TENNECO PACKAGING SPECIALTY & CONSUMER PRODUCTS, INC., Opposer,	}	IPC No. 14-1999-00022 Opposition to: Serial No. 95705 Date Issued: October 5, 1994
-versus-	}	
	}	Trademark: “HEFTY”
CARTIGNY PTY. LTD. Respondent-Applicant.	}	
x----------x		Decision No. 2001-18

DECISION

Before this Office is the Opposition filed on July 23, 1999 against the registration of the mark “HEFTY” bearing Serial No. 95705for the goods “plastic film for wrapping” falling under class 16 of the International Classification of goods and which trademark applications was published on page 49, Volume I, No. 6 of the Intellectual Property Office Official Gazette, which was officially released for circulation on March 29, 1999.

The herein Opposer is “TENNECO PAKCAGING SPECIALTY & Company, a corporation duly organized and existing under the laws of the State of Delaware, U.S.A. , with offices at 1900 West Field Court, Lake Forest, Illinois, 60045 U.S.A.

On the other hand, the Respondent-Applicant in this Opposition proceeding is “CARTIGNY PTY. LIMITED”, a company incorporated under the laws of the State of New South Wales, and having an office at Gibbon Road, Winston Hills, New South Wales, 2153, Commonwealth of Australia.

One important point to be considered in the instant proceedings is the fact that the trademark “HEFTY” subject of the opposition was filed on October 5, 1994 when the law governing the Trademark Law at that time was R.A. No. 166, as amended.

However, when this particular Opposition was filed on July 23, 1999, the governing law was R.A. No. 8293 otherwise known as the Intellectual Property Code of the Philippines, which took effect on January 1, 1998.

Considering that Opposer instituted the instant opposition on the grounds provided under R.A. No. 8293, the applicable provisions are Secs. 134 and 123.1 paragraph (d) which provide that:

> “SEC 134. Opposition – Any person who believes that he would be damaged by the registration of a mark may upon payment of the required fee and within thirty (30) days after the publication referred to in Subsection 133.2 file with the office an opposition to the application. xxx”
>
> "SEC. 123 (d) Registrability-123.1. A mark cannot be registered if it:
>
> "xxx
>
> “(d) Is identical with a registered mark with an earlier filing or priority date in respect of:
>
> "(I) The same goods or services or

"(II) Closely related goods or services
"(III) If it nearly resembles such mark as to be likely to deceive or cause confusion."

The grounds for opposition are as follows:

"1. The registration of the trademark "HEFTY" in the name of the Respondent-Applicant will violate the rights and interests of the Opposer over its trademark "HEFTY" and will therefore cause great and irreparable injury and damage to herein Opposer, pursuant to Section 134 of the Intellectual Property Code, R.A. No. 8293.

"2. The registration of the trademark "HEFTY" in the name of the Respondent-Applicant will mislead the purchasing public and make it easy and convenient for dealers, if not Respondent-Applicant to pass of its goods as goods of the Opposer, to the injury of the Opposer and the purchasing public.

"3. The trademark "HEFTY" applied for by Respondent-Applicant is so confusingly similar, if not identical, so that the registration of the mark "HEFTY" of the Respondent-Applicant will violate and run counter to Section 123.1 of the Intellectual Property Coder, Republic Act No. 8293 and Article 6(bis) of the Paris Convention for the protection of Industrial Property."

Opposer relied on the following facts to support its opposition:

"(a) The Opposer and its predecessor-in-interest is and has always been the owner of the trademark "HEFTY" used in its business operation and on various goods long before the date of the alleged date of first use of the mark "HEFTY" by Respondent-Applicant.

"(b) The Opposer and its predecessor-in-interest has for many years used the trademark "HEFTY" in its business operations and on its goods not only in the United States of America, its home country, but in many other countries of the world, including the Philippines, and the registration of the trademark "HEFTY" in the name of the Respondent-Applicant will greatly damage and prejudice Opposer in the use of its trademark "HEFTY" in the Philippines.

"(c) The trademark "HEFTY", subject of the application of Respondent-Applicant is used in goods similar and/or closely related to the goods on which the Opposer uses the trademark "HEFTY" so much so that the public will be confused and may assume that the goods of the Respondent-Applicant are goods of Opposer;

"(d) The Opposer has spent large amounts for advertising and popularizing its trademark "HEFTY" all over the world;

"(e) The long use of, and the large amounts spent by Opposer for popularizing its trademark "HEFTY" has generated an immense goodwill for the said trademark in the Philippines and in other countries of the world, and has acquired general international consumer recognition to as belonging to the one owner and source, i.e. the Opposer, herein, and Opposer's goods have acquired the reputation of high quality products by the purchasing public so that the trademark "HEFTY" of Opposer has become strong and

distinctive and is not, therefore, an ordinary, common and weak trademark;

"(f) Opposer's trademark "HEFTY" has been applied for registration in the Philippines, and is registered and used in many countries of the world and, is a well-known mark such that it is entitled to protection of the Intellectual Property Code, R.A. No. 8293, and Article 6 (bis) of the Paris Convention for the Protection of Industrial Property;

"(g) The trademark "HEFTY" subject of Respondent-Applicant's application is a flagrant and veritable imitation of the Opposer's trademark "HEFTY" so that its use on the goods of the Respondent-Applicant will indicate that Respondent-Applicant's goods are the same or connected with the goods manufactured and/or sold by herein Opposer as to falsely suggest a connection with the existing business of the Opposer and therefore may result in defrauding Opposer of its long-established business;

"(h) The trademark "HEFTY" subject of the application of Respondent-Applicant is so confusingly similar to the trademark "HEFTY" and when applied to or used with the goods of Respondent-Applicant will likely cause confusion or mistake or deceive purchasers as to the source or origin of the Respondent-Applicant's goods to such an extent that the goods covered by the trademark "HEFTY" will be mistaken by the unwary public of the goods manufactured and/or sold by Opposer will cause the purchasing public to believe that herein Respondent-Applicant is affiliated or connected with Opposer's business.

"(i) The goods covered by the trademark "HEFTY" of Respondent will be sold in similar stores and/or outlets as those of the Opposer's "HEFTY" and will make it even more likely for the purchasers to confuse one for the other considering the similarity of the two trademarks both in appearance and pronunciation, to the great prejudice of the Opposer;

"(j) The trademark "HEFTY" of Respondent-Applicant is so confusingly similar to the trademark of Opposer "HEFTY" such that it may have been adopted and used by Respondent-Applicant with the intention of riding on the long-established goodwill of the trademark of the Opposer."

The issue to be resolved in this case is WHO BETWEEN THE PARTIES IS THE PRIOR USER AND ADOPTER OF THE MARK "HEFTY" and therefore, entitled to its registration.

On August 20, 1999, Respondent-Applicant received the Notice to Answer sent by this Office requiring the said party to Answer the Notice of Opposition within fifteen (15) days from receipt thereof.

Upon the Motion of the Opposer through counsel Respondent-Applicant have been declared in default for not filing the required Answer notwithstanding the lapse of more than fifteen (15) days from receipt of the Notice. Opposer was thereafter allowed to present its evidence Ex-parte under ORDER No. 99-519 dated 24 September 1999.

Pursuant to the ORDER of Default, Opposer presented its evidence ex-parte consisting of Exhibits "A" to "F-12" inclusive of sub-markings.

At the outset, it should be noted that both parties in the above-entitled case are foregoing entities whose country of origin are both member of the PARIS CONVENTION, and the Philippines where the subject mark is under litigation is likewise a member of the PARIS CONVENTION FOR THE PROTECTION OF INTELLECTUAL PROPERTY RIGHTS.

Records will show that the trademark application filed by the herein Respondent-Applicant for the mark “HEFTY” bearing Serial No. 95705 on October 5, 1994 is based on HOME REGISTRATION under Section 37 of R.A. No. 166 based on the Registration No. 63689 issued in Australia on August 4, 1994. The goods covered or stated in the Certificate if “PLASTIC FILM FOR WRAPPING” in Class 16 of the international classification of goods. this is the basis of ownership claimed by the Respondent-Applicant.

On the other hand, the documentary evidence show that the Opposer has registered the mark “HEFTY” in its country of origin, the United States of America on August 13, 1968 bearing Registration No. 854,403 (Exhibit “D-2”) and in many countries of the world consisting of forty (40) registrations since October 18, 1976, (Exhibit “F-11”) for plastic bags.

Opposer has likewise shown proofs of the use of its mark (Exhibit “F” to “F-6”).

Further, Opposer has advertised its mark in many places other than in its country of origin (Exhibit”F-8”).

A comparison between Opposer’s Certificate of home registration and that of Respondent would show that Opposer’s Certificate was issued on August 13, 1968, while that of Respondent-Applicant was issued on August 4, 1994 or twenty six (26) years later, hence it cannot be denied that the Opposer is the prior adopter and user of the mark “HEFTY”.

Another vital point to be emphasized is that Opposer’s U.S. Registration and so with its foreign Certificates of Registration, are not disputed as Respondent-Applicant did not present any proof to contradict or put it in issue.

Moreover, it must be noted that the herein Respondent-Applicant was declared in DEFAULT in accordance with the Rules of Court for its failure to file the required ANSWER to the Notice of Opposition within the reglementary period, and upon motion of Opposer through Counsel, (ORDER No. 99-519 dated 24 September 1999).

In this regard, it was held by the Supreme Court in “DELBROS HOTEL CORPORATION vs. Intermediate Appellate Court, 159 SCRA, 533, 543, 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 on the complaint”

Indeed, this Office cannot but notice the lack of concern the Respondent-Applicant had shown in protecting the mark which is contrary to the norm that: “A person takes ordinary care of his concern” (Sec. 3 (d), Rule 131 of the Rules of Court.)

Finally, there is no doubt that Respondent-Applicant’s trademark HEFTY is not confusingly similar but identical to Opposer’s trademark and considering that the goods on which both trademarks are being used are similar or related, it can indeed cause confusion or deception in the mind of the purchasing public.

> “Modern trade and commerce demands that depredation on legitimate trademarks of non-nationals including those who have not shown prior registration thereof should not be countenanced. The law against such depredations is not only for the protection of the owner of the trademark but also, and more importantly, for the protection of purchasers from confusion, mistake, or deception as to the goods they are buying (LA CHEMISE LACOSTE, S.A. vs. FERNANDEZ, 129 SCRA I, and GENERAL GARMENTS CORP. vs. DIRECTOR OF PATENTS, 41 SCRA 50)”.

THE Supreme Court repeatedly ruled in connection with the use of a confusingly similar or identical mark, that:

> "Those who desire to distinguish their goods form the goods of another have a broad field from which to select a trademark for their wares and there is no 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 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 combinations of the letter and designs available, the appellee had to choose, those so closely similar to another's trademark if there is no intent to take advantage of the goodwill generated by the other mark". (AMERICAN WIRDE & CABLE CO. vs. Director of Patents, 31 SCRA 544)

WHEREFORE, premises considered, the Opposition is hereby SUSTAINED. Consequently, trademark application bearing Serial No. 95705 for the mark "HEFTY" filed on October 5, 1994 by CARTIGNY PTY. LTD., is hereby REJECTED.

Let the filewrapper of this case be forwarded to the Administrative, Financial and Human Resource Development Services 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, 29 November 2001.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs