

ORIGIN PRODUCTS LTD.,	}	Inter Partes Case No. 14-2002-00057
<i>Opposer,</i>	}	Opposition to:
	}	
-versus-	}	Appl'n Serial. No.: 106240
	}	Date Filed : 28 February 1996
	}	Trademark : "POLLY POCKET &
	}	Design"
	}	
CARMELITA L. CRUZ	}	
<i>Respondent-Applicant.</i>	}	Decision 2004 – 02
X-----X		

D E C I S I O N

This pertains to an opposition filed on October 30, 2002 by ORIGIN PRODUCTS, LTD., a corporation duly organized and existing under the laws of England, with principal business address at 10 Lambton Place, London W11 2SH, England, against the registration of the mark "POLLY POCKET & DESIGN" bearing Serial No. 106240 filed on February 28, 1996 by the herein Respondent-Applicant "CARMELITA L. CRUZ, a Filipino citizen with address at MAMBUGAN, Antipolo, Rizal, covering the goods "*children shoes, slippers, sandals* under class 25 of the International Classification of goods, which application was published for opposition in the Official Gazette Volume V No. 4 issued by the Intellectual Property Office (IPO) last August 5, 2002.

The grounds for opposition are the following:

"1. Opposer is the owner of the internationally well-known trademark "POLLY POCKET", which is the subject of a trademark registration in the Philippines bearing Registration No. 65819 covering the International Class 28.

"2. Opposer has other trademark applications still pending with the Intellectual Property Office (IPO), namely

Trademark	:	POLLY POCKET
Serial No.	:	4-2002-0005532
Date Filed	:	July 5, 2002
Classes	:	3, 11, 14, 16, 18, 21, 24, 25 and 30

"3. In addition to the above-named trademark registration and applications, Opposer also has trademark registrations and pending trademark applications for the mark "POLLY POCKET" in various jurisdictions spanning several continents throughout the world. Enclosed as Annex "A" is a list of all the countries wherein the trade mark POLLY POCKET is registered. Enclosed as Annex "B" is a list of all countries wherein applications for the trademark POLLY POCKET have been filed. Enclosed as Annex "C" are copies of the certificate of registration of the POLLY POCKET trademark in the following countries:

Argentina	Japan
Australia	Malaysia

Benelux	Mexico
Canada	New Zealand
Chile	Panama
China	Peru
Colombia	Philippines
European Union	Singapore
France	Spain
Germany	Thailand
Hong Kong	United Kingdom
Italy	U.S.A.

Some of the registered trademarks are shown as being in the names of either Bluebird Toys (UK) Ltd. or Mattel Inc. which companies were the predecessors in title to the Opposer, the rights in these trademarks have now been transferred / assigned to Opposer.

- “4. The Opposer was first to adopt and use the trademark in actual trade and commerce in the Philippines and in other jurisdictions for various international classes for several years now, *long before* the filing of Respondent-Applicant’s trademark application and her alleged use thereof. Since then, the mark created and adopted by the Opposer has become internationally well-known and has acquired world-wide goodwill now being capitalized with undue advantage by Respondent-Applicant;
- “5. Registration of the mark “POLLY POCKET” in the name of Respondent-Applicant would violate pertinent provision of Republic Act No. 8293 (Intellectual Property Code), hereunder quoted as follows:

“SEC. 123 *Registrability.* – 123.1. A Mark cannot be registered if:

X X X

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or
 - (ii) Closely related goods or services, or
 - (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;
- (e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in

determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark.”

Although the Opposer’s trademark registration in the Philippines covers a class of goods different from that of the Respondent-Applicant’s, the above provision still *precludes* a junior applicant (like Respondent-Applicant) to register a well-known mark even on goods or service which is unrelated or not similar to the goods or services to those specified in the certificate of registration of well-known mark, i.e., the Opposer’s (*Agpalo, The Law on Trademark Infringement and Unfair Competition, 2000 Ed. P. 168*).

