TWENTIETH CENTURY FOX FILM CORPORATION,	}	INTER PARTES CASE NO. 4314
Opposer,	}	Opposition to :
	}	Serial No. : 93010
-versus-	}	Date Filed : 03 June 1994
	}	Trademark : "HOME ALONG DA RILES & Device"
ABS-CBN BROADCASTING CORPORATION,	}	
Respondent-Applicant,	}	Decision No. 2003 - 31

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Decision

This is and opposition to the registration of the mark "HOME ALONG DA RILES & DEVICE" bearing Serial No. 93010 filed on June 6, 1994 by ABS-CBN BROADCASTING CORPORATION, which application was published on page 20, VOL. IX, No. 6, November-December 1996 issue of the Official Gazette, a monthly publication of the Intellectual Property Office and officially released for circulation to the public on August 20, 1997.

The Opposer in the above-entitled case is TWENTIETH CENTURY FILM FOX CORPORATION, a foreign (Delaware) corporation organized under the law of United States of America with address at 10201 West Pico Boulevard, Los Angeles, California 90064, U.S.A.;

On the other hand, the Respondent-Applicant is ABS-CBN BROADCASTING CORPORATION, a corporation, incorporated under Philippine Laws with address at Mother Ignacia Street corner Sergeant Esguerra Avenue, Quezon City.

The ground of the opposition is that the registration of the mark "HOME ALONG DA RILES & DEVICE" in the name of the Respondent-Applicant is proscribed by SEC 4(d) of Republic Act No. 166, as amended.

Opposer relied on the following facts to support its opposition:

"1. Opposer is the owner and prior user of the internationally-renowned HOME ALONE and was issued by the U.S. Patent and Trademark Office Certificate of Registration No. 1,842,094 for the trademark HOME ALONE for entertainment services in the nature of motion picture film and video tape reproduction on Class 41. Moreover, Opposer has adopted and used the mark HOME ALONE in the Philippines.

"2. The mark Home Along Da Riles which Respondent-Applicant seeks to register is identical to or, at the very least, confusingly similar to the trademark HOME ALONE of Opposer.

"3. The approval of the application in question is proscribed under Section 4(d) of Republic Act No. 166, as amended.

"4. The use and approval of registration of Respondent-Applicant's mark will deceive the consuming public into thinking that Respondent-Applicant's goods or business come from or are authorized by Opposer; and

"5. The approval of Application No. 87324 for the mark HOME ALONG Da Riles will cause irreparable damage and injury to the Opposer."

On January 28, 1998, Respondent-Applicant filed its Answer denying all the material allegations of the opposition.

The issued having been joined, this Office called the case for pre-trial. Failing to reach an amicable settlement, the parties went into trial, adduced their respective evidences.

Records will show that this case is considered submitted for DECISION (ORDER No. 2002-262) dated 2 July 2002, however on October 21, 2002, Opposer through counsel filed an Urgent Manifestation and Motion and Respondent-Applicant filed its comment thereto, hence, before this Office can decide the merits of the instant case, it has to resolve the Urgent Manifestation and Motion first.

It has been prayed in the Urgent Manifestation and Motion that the trademark application bearing Serial No. 93010 for the mark "HOME ALONG DA RILES (Design)" filed on June 6, 1994 subject of the instant opposition proceedings be REFUSED registration pursuant to Memorandum Circular No. BT Y2K-8-03 or for non-filing of the applicant of the DECLARATION OF ACTUAL USE.

The records will show that subject application was filed when Republic Act No. 166 as amended was still in force wherein the ownership of the mark is based on actual use and that before a before mark can be applied for registration, actual use thereof in commerce within two months before the filing of the application for registration is required except under Sec. 37 of said law when the application is based on home application or home registration.

There is also no showing that the applicant chose to prosecute said application under Republic Act No. 8293.

The records likewise show that the trademark application has been subscribed and sworn to before a Notary Public and that applicant had DECLARED UNDER OATH that the mark was first used on the goods on December 23, 1992 and in the Philippines on December 23, 1992 which in effect is a declaration of actual use of the mark being applied for registration.

Sec. 235.2 of R.A. 8293 provides as follows:

"235.2 All application for registration of marks or trade names pending in the Bureau of Patents, Trademark and Technology Transfer at the effective date of this Act may be amended, if practicable to bring them under the provisions of this Act. The prosecution of such applications so amended and the grant of registrations thereon shall be proceeded with in accordance with the provisions of this Act. If such amendments are not made, the prosecution of said applications shall be proceeded with and registrations thereon granted in accordance with the Acts under which said applications were filed; and said Acts hereby continued in force to this extent for this purpose only, notwithstanding the foregoing general repeal thereof". (Underscoring supplied)

In view of the above quoted provision of RA 8293, the active prosecution of this case by the Respondent-Applicant and the fact that Respondent has declared under oath its actual use of the mark as of the time of filing of the application, the NON-FILING OF DECLARATION OF ACTUAL USE cannot therefore justify nor warrant refusal of registration SINCE IT IS NO a requirement under RA 166 but a requirement only under RA 8293 and considering that a Memorandum Circular, Office Order, or Regulation cannot amend a very clear and specific provision of law (See Sec. 235.2, R.A. 8293).

IN VIEW OF FOREGOING AND THE ABOVE QUOTED PROVISION OF LAW, the Urgent Manifestation and Motion to refuse registration filed by Opposer is hereby DENIED FOR LACK OF PERM.

Consequently, the only issue to resolved in this case is WHETHER OR NOT THE MARK OF THE OPPOSER "WHETHER OR NOT THE MARK OF THE OPPOSER "HOME ALONE" AND THAT OF REPSPONDENT'S APPLICANT'S MARK "HOME ALONG DA RILES & DEVICE" ARE CONFUSINGLY SIMILAR.

It must be emphasized that the trademark application subject of the instant opposition proceedings was filed on June 3, 1994 of which the prevailing law in force at the time is Republic Act No. 166, as amended.

The applicable provision is Section 4(d) of Republic Act No. 166 which provides:

> "SEC. 4. – *Registration of trademarks, trade name and service marks on the Principal register.* – There is hereby established a register trademarks, trade names and service marks which shall be known as the principal register. The owner of a trademark, trade name and service mark used to distinguish his goods, business or services of others shall have the right to register the same in the principal register, unless it: x x x
>
> (d) Consist of or comprises a mark trade name whish co resembles a mark or trade name registered in the Philippines or a mark or trade name preciously used in the Philippines by another and not abandoned, as to be likely, when applied to or used connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers."

In determining whether the two trademarks are confusingly similar, the test is not simply to take their word and compare the spelling and pronunciation of said words. Rather it is to consider the two marks in their entirety as they appear in the respective labels, in relation to the goods to which they are attached; the discerning eye of the observer must focus not only on the predominant words, but also in other features appearing on both labels. (MEAD JOHNSON & CO., vs. N.V.J. VAN DORP, LTD. [7 SCRA 769] [G.R. No. L-17501]) (BRISTOL MYERS CO. vs. DIRECTOR PATENTS, 17 SCRA 128)

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not juxtaposition) of the trademark said to be infringed. (87 C.J.S., pp. 291-292) For indeed, trademark infringement is a form of unfair competition. (CLARKE vs. MANILA CANDY CO., 36 Phil. 100, 106; CO TIONG vs. DIRECTOR OF PATENTS, 95 Phil. 1, 4)

The competing marks are composite, containing different words. The Opposer's mark consists of the words "HOME ALONE" while Respondent-Applicant's mark consists of the words "HOME ALONG DA RILES and DEVICE" consisting of a pictorial representation of a railroad and a background sketch of houses along the railroad.

There is no confusing similarity as the two marks are entirely different from each other. The only similarity they have is the presence of the "HOME" but all the other features are not the same both in SPELLING, SOUND, PRONUNCIATION as well as in MEANING. The two marks not only have visual dissimilarities but also have different connotations and overall impression

that the viewing public would not, in any way, be confused nor would such public associate Opposer's mark with that of the Respondent-Applicant's mark.

Respondent-Applicant's mark is used on "NOTEBOOKS" and related paper articles which fall under class 16 of the International Classification of goods while that of the Opposer's mark is being used in ENTERTAINMENT SERVICES in the nature of motion picture film and video tapes reproduction in class 41 and therefore, are entirely different from each other and flow through different trade channel. On this alone, assuming for the sake of argument that the competing marks are similar, the opposition must fail as ruled by the Supreme Court in the case "CANON KABUSHIKI KAISHA vs. COURT OF APPEALS and NSR RUBBER CORP." [G.R. No. 120900] promulgated on July 20, 2000, wherein the mark "CANON" used on SANDALS was allowed for registration despite the existence of the same "CANON" registered for the goods, paints, chemical products, toner, dyestuff (class 2).

WHEREFORE, the opposition is hereby DENIED. Consequently, trademark application bearing Serial No. 93010 for the mark "HOME ALONG DA RILES and DESIGN" filed on June 3, 1994 by ABS-CBN BROADCASTING CORP., is hereby GIVEN DUE COURSE.

Let the filewrapper of the mark HOME ALONG DA RILES and DESIGN subject matter of this case be forwarded to the Administrative, Financial Human Resource Development Service Bureau (AFHRDSDB) for appropriate action in accordance with this DECISION with a copy furnished the Bureau of Trademarks (BOT) for information and to update its records.

SO ORDERED.

Makati City, 8 July 2003.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs