

TATLER PUBLISHING CO. LTD.,	}	Inter Partes Case No. 3405
Petitioner,	}	Petition for Cancellation of:
	}	
-versus-	}	Regn. No. : 38883
	}	Issued : May 9, 1988
	}	Trademark : "MANILA
	}	TATLER & DEVICE"
	}	Class : 16
ILLUSTRATED MAGAZINE	}	Goods : Books, printed
PUBLISHING CO. LTD.,	}	matter, magazines
Respondent-Registrant.	}	and periodicals
x-----x	}	Decision No. 2003-16

## D E C I S I O N

Certificate of Registration No. 38883 for the trademark MANILA TATLER & DEVICE was issued on May 9, 1988 in favor of Illustrated Magazine Publishing Co. Ltd., a corporation organized and existing under the laws of Hong Kong, with office address at Hong Kong Plaza, 186-191, Connaught Road West, Hong Kong.

On June 26, 1989 petitioner Tatler Publishing Company Ltd., organized and existing under laws of United Kingdom with office address at Vogue House, Hanover Square, London WL, filed a verified petition for the cancellation of the above-mentioned mark.

Petitioner relied on the following grounds in its quest for the cancellation of subject matter, to wit:

- "1. The registration was obtained fraudulently by respondent.
- "2. Respondent is not the true lawful owner and first user of the mark and the registration was accordingly secured contrary to the provisions of Sections 4 and 17 of Republic Act No. 166, as amended.
- "3. Respondent's goods and the use of the mark thereon will likely mislead the buying public into believing that the goods of respondent and produced by, originate from or are under the sponsorship of petitioner.
- "4. The registration of the trademark MANILA TATLER AND DEVICE in the name of, and its use in commerce by, respondent amount to an infringement of petitioner's trademark which is entitled to protection under Section 37 of the Trademark Law even "without the obligation of filing or registration whether of not (it) form(s) part of the marks."
- "5. The cancellation is authorized by the other provisions of the Act."

Petitioner relied on the following facts in support of its petition:

- "1. Petitioner is the owner and first user of the trademark "TATLER" used on books, magazines, newspapers and other printed matters and related articles, having first been used in England in 1709. The TATLER magazine has been continuously published with a worldwide circulation since 1901 and had been known throughout the world as a magazine of English origin.
- "2. Respondent' knowledge of the existence of the "TATLER" publication is reflected in the duplication of Petitioner's trademark

“TATLER” and its logo as appearing in Respondent’s publication in the Official Gazette.

“3. Respondent’s adoption and use of Petitioner’s trademark/tradename and logo indicates an intent to capitalize on the goodwill and popularity of Petitioner’s publication for respondent’s own benefit;

“4. Respondent’s trademark includes the word “TATLER” which is clearly and evidently similar in sounds, meaning and appearance to the trademark/tradename of Petitioner, and the logo is substantially similar in appearance to the logo/trademark of Petitioner and will definitely deceive the public into believing that the trademarks and logo are associated with those of the Petitioner.”

In its Answer, Respondent-Registrant denied all the material allegations in the petition and by way of its Special and Affirmative Defenses interposed the following:

“8. Respondent’s trademark was registered in the usual course with the Bureau of Patents, Trademarks and Technology Transfer after compliance with all the requirements of law and after the Director of Patents was fully satisfied that Respondent had complied with such statutory requirements, by reason of which the Director issued the corresponding Certificates of Registration No. 38883 in favor of Respondent;

“9. Petitioner is not the owner of the word “Tatler” nor of the device and accordingly, it has no right nor legal personality to file the instant petition for cancellation of Respondent’s trademark;

“10. Assuming arguendo, that petitioner has adopted and used the word “Tatler”, its adoption or use is illegal and cannot vest in it any trademark right;

“11. In any event, Respondent has long used the trademark in question as well as word “Tatler” and device and Respondent’s long prior use in commerce of the trademark in question including the word “Tatler” and the device, is so extensive in some parts of the word including the Philippines, that it entitles Respondent to exclusively use said trademark or device, to the exclusion of petitioner and others;

“12. Respondent’s long prior and extensive use in commerce of the trademark, including the word “Tatler” and device in a number of countries, including the Philippines, is shown among others, by subscriptions, advertisements, etc., to such an extent that said trademark, including the word “Tatler” and device, has acquired considerable goodwill and distinctiveness in favor of respondent as to further entitle Respondent to exclude any person, including petitioner, from using the trademark, or the word “Tatler”, and device;

“13. Assuming arguendo, that petitioner has adopted the word “Tatler”, it is guilty of laches and/or estoppel so as to preclude petitioner from prosecuting its petition for cancellation;

“14. Assuming, further, that petitioner has used the word “Tatler”, petitioner has no right to prevent Respondent from using the same word on publications or printed matter; nor has any right to prevent Respondent

from using the device itself, as petitioner has not used it; and in any event petitioner's trademark, assuming it has a right thereto, and the trademark of Respondent, which is a composite mark, are not confusingly similar;

"15. Petitioner's petition for the cancellation of trademark has no cause of action."

The parties respectively submitted their Pre-Trial Briefs on December 7, 1990 interposing the following issues:

1. Who as between the parties has the prior right to register and/or adopt and use the "Tatler and Device" trademark in the Philippines;
2. Who as between the parties is the lawful owner of the "Tatler and Device" trademark;
3. Assuming that it has adopted "Tatler" and/or the device as a trademark, whether petitioner has acquired goodwill from such use;
4. Assuming that it has adopted "Tatler" and/or the device as a trademark, whether petitioner is guilty or estoppel by laches in prosecuting this cancellation proceeding.

There being no amicable settlement reached between the parties despite effort, trial on merits ensued. Petitioner formally offered its evidence on June 18, 1992 consisting of Exhibits "A" to "JJ" inclusive of sub-markings. Said Exhibits were admitted as evidence for the petitioner over the objection of the Respondent-Registrant.

The necessary Letters Commission was issued on August 30, 1994 upon formal request by Respondent-Registrant for the taking of deposition of its foreign witness in Hong Kong in the person of Dr. Mahabir Mohindar. Thereafter Respondent-Registrant never filed any pleading, motion or manifestation as to its interest in pursuing the case despite notice thereof. This prompted this Office, upon motion of petitioner, to consider the case at bar submitted for decision on the basis of the evidence on record.

The issues posited by the contending parties can be reformulated as follows:

1. Whether or not respondent-registrant's mark MANILA TATLER & DEVICE is confusingly similar to petitioner's mark TATLER;
2. Who has the better right over the mark TATLER under the governing law; and
3. Whether or not the trademark TATLER of Petitioner is a well-known mark and enjoys protection under the Paris Convention.

After perusal of the documents on record it is shown that in the mark MANILA TATLER & DEVICE of respondent-registrant and TATLER of petitioner, the word TATLER appears to be the dominant feature. Respondent-registrant's mark is a composite one consisting of four words while that of petitioner stands alone. Despite of said variation in letter composition, both marks contain the dominant feature TATLER which indubitably leads to confusion. "Where the goods are advertised over the radio, similarity of sound is sufficient grounds for holding that two descriptive properties are confusingly similar. ("Marvex Commercial Company, Inc. vs. Perta Hawpia & Company, 18 SCRA 1178). The Supreme Court is applying the dominancy test categorically ruled that "if there is similarity with the essential or dominant feature of the trademark, despite some differences or variations in details, there is infringement". (Co Tiong Sa vs. The Director of Patents, 95 Phil. 1; Sapolin Corp. vs. Balmaceda, 67 Phil. 705; Forbes Nurma & Co. vs. Ang San To, 40 Phil. 272).

