

KRAFT FOODS INCORPORATED,	}	Inter Partes Case No.
Opposer,	}	14-1999-00060
	}	
	}	Opposition to:
-versus-	}	Appl'n Serial No.: 105670
	}	Date Filed : 2 February 1996
	}	Trademark : "TANGEE"
	}	
	}	
INTERNATIONAL	}	
PHARMACEUTICALS INC.,	}	
Respondent-Applicant.	}	Decision No. 2002 – 10
x-----x		

DECISION

On December 22, 1999, a Verified Opposition was filed to the registration of the mark "TANGEE" bearing Serial No. 105670 used on appetizer under class 32 of the International Classification of goods which application was published for opposition on page 93 of the Intellectual Property Office (IPO) Official Gazette Vol. II No. 3 and officially released for circulation on October 26, 1999.

Opposer in the instant case is "KRAFT FOODS, INC.," a foreign corporation organized and existing under the laws of the United States of America with principal office at Three Lakes Drive, Northfield, Illinois, U.S.A.

The herein Respondent-Applicant is "INTERNATIONL PHARMACEUTICALS, INC.," a corporation duly organized and existing under the laws of the Philippines with office address at Juan Lena Avenue, Mabolo, Cebu City, Philippines.

Opposer opposes the application on the following grounds:

- "a. Opposer is the owner of trademark "TANG" for beverage drink. Such ownership exists up to the date has never been abandoned.
- "b. Opposer's ownership of the trademark "TANG" as used in the goods aforesaid is evidenced by the certificates of registration which it has obtained from various countries including the Philippines.
- "c. The trademark "TANGEE" applied for by Respondent-Applicant is confusingly similar to Opposer's trademark "TANG", and its registration would thereby be contrary to Sec. 123 (e) of R.A. 8293.
- "d. The trademark "TANG" can be considered a world famous mark that deserves protection under and pursuant to the Convention of Paris for the Protection of Industrial Property (Lisbon version) to which the Philippines, like the United Stated pf America is a signatory.
- "e. In the Philippines, the trademark "TANG" has been continuously used by the Opposer since September 3, 1957 or for more than forty (40) years now and has been recognized by the buying public as indicative of the origin of the goods of Opposer so much so that Respondent-Applicant's use of confusingly similar mark

like "TANGEE" diminished the distinctiveness of the trademark "TANG" and thereby dilutes Opposer's goodwill thereon, and is, therefore, tantamount to infringement and unfair competition.

A Notice to Answer dated 4 January 2000 was sent to Respondent-Applicant through registered mail, giving the same fifteen (15) days from receipt of said notice to file its Answer. However, despite due notice, it failed to file the same and was subsequently declared IN DEFAULT on motion of the Opposer on 2 February 2000 per Order No. 2000-91. Considering that the Respondent-Applicant neither filed a motion to set aside the order of default nor manifested any interest in the present Opposition against its application, the ex-parte presentation of the Opposer's evidence was ordered by this Office in accordance with Section 11(b) of the Rules and Regulations on Inter Partes Proceedings.

The main issue to be resolved in this case is:

WHETHER OR NOT RESPONDENT-APPLICANT'S MARK "TANGEE" IS CONFUSINGLY SIMILAR TO OPPOSER'S TRADEMARK "TANG".

At the outset, it must be emphasized that the trademark application subject of the opposition proceedings was filed at the time the law governing intellectual property right particularly trademark is R.A. No. 166 as amended.

"Sec. 4. Registration of trademarks, tradenames and service marks on the Principal Register – There is hereby established a register of trademarks, tradenames 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 others shall have the right to register the same on the Principal Register unless it:

xxx

xxx

xxx

"(d) consists of or comprises a mark or a 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."

Pursuant to the Order of Default, Opposer presented its evidence consisting of Exhibits "A" to "X" inclusive of sub-markings.

The determinative factor in a contest involving registration of trademark is now 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 trademarks must be so 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 (AMERICAN WIRE & CABLE CO. vs. DIRECTOR OF PATENTS and Central Banahaw Industries, 31 SCRA 544).

In the case at bar and as shown by the evidence presented, the Respondent-Applicant's trademark "TANGEE" is confusingly similar to Opposer's trademark "TANG" which is registered

in this Office and not abandoned. The Opposer's trademark was filed last June 27, 1994 and was registered last November 19, 1998 under class 32 (Exhibit "G-G-1", "G-2" and "G-3"). The only difference between the two (2) marks is the presence of the last two (2) letters in Respondent-Applicant's trademark which are letters "EE". Respondent-Applicant can not appropriate Opposer's trademark in toto and avoid likelihood of confusion by adding the two (2) letters "EE". Thus, in *Continental Connector Corp. vs. Continental Specialties Corp.*, 207USPQ 60, it has been ruled that "Courts have repeatedly held that the confusion created by the use of the same word as the primary element in a trademark is not counteracted by the addition of another term."

Opposer's trademark "TANG" has been registered in many countries of the world including the Philippines for the goods not limited to class 32 on the International Classification of Goods while the Respondent-Applicant's goods "APPETIZER DRINK" likewise fall under Class 32.

In determining confusion similarity, a side comparison of the marks is to be done, emphasizing differences in detail is not the appropriate test. The key inquiry is not similarity PER SE but rather whether a similarity exist which is likely to cause confusion (SEE *EXXON CORP. vs. ZOIL ENERGY RESOURCES, INC.*, 552 F. SUPP, 1008, 1016, 216 USPQ 634, 641-642 [S.D.N.Y.]). This test must be applied from the perspective of purchasers. Thus, it must be determined whether the impression which the infringing mark makes upon the consumer is such that it is likely to believe the product is from the same source, as the one he knows under the trademark (*Mc Gregor-Doniger, Inc. vs. Drizzle, Inc.* 599 f 2d at 1133, 202 USPQ 81, 86-87). In making this determination, it is the overall impression of the marks as a whole that must be considered. Likewise, it has been consistently held that infringement of a trademark is to be determined by the "TEST OF DOMINANCY". Similarity in size, form, and colors, while relevant, IS NOT CONCLUSIVE. If the competing trademarks contain the main essential or dominant features of another, and confusion and deception is likely to result, infringement takes place. Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate (*CO TIONG S.A. vs. DIRECTOR OF PATENTS, G.R. L-5372, May 24, 1954*).

In the instant case, visual examination of the competing marks reveals that both contain the word "TANG". They differ only in the presence of the two (2) letters "EE" which were added to the Respondent-Applicant's mark in the end portion. However, when the two marks are pronounced, the prevailing SOUND that may heard is the pronunciation of the word "TANG", hence they are almost the same if not identical. There is no doubt that the competing marks appears to be confusingly similar.

When one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be REJECTED and DISMISSED outright, even without any opposition on the part of the owner and user of a previously registered label or trademark, this is not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill (*CHUAN CHOW SOY & CANNING CO. vs. DIRECTOR OF PATENTS and VILLAPANTA, 108 Phil. 833, 836*).

In connection with the use of a confusingly similar or identical mark, it has been ruled, thus:

"Those who desire to distinguish their goods from the goods of another have a broad field which to select a trademark for their wares and there is no such poverty in the English Language or paucity of signs, symbols, numerals etc. as to justify one who really wishes to distinguish his products from those of all others entering the twilight zone of a field already appropriated by another." (*WECO PRODUCTS CO. vs. MILTON RAY CO.*, 143 F. 2d, 985, 32 C.C.P.A. Patents 1214)

“Why of the million of terms and combinations of letters and designs available appellee had to choose those so closely similar to another’s trademark if there is no intent to take advantage of the goodwill generated by the other mark.” (AMERICAN WIRE & CABLE CO. vs. DIRECTOR OF PATENTS, 31 SCRA 544)

“Why with all the birds in the air, and all the fishes in the sea, and all the animals on the face of the earth to chose form, the defendant company (MANILA CANDY CO.) elected two (2) roosters as its trademark, although its directors and managers must have been well aware of the long-continued use of a rooster by the plaintiff with the sale and achievement of its goods? xxx a cat, a dog, a carabao, a shark or an eagle stamped upon the containers in which candies are sold would serve as well as a rooster for the products of defendant’s factory. Why did defendant select two (2) roosters as its trademark? (CLARKE vs. MANILA CANDY CO., 36 Phil. 100)

Worthy to be noted is that the herein Respondent-Applicant was declared in DEFAULT in accordance with the Rules of Court for its failure to file its ANSWER within the reglementary period and upon Motion of Opposer’s Counsel (ORDER No. 2000-91) dated February 2, 2000.

It was held by the Supreme Court in (DELBROS HOTEL CORPORATION vs. Intermediate Appellate Court, 159 SCRA 533, 543) that:

“Fundamentally, default Orders are taken on the legal presumption that in falling to file an Answer, the Defendant does not oppose the allegation and relief demanded in complaint.

Indeed, this Office cannot but notice the lack of concern the Respondent-Applicant had shown in protecting the mark which is contrary to the norm that: A person takes ordinary case of his concern.” (SEC. 3 (D), Rule 131 of the Rules of Court)

WHEREFORE, premises considered, the Opposition is hereby SUSTAINED. Consequently, trademark application bearing Serial No. 105670 for the registration of the mark “TANGEE” filed by International Pharmaceuticals Incorporated is hereby REJECTED.

Let the filewrapper of trademark TANGEE subject matter of this case be forwarded to the Administrative, Financial Human Resource Development Service Bureau (AFHRDSB) for appropriate action in accordance with this DECISION with a copy furnished the Bureau of Trademarks (BOT) for information and to update its records.

SO ORDERED.

Makati City, 04 June 2002.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office