

GAMMA METAL INDUSTRIES CORP.,
Opposer,

INTER PARTES CASE NO. 3756
Opposition to:

-versus-

Serial No. : 72791
Filed : August 1, 1990
Trademark : "CAMEL &
REPRESENTATION
THEREOF"

WILCHAN METAL INDUSTRIAL
CORPORATION,
Respondent-Applicant

DECISION NO. 98-21

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DECISION

This is an opposition proceeding filed by GAMMA METAL INDUSTRIES CORPORATION (hereinafter referred to as the Opposer) against the application of WILCHAN METAL INDUSTRIES CORPORATION (hereinafter referred to as the Respondent-Applicant) for the registration of the trademark CAMEL & REPRESENTATION THEREOF for use on electric fan under Serial No. 72791.

Oppose is a corporation duly organized and existing under the laws of the Philippines with business address at 40 A Rincon Road, Valenzuela, Metro Manila while herein Respondent-Applicant is likewise a domestic corporation with business address at 117 J. Abad Santos St., Sta. Lucia, Valenzuela, Metro Manila.

In its verified Notice of Opposition, Opposer cited the following as grounds for its opposition, namely:

- "1. The approval of application in question is contrary to Section 4(d) of Republic Act No. 166, as amended;
- "2. The approval of the application in question will violate Opposer's right to its registered trademark CAMEL & REPRESENTATION THEREOF and the right to extend the use thereof to other goods including electric fan;
- "3. Respondent-applicant is guilty of fraud in the filing and prosecution of the application in question;
- "4. The approval of the application in question will cause great and irreparable damage and injury to Opposer.

Opposer relied upon the following facts to support its opposition that:

"1. The opener is the registered owner of the trademark CAMEL AND REPRESENTATION THEREOF under Registration Certificate No. 6469 issued on April 10, 1984.

"2. The Opposer is also the registered owner of the trademark CAMEL AND REPRESENTATION THEREOF under Registration No. 37640 issued on October 22, 1987.

"3. The both Annexes "A" and "B" are still valid and in full force and in effect as of today:

"4. That the trademark CAMEL AND REPRESENTATION THEREOF is also being applied for registration by Opposer under Application Serial No. 79298 filed last January 22, 1992.

"5. That long before Respondent-Applicant filed its application in question for the registration of the trademark CAMEL AND DEVICE, Opposer have been using its trademark CAMEL AND REPRESENTATION THEREOF for a wide variety of goods which use has not been abandoned but continuous up to the present;

"6. That the trademark CAMEL AND DEVICE being applied for registration by Respondent-Applicant is identical to or at very least, confusingly similar to the registered trademark CAMEL AND REPRESENTATION THEREOF of Opposer;

"7. That the approval of the application in question is contrary to Sec. 4 (d) of R.A. 166, as amended;

"8. That the approval of the application in question is violation of the right of opposer to its registered trademark CAMEL AND REPRESENTATION THEREOF and its right to extend its use thereof to other goods, including electric fan;

"9. That Respondent-Applicant is guilty of fraud in the filing and prosecution of the application in question. Respondent-Applicant has been claiming that subject mark is already registered when in fact its application is still pending;

"10. That the approval of the application in; question will cause great and irreparable damage and injury to Opposer;

In its Answer, Respondent-Applicant denied the grounds cited in the opposition, thus:

"a] Respondent-applicant denies paragraphs 1, 2 and 3 of the grounds for Opposition on the ground that Respondent-Applicant has been using the mark in commerce before and after the application thereof for registration and that it had absolutely no knowledge of any party using or have registered the same mark on electric fan at the time Respondent-Applicant filed the application;

"b] while the trademark "CAMEL & DEVICE of the Respondent-Applicant may be construed to be confusingly similar to the Opposer's mark, the fact however is that Opposer has better right over said mark considering that it was the first one to use and apply the mark in commerce on electric fans in the Philippines, hence, Respondent-Applicant denies paragraphs 2 and 3 of the grounds for opposition;

"c] Respondent-Applicant likewise denies Opposer's claim in paragraph 4 of the grounds for the opposition that it will be damaged by the registration of the trademark "CAMEL & DEVICE" in favor of Respondent-Applicant as such claim has no legal or factual basis."

