

THE BOEING COMPANY,
Opposer,

-versus-

FIRST SOLID RUBBER INDUSTRIES
INC .,

Respondent-Applicant

x-----x

IPC NO. 3761
Opposition to:

Serial No. : 60730
Date filed : 01-13-87
Trademark : JUMBO 747

Decision No. 2003-

DECISION

This pertains to the Opposition filed on April 13, 1992 by the herein Opposer, The BOEING Company, organized and existing under the laws of the State of Delaware, United States of America, located and doing business at 7755 E. Marginal Way, Seattle, Washington 98124, USA against the registration of the trademark "JUMBO 747" filed on January 13, 1987 bearing Serial No. 60730 covering the goods motorcycle, tricycle, bicycle, tires and tubes under Class 12 of the Intermediate Classification of Goods, which application was published on page 17, Vol. IV, No. 6 of the Official Gazette November-December 1991 issue and officially released on December 31, 1991.

The herein Respondent-Applicant is The First Solid Rubber Industries, Inc., a corporation duly organized and existing under the laws of the Philippines with address at Caloocan City, Metro Manila.

The grounds for the Opposition are as follows:

- "1) The grant of registration of the application for registration in the Principal Register of the mark "JUMBO 747" in the name of Respondent-Applicant is a blatant violation of Section 4(d) of the Republic Act 166, as amended because this mark is patently confusingly similar to the Opposer's registered trademark "747" which is being continuously in use all over the world as well as in the Philippines up to the present, thus the same has never been abandoned by the Opposer.
- "2) The registration of the mark "JUMBO 747" in the name of the Respondent-Applicant will cause grave and irreparable injury and damages to the Opposer within the meaning of Section 8 of Republic Act 166, as amended."

Opposer relied on the following facts to support its Opposition:

- "1) The Opposer is the registered owner in the Philippines and worldwide, of the trademark "747" having been issued by the Bureau of Patents, Trademarks & Technology Transfer (BPTTT) Trademark Certificate of Registration No. 39285 on June 13, 1988 for the goods "aircraft and aircraft parts" under Class 12. Photocopy of this Trademark Registration is made an integral part of this Opposition and is hereto attached as Annex "A".
- "2) Opposer's goods, which is described worldwide as a "jumbo" jetliner being a wide bodied, high passenger/cargo capacity jet aircraft primarily used for commercial aviation, and parts thereof bearing the trademark "747" since more than twenty two (22) years ago has been sold to the various airlines and even governments all over the world including the

Philippines and is continuously used in commerce worldwide and in the Philippines up to the present.

- "3) Opposer has obtained registration of this trademark for goods falling under Class 12 and also for other goods under other Classes in the home country which is the United States of America and likewise in other countries of the world which have a system of trademark protection. Photocopy of the corresponding U.S. Trademark Registration under International Class 12 is made an integral part of this opposition and is hereto enclosed as Annex "B".
- "4) The Opposer's goods covered by the trademark "747", particularly the wide bodied passenger jet aircraft popularly known and described worldwide as the "jumbo" jet aircraft due to its large configuration and high passenger and/or cargo capacity, has been and continues to be the most widely used and sought after passenger and cargo aircraft of its class in the whole world, being utilized by the most if not all of the leading airlines in the world which includes our own flag carrier, the Philippine Airlines, wherein the 747 aircraft is the mainstay of its international fleet. It is therefore common knowledge that the Opposer, the Boeing Company, has since twenty-two years ago established a very valuable worldwide goodwill of its "747" trademark which is internationally famous primarily due to the superior quality of its products as well as to the substantial amount of money, time and effort spent on worldwide advertisement to increase the people's awareness all over the world of Opposer's ownership of this trademark and of the various products and services emanating from the Opposer under this trademark. The trademark "747" generally known and recognized the world and sold over for decades up to the present is automatically associated to the Opposer. The Boeing Company, by people from all over the world from all walks of life who are literate enough to read their own national newspaper or tabloid or to understand what is shown in their national television programs and movies.
- "5) The goods covered by both the Opposer's and the Respondent-Applicant's mark belong to the same class of goods in accordance with Rule 82 of the Revised Rules of Practice in Trademark Cases.
- "6) A comparison of the Opposer's registered trademark with that of the Respondent-Applicant's mark would show that the latter's mark is confusingly similar with the Opposer's said trademark in clear violation of Section 4 (d) of Republic Act No. 166, as amended.
- "7) The grant of registration of the Respondent-Applicant's mark "JUMBO 747" will not only transgress on the rights and interest of herein Opposer over its registered trademark "747", but worse, it will tend to mislead the general public into believing that the Respondent-Applicant's products are the products of the damages and injury to both the interest of the Opposer and the public at large, and on the other hand, to the underserved or even fraudulent gain of herein Respondent-Applicant. This is obviously the case because the famous trademark "747" is known all over the world to be owned by herein Opposer, the Boeing Company, thus goods and services which carries the mark "747" would be believed by the general public to be emanating from the opposer. In today's fast changing world, wherein we are witnessing the emergence of corporate conglomerates, which owns world famous trademarks, producing goods and services which are very divergent from each other even belonging to

different International Classification of Goods, the public at large, including those in the Philippines, is now very much aware of this, through widespread dissemination of information made possible by modern mass media facilities worldwide and in the Philippines such that the use of famous trademarks on goods which are related and unrelated would lead the public at large to believe that these goods are made or authorized to be made by said conglomerates which originated and owns various world famous trademarks. Thus in this case on hand, the grant of registration of Respondent-Applicant would cause confusion to the Philippine public wherein they would be mistakenly led to believe that the goods covered by the Respondent-Applicant mark is manufactured by the Opposer or that the Respondent-Applicant is authorized by the Opposer to manufacture and market said goods.

- 8) The foregoing clearly shows that the Opposer will be greatly and irreparably damaged by the grant of registration of the questioned mark in the name of Respondent-Applicant, particularly the Opposer's business reputation and goodwill not only here in the Philippines but internationally as well."

On June 23, 1992, Respondent-Applicant filed its Answer specifically denying the allegations of the Opposition, to wit:

- "1) That Respondent-Applicant specifically denies the allegations contained in paragraph 1 of the grounds relied upon in the opposition for the reason that Opposer's trademark as stated in said opposition is merely "747" and not JUMBO 747 which is the trademark sought to be registered by the Respondent-Applicant.
- "2) That the Registration of Respondent-Applicant's trademark "JUMBO 747" will not cause grave and irreparable damage to the Opposer because the aggrupation of the number "747" even deprives the Respondent herein the right to use numbers which is not capable of being monopolized.
- "3) The Respondent's application is for the trademark "JUMBO 747" and not merely 747 and certainly, since Opposer's products cover "AIRCRAFT & AIRCRAFT PARTS", it seems inconceivable that the products of the Respondent which are motorcycles, tricycles and bicycles could be confused with aircrafts and aircraft parts, especially since buyers of aircrafts are considerably limited to airlines or those engaged in the airline industry.
- "4) That the fact that Opposer's goods are described worldwide as "JUMBO" does not give Opposer to deprive the Respondent of the use of the word "JUMBO" which is found in an ordinary dictionary meaning "anything huge". The fact therefore that "JUMBO" is a "descriptive word" can never be acquired no longer how long used or how long advertised.
- "5) That Respondent specifically denies the allegations contained in the facts relied upon by the Opposer in its Opposition for lack of knowledge as to the veracity of the information stated therein more particularly in paragraphs 3, 4, and 5 of the Notice of Opposition;
- '6) That Respondent specifically denies the allegations contained in paragraph 6 of the facts because there is no confusing similarity between respondent's trademark and the Opposer's trademark since the latter's

mark is merely "747" while that of the respondent covers two sets - "JUMBO 747";

- "7) That Respondent specifically denies the allegations contained in paragraph 8 of the facts because the buyers of Opposer's products are airlines or those engaged in the airline industry while the buyers of respondent's products are users of motorcycles, tricycles or bicycles and therefore, it seems improbable, if not impossible that an airline buyer would purchase from the respondent an "aircraft or aircraft parts". In fact, the facts relied upon further state that admittedly, the Opposer's products are so well known all over the world as referring to aircrafts that the buying public would certainly not be confused by purchasing a bicycle from The Boeing Company. That would be downright insulting to the Opposer since certainly it does not manufacture such items as a bicycle tire or tube or a tri-cycle or a motorcycle. Opposer's products consisting of "huge" and custom-built airplanes seating 300 to 500 people cannot be "confused" with a product that seats - at most, three people.

