

GTE DIRECTORIES (PHILS.) CORP.,
Opposer,

INTER PARTES CASE NO. 3589
Opposition to:

Serial No. : 65505
Date Filed : 08-15-88
Trademark: "PHILIPPINE
YELLOW PAGES & LOGO"

-and-

-versus-

INTER PARTES CASE NO. 3590
Serial No. : 65504
Date Filed : 08-15-88
Trademark : "PHILIPPINE
NEIGHBORHOOD
DIRECTORY &
LOGO"

PHILIPPINE TELEPHONE
DIRECTORY INC.,
Respondent-Applicant.

DECISION NO. 98-38

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DECISION

This is a consolidated Opposition filed by GTE Directories (Phils.) Corp., a corporation duly organized and existing under the Philippine laws, docketed as Inter Partes Case No. 3589 and 3590. The Respondent-Applicant in both cases is Philippine Telephone Directory Inc., likewise a corporation duly organized under the laws of the Philippines and with address at 3rd Floor Corinthian Plaza, Paseo de Roxas, Makati City, Metro Manila.

The above-mentioned consolidated case involved the opposition to the application for registration of the trademark "NEIGHBORHOOD YELLOW PAGES & LOGO" bearing Serial No. 65505 filed on August 15, 1988 and the trademark "PHILIPPINE NEIGHBORHOOD DIRECTORY & LOGO" bearing Serial No. 65504 likewise filed on August 15, 1988 by the herein Respondent-Applicant, which applications were published in the Bureau of Patents, Trademarks and Technology Transfer Official Gazette, Vol. III, No. 4 in pg. 24 thereof, officially released on August 31, 1990.

The common grounds upon which the Opposer based its opposition are as follows:

- "1. The Opposer is also engaged in the publication and distribution of directories in the Philippines and has been engaged in such business longer than the Respondent-Applicant.
- "2. While there is a disclaimer on the exclusive use of the words PHILIPPINE DIRECTORY, the mark sought to be registered by the Respondent-Applicant under Application No. 65504 still maintains the latter's claim of exclusive right to use the word NEIGHBORHOOD for its telephone directories. Said word, by itself, and the entire applied mark of PHILIPPINE NEIGHBORHOOD DIRECTORY are patently descriptive of the focus and nature of Respondent-Applicant's business and therefore its registration as a mark is proscribed by Section 4(e) of the Trademark Law.
- "3. The approval of Respondent-Applicant's trademark application s will clearly cause damage to Opposer since it will exclude Opposer and other telephone

directory publishers from using the descriptive words mentioned in the application in the description of their business.

- “4. In the course of the proceedings, Opposer will prove facts in support of the preceding allegations, with the reservation to present evidence to prove other facts as may be necessary, depending upon the evidence that may be introduced by Respondent-Applicant.”

On January 10, 1991, Respondent-Applicant through counsel filed its Answer denying the material allegations in the opposition and thus alleges the following:

- “1. The allegations in paragraph 1 of the opposition are specifically DENIED for lack of knowledge or information sufficient to form a belief as to the truth thereof;
- “2. Likewise the allegations contained in paragraph 2 of said opposition, specifically that which states that the word NEIGHBORHOOD as well as the entire applied mark of Philippine Neighborhood Directory are patently descriptive of the focus and nature of Respondent-Applicant’s business are specifically DENIED the same being mere conclusions of law, and allege that the entire applied mark of Philippine Neighborhood Directory is registrable under the Trademark Law.
- “3. The allegations of damaged contained in Paragraph 3 of the Opposition are also DENIED for lack of knowledge or information sufficient to form a belief as to the truth thereon and for having no legal and factual basis.”

The issues having been joined, this Office set the consolidated case for pre-trial conference. Failing to reach an amicable settlement, the parties went into trial, adduced testimonial and documentary evidences and, together with their respective memoranda, submitted the cases for decision.

The issues n the instant cases are as follows:

1. WHETHER OR NOT the trademarks of Respondent-Applicant consisting of Neighborhood Yellow Pages and Logo and Philippine Neighborhood Directory are confusingly similar to Opposer’s trademark “WALKING FINGERS LOGO” bearing Certificate of Registration No. 40499 issued on August 12, 1988, and
2. WHETHER OR NOT the use by Respondent-Applicant of its trademark and accompanying logo being applied for registration will cause damage or prejudice to the Opposer.

