

RE: APPEAL FROM EXAMINER'S
FINAL REJECTION OF
TRADEMARK APPLICATION

EX-PARTE CASE (unnumbered)

Application Serial No. 58850
Filed : May 26, 1986
Applicant : Pelikan AG
Trademark : PELIKAN
Used on : Goods falling under
Classes 1, 2, 9, 16 and 28

PELIKAN AG,
Applicant-Appellant.
x-----x

DECISION NO. 89-36 (TM)
June 13, 1989

DECISION

This is an appeal from the final action of the Trademark Examiner in rejecting Application Serial No. 58850 for registration of the trademark "PELIKAN" filed by Pelikan AG (herein referred to as Applicant-Appellant) of Germany on May 26, 1986 for goods falling under Classes 1, 2, 9, 16 and 28.

The ground for rejection is Section 4 (d) of Republic Act 166, as amended, on confusing similarity. The Trademark Examiner ruled that the mark sought to be registered is confusingly similar with the marks "PELICAN" under Serial No. 43897 for printed books and "PELICAB DEVICE" under Serial No. 43894 for printed publications and books, as all marks include goods under Class 16. Both cited rival marks eventually matured into Registration Nos. 39887 and 39886, respectively.

Applicant-Appellant argues that the Examiner erred in failing to consider the superior right acquired by it over the trademark "PELIKAN" by virtue of its existing prior registration for the same mark.

A perusal of the records of this Bureau shows that the herein Applicant-Appellant has already registered under its name the mark "PELIKAN & DEVICE", Registration No. R-2838 on June 21, 1962 for carbon papers, typewrite ribbons, ink for writing and printing, inking materials, fountain pens, etc., all falling under Classes 16 and 21. In 1983, however, another Trademark Examiner allowed for publication, ultimately registration, Serial Nos. 43897 and 43894, the cited rival marks, both for printed books, also under Class 16. With these, the Applicant-Appellant claims that "if any mark should be barred from registration on a finding of confusing similarity, in contemplation of Section 4 (d) of the Trademark Law, it should be the cited marks". But the Examiner therein correctly ruled that classification of goods alone is not determinative of whether or not goods are related or competitive. The Supreme Court aptly held in Philippine Refining Co. vs. Ng Sam, 115 SCRA 472 that:

"x x x while ham and some of the products of the petitioner are classified under class 47 (Foods and ingredients of food), this alone cannot serve as the decisive factor in the resolution of whether or not they are related goods. Emphasis should be on the similarity of the products involved and not on the arbitrary classification or general description of their properties or characteristics."

And the Court went on to conclude that:

“x x x the businesses of the parties are non-competitive and their products are so unrelated that the use of identical trademarks is not likely to give rise to confusion, much less cause damage to petitioner.”

Any person with the technical knowledge on this regard would readily admit that the process of printing and/or publishing books is different from the production of carbon papers, typewriter ribbons, inks and the like. Moreover, books are obtained for reading while the other school/ office supplies mentioned are of different uses. Certainly, the goods between Registration No. R-2838 and Registration Nos. 39887 and 39886 are unrelated and the businesses of the parties non-competitive.

In the case before us, Applicant-Appellant is applying the mark for the goods falling, inter alia, under Class 16 which particularly include books and printing products. As already pointed out, the cited rival marks, Registration Nos. 39887 and 39886, cover books and printed publications. Without question, Application Serial No. 58850 for Applicant-Appellant is confusingly similar with Registration Nos. 39887 and 39886.

PREMISES CONSIDERED, the Examiner's final rejection dated January 25, 1989, is hereby SUSTAINED.

SO ORDERED.

IGNACIO S. SAPALO
Director