

TINKERBELL TOY CORPORATION,  
Opposer,

INTER PARTES CASE NO.  
Opposition to:

- versus-

Serial No.: 66286  
Date Filed: November 23, 1988  
Trademark: "TINKKERBELL"

TINKERBELL ALTA FOOD SERVICES,  
Respondent-Applicant.

X-----X

DECISION NO. 97-29

### DECISION

This pertains to an opposition filed in the matter of the application for the registration of the trademark TINKERBELL & REP. OF FAIRY allegedly used for foodstuff namely, fried chunky chicken, shredded beef in oyster sauce, beef spareribs, braised beef, crispy lechon kawali, chicken beef, pork with noodles, almond chocolate, roasted pork, pork barbecue, canton noodles, soy chicken spl. and other iced tapioca with black magic, filed on November 23, 1988, under Serial No. 66286 by Tinkerbelle Alta Food Services (The respondent) of Parañaque, Metro Manila, which application was published on page 41, of No. 10, vol. 11, October 31, 1989 issue of the Bureau of Patents, Trademarks and Technology Transfer (BPTTT) Official Gazette, Officially released for circulation on November 7, 1989.

The herein Opposer (TINKERBELL TOY CORPOPATION ) is a corporation organized and existing under the laws of the Philippines, with business address and office at Rm. 205 Centrum 11 Condominium, 150 Valero, Street, Salcedo Village, Makati City, while Respondent-Applicant is a single proprietorship with address ant Sun Valley Drive, South Superhighway, Parañaque, Metro Manila.

The grounds upon which opposer bases its opposition are as follows:

"1. Opposer is the owner by prior adoption and use of the trademark "TINKERBELL & TEDDY BEAR DESIGN" used for stuffed toys. Such ownership subsists and has never been abandoned.

"2. Products bearing Opposer's trademark have been sold in the Philippines for more than five (5) years and have gained a high degree of goodwill among the, buying public for high quality and workmanship.

"3. The application for the trademark TINKERBELL and Representation of a Fairy is tantamount to fraud as the use of the said trademark on the goods described in the application clearly infringes upon the established rights of the Opposer to the latter's trademark TINKERBELL & TEDDY BEAR Design.

"4. Respondent's mark TINKERBELL & Representation of A Fairy and its use in commerce in connection with the goods of respondent is likely to cause confusion or mistake upon, or deception on purchasers who would be led to believe that such goods also originate from herein opposer. Such use, therefore, is in violation of Section 22 of Republic Act No. 166, as amended. Moreover, the registration of Respondent's mark is proscribed by Section 4(d) of the same law."

To support its opposition, the Opposer relies on the following facts:

"a.) The Opposer is the original and lawful owner by adoption and use of the trademark "TINKERBELL & Teddy Bear Design" in the Philippines for stuffed toys as early as the latter part of 1984.

"b.) In the Philippines, the trademark TINKERBELL & TEDDY BEAR DESIGN is registered in the name of Opposer under Certificate of Registration No. 43660 issued on March 30, 1989. A copy of the Certificate is attached as Annex "A".

"c.) The Opposer's goods, i.e. stuffed toys, bearing the trademark "TINKERBELL & Teddy Bear Design", have been sold as early as 1984 and such goods are still being sold until the present.

"d.) The Opposer has spent a substantial amount of money by way of advertising and other expenses in order to promote their products bearing the trademark TINKERBELL & Teddy Bear Design, so much so that said trademark gained tremendous goodwill and popularity as well as general consumer recognition. Through such extensive sales and promotional schemes, the Opposer has effectively identified their products in the minds of the public through the use of the said trademark.

"e.) The use of the dominant word TINKERBELL in Respondent's mark constitutes an imitation likely to cause confusion with Opposer's own extensive use of the same word mark. Differences in the design/representation do not effectively dispel the confusion engendered that Respondent's products come from or are somehow connected with the Opposer."

On February 15, 1990, Respondent-Applicant (Tinkerbell Alta Food Services) filed its Answer specifically denying all the material allegations in the opposition and at the same time interposed affirmative allegations and defenses such as follows:

x x x

"7. Tinkerbell, as it is commonly known, is a small fairy; a character popularized in the children's story "Peter Pan".

"8. Respondent-Applicant has adopted and has been using the trademark "TINKERBELL with a Fairy Design" to identify its fast food outlet since 1988.

"9. Respondent-Applicant has also adopted and has been using the trademark "TINKERBELL with A Fairy Design" for its food products i.e. fried chunky chicken, shredded beef in oyster sauce, beef spareribs, braised beef, crispy lechon kawali, chicken/beef, pork with noodles, almond chocolate, roasted pork, pork barbecue, canton noodles, soy chicken special, iced tapioca with black magic and others; such products are sold mostly through Respondent-Applicant's fast-food outlets.

"10. Such adoption and use by Respondent-Applicant of the aforementioned trademark to identify its fast-food outlets and its products are in good faith, as shown by the following:

"10.1. The application-in-question was filed way back on November 23, 1988;

"10.2. From the time such application was filed, this Hon. Office has not issued an order addressed to Respondent-Applicant to cease and desist from using the trademark "TINKERBELL with Fairy Design" on the ground that there is a prior registered owner of such trademark;

"10.3. In fact, the examination previously conducted by this Hon. Office in connection with the application-in-question does not indicate that the trademark

sought to be registered by Respondent-Applicant is confusingly similar to the trademark allegedly by being used by the Opposer;

"10.4. The adoption and use by Respondent-Applicant since 1988 of the trademark "TINKERBELL with Fairy Design" for its food outlets and food products are open and continuous and such adoption and use subsist to the present;

"11. The trademark sought to be registered by Respondent-Applicant will not result to any confusion with the trademark allegedly owned by Opposer;

"12. The possibility of confusion becomes even remote as the products on which respondent-applicant had been using the trademark for are not similar to the products allegedly being sold by Opposer. Applicant is using the trademark in its fast-food business while Opposer is using its trademark on its toy manufacturing business;

"13. As such, the registration described in Annex "A" of the Notice of Opposition does not confer upon Opposer exclusive right to the use of the word TINKERBELL neither does the adoption and use thereof by Respondent-Applicant infringe upon the rights of Opposer."