In any event, the existence of the Opposer’s other pending trademark applications in the Philippines for the mark POLLY POCKET which covers the same class of goods as Respondent-Applicant’s, and also Opposer’s existing registrations and applications for the mark POLLY POCKET in various jurisdiction throughout the world, also preclude the Respondent-Applicant from appropriating and registering the same in her name;

- “6. Opposer’s trademark “POLLY POCKET” should be afforded the protection under the law given to internationally-known trademarks and, therefore, should be given preference and priority over and against Respondent-Applicant’s mark “POLLY POCKET” which is clearly a copy of Opposer’s well-known trademark;
- “7. Respondent-Applicant’s mark POLLY POCKET is a flagrant and veritable imitation of Opposer’s internationally-known trademark “POLLY POCKET” that would likely cause confusion, mistake and deception to the buying public. Confusion between Opposer’s and Respondent-Applicant’s respective business and products as well as dilution and loss of distinctiveness of Opposer’s trademark are inevitable;
- “8. Opposer’s trademarks have acquired tremendous goodwill in the Philippines and throughout the world. Obviously, Respondent-Applicant is merely riding on the popularity and goodwill of the Opposer’s trademarks. Thus, Opposer’s right under the provisions of Intellectual Property Code and the Paris Convention on the Protection of Industrial Property must be protected.

A Notice to Answer was issued by this Office dated 13 November 2002 and sent to the Respondent-Applicant through registered mail with Return card on November 20, 2002 under No. C-5811.

For failure of the Respondent-Applicant to file her Answer to the Notice of Opposition within the reglementary period, this Office issued Order No. 2003-252 dated 26 June 2003 declaring Respondent-Applicant as in DEFAULT.

Pursuant to the Order of Default, Opposer presented its evidence ex-parte consisting of Exhibits “A” to “DD” inclusive of sub-markings.

The main issue to be resolved in this case is whether Respondent-Applicant’s trademark “POLLY POCKET & Design” is confusingly similar to Opposer’s trademark “POLLY POCKET”.

To be noted in this case is the fact that the trademark application subject of the opposition was filed on February 28, 1996 and that the governing law pertaining to Intellectual Property Rights particularly "TRADEMARKS" is Republic Act No. 166, as amended.

The applicable provision of law is SECTION 4(d) of Republic Act No. 166, as amended which provides as follows:

"SECTION 4. *Registration of trademarks, trade names 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:

x x x

(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 service of the applicant, to cause confusion or mistake or to deceive purchasers."

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxta position) of the trademark said to be infringed (87 C.J.S., pp. 288-291). Some such factor as sound, appearance, form, style, shape, size or format, color; ideas connoted by the marks, the meaning, spelling and pronunciation of the words used; and the setting in which the words appear" may be considered, (87 C.J.S., pp. 291-292). For, indeed, trademark infringement is a form of unfair competition. (*CLARKE vs. MANILA CANDY CO.*, 36 PHIL. 100, 106; *CO TIONG SA vs. DIRECTOR OF PATENTS*, 95 Phil. 1, 4)

Confusion is likely between trademarks only if their over-all presentation in any of the particular of sounds, appearance, or meaning are such as would lead the purchasing public into believing that the products to which the marks are applies emanated from the same source.

Considering the two trademarks in question as shown in the Respondent-Applicant's submitted drawings and facsimile and the mark of the Opposer as appearing in the Certificate of Registration issued in favor of the Opposer in China (Exhibit "F"), it is very clear that the two marks are identical in all aspect, as to sound, spelling, pronunciation, the manner of display, the lettering and the design contained therein as part of the mark is practically the same. No distinction could be found whatsoever.

One vital point to be considered is the fact that the herein Opposer has filed with the Bureau of Patents, Trademarks and Technology Transfer (BPTTT) now the Intellectual Property Office (IPO) the registration of the mark "POLLY POCKET" on March 24, 1995 bearing Serial No. 99260 which application matured to Registration No. 65819.

On the other hand, the Respondent-Applicant has filed her trademark application for the registration of the mark "POLLY POCKET & DESIGN" subject of the instant opposition

proceedings only on February 28, 1996, much later than the filing date of the Opposer's application.

Viewing from the circumstances as stated, it can be concluded that the Respondent-Applicant copied and adopted the trademark of the Opposer.

In connection with the use of a confusingly similar or identical mark, both foreign authority and our Supreme Court on several occasions ruled, thus:

“Those who desire to distinguish their goods from the goods of another have a broad field from 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 by entering the twilight zone of a field already appropriated by another.” (*WECO PRODUCTS CO. vs. MILTON RAT 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, the appellee had to choose those closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark.” (*AMERICAN WIRE & CABLE CO. vs. DIRECTOR OF PATENTS*, 31 SCRA 544.)

“x x x. 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 choose from, the defendant company (Manila Candy Co.) elected two roosters as its trademark, although its directors and managers must be well aware of the long-continued use of a rooster by the plaintiff with the sale and achievement of its goods? x x x a cat, a dog, a carabao, a shark or an eagle stamped upon the container in which candies are sold would serve as well as a rooster for purposes of identification as the product of defendant's factory. Why did defendant select two roosters as its trademark?” (*CLARKE vs. MANILA CANDY CO.*, 36 Phil. 100).