Moreover, the goods covered by Respondent-registrant's mark MANILA TATLER & DEVICE and that of Petitioner's mark TATLER apply to related or similar goods falling under international class 16 as shown in filewrapper and the foreign registrations such as; Australian Certificate of Registration No. A415521 issued on September 21, 1984, New Zealand Certificate of Registration No. B165252 issued on May 2, 1986, U.S. trademark Registration No. 1, 596,339 issued on May 15, 1990 and United Kingdom Certificate of Registration No. 1180723 dated August 25, 1992. All of these registrations are under class 16, for newspaper, periodicals and related articles (Exhibits "AA" to "DD" inclusive of sub-markings). "Goods are so 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, textures or quality. They may also be related because they serve the same purpose or are sold or distributed in the same channel of trade" (ESSO Standard Eastern vs. Court of Appeals, 166 SCRA 336). Unwary purchaser cannot help but conclude that Respondent-registrant's mark and that of Petitioner are one and the same or one is the subsidiary of another primarily because of the presence of the dominant word TATLER on both marks. The margin of error by Respondent-registrant's mark is similar to that of Petitioner. This is violative of Section 4 (d) of Republic Act No. 166, as amended, which provides:

*Sec. 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, tradename or service mark used to distinguish his goods, business or services from the goods, business or services of the other shall have the right to register the same in 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 deceive purchasers; x x x"

In this connection, the Supreme Court, in the case of Armco Steel Corp. vs. Securities and Exchange Commission, 156 SCRA 822 ruled that:

"ARMCO STEEL-PHILIPPINES has not only an identical name but also a similar line of business as that of ARMCO STEEL-OHIO. People who are buying and using products bearing the trademark "ARMCO" might be led to believe that such products are manufactured by the respondent, when in fact, they might actually be produced by petitioner. Thus, the goodwill that should grow and inure to the benefit of the petitioners could be impaired and prejudiced by the continued use of the same term by the respondent."

To constitute an infringement of an existing trademark and warrant a denial of an application for registration, the law does not require that the competing trademarks must be identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it (Acoje Mining vs. Director of Patents, 38 SCRA 480).

In the case of Continental Connector Corp. vs. Continental Specialties Corp., 207 SCPQ 60, the repeated rule was applied to wit:

"that confusion created by the same word as the primary element in a trademark is not countered by the addition of another term. Examples "Miss USA

and Miss USA World” (Miss Universe, Inc. vs. Patrecelli, 1616 USPQ 129); “GUCCIE” and “GUCCI-GOO” (Gucci Shops vs. R.H. Macy and Co. 446 F. Supp. 838); “Comfort” and “Foot Comfort” (Scholl, Inc. vs. Tops E.H.R. Corp. 185 USPQ 754); “ACE” vs. “TEN-ACE” (Becton, Dickson and Co. vs. Wiguam Mills, Inc. 1999 USPQ 607).”

Thus, in light of the foregoing, the penumbra of doubt was replaced with the core of certainly that confusion similarity indeed exists between the two marks of the contending parties.

“Likewise, the Supreme Court had occasion to rule in relation to confusingly similar or identical mark 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 English language or paucity of signs, symbols, numerals etc., as to justify one who really wishes to distinguish his products from those of all other entering the twilight zone of a field already appropriated by another, (Wecco Products Co., 143, F. 2<sup>nd</sup> 985, 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 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. Directors of Patents, 31 SCRA 54).”

On the second issue of who has the better right between the two contending parties as to the use of the mark TATLER under the governing law, this Office finds, as the evidence showed, in favor of the Petitioner.

