

R.J. REYNOLDS TOBACCO COMPANY,  
Opposer,  
- versus -  
DURATRAK TRADERS, INC.,  
Respondent-Applicant.)  
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INTER PARTES CASE NO. 3519  
OPPOSITION TO:  
Application Serial No. 58078  
Filed : January 6, 1986  
Applicant : Duratrak Traders, Inc.  
Trademark : DURATRAK AND REP. OF A CAMEL  
Used on : Business of wholesale and retail of tires and tubes  
DECISION NO. 94-14 (TM)  
January 18, 1994

### DECISION

On February 20, 1990, R.J. Reynolds Tobacco Company, a corporation duly organized under the laws of the State of New Jersey, U.S.A., with principal Office at Winston Salem, North Carolina, U.S.A. filed its verified Notice of Opposition against the application for registration of the mark "DURATRAK and REPRESENTATION OF A CAMEL" for business of wholesale and retail of tires and tubes, filed on January 6, 1986 under Serial No. 58078 in the name of DURATRAK TRADERS, INC., WHICH WAS PUBLISHED ON PAGE 52, Vol. II, No. 11, November 29, 1989 issue of the Official Gazette, officially released for circulation on December 21, 1989.

The Respondent-Applicant is a corporation organized under the laws of the Philippines with address at 9 & 10 Saric Building Sta Ana Avenue, Davao City, Philippines.

The grounds for the opposition are as follows:

1. The mark "DURATRAK and REPRESENTATION OF A CAMEL" so resembles Opposer's registered trademark "CAMEL" and "REPRESENTATION OF A CAMEL" which has been previously used in commerce in the Philippines and other parts of the world and not abandoned, as to be likely, when applied to or used in connection with the services of applicant, to cause confusion, mistake and deception on the part of the purchasing public.
2. The registration of the mark "DURATRAK and REPRESENTATION OF A CAMEL" in the name of the applicant will violate Section 37 of R.A. No. 166 as amended, and Section 6bis and other provisions of the Paris Convention for the Protection of Industrial Property to which the Philippines and the United States of America are parties.
3. The registration and use by applicant of the mark "DURATRAK and REPRESENTATION OF A CAMEL" in the name of the applicant is contrary to other provisions of the Trademark Law."

To support this opposition, Opposer will prove and rely upon, among other facts the following:

“1. Opposer is a manufacturer of a wide-range products, including cigarettes bearing the trademark CAMEL and Representation of a Camel which have been marketed and sold in the Philippines and in other parts of the world. Opposer has been commercially using the trademark CAMEL and Representation of a Camel internationally and in the Philippines prior to the use of DURATRAK and Representation of a Camel by Applicant.

2. Opposer is the owner of the trademark CAMEL and Representation of a Camel which was registered with the Bureau of Patents, Trademarks and Technology Transfer under Renewal Registration Certificate No. 358 for cigarettes products. CAMEL and Representation of a Camel is also registered and is used as a trademark for the same products in the United States of America and several other countries.

3. Opposer is the first used of the trademark CAMEL on the goods included under the above-described registration which have been sold and marketed in various countries worldwide, including the Philippines.

4. Opposer’s mark is a well-known mark within the meaning of Section 6bis of the Paris Convention and is entitled to protection against unauthorized user of the same on similar mark under the Memorandum dated November 20, 1980 of the then Minister of Trade to the Director of Patents.

5. By virtue of Opposer’s prior and continued use of CAMEL and Representation of a Camel in the Philippines and other parts of the world, said trademark has become popular and internationally well-known and has established valuable goodwill for Opposer among consumers who have identified Opposer as the source of the goods bearing said trademark.

6. The registration and use of a confusingly similar mark by the Applicant will tend to deceive and/or confuse purchasers into believing that Applicant’s services emanate from or are under the sponsorship of Opposer. Applicant obviously intends to trade, and is trading on, Opposer’s goodwill.

7. The registration and use of a confusingly similar mark by Applicant will diminish the distinctiveness and dilute the goodwill of Opposer’s trademarks.”

On April 2, 1990, Respondent-Applicant filed its answer denying the allegation that the trademark “DURATRAK and Representation of a Camel” so resembles Opposer’s registered trademark CAMEL. It stated that there can be no confusion, mistake and deception on the part of the purchasing public because DURATRAK is not engaged in a business similar to that of the Opposer. The Opposer is engaged in manufacturing CIGARETTES while the Respondent-Applicant is engaged purely in distributing/selling GOODYEAR TIRES AND TUBES.

The issues to be resolved are the following:

“1. Is applicant’s trademark “DURATRAK and Representation of a Camel” identical and/or confusingly similar to Opposer’s trademark “CAMEL and Representation of a Camel”

2. Would the registration of the trademark “DURATRAK and Representation of a Camel” in the name of applicant violate Section 37 of R.A. No. 166 as amended.

Our Trademark Law, particularly Section 4(d) thereof provides as follows:

“SEC. 4. Registration of trademark, 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 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:

xxx

(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 services of the applicant, to cause confusion or mistake or to deceive purchasers.”

Infringement of trademark depends on whether the goods of the two contending parties using the same trademark are so related as to lead the public to be deceived.

Goods are 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 in grocery stores. Thus, biscuits were held related to milk because they are both food products. Soap and perfume, lipstick and nail polish are similarly related because they are common household items nowadays. (Esso standard v. Court of Appeals, 116 SCRA 336).

The goods covered by Respondent’s trademark “DURATRAK TRADERS, INC. & CAMEL DEVICE inside a Circle” is the business of wholesale and retail of tires. Opposer’s trademark “CAMEL AND REPRESENTATION Thereof” as shown in the Certificate of Registration No. 186 and Renewal No. 1867 effective September 20, 1977 covers the goods “CIGARETTES”.

Undoubtedly, these goods are non-competing. They belong to different classes of goods and are different and distinct from each other.

They are so foreign to each other as to make it unlikely that purchasers should think that Opposer is the manufacturer of respondent’s goods. The mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on unrelated articles of a different kind.

In the case “Acoje Mining Co. Inc. vs. Director of Patents (G.R. No. 28744, April 29, 1971, 38 SCRA 480) the Supreme Court held that the trademark “Lotus” for soy sauce and “Lotus” for edible oil were held not confusingly similar because there is quite difference between soy sauce and edible oil. If one is in the market for the former, he is not likely to purchase the latter just because of the trademark “Lotus”.

The trademark “CAMIA” for ham and “CAMIA” for lard, cooking oil, abrasive detergents, polishing materials and soap were held not confusingly similar because the products are unrelated and while ham and some of the products of the Junior user fall under the same classification as prescribed by the Philippine Patent Office, that fact alone may not be a decisive factor in the resolution as to whether or not the goods are related, the emphasis being on the similarity of the products and not on the arbitrary classification or general description of their properties or characteristics (Philippine Refining Co. Inc. vs. Ng Sam), G.R. No. 26076, July 30, 1982, 115 SCRA 472.

In another case, the Court held that the owner of “HICKOK” for handkerchief, underwear, wallet and belt can not validly object to the use by a Junior user of “HICKOK” for shoes because

the goods involved are unrelated and non-competing. The Court stated: It is established doctrine xxx that emphasis should be on the similarity of the products involved and not on the arbitrary classification or general description of their properties or characteristics and that the mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on unrelated articles of a different kind, (Hickok Manufacturing Co. Inc. vs. Court of Appeals) G.R. No. 44707, August 31, 1982, 116 SCRA 387.

In the case of Shell Company of the Philippines, Ltd. vs. Court of Appeals, G.R. No. 49145, June 29, 1979, the court affirmed the Patent Office's registration of the trademark "SHELL" as used in the cigarettes manufactured by Fortune Tobacco Corporation notwithstanding Shell Company's Opposition thereto as the prior registrant of the same trademark for its "gasoline and other petroleum trademarks.

WHEREFORE, premises considered the herein Notice of Opposition is hereby DENIED. Accordingly, Application bearing Serial No. 58078 for the trademark "DURATRAK TRADERS, INC. and CAMEL DEVICE inside a Circle" filed on January 6, 1986 by Duratrak Traders, Inc. is hereby GIVEN DUE COURSE.

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

SO ORDERED.

IGNACIO S. SAPALO  
Director