

GRACE ANN O. PANGILINAN,  
Opposer,

INTER PARTES CASE NO. 4127  
Opposition to :

-versus-

Serial No : 84728  
Filed : March 9, 1993  
Trademark : "BIG BLUE"

CARLOS YAO CHIA YU,  
Respondent-Applicant.  
X-----X

DECISION NO. 98-26

### DECISION

The application for registration of the trademark "THE BIG BLUE" used on men's ladies and children's wear particularly t-shirts, pants, shorts, blouse, shoes and socks with Application Serial No. 84728 filed on March 09, 1993 by CARLOS YAO CHIA YU, of Mandaluyong, Metro Manila was published for Opposition on page 58 of Volume VII, Issue No. 5, Official Gazette of the then BPTTT, which was officially released for circulation on November 8, 1994.

In accordance with the said publication, and after the second extension of time to file Notice of Opposition, the herein Opposer, Grace Ann O. Pangilinan, with office address at Ocampo's Emporium, General Hizon, San Fernando, Pampanga, believing that she will be damaged by the registration of the said trademark, filed her NOTICE OF OPPOSITION, on 04 February 1995, alleging therein, among others, the following grounds:

- "1. The registration of the trademark THE BIG BLUE in favor of respondent is contrary to Section 4 (d) of Republic Act No. 166, as amended;
- "2. Respondent-Applicant is not entitled to register the trademark THE BIG BLUE;
- "3. The registration of the trademark THE BIG BLUE in favor of Respondent-Applicant will cause grave and irreparable damage and injury to Opposer;
- "4. Opposer has filed her trademark application Serial No. 87720 on August 27, 1993. The filing dates of the two (2) interfering applications are barely four and one half months apart for which reason there should have been declared an interface. Until now no interference has been declared."

Opposer relied on the following facts to support her Opposition:

- "1. Opposer is an established manufacturer, distributor and seller of a wide range of goods falling under Class 25 for men's, ladies and children's wear particularly t-shirts, pants, shorts, blouse, shoes belts, socks;
- "2. Opposer adopted and has been using before respondent-applicant's filing date the trademark THE BIG BLUE and Device for the various goods it manufactures, distributes and sells;
- "3. The trademark which the Respondent-Applicant seeks to register, namely, THE BIG BLUE is confusingly similar if not identical to Opposer's trademark THE BIG BLUE and Device;

"4. Respondent-Applicant is not entitled to register the trademark THE BIG BLUE in his name. Respondent-Applicant has not used in lawful commerce the trademark THE BIG BLUE;

"5. Opposer has established sufficient goodwill through her long continued use of the trademark THE BIG BLUE and Device and sustained promotional efforts and expense to popularize said mark;

"6. Respondent – Applicant has never raised any objection or oppositions to Opposer's open and continuous use of the trademark THE BIG BLUE and Device;

"7. The registration of the trademark THE BIG BLUE in favor of respondent-applicant will cause grave and irreparable damage or injury to Opposer."

A NOTICE TO ANSWER dated 07 February 1995 was sent to the herein Respondent-Applicant, MR. CARLOS YAO CHIA YU, requiring him to file his ANSWER within fifteen (15) days from receipt thereof. Said notice was received by him on 11 February 1995 per Registry Return Card No. G 365.

For failure of the herein Respondent-Applicant to file his ANSWER within the reglementary period, Opposer filed a MOTION TO DECLARE RESPONDENT-APPLICANT IN DEFAULT, which was granted by this Office in its Order No. 95-209 and the case was set for ex-parte presentation of Opposer's evidence on May 8, 1995.

At the said hearing for the ex-parte presentation of Opposer's evidence, Opposer marked in evidence Exhibits "A" to "G" inclusive of submarkings. Counsel for Opposer was required to file his written Formal Offer of Exhibits ten (10) days thereafter and to submit MEMORANDUM ten (10) days from the receipt of the Order admitting said exhibits.

The Opposer then submitted his written formal offer of exhibits on June 19, 1995 which were admitted in evidence for the Opposer for whatever they are worth, in this Office Order No. 95-340. Accordingly, Opposer filed his MEMORANDUM on 16 August 1995 and this case is now deemed submitted for decision.

The issue to be resolved in this case is WHETHER OR NOT RESPONDENT – APPLICANT TRADEMARK "BIG BLUE" IS CONFUSINGLY SIMILAR TO THAT OF OPPOSER'S TRADEMARK "THE BIG BLUE AND DEVICE."

With the enactment of R.A. 8293, otherwise known as the "Intellectual Property Code of the Philippines" which took effect on January 01, 1998, the application for the registration of the mark "BIG BLUE" should have been prosecuted under the new law (R.A. 8293).

However, this Office takes cognizance of the fact that the herein Application Serial No. 84728 was filed on March 1993 when the new law was not yet in force. Section 235.2 of R.A. 8293, provides, inter alia that: "All applications for registration of marks or trade name pending in the Bureau of Patents, Trademarks and Technology Transfer at the effective date of this act may be amended, if practicable to bring them under the provision of this Act. xxx. If such amendment are not made, the prosecution of said application shall be PROCEEDED WITH and registration thereon granted in accordance with the ACTS UNDER WHICH SAID APPLICATION WERE FILE AND SAID ACTS HEREBY CONTINUED TO BE IN FORCE TO THIS EXTENT ONLY NOTWITHSTANDING THE FOREGOING REPEAL THEREOF.

Considering however, that this application subject of opposition proceedings is now for resolution, thereby rendering impractical to so amend it in conformity with R.A. 8293 without adversely affecting rights already acquired prior to the effectivity of the new law (Sec. 236, supra), this Office undertakes to resolve the case under the former law, R. A. 166 as amended, particularly Section 4 (d), which provides:

*“SEC. 4. Registration of trademarks, trade names and service mark 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 trade mark, trade name or service mark used to distinguish his goods, business or service from the goods, business or service 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 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 consumers.”*

In the case at bar, the mark is not only confusingly similar but is identical except for the design. Both contain the word “BIG BLUE” and being used on the same goods, CLASS 25, such as men’s and ladies’ t-shirts, pants, shorts, blouses, jacket shirts, belts, shoes and socks ( Opposer’s Exhibits “D”, “E”, and “F” and Respondent-Applicant’s Trademark Application). Hence, there is a great possibility that the purchasing public might be deceived or confused into believing that all these products came from one manufacturer or the same origin.

In connection with the use of a confusingly similar or identical mark, the Supreme Court has ruled that:

*“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 entering the twilight zone of a field already appropriated by another. (Weco Products Co. Milton Ray Co., 143 F. 2e, 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 so 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 C. vs. Director of Patents, 31 SCRA 544)”*

In the light of the above-quoted provisions of law and authorities, there is no doubt that confusing similarity between the two marks exists.

The next issue to be resolved then, is WHO BETWEEN THE PARTIES IS ENTITLED TO THE REGISTRATION OF THE MARK?

Herein Opposer adopted and used the trademark “THE BIG BLUE and Device, as early as May 1, 1992 as shown in Exhibits “B”, Cash Invoice No. 7006 representing payment to Opposer’s first delivery of products to Ocampo’s Emporium, and formally launched said products in the market as evidenced by the advertisement published in the Philippine Daily Inquirer issue dated June 27, 1992 (Exhibits “C”, “C-1”, and “C-2”).

On other hand, Respondent – Applicant’s trademark application show that his first date of use was on July 27, 1987. However, Rule 173 of the rules of Practice in Trademark Cases specifically provides, that:

*“173. Allegations in the application not evidence on behalf of the applicant. – in all inter partes proceedings, the allegations 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 date of the application as the date of his first use.* (underscoring ours)

Respondent – Applicant did not adduce evidence to substantiate his claims of first use, as he was declared in default, so his date of first use of the mark is limited to the filing date of his application, which was on *March 09, 1993.*

Moreover, the non-filing of the Answer and Motion to Lift Order of Default by the herein Respondent-Applicant signifies lack of interest on his part and that he does not oppose the allegations and the relief demanded by the Opposer. The Supreme Court held in *DELBROS HOTEL CORPORATION vs. INTERMEDIATE APPELATE COURT*, 159 SCRA 533, 543 (1988) that:

“Fundamentally, default orders are taken on the legal presumption that in failing to file an ANSWER *the defendant does not oppose the allegations and relief demanded in the complaint.*” (underscoring ours)

*WHEREFORE*, the Notice of Opposition is hereby *SUSTAINED*. Accordingly, Application Serial No. 84728 for the registration of the trademark “BIG BLUE” filed by the herein Respondent – Applicant is hereby *REJECTED*.

Let the filewrapper of BIG BLUE, subject matter of this case be forwarded to the Administrative, Financial and Personnel Services Bureau for appropriate action in accordance with this Decision with a copy to be furnished the Bureau of Trademarks for information and update of its records.

*SO ORDERED.*

Makati City, December 31, 1998

ESTRELLITA BELTRAN-ABELARDO  
Caretaker/Officer-in-Charge