

LEE KUM KEE CO., LTD.,
Opposer,

INTERPARTES CASE NO, 3211

- versus -

OPPOSITION TO:
Application Serial No. 57427
Filed: September 23, 1985
Applicant: Chan Tin Chung
Trademark: TWIN PANDA & DEVICE
Used on: Misua, bihon, sotanghon,
Noodles

CHAN TIN CHUNG,
Respondent-Applicant.
x-----x

DECISION NO. 90-29 (TM)
July 24, 1990

DECISION

On September 16, 1988, Lee Kum Kee Go., Ltd., a company of Hong Kong, with address at Lee Kum Yee Industrial Building, 40 Shek Pai Wan Road, Tin Wan, . Aberdeen, Hong Kong, filed its verified Notice of Opposition (Inter Partes Case No. 3211) to Application Serial No. 57427 for the trademark "TWIN PANDA & DEVICE" used on misua, bihon, sotanghon, noodles, which application was filed on September 23, 1985 by Chan Tin Chung, a Filipino citizen doing business under the name "Mabuhay Misua Factory" at 177 M. Tengco Street, Pasay City, Metro Manila, which was published on July 18, 1988 issue of the Bureau of Patents, Trademarks and Technology Transfer Official Gazette, Volume I, No. 5, Page 89.

Opposer stated as basis for its opposition the following:

"1. The trademark 'PANDA' sought to be registered by the respondent-applicant is confusingly similar and/or identical to the trademark 'PANDA' of herein opposer x x x;

2. The opposer has spent much for the advertisement and promotion of the trademark 'PANDA' and its business will clearly be damaged and will suffer irreparable injury;

3. The trademark 'PANDA' of the respondent-applicant so resembles the trademark 'PANDA' of the opposer as to be likely when applied to or used in connection with the goods of the respondent-applicant, to cause confusion or mistake or to deceive purchasers;

4. On September 23, 1985, which is much later than the dates of registration of opposer's trademark in its home country and the other countries, respondent-applicant with obvious knowledge of the popularity of opposer's trademark 'PANDA' filed an application for the registration of the identical mark 'PANDA' alleging use in commerce since January 2, 1983 such use being fictitious and/or likely to cause confusion or mistake or deceive purchasers or the public;

5. Opposer alleges that it has its real and effective industrial or commercial establishment in Hong Kong, which country is a member of the Convention of Paris for the Protection of Industrial Property, otherwise known as the Paris Convention of which the Philippines is also an adherent by virtue of Senate Resolution No. 69 dated May 10, 1965.

Under said Convention, each country of the Union undertakes at the request of an interested party to prohibit the use of a trademark which constitutes a reproduction, imitation or translation of a mark already belonging to a person entitled to the benefits of 'the Convention and used for identical or similar goods.'

On October 28, 1988, Respondent-Applicant filed his Answer raising the following special/affirmative defenses;

“7.1. That the respondent-applicant has been using the trademark TWIN PANDA since January 2, 1983, on misua, bihon, sotanghon and noodles and had been issued Certificate of Registration No. 8061 under the Supplemental Register last June 13, 1988;

7.2. That respondent-applicant is the first user of the trademark PANDA in the Philippines for misua, bihon, sotanghon and noodles;

7.3. That respondent-applicant has spent considerable amounts of money to popularize and advertise its trademark PANDA in this country and opposer, after knowing that respondent's brand has been popularized in this country, wants to 'take over' and claim that TWIN PANDA is after all his trademark, NOT IN THE PHILIPPINES, BUT IN HONG KONG or some other foreign country;

7.4. That the fact that opposer's trademark is registered in Hong Kong does not automatically qualify it to set aside the registration or prior application or prior use of the trademark PANDA by the respondent-applicant notwithstanding the fact that Hong Kong is a member of the Paris Convention. x x x

x x x

7.6. That by its own admission, its registration in Hong Kong was only on September 23, 1985, which even if the same were to be used as the basis for 'first use' would still be MUCH LATER than respondent's first use of January 2, 1983.

x x x

7.8. That the Notice of Opposition does not include the required labels which are jurisdictional requirements in the filing of an Opposition.”

The main issue to be resolved is whether or not the use of the trademark “PANDA” on Respondent-Applicant's goods would likely cause confusion, mistake or deception upon purchasers as to the source or origin thereof.

Our Trademark Law, particularly Section 4(d) thereof, Provides as follows:

“SEC. 4. Registration of trademark, tradenames and service marks on the principal register. - There is hereby established a register of trademarks, trade names 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

(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 services of the applicant, to cause confusion or mistake or to deceive purchasers.”

For failure of the Respondent-Applicant's counsel to appear at the pre-trial conference scheduled for December 13, 1988, January 12, 1989, February 16, 1989 and March 15, 1989, respectively, Respondent-Applicant was declared in default (Order No. 89-781 dated September 26, 1989).

Pursuant to the Order of Default, Opposer presented its evidence ex-parte consisting of documentary exhibits marked as Exhibits "A" to "L-2", inclusive of sub-markings.

The evidence shows that Respondent-Applicant's trademark "TWIN PANDA & REP." is identical to Opposer's trademark "PANDA LOGO" and "PANDA BRAND" in Chinese characters as both marks contained the device of a panda (Exhs. "D", "J", "J-1" and "J-3"). Both parties' goods belong to the same class (30). Hence, there is factual basis to hold that Respondent-Applicant's trademark is confusingly similar with Opposer's trademark.

Respondent-Applicant may not appropriate Opposer's trademark in toto and avoid likelihood of confusion by adding the word "TWIN" thereto. Thus, in *Continental Connector Corp. vs. Continental Specialties Corp.*, 207 USPQ 60, it has been ruled that "Courts have repeatedly held that the confusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term". Examples: "MISS USA" and "MISS USA WORLD" (*Miss Universe Inc. vs. Patricelli*, 161 USPQ 129); "GUCCI" and "GUCCHI-GOO" (*Gucci Shop vs. R.H. Macy & Co.*, 446 F. Supp. 838); "COMFORT" and "FOOT COMFORT" (*Scholl, Inc. vs. Tops E.H. R. Corp.*, 185 USPQ 754); "ACE" and "FFEN-ACE" (*Becton, Dickinson & Co. vs. Wigwam Mills, Inc.*, 199 USPQ 607). Opposer's trademark "PANDA LOGO" is registered in Hong Kong (Exhs. "D" and "D-1") and some other countries (Exhs. "J", "J-1" to "J-28") and used by the Opposer since 1888 (Exh. "K").

Therefore, Opposer deserves protection under Section 4(d) of Republic Act No. 166, as amended.

WHEREFORE, the opposition is GRANTED. Application Serial No. 57427 filed by Chan Tin Chung is DENIED.

Let the records of this case be remanded to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director