From the cursory examination of the documents on hand, it is shown that the mark TATLER was used as early as April 12, 1709, (Exhs. “EE” and “FF” and its sub-markings) and was continuously published thereafter (Exhs. “GG” inclusive of sub-markings). The chain of ownership of the mark TATLER as shown in Exhibits “EE” and “HH” inclusive of sub-markings are as follows:

1901	The Sphere & Tatler Limited
12.1.27	Illustrated News Papers Limited
1937	Illustrated News Papers Limited
13.11.67	Illustrated News Papers Ltd. to Illustrated County Magazine Group Ltd
6.9.77	Tatler and Bystander Ltd. to Southern Nominees Ltd.
19.8.77	Southern Nominees Ltd. changed its name to “The Tatler & Bystander Magazine And Publishing Company Ltd”
13.11.81	The Tatler & Magazine And Publishing Company Ltd. to Rayrig Limited

Ownership of TATLER was further shown by its publication (Exhibits “B”, “C”, “D”, and “E”) by Illustrated Newspaper Ltd, Illustrated County Magazine Group Ltd. and Tatler & Bystander Magazine And Publishing Company Ltd respectively. Petitioner showed its publication of the article bearing the mark TATLER on the September 1987 and October 1989 issue (Exhibits “F” and “G”).

Petitioner's registration of the mark TATLER was issued on September 21, 1984 bearing the Australian Certificate of Registration No. A415521, New Zealand Certificate of Registration No. B165252 issued on May 2, 1986, U.S. Trademark Registration No. 1,596,339 issued on May 15, 1990 and United Kingdom Certificate of Registration No. 1180723 dated August 25, 1992. All of these registrations are under Class 16 for newspaper, periodicals and related articles (Exhibits AA to DD inclusive of sub-markings. Exhibits "I" to "N" show the subscription cards of the TATLER article under the name of the Conde Nast Publication Ltd.

Although the Certificate of Registration is a prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with goods, business, or services specified in the certificate, as provided in Section 20 of the former Trademark Law, R.A. 166 as amended, the same can be overturned by overwhelming evidence. The word *prima facie* implies that the certificate of registration is still subject to question and can still be overturned.

The questioned Certificate of Registration No. 38883 was issued on May 9, 1988 for Class 16, has a later registration date than that of petitioner. This shows that the mark MANILA TATLER & DEVICE which Respondent-registrant was able to register in its favor originated elsewhere.

Moreover, under Article 8 of the Paris Convention and Section 37 of the old Trademark Law, it is provided that tradenames are protected even without the benefit of registration. The Paris Convention requires that a tradename shall be protected in all countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.

The Court even rules to the extent that: Article of the Convention of the Union of Paris for the Protection of Industrial Property to which the Philippines is a party provides that "a trade name [corporate name] shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of the trademark." This law is reiterated in Section 37 of Republic Act No. 166, as amended (Converse Rubber Corporation vs. Universal Rubber Products, Inc., 156 SCRA 154). Section 37 of the former Trademark Law provides that:

Rights of foreign registrant. – Persons who are nationals of, domiciled in, or have a bonafide or effective business or commercial establishment in any foreign country, which is a party to any international convention or treaty relating to marks or trade-name or the repression of unfair competition to which the Philippines may be a party, shall be entitled to the benefits and subject to the provisions of this Act to the extent and under the conditions essential to give effect to any such conventions and treaties so long as the Philippines shall continue to be a party thereto, xxx.

In the case at bar, Petitioner's mark TATLER is likewise its tradename. To support its claim, Petitioner presented the affidavit and deposition of Michael John Moore Garvin (Exhs. "A" and "EE" inclusive of its sub-markings) as his direct testimony.

Comparing the dates when Petitioner registered its mark on September 21, 1984 with that of Respondent-registrant's date of registration, which is on May 25, 1988 as indicated in its trademark Certificate of Registration No. 38883, it is clearly shown that Petitioner's date of registration is earlier, plus the fact that it was used as early as 1709, an indication that its trademark has been in existence very much earlier than that of respondent-registrant's and has been circulated in many countries of the world.

Considering that the mark "TATLER" was earlier adopted, used and registered by the Petitioner not only as its trademark but also as its tradename or business name, hence, Petitioner has superior right thereto and therefore, entitled to protection against any subsequent user. Such superior right precludes any third party from appropriating the same.

