

SHELL INTERNATIONAL PETROLEUM COMPANY LIMITED, <i>Opposer,</i>	}	Inter Partes Case No. 14-2005-00037 Opposition to:
	}	
	}	Appln. Serial No.: 4-1990-073500
	}	Date Filed : 03 October 1990
-versus-	}	Trademark : "RED SHELL DEVICE"
	}	
HI CHIOK ANG, <i>Respondent-Applicant,</i>	}	Decision No. 2006 – 70
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DECISION

This pertains to the opposition for the registration of the mark "RED SHELL DEVICE" bearing Serial No. 4-1990-073500 filed on October 3, 1990 for garments, t-shirts, sando and polo shirts under class 25 of the International Classification of goods which application was published for opposition on the e-gazette released January 10, 2005.

The Respondent-Applicant is HI CHIOK ANG with address at 117 C. Cardeno St., Caloocan City.

The Opposer on the other hand is SHELL INTERNATIONAL PETROLEUM COMPANY LIMITED, a foreign corporation with address at Shell Centre, London SE1 7NA.

The grounds for opposition are as follows:

- "1. The mark RED SHELL DEVICE is confusingly similar to Opposer's SHELL DEVICE which is registered in the same Class 25 in which Respondent-Applicant applies to have his mark registered.
- "2. Opposer's mark is an internationally famous entitled to protection under the Paris Convention and the Intellectual Property Code.
- "3. The registration of a similar shell device will render Opposer's mark less distinctive, thereby causing damage to Opposer.
- "4. Opposer has the priority of adoption and use of a shell device.

To support its opposition, Opposer relied upon the following facts:

- "1. The Opposer is the owner and prior adoption and use of the mark SHELL DEVICE which it uses in its fuel retailing station worldwide, including the Philippines.
- "2. Apart from Opposer's use of the mark in its fuel retailing stations, Opposer also uses the SHELL device in connection with various other activities, products and promotional items such as umbrellas, t-shirts-jackets, key chains, stationeries and publications and various accessories. Opposer furthermore uses the mark on the jerseys of its locally well-known basketball team which plays in the Philippine Basketball Association, the professional basketball league of the Philippines.
- "3. Opposer has registered the SHELL DEVICE in Class 25 as well as in other relevant classes in which Opposer uses the SHELL

DEVICE. Attached hereto as Annex "A" is a copy of Opposer's Registration No. 44046 issued in April 16, 1989 showing registration of Opposer's SHELL DEVICE in Classes 25, 21, 13, 15, 31, 34, 28, 18, 11, 7, 6 and 12. Attached as Annex "B" is a copy of Opposer's Registration No. 41789 issued on November 14, 1988 showing registration of Opposer's SHELL DEVICE in Class 9.

- "4. Opposer has also registered the SHELL DEVICE in many countries all over the world. Certified copies of these registrations will be presented by Opposer and testified on during the proceedings.
- "5. By virtue of Opposer's extensive use of the SHELL DEVICE in the Philippines as well as all over the world, the SHELL DEVICE has become associated with Opposer and has come to symbolize the quality of Opposer's products and services. The SHELL DEVICE, accordingly, carries with it a goodwill identified by the public with the Opposer.
- "6. Respondent-Applicant's adoption of a similar SHELL DEVICE in the same Class 25 and for the same goods on which Opposer also uses its SHELL DEVICE will cause damage to Opposer by rendering Opposer's mark less distinctive.
- "7. Confusion is likely to result because public will tend to perceive Respondent-Applicant's SHELL DEVICE to be a variant of Opposer's SHELL DEVICE or somewhat associated with Opposer. In this regard, it is to be noted that Respondent-Applicant presents in its SHELL DEVICE a shell that is of the same variety of shell as Respondent-Applicant's shell device and presents the same shell in the same configuration and the same position shown in Opposer's SHELL DEVICE. What is immediately called to mind by this manner of presentation of Respondent-Applicant's SHELL DEVICE is Opposer's SHELL DEVICE.

On June 20, 2005, Respondent-Applicant filed a Motion to Admit Answer which was granted under Order No. 2005-618 dated August 24, 2005.