In addition to the fact that the Opposer's trademark “POLLY POCKET” has been registered in the Philippines for which the corresponding application was filed in the year 1995 as against that of the Respondent-Applicant who only filed her application in 1996, the Opposer also has trademark applications and registrations in various countries of the world (Exhibits “B” and “C”). Opposer has also submitted as Exhibits “D” to “CC” copies of the Certificate of Registrations of the mark “POLLY POCKET” in various countries and jurisdictions. In addition, Opposer has other trademark applications still pending with the Intellectual Property Office for the registration of the trademark “POLLY POCKET” filed on July 5, 2002 bearing Serial No. 4-2002-0005532 under classes 3, 11, 14, 16, 18, 21, 24, 25 and 30.

Another point to be emphasized which is shown by the records is that Opposer's trademark “POLLY POCKET” has been registered in the United States bearing Registration No. 2, 112,633 on November 11, 1997 for the foods under classes 16 and 25 of the International Classification of goods and that its first use is in the year 1994 (Exhibit “CC”).

On the part of Respondent-Applicant, she claimed first use of the mark POLLY POCKET & Design on September 11, 1992 as indicated in her trademark application. However, she failed to substantiate such claim as she failed to file her Answer and was declared IN DEFAULT, hence, she is limited only to the date of filing of her application on February 28, 1996 as her date

of first use, which is a date later than the date of first use of the Opposer which is in the year 1994.

The Supreme Court ruled in the case of SY CHING vs. GAW LIU, 44 SCRA 143 that, “x x x Thus, under the Rules of Practice in trademark cases (Rule 173), in all Inter Partes proceedings, the allegation of date of use in the application for registration of the applicant or of the registrant 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 of the application as the date of his first use.”

The right to register trademark is based on ownership. (Operator Inc., vs. Director of Patents, 15 SCRA 147). The applicant has the burden of proving ownership. An applicant for registration is not bound by the date of first use as stated by him in his application, but is entitled to carry back said date of first use to prior date by proper evidence; but in order to show an earlier date of use, he is then under a heavy burden, and his proof must be clear and convincing. In the case at bar, the Respondent-Applicant failed to show any proof of ownership over the mark except to the date of her first use as stated in her trademark application which was not substantiated by any proof required by law to invest her with exclusive, continuous adoption and use of the trademark.

Furthermore, “a boundless choice of words, phrases and symbols is available to one who wishes a trademark sufficient unto itself to distinguish his products from those of others. *When, however, there is no reasonable explanation for the defendant’s choice of such a mark though the field for his selection was so broad, the inference is inevitable that it was chosen deliberately to deceive.*” (Ill, Callman, Unfair Competition, 2nd Ed., pp 1527-1528)

Moreover, it is noteworthy to emphasize at this point that the trademark applied for by the Respondent-Applicant is the very same word and has exactly the same appearance as of Opposer’s mark, the choice and adoption of which has no reasonable explanation, hence, confusing similarity among the buying public can necessarily be expected.

As to the position of the Opposer that its trademark “POLLY POCKET” should be afforded the protection under the law to internationally-known trademarks particularly the Convention of Paris for the Protection of Industrial Property, the relevant article provides:

Article 6 bis
[Marks: Well-known marks]

(1.) The countries of the Union undertake, ex-officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

In support of its claim that the trademark “POLLY POCKET” had attain the status of a well-known mark, Opposer submitted in evidence a listing of various registrations in different countries of the world including the Philippines, most of which were issued before CARMELITA L. CRUZ’s date of application marked Exhs. “B” and “C” as well as copies of different Certificates of Registrations in various countries and jurisdictions marked Exhs. “D” to “CC”. This alone unquestionably demonstrates that the “POLLY POCKET” mark in the name of the Opposer is internationally well-known.

In the light of the foregoing and under the plain language of the applicable law and rules, this Office finds the Respondent-Applicant not entitled to register the mark "POLLY POCKET & DESIGN" in her name and favor.

WHEREFORE, the Opposition is hereby SUSTAINED. Consequently, trademark application bearing Serial No. 106240 for the mark "POLLY POCKET & DESIGN" filed on February 28, 1996 by CARMELITA L. CRUZ is as it is hereby, REJECTED.

Let the file wrapper 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 for information and to update its record.

SO ORDERED.

Makati City, 26 February 2004.

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