By way of Special Affirmative Defenses:

- "1) That the Respondent's applied for trademark is "JUMBO 747" while Opposer's trademark, as registered, is on "747" and therefore, the registration of Respondent's trademark is not in violation of Sec. 4 (d) of R.A. 166;
- "2) That Opposer cannot have a "monopoly" of the numbers and cannot deprive the herein Respondent the use of the number "747" or the word "JUMBO" which is descriptive and means "anything huge".
- "3) That the registration of Respondent's trademark will not cause damage and injury to the Opposer because the products manufactured by both parties are entirely different and distinct from each other. Furthermore, the buyers of these products belong to different classes. For instance, an ordinary laborer can purchase a bicycle or save enough to have a motorcycle and/or a tricycle but he certainly cannot save enough to purchase a custom-built Boeing product even if he slaves for the duration of his life. Only corporate conglomerates, as referred to by the Opposer, can buy a Boeing plane.
- "4) While it may be true that world-famous trademarks have had subsidiaries manufacturing different products, such is not true in the instant case. Besides, it seems strange that a number like "747" could have been registered as such. Would the Opposer have objected if the Respondent were to change the number to the now famous "349"? By using these numbers, the Opposer has, in effect, denied others the use of this particular combination of numbers which is unfair since the numbers are in the nature of "generics".

The issues having been joined, the case was scheduled for Pre-Trial Conference. For failure of the parties to reach for an amicable settlement trial on the merits ensued.

The main issue to be resolved in this case is whether or not the Respondent-Applicant's trademark "JUMBO 747" is confusingly similar to Opposer's trademark "747".

In resolving the issue involved, the applicable provision of the law is Section 4 (d) of R.A. No. 166 as amended which provides:

"Section 4 - Registration of trademarks, trade names and service marks on the Principal Register. There is hereby established a register of trademarks, tradenames and service marks which shall be known as the Principal Register. The owner of the trademark, tradename or service mark used to distinguish his goods, or business or services from the goods, business or services 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 trademark which so resembles a mark or tradename registered in the Philippines or a mark or a 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 service of the applicant, to cause confusion or mistake or to deceive purchasers."

In support of its claim of ownership over the marks "747", Opposer presented in evidence various foreign trademark certificate of registrations as well as its registration in the Philippines (Exhibit "A" to "E-1" inclusive of sub-markings).

Through visual comparison of the competing marks, it is observed that Opposer's mark consists of the numerical numbers "747" while the Respondent-Applicant's mark on the other hand consists of the word "JUMBO" and the numerical number "747". Therefore, under the "TEST OF DOMINANCY" it is concluded that the numerical numbers "747" is the dominant feature of the competing marks.

Another most vital factor to be considered in the case are the goods/products covered by the competing marks in order to finally resolve whether there is confusing similarity.

On the basis of the evidence presented, the goods/products covered by the Opposer's mark are as follows:

- 1) Aircraft and aircraft parts (Class 12)
Exhibit "A"
- 2) Airplanes and airplane parts (Class 12)
Exhibit "A-1"
- 3) Toy model airplanes, model airlines for display, and toy model airplane in kit form (Class 28) Exhibit "B" & "B-1"

Further to the above-mentioned goods, Opposer engaged in various products as alleged and contained in the Affidavit of Opposer's witness "CHRISTOPHER P. FOLEY, ESQ." Exhibit "C" which include various kinds of aircrafts, ships, vehicles, transportation machines and apparatus, and parts thereof; and all other commodities properly belonging to this class. (Exhibit "C-2-P")

On the other hand, the goods/products covered by the Respondent-Applicant's mark as indicated in its trademark application are as follows:

- a) Motorcycle
- b) Tricycle
- c) Tire and tube

Perusal of the goods/products covered by the competing marks, reveal that they are entirely distinct and different from each other.

Moreover, the Certificate of Registration issued by the Bureau of Patents, Trademarks and Technology Transfer in the name of the herein Opposer for the mark "747" bearing Reg. No. 39285 and 53653 covered the goods "Aircraft and aircraft parts (class 12) and toy model airplanes, model airplanes for display, and toy display model airplanes in kit form, (class 28) Exhibits "A" and "B", shows that Opposer is the owner of the mark "747" and its exclusive right to use the same in connection with the goods business or services specified in the Certificate.

However, Opposer's ownership of and its exclusive right to use the mark "747" is not an absolute bar to the use and registration of the same trademark by another. Section 4 (d), quoted above, clearly provides that registration by another is barred only when the mark being applied for, when used in connection with the goods specified in the application, is likely to cause confusion or mistake or to deceive purchasers.

