent-Applicant is F.M.C. Manufacturing Company of Caloocan City, Metro Manila.

The grounds for the opposition are as follows:

- "1. Opposer is the owner of the trademark "FMC" for goods covered by International Classes 1, 2, 3, 5, 6, 7, 9, 11, 12, 13, 16, 17, 19 and 22, registered under Certificate of Registration No. 29501 issued on May 22, 1981. The trademark "FMC and Device" sought to be registered by Respondent-Applicant so resembles the aforementioned registered and unabandoned mark of Opposer that the use of Respondent-Applicant's mark on its goods will very likely cause confusion or mistake, or will deceive the purchasers thereof, such that the unwary public may be led to believe that the mark of the Respondent-Applicant and the goods on which the said mark is used are those of the Opposer herein. Consequently, the registration of the mark "FMC and Device" in the name of the Respondent-Applicant will be in violation of Sec. 4(d) of Republic Act 166, as amended.
  
- "2. The registration of the trademark "FMC and Device" in the name of the Respondent-Applicant is likewise in violation of Sec. 4(d) of Republic Act No. 166, as amended because it is confusingly similar to the word "FMC" which is part of Opposer's corporate name or trade name "FMC Corporation" as to likely deceive purchasers of products on which it is to be used to the extent that the said products may be mistaken by the unwary public to be manufactured by herein Opposer.
  
- "3. The registration in the name of Respondent-Applicant of the word mark "FMC" which forms part of the trade name of Opposer will

also be in violation of Article 8 of the Paris Convention for the Protection of Industrial Property of which Opposer's country as well as the Republic of the Philippines are member signatories.

- "4. Likewise registration in the name of Respondent-Applicant of the word mark "FMC" which forms part of the trade name of the Opposer will be in violation of Section 37 of Republic Act No. 166, as amended, otherwise known as the Trademark Law.
- "5. Opposer believes that the registration of the mark "FMC and Device" in the name of the Respondent-Applicant will cause irreparable injury and damage to Opposer, as provided in Section 8 of Republic Act No. 166, as amended.

The Opposer relied on the following facts to support its opposition:

- "a. The Opposer's trade name is "FMC Corporation" as shown by the appropriate commercial register of Opposer issued by the proper government agency of the country of domicile of Opposer.
- "b. The Opposer's trade name is well known in the world, and its trademark "FMC" used on its goods is likewise well-known throughout the world, including the Philippines as evidenced by the registration and used of the said mark by Opposer in various countries. The mark "FMC" is covered by Certificate of Registration No. 29501 issued to Opposer on May 22, 1981 by the Philippine Patent Office.  
  
Opposer has used the mark "FMC" on goods falling under several International Classes of goods, including garments.
- "c. The mark "FMC and Device" appearing on the drawing and facsimiles submitted by Respondent-Applicant in its application for registration is confusingly similar to Opposer's aforementioned registered mark as used on the goods of the Opposer.
- "d. The trademark "FMC" which Opposer has created, adopted and used is so well known all over the world, having required international recognition and goodwill for its quality products bearing said mark.
- "e. The registration of the mark in the name of Respondent-Applicant will dilute Opposer's mark "FMC" and harm its strength and distinctiveness as it is a fanciful, coined word and therefore a strong mark; and further, it would naturally prevent Opposer from expanding its use in the Philippines.
- "f. The long use of, and the large amount spent by Opposer for popularizing its trademark "FMC" have generated an immense goodwill for said trademark not only in the Philippines but also in other countries.
- "g. The similarity of the trademark "FMC and Device" subject of the application to the trademark of the Opposer betrays Respondent-Applicant's intention to ride on the goodwill and popularity of Opposer's trade name "FMC", which is also used as a trademark.



design where the word “FMC” is written is immaterial as the dominant feature of both marks is the word “FMC” which when pronounced is the same and the spelling is likewise the same.