On the third issue that Petitioner's mark TATLER is internationally well known and thus enjoys the protection of the Paris Convention, this Office finds in the affirmative.

In support of its quest for the cancellation of registration of Respondent-registrant's mark MANILA TATLER & DEVICE, Petitioner invites the attention of this Office to the fact that its mark is known throughout the world or internationally known, thus enjoys the protection of the Paris Convention. In so far as adherence to the Paris Convention is concerned, the Philippines being a signatory thereof in pursuant to *pacta sunt servanda* had been acknowledged in the case of La Chemise Lacoste vs. Hernandez, 129 SCRA, 373.

Articles 6 bis of the Paris Convention provides that:

“(1) The countries of the Union undertake, either administratively 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 constitute a reproduction, liable to create confusion, of a mark considered by the competent authority of the country of registration or used to be well known in the country as being already mark of a person entitled to the benefits of the present Convention and used for identical or similar goods. These provision shall also apply when the essential part of the mark constitute a reproduction or any such well-known mark or an imitation liable to create confusion therewith.”

Then Minister Roberto V. Ongpin issued a Memorandum dated October 25, 1983 laying down the criteria for a mark to be classified as internationally well known, which hereunder is quoted as follows:

xxx

“(1). Whether the trademark under consideration is well-known in the Philippines or a mark already belonging to a person entitled to the benefits of the Convention, this would be established pursuant to Philippine Patent Office procedures in Inter Partes and ex-parte cases, according to any of the following criteria or any combination thereof.

“(a) a declaration by the Ministry of Trade and Industry that the mark being considered is already well-known in the Philippines such that permission for its use by other than its original owner will constitute a reproduction, imitation, translation or other infringement;

“(b) that the mark is used in commerce internationally, supported by the proof that the goods bearing the trademark are sold on an international scale, advertisements, the establishment of factories, sales offices, distributorship, and the like in different countries, including volume and other international trade and commerce;

“(c) that the trademark is duly registered in the industrials property office(s) of another country or countries, taking into consideration the dates of such registration;

“(d) that the mark has long been established and obtained goodwill and general international consumer recognition under the provisions of the aforestated Paris Convention.

xxx

“3. The Philippine Patent Office shall refuse all application for, or cancel the registration of trademarks which constitute a reproduction, translation or imitation of a trademark owned by a person, natural or corporate, who is a citizen of a country signatory to the Paris Convention of Industrial property.”

(Underscoring supplied)

In support of its claim, Petitioner submitted Exhibits “AA” to “DD” inclusive of sub-makings, which show registration in various countries of its mark. The foregoing exhibits show that the mark was registered on goods under Class 16, similar to that of Respondent-registrant (see filewrapper). The countries to which Petitioner registered its mark includes Australia, New Zealand, United Kingdom and United States of America. Moreover, Exhibits “B” to “Z” and “FF” to “GG” showed that mark TATLER of petitioner was continuously used and circulated in commerce worldwide.

Respondent-applicant for its part failed to present any evidence in its favor except the records of its registration.

The set of documents presented by petitioner clearly indicate that Petitioner’s mark TATLER meets the criteria of being internationally well known as laid down in the above-mentioned Memorandum in pursuant to the Paris Convention.

WHEREFORE, premises considered, the instant Petition for Cancellation is hereby GRANTED. Consequently, Certificate of Registration No. 38883 issued on May 9, 1988 in favor of herein Respondent, for the trademark MANILA TATLER & DEVICE is hereby ordered CANCELLED.

Let the filewrapper of the mark MANILA TATLER & DEVICE subject of this petition be forwarded to the Administrative, Financial Human Resource Development Service Bureau (AFHRDSB) for appropriate action in accordance with this Decision with a copy thereof to be furnished the Bureau of Trademarks (BOT) for information and update of its records.

SO ORDERED.

Makati City, March 11, 2003.

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