The parties were not able to come out with an amicable settlement, for which trial on the merit was conducted.

The main issue to be resolved in this particular case is WHETHER OR NOT the registration of the mark "TINKERBELL & FAIRY DESIGN" is violative of Section 4(d) of Republic Act No. 166, as amended.

In the instant opposition Tinkerbell Toy Corporation claims that it is the owner of the trademark TINKERBELL and that Tinkerbell Alta Food Services should be barred from registering the mark TINKERBELL in its name, pursuant to Section 4(d) of R.A. No. 166, as amended which provides:

"SEC. 4. Registration of trademark, tradenames 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 a trademark, tradename or service mark used to distinguish his goods, 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 tradename which so resembles a mark or tradename registered in the Philippines or a mark or 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 mark TINKERBELL Tinkerbell Toy Corporation, the herein Opposer presented in evidence Certificate of Registration in the Principal Register issued by this Office (BPTTT) on March 30, 1989 for the mark "TINKERBELL and Teddy Bear Design" bearing Regn. No. 43660 covering the goods STUFFED TOYS falling under class 28 of the international classification of goods.

The above-mentioned Certificate of Registration, Exhibit "A", Regn. No. 43660 for the mark "TINKERBELL and Teddy Bear Design", presumably shows that the herein Opposer is the owner of the said trademark and its exclusive right to use the same in connection with the goods, business or services specified in the Certificate in accordance with Section 20 of R.A. No. 166,

as amended. The goods covered by the Certificate of Registration is very specific and that is STUFFED TOYS.

However, Opposer, Tinkerbell Toy Corporation's ownership of, and its exclusive right to use the mark TINKERBELL is not an absolute bar to the use and registration of the same by another. Sec. 4(d) quoted above clearly provides that registration by another is barred only when used in connection with the goods specified in the application or to goods which is likely to cause confusion or mistake or to deceive purchasers. In this regard, the Supreme Court in the case of ESSO Standard Eastern, 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 brand will be associated with whatever goods the Petitioner's ESSO trademark may have generated. Although petitioner's products are numerous, they are of the same class or line of merchandise which are non-competing with respondent's product of cigarettes, which as pointed out in the appealed judgment is beyond petitioner's zone of potential or natural and logical expansion."

The case before us is similarly situated. The relevant public knows too well that TINKERBELL Toy Corporation, the herein Opposer deals primarily with STUFFED TOYS, while the herein Respondent Tinkerbell Alta Food Services deals with fast food products. There is just no possibility that people would reasonably believe that TINKERBELL Toy Corporation has expanded its business to fast-food products. Neither would people think that TINKERBELL Alta Food Services is connected in whatever way with the herein Opposer because the goods which the parties deal with are just too unrelated.

It is worthy to note at this point that the trademark TINKERBELL has already been registered by different parties namely:

1. Tinker Bell Snack House  
Regn. No. 31924 dated 06-09-83  
Goods: Snack house business  
Registrant: Mary L. Co.
2. Tinkerbell  
Regn. No. 34242  
Goods: Toilet water  
Registrant: Tom Fields Ltd.
3. Tinkerbell & Teddy Bear Design  
Regn. No. 43660  
Goods: Stuffed toys  
Registrant: Tinkerbell Toy Corporation

The existence of several registration of the trademark TINKERBELL to different parties show that said mark is capable of appropriation by other parties subject to the limitation imposed by law in accordance with Sec. 4(d) and Sec. 20 of R.A. No. 166, as 'X' amended. In other words, registration of the same trademark is allowed if the goods or products covered is entirely distinct or unrelated to the goods or products covered by the different registration above-mentioned. In short, Section 20 of the Trademark Law as applied to the evidence adduced by Opposer, the Certificate of Registration issued by the Director of Patents, Trademarks and Technology Transfer can only confer upon Opposer the exclusive right to use its own trademark only to those goods specified in the certificate, subject to any conditions and limitations stated therein.

This basic point is perhaps the unwritten rationale of Justice Escolin in Philippine Refining Co. vs. Ng Sam (115 SCRA 472 [198.1], where he stressed the principle enunciated by the United States Supreme Court in American Foundries vs. Robertson (269 U.S. 372, 381, 70 L ed 317, 46 S& 160) that one who has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others for products which are of a different description.

The Supreme Court also had the occasion to observe the same principle in the 1966 case of George W. Luft Co., Inc. vs. Ngo Guam (18 SCRA 944 [1966]) that no serious objection was posed by the Petitioner therein since the applicant utilized the emblem TANGO for no other product than hair pomade in which petitioner does not deal.

WHEREFORE, in view of all the foregoing, this Opposition case is as it is hereby DENIED. Accordingly, Application Serial No. 66286 for the registration of the trademark "TINKERBELL with Fairy Design" filed on November 23, 1988 by Tinkerbelle Alta Food Services, Respondent-Applicant is hereby GIVEN DUE COURSE.

Let the filewrapper of this case be forwarded to the Application Issuance and Publication Division for appropriate action in accordance with this Decision with a copy thereof furnished to the Trademark Examining Division for information and to update its record.

SO ORDERED.

Makati City, November 24, 1997.

EMMA C. FRANCISCO  
Director