One vital point to be emphasized is the fact that the trademark of the Opposer “FMC” has been registered in many countries of the world (Exhibit “D-1”) including the Philippines. The registration in the Philippines was granted on May 22, 1981 bearing Registration No. 29501 covering the goods falling under classes 1, 2, 3, 5, 6, 7, 9, 11, 12, 13, 16, 17, 19 and 22 of the International Classification of Goods and the application which matured into the above-mentioned Certificate of Registration was filed in the Philippines on April 22, 1974 based on Section 37 of Republic Act No. 166, as amended.

As previously discussed, the Respondent-Applicant failed to file its Formal Offer of Evidence and as such, the date of first use indicated in its trademark application August 16, 1973 subject of the instant opposition cannot be considered but limited to the filing date February 6, 1989 pursuant to Rule 173 of the Rules of Practice in Trademark Cases, which provides:

“Rule 173. *Allegations in the application nor evidence on behalf of the applicant.* – In all inter partes proceedings, the allegations of date of use in the application for registration cannot be used as evidence in behalf of the party making the same. In case no testimony is taken as to the date of use, the party will be limited to the filing date of the application as the date of his first use.”

Opposer’s trademark “FMC” is registered in the Philippines on goods falling under classes 1, 2, 3, 5, 6, 7, 9, 11, 12, 13, 16, 17, 19 and 22 of the International Classification of Goods as indicated in its Certificate of Registration (Exhibit “D-1”), while Respondent-Applicant’s trademark is being used on goods namely ladies wear, t-shirts, blouses, skirts, sweat shirts, panty, bra, under Class 25 of the International Classification of goods and as such, mistake or deception upon purchasers is far fetch/nil as the products of the contending trademarks are entirely distinct and different from each other hence, confusion is not present.

Moreover, there is no indication that the herein Opposer intends to venture into the business of producing goods under Class 25. This is clearly shown in its trademark registration granted in the Philippines on May 22, 1981, where the products of the said Opposer had been clearly and specifically described as falling under classes 1, 2, 3, 5, 6, 7, 9, 11, 12, 13, 16, 17, 19 and 22.

In *Faberge, Incorporated vs. Intermediate Appellate Court, the Director of Patents* allowed the Junior user to use the trademark of the Senior user on ground that the briefs manufactured by the Junior user, the product for which the trademark “BRUTE” was sought to be registered, was unrelated and non-competing with the products of the Senior user consisting of *after shave lotion, shaving cream, deodorant, talcum powder and toilet soap.*

In *CANO KABUSHIKI KAISHA vs. COUR OF APPEALS and NSR RUBBER CORPORATION, G.R. NO. 120900*, promulgated on July 20, 2000, the Supreme Court ruled that:

“The trademark “CANON” as used by Petitioner for its *paints, chemical products, toner and dyestuff* can be used by the private respondent for its *sandals* because the products of these two parties are *dissimilar.*”

The Supreme Court further stated, that ordinarily, the ownership of a trademark of trade name is a property right that the owner is entitled to protect as mandated by the Trademark Law. However, when a trademark is used by a party for a product in which the other party does not deal, the user of the same trademark on the latter’s product cannot be



not by any means imply the primacy of the International Law over national Law in the municipal sphere. Under the doctrine of incorporation as applied in most countries, rules on International Law are given a standing equal, not superior, to national legislative enactments.”

WHEREFORE, premises considered, the Opposition for the registration of the mark “FMC & DESIGN” is, as it is hereby, DENIED. Consequently, this case is DISMISSED and trademark application bearing Serial No. 66877 for the mark “FMC & DEVICE” filed on August 27, 1990 by FMC Manufacturing Company is hereby GIVEN DUE COURSE.

Let the filewrapper of “FMC & Device” subject matter under consideration be forwarded to the Administrative, Financial and Human Resources Development Services Bureau (AFHRDSB) for appropriate action in accordance with this Order with a copy thereof to be furnished the Bureau of Trademarks (BOT) for information and to update its records.

SO ORDERED.

Makati City, 22 June 2005.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs