

QUALITY HOUSE, INC.,  
Opposer,

IPC 3625

-versus -

Opposition to:  
TM Application No. 67214  
(Filing Date: 02 March 1989)

OLIN CORPORATION  
Respondent-Applicant

TM: "WINCHESTER"  
Decision No. 2007-68

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## DECISION

This is an opposition against the application filed by OLIN CORPORATION on March 2, 1989 bearing Serial No. 67214 for the registration of the mark "WINCHESTER" used on eye glasses, sun glasses, jewelry, watches and clothing under classes 14 and 15 of the International Classification of Goods, which application was published for opposition in page 58, Volume III No.6, November to December 1990 issue of the Official Gazette, officially released for the circulation on December 31, 1990.

Opposer is a corporation duly organized under Philippine laws with principal office at 669 Pina Avenue, Sampalok, Metro Manila. In 1982 and 1989, opposer caused the registration of the trademark "WINCHESTER" with the Philippine Patent Office and Bureau of Patent, Trademark and Technology Transfer under Certificates of Registration Nos. 30639 and 38782, issued on February 15, 1982 and April 29, 1988 respectively. Certificate of Registration No. 30639 covers belt under Class 25 while Certificate of Registration No. 38782 covers coin purses, key holders, key cases, men's and ladies' wallets and clutch bags under Class 18.

On the other hand, Respondent-Applicant, OLIN CORPORATION, with address at No. 120 Long Ridge Road, Stamford, Connecticut 06904, U.S.A. filed on March 2, 1989, an application bearing Serial No. 67214 for the registration of the mark "WINCHESTER" for its products, eye glasses, sun glasses, jewelry, watches and clothing likewise falling under classes 14 and 25.

The grounds for opposition to the registration of the mark are as follows:

1. The trademark "WINCHESTER" is identical to Opposer's registered trademark "WINCHESTER", which has been previously used in commerce in the Philippines and not abandoned, as to be likely, when applied to or used in connection with the goods of the applicant, to cause confusion, mistake and deception on the part of the purchasing public;
2. The registration of the trademark "WINCHESTER" in the name of the applicant will violate Section 2-A of Republic Act No. 166, as amended, which prohibits the appropriation by a trader of a trademark which has previously been appropriated and used by another to distinguish his wares and services from those of others;
3. The registration and use by applicant of the trademark "WINCHESTER" will diminish the distinctiveness and dilute the goodwill of opposer's trademark "WINCHESTER";
4. The registration of the trademark "WINCHESTER" in the name of the applicant is contrary to other provisions of the Trademark Law;

The Opposer relied on the following fact to support its contentions on this Opposition:

1. Opposer is a manufacturer of a wide-range of products, including coin purses, key holders, key cases, belts, men's and ladies' wallets and clutch bags bearing the trademark "WINCHESTER", which have been marketed and sold in the

Philippines since May 15, 1979. Opposer has been commercially using the trademark "WINCHESTER" much ahead of applicant's filing date of its application;

2. Opposer is the owner of the trademark "WINCHESTER" which was registered with the Bureau of Patents, Trademarks and Technology Transfer under Registration Certificate No. 38782 for coin purses, key holders, key cases, men's and ladies wallets and clutch bags and other goods under Class 18;

3. Opposer is the first user of the trademark "WINCHESTER" on Goods included under the above described registration which have been sold and marketed in the Philippines since May 15, 1979;

4. By virtue Opposer's prior and continued use of "WINCHESTER" in the Philippines, said trademark has become popular and has established valuable goodwill for Opposer among consumers who have identified Opposer as the source of the goods bearing said trademark;

5. The registration and use of an identical trademark by the applicant will tend to deceive and/or confuse purchasers into believing that applicant's products emanate from or are under the sponsorship of opposer. Applicant obviously intends to trade, and is trading on, Opposer's goodwill;

6. The registration and use of an identical trademark by applicant will diminish the distinctiveness and dilute the goodwill of opposer's trademark and prevent the natural expansion of opposer's trade.

Respondent-Applicant filed its Answer on November 23, 1990 where the affirmative and special defenses were set forth, among which is that Opposer is not the owner of the mark "WINCHESTER" hence, its registration is invalid.

The issue having been joined, the case was set for pre-trial conference. For failure of the parties to reach an amicable settlement, the case proceeding to trial on the merits.

To be noted is the fact that the hearing of this particular case was held jointly with the case under IPC No. 3595 which involved the same mark "WINCHESTER", the same subject matter and the parties are likewise the same. IPC No. 3595 is an opposition to trademark "WINCHESTER" bearing Application Serial No. 67679 filed on April 18, 1989 by Respondent, Olin Corporation. This case has been decided in favor of Opposer, Quality House, Inc. Under Decision No. 2006-034 dated May 24, 2006.

On June 20, 1991, Opposer formally offered its evidence consisting of Exhibit "A" to "QQQ" inclusive of sub-markings. This Office issued an Order dated July 15, 1991, admitting the same.

For failure of Respondent-Applicant to appear on the scheduled hearing on October 18, 2004, it was declared to have waived its right to present further evidence. Subsequently, this case was submitted for decision.

**THE MAIN ISSUE TO BE RESOLVED IN THIS CASE IS WHETHER THE RESPONDENT-APPLICANT'S APPLICATION FOR REGISTRATION OF THE MARK "WINCHESTER" SHOULD BE DENIED.**

It should be noted that the trademark application being opposed was filed on April 18, 1989 or during the affectivity of the old Trademark Law (R.A 166, as amended). Thus, the applicable provision of law in resolving the issue involved is Section 4(d) of R.A. No. 166.

Under Section 4(d) of Republic Act No. 166, a trademark shall not be registered if it consists of or comprises a mark which so resembles a mark registered in the Philippines or a mark or trade name previously used in the Philippines by another and not abandoned.

Such limited right over a trademark is likewise reflected in Republic Act 8293. Under Sec. 123 (d), Registration of a trademark which is identical with another already registered mark or a mark with an earlier filing date or priority date shall be denied, where to allow such registration would likely result in confusion, mistake or deception to the consumers. Conversely, where no confusion is likely to arise, registration of a similar or even identical mark may be allowed.

The right to register trademark is based on ownership. When the applicant is not the owner of the trademark being applied for, he has no right to apply for the registration of the same. Under the Trademark Law, only the owner of the trademark, trade name, or services mark used to distinguish his goods, business, or service from the goods, business or service of others is entitled to register the same. (UNNO COMMERCIAL ENTERPRISES, INCORPORATION vs. GENERAL MILLING CORPORATION [G.R. No L-28554, February 28, 1983])

In the case at bar, Respondent-Applicant claimed that it is owner of one of the world's famous trademark "WINCHESTER" for firearm and ammunition, dating back to 1866 when Oliver F. Winchester founded the Winchester Repeating Arm Company. That it had prior registration for the "WINCHESTER" trademark dating back to Registration No. 4688 issued on November 19, 1924. That as a result of its continuous and extensive use of the mark "WINCHESTER" it has developed and now as distinctive and secondary meaning of the public and has come to mean and does not mean, indicate and stand for its products to the trade and the general public throughout the world and in the Philippines. However, no evidence was presented to support all its claims.

On the other hand, Opposer was able to show evidence that the trademark "WINCHESTER" was owned and registered in the name of herein Opposer, Quality House, Inc. It had presented evidence clearly and convincingly establishing this ownership of the trademark (Exhibit "PPPPP" to "QQQQQ").

Moreover, Opposer has sufficiently shown that it has been in the business of selling its products bearing the trademark "WINCHESTER" since 1971 as evidenced by appropriate sales invoices in various stores and retailers (Exhibit "M" to "XXXX"). Likewise, Opposer has been advertising its products bearing the trademark "WINCHESTER" as early as 1983. That if ever the word "WINCHESTER" has been known to exist in this country; it is because of Quality House, Inc.'s trade/commercials activities.

Another factor why Respondent's application should be denied is the confusing similarity between its trademark "WINCHESTER" and Opposer's trademark "WINCHESTER" which could confuse the purchasing public to the prejudice of Opposer. As correctly stated by the Opposer, the mark applied for by Respondent-Applicant not only resembles its mark, which it previously registered but the same or is identical to its trademark.

Moreover, their goods are identical, similar, competing, or related. When goods are so related that the public may be, or is actually, deceived and misled that they come from the same maker or manufacturer, trademark infringement occurs. (MIGHTY CORPORATION and LA CAMPANA FABRICA DE TABACO, INC., petitioners vs. E. & J. GALLO WINERY and THE ANDRESONS GROUP, INC., respondents, G. R. No. 154342, July 14, 2004)

In the case of ESSO STANDARD EASTERN, INC., vs. THE HONORABLE COURT OF APPEALS and UNITED CIGARETTE CORPORATION [G. R. No. L- 29971, August 31, 1982], the Supreme Court ruled:

"Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential

characteristics with reference to their form, composition, texture or quality. They may also be related because they served the same purpose or are sold in grocery stores. Thus, biscuits were held related to milk because they are both food products. Soap and perfume, lipstick and nail polish are similarly related because they are common household items nowadays. The trademark "Ang Tibay" for shoes and slippers was disallowed to be used for shirts and pants because they belong to the same general class of goods, Soap and pomade, although non-competitive, were held to be similar or to belong to the same class, since both are toilet articles."

Applying these legal precepts to the instant case, Respondent-Applicant's use of the trademark "WINCHESTER" is likely to cause confusion or mistake or to deceive the consumers of either the goods of the Opposer and that of the Respondent-Applicant or both as to the identity of the goods, their source or origin, or identity of the business of Opposer and Respondent-Applicant. Their respective trademarks are being used on almost identical goods since they belong to the same class of goods, Class 25.

Another factor that shows that the goods involved are related is that they flow through the same channels of trade. Both products are being sold in markets, supermarkets, department stores, and other retailing stores.

WHEREFORE, in view of the foregoing, the Notice of Opposition filed by the Opposer is, as it is hereby SUSTAINED. Consequently, Application Serial No.67214 filed on March 2, 1989 for the mark "WINCHESTER" used on eyeglasses, sunglasses, watches and clothing filed by Olin Corporation is hereby REJECTED.

Let the filewrapper of "WINCHESTER" subject matter of this case together with this Decision be forwarded to the Bureau of Trademark (BOT) for appropriate action.

SO ORDERED.

Makati City, 6 June 2007.

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