In this regard, the Supreme Court in *ESSO STANDARD vs. COURT OF APPEALS* (116 SCRA 336) held that a trademark used by a corporation for its various petroleum products can be used by another as its trademark for cigarettes. The court held:

"The public knows too well that petitioner deals solely with petroleum products that there is no possibility that cigarettes with "ESSO" trademark may have generated. Although Petitioner's products are numerous, they are of the same class, which are non-competing with Respondent's products Cigarettes, which as pointed out in the appealed judgment is beyond petitioner's zone of potential or natural logical expansion.

Likewise, in the case of *Philippine Refining Co., Inc. vs. Ng Sam* (115 SCRA 473) the Supreme Court held, thus:

"The trademark "CAMIA" is used by petitioner on a wide range of products: lard, butter, cooking oil, abrasive detergents, polishing materials and soap of all kinds. Respondent desires to use the same on his product, ham. While ham and some of the products of petitioner are classified under class 47 (Foods and Ingredients of Food), this alone cannot serve as the decisive factor in the resolution of whether or not they are related goods. Emphasis should be on the similarity of the products worked and not on the arbitrary classification or general description of their properties or characteristics. (Underscoring supplied)

The case before us is similarly situated. The relevant public knows too well that the Opposer "The BOEING Company" deals with aircrafts or airplanes and airplane parts, the goods specified in its trademark registrations. There is therefore no possibility that people would reasonably believe that Opposer has expanded its business to the manufacture and sale of motorcycle, tricycle, bicycle, tire or tube. Neither would people be confused nor led to believe that the herein Respondent-Applicant is connected in whatever way to the herein Opposer because the goods which the parties deal with are just too unrelated.

Another point to be considered is the class of the purchasers or buyers. It is of public knowledge that the products of the Opposer is not an ordinary product, it being aircrafts or aircraft parts hence its purchasers are those engaged in the airline industry who not ordinary buyers/passengers.

In this connection, in *FABERGE INCORPORATED vs. THE INTERMEDIATE APPELLATE COURT*, G. R. NO. 71189, November 4, 1992, the Supreme Court held:

"Having thus reviewed the laws applicable to the case before us, it is not difficult to discern from the going statutory enactments the Private Respondents may be permitted to register the trademark "BRUTE" for briefs produced by it notwithstanding Petitioner's vehement protestations of unfair dealings in marketing its own set of items which are limited to "After-shave lotion", shaving

cream, deodorant, talcum powder and toilet soap. In as much as Petitioner has not ventured in the production of briefs an item which is not listed in its certificate of registration, Petitioner cannot and should not be allowed to feign that Private Respondent had invaded Petitioner's exclusive domain.

x x x

"One who has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademarks by others for products which are of a different description" (citing Philippine Refining Co. Inc. vs. NG LAM, 115 SCRA 472) (Underscoring provided)

Moreover, in the most recent case decided by the Supreme Court CANON KABUSHIKI KAISHA vs. COURT OF APPEALS & NSR RUBBER CORPORATION, G.R. NO. 120900, promulgated on July 20, 2000, the Supreme Court upheld the opinion of the Bureau of Patents, Trademarks and Technology Transfer and the Court of Appeals that the trademark "CANON" as used by Petitioner for its paints, chemical products, toner, and dyestuff, can be used by Private Respondent for its "SANDALS" because the products of these two parties are dissimilar.

Applying the doctrine in the above-mentioned decision of the Supreme Court of which the present case is similarly situated, the trademark "JUMBO 747" for motorcycle, tricycle, bicycle, tire & tube therefore, is not confusingly similar to the trademark "747" of the Opposer covering the goods aircraft/airplane and aircraft parts, which are distinctly and different from the goods of the Respondent-Applicant, i. e. motorcycle, tricycle, bicycle, tires and tubes.

WHEREFORE, in view of the foregoing, the instant Opposition is hereby DENIED. Consequently, application bearing Serial No. 60730 for the mark "JUMBO 747" used on motorcycle, tricycle, bicycle, tires and tubes is hereby GIVEN DUE COURSE.

Let the file wrapper of JUMBO 747 subject matter of this case be forwarded to the Administrative, Financial, Human Resource Development Service Bureau (AFHRDSB) for appropriate action in accordance with this Decision with a copy to be furnished the Bureau of Trademarks (BOT) for information and to update-its record.

SO ORDERED.

Makati City, 28 March 2003.

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