As to the first issue in this case which is whether or not there exist confusing similarity between Respondent-Applicant’s trademark “PHILIPPINE NEIGHBORHOOD DIRECTORY and Logo” and “NEIGHBORHOOD YELLOW PAGES and Logo” and Opposer’s trademark “WALKING FINGERS LOGO” under Registration No. 40499, the applicable provision of the TRADEMARK Law is Section 4(d) of R.A. No. 16, as amended, which provides:

“Sec. 4. Registration of trademarks, trade names and service marks on the principal register. – There is hereby established a register of trademarks, trade name and service marks which shall be known as the principal register. The owner of a trademark, trade name or service mark used to distinguish his goods, business or services from the goods, business or services of other shall have the right to register the same on the principal register, unless it:

(d) Consist of or comprises 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 services of the applicant, to cause confusion or mistake or to deceive purchasers;

XXX

(Underscoring provided)

In interpreting the above-quoted provision, the Supreme Court has ruled in several cases that:

“There is infringement of trademark when the use of the trademark involved would likely cause confusion or mistake in the mind of the public or to deceive purchaser as to the origin or source of the commodity.” (Philippine Nut Industry vs. Standard Brands, 65 SCRA 515).

“In resolving whether or not the competing marks are confusingly similar with each other. The test is not simply to take their words. Rather it is to consider the two marks in their entirety as they appear in their respective labels, in relation to the goods to which they are attached.” (Mead Johnson & Co. vs. N.V.T. Van Dorp, Ltd., L-17501 April 27, 1963)

In the case at bar, a close and careful consideration of the records and the evidences presented set forth the following findings, to wit:

1. No confusion would exist even if “PHILIPPINE NEIGHBORHOOD DIRECTORY & LOGO”, “NEIGHBORHOOD YELLOW PAGES & LOGO” and “WALKING FINGERS LOGO”, appear simultaneously and side by side with each other.
2. Both marks may co-exist independently from each other without giving rise to confusion among consumers as they differ in composition, spelling, meaning, sound, appearance, and pictorial representation as well.
3. The only similarity between them is the presence of “LOGO” however, the logos are not the same and differ from each other.

As shown by the records, Respondent-Applicant’s logo consists of an Icon of An Open Telephone Directory Book with a Roof over It. In the other hand, the Opposer’s logo consisting of WALKING FINGERS WITHIN A RECTANGULAR DESIGN. An examination of two logos reveal that they are distinct and different from each other.

Further, the dominant feature of the Respondent-Applicant’s trademarks are the words “NEIGHBORHOOD” and “LOGO” which are entirely not present in the Opposer’s trademark. Such being the case, there is absolutely no similarity much less confusing similarity between the two competing marks.

Another important point to be taken into consideration in this particular case is the fact that Respondent-Applicant expressly renounces or waives its right to exclusive use of the words disclaimed such as the following:

- a. Yellow pages
- b. Philippine and Directory

With the disclaimer, the main feature of Respondent-Applicant’s trademark is the word “NEIGHBORHOOD” and the logo consisting of an icon if an open telephone directory book with a roof over it, which is not present in Opposer’s trademark, which consists of WALKING FINGERS

logo, hence, confusing similarity between the two marks does not exist. Consequently, the public will not be deceived nor confused into believing Respondent-Applicant's mark for that of Opposer's. Consequently, the registration of the Respondent-Applicant's trademark will not cause damage or prejudice to the Opposer.

WHEREFORE, premises considered the herein Notices of Opposition are, as they are hereby, DENIED. Accordingly, Application Serial No. 65504 for the trademark "PHILIPPINE NEIGHBORHOOD DIRECTORY & LOGO" ("Philippine" and "Directory" disclaimed except in the manner of use) and Application Serial No. 65505 for the trademark "NEIGHBORHOOD YELLOW PAGES & LOGO" ("Yellow Pages" disclaimed except in the manner of use) filed on August 15, 1990 by Philippine Telephone Directory, Inc., are as they are hereby, GIVEN DUE COURSE.

Let the filewrappers subject trademark application be forwarded to the Administrative, Financial and Human Resource Development Bureau for appropriate action in accordance with this Decision, with a copy of this Decision furnished the Bureau of Trademarks for information and update of its record.

SO ORDERED.

Makati City, December 29, 1998.

ESTRELLITA BELTRAN-ABELARDO
Caretaker/Officer-In-Charge