Respondent-Applicant in his answer denied all the material allegations of the opposition and further alleged the following as his special and affirmative defenses:

- "1. Under the Section 134 of the Intellectual Property Code of the Philippines, verified opposition to a trademark application must be filed within thirty (30) days after publication of the application.
- "2. As the record of the Honorable Office would show, the application for RED SHELL MARK was published for opposition in the e-gazette on January 10, 2005. The oppositor's verified opposition, however, was filed only 09 May 2005.
- "3. Thus, the oppositor's verified opposition should be dismissed outright for having been filed out of time."

Subsequently, on October 10, 2005 a Notice to comply with Office Order No. 79, dated 05 October 2005 was issued by this Office and sent to both parties.

Opposer filed a manifestation dated June 1, 2006 which states that it is relying on the opposition and the supporting documents submitted thereto, which documents are duly sworn and verified by the Opposer as its evidence in this case pursuant to the new rules. On the other hand, Respondent-Applicant failed to comply with Office Order no. 79 or submit his evidences. As such, he was considered to have waived his right to present evidence.

The only issue to be resolved in this particular case is:

WHETHER OR NOT THE MARK "RED SHELL DEVICE" IS
CONFUSINGLY SIMILAR TO OPPOSER'S MARK "SHELL DEVICE"

The applicable provisions of law is Section 123.1 (d) of Republic Act no. 8293 which provides:

"Sec. 123.1. A mark can be registered if it:

(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.

A cursory review of the records indicate that both trademarks or the competing marks consist of the "SHELL DEVICE" and the only difference is the presence of the word "RED" in the Respondent-Applicant's mark.

To be noted is the fact that Opposer's trademark "SHELL (Device)" is registered with the Bureau of Patents, Trademarks and Technology Transfer (BPTTT) on April 19, 1989 bearing Registration No. 44046 covering the goods belonging to Classes 21, 25, 13, 15, 31, 34, 28, 18, 11, 7, 6 and 12 of the International Classification of goods. (Annex "A" of the opposition. The specific goods under Class 25 is Article of outer clothing)

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 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)

Respondent-Applicant's mark "RED SHELL DEVICE" is being used on garments, t-shirts, sando, polo shirt under Class 25 of the International Classification of goods. Likewise, the goods covered by the Opposer's mark "SHELL DEVICE" is article of outer clothing under the same Class 25.

After carefully deliberating n the marks involved, this Bureau finds that the Respondent-Applicant's mark "RED SHELL DEVICE" is confusingly similar to Opposer's mark "SHELL DEVICE" registered with the Bureau of Patents, Trademarks and Technology Transfer as early as April 19, 1989.

Moreover, the two marks are used on identical products under Class 25 of the International Classification of goods, which would cause confusion, mistake or deception as to the source or origin of the goods in the mind of the purchasing public.

In *American Wire and Cable CO., vs. Director of Patents*, February 16, 1997, 31 SCRA 544, the Supreme Court held that the determinative factor in a contest involving the registration of trademark is not 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 justify the denial of an application for registration, the law does not require that the competing trademarks be so identical as to produce actual error or mistake; it would be sufficient that the similarity be such that there is a possibility or likelihood that the purchasers mistake the older for the newer brand. Thus, the Court found trademark "DYNAFLEX" for electric wires to be confusingly similar to "DURAFLEX", also for electric wires.

In connection with the use of 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 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., vs. Milton Ray Co.*, 143 F. 2d, 985, 32 C.C.P.A. Patents 1214)

"Why of the million of terms and combination 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 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 choose from, the defendant (*Manila Candy Co.*) elected two 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? 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 the product of defendant's factory. Why did defendant select two roosters as its trademark (*Clarke vs. Manila Candy Co.*, 36 Phil. 100)

It may also be noted that Respondent-Applicant exerted no effort to defend his rights if any, over the trademark. In fact, he failed to submit his evidence in compliance with Office Order No. 79, hence the same was considered waived.

WHEREFORE, premises considered herein Notice of Opposition is, as it is hereby SUSTAINED. Accordingly, Application bearing Serial No. 4-1990-073500 filed on October 03, 1990 for the trademark "RED SHELL DEVICE" for garments, t-shirts, sando, polo shirt under Class 25 by HI CHIOK ANG is hereby REJECTED.

Let the filewrapper of the trademark "RED SHELL DEVICE" subject matter in this case be forwarded to the Bureau of Trademarks for appropriate action in accordance with this DECISION.

SO ORDERED.

Makati City, 31 July 2006.

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