In support of his opposition, Opposer presented two (2) witnesses, namely: Gregorio Ong and Anson Tan, and offered Exhibits "A" to "S-2" during the presentation of its evidence in chief and Exhibits "T" to "FF" as part of its cross-examination of Respondent-Applicant's witnesses.

Briefly, the evidence of Opposer may be summarized as follows:

Opposer was organized and duly incorporated on October 8, 1976 (Exhibit "B"). on June 1, 1980, it adopted and started using the trademark CAMEL & REPRESENTATION THEREOF for its kitchen wares and utensils specifically kettle, frying pan, sauce, pot, basin, steamer, colander, water kettle and water pail (Exhibits "D-2-B" and "E-2-B"). On April 10, 1984, this Office issued to Opposer Registration Certificate No. 6469 on the Supplemental Register (Exhibit "D-1") and Registration Certificate No. 37640 on the Principal Register for the trademark CAMEL & REPRESENTATION THEREOF for use on kitchen and utensils on October 22, 1987 (Exhibit "E-1"). Towards the second half of 1989, Opposer extended the use of the trademark CAMEL & REPRESENTATION THEREOF to other kitchen wares and utensils such as ice bucket, mixing bowl, bottle sterilizer, ladle, barbeque stand and thermos bottle. In addition, it also importing

unbranded CKD and SKD small home appliances such as flat irons, rice cookers, electric fans, gas stoves and selling them under the trademark CAMEL & REPRESENTATION THEREOF. As a consequence thereof, Opposer filed Application Serial No. 79298 on January, 1992. In support of its claim for extension of use as testified to by its witness Gregorio Ong, Opposer presented actual samples of mixing and distributed bowls, ice buckets, steamer, sterilizer, gas stoves, flat iron, electric fan, barbeque stand, vacuum bottles, and subsequently substituted them with photographs thereof which were marked in evidence as Exhibits "G", "H", "I", "J", "K", "L", "M", "N", and "O", respectively. Opposer likewise presented various wholesale invoices which were marked as Exhibits "P", "P-1" to "P-11", with Exhibit "P-5" being dated August 14, 1989.

Opposer's second witness Anson Tan testified that sometime in July 1989, he accompanied his wife to Hong Kong and during said trip, they brought unbranded household appliances such as electric fans, flat irons, airpots and other items which his wife sold to Opposer (Exhibit "Q"). As evidence thereof, Anson Tan submitted various invoices of Gamma & Sons dated July 28, July 31 and August 2, 1989 and subsequently marked as Exhibits "Q-1" to "Q-3", respectively.

For its part, Respondent-Applicant presented four (4) witnesses, namely: David Lam, William Chan, Dennis Peralis and Barbara Go and offered Exhibits "1" to "50". Although Respondent-Applicant's President William Chan claimed that the trademark CAMEL & DEVICE has been assigned to Camel Appliances Corporation, no document to support said claim was ever presented to, nor recorded with this Office. Accordingly, the various documentary exhibits presented depicting or indicating Camel Appliance Corporation to be the user of the mark CAMEL & DEVICE must be ruled as immaterial.

On the other hand, Respondent's evidence are as follows:

In its application statement (Exhibit "T"), Respondent-Applicant through its President William Chan, declared under oath that it started using the mark CAMEL & DEVICE on May 23, 1990. In his Affidavit (Exhibit "I"), William Chan claimed that Respondent-Applicant has been using the trademark CAMEL & DEVICE on electric fans since the early part of 1989. The earliest date of first use supported by Respondent's Exhibit however, is only on May 25, 1991 (Exhibit "23"). In contrast, the earliest date of first use supported by Opposer's exhibits is on August 14, 1989 (Exhibit "P-5").

The main issue to be resolved in this case is whether the registration of the trademark of Respondent is contrary to Sec. 4 (d) of R.A. 166 as amended to wit as follows:

SEC. 4. Registration of trade-marks, trade-names and service-marks on the principal register – *There is hereby established a register of trade-marks, trade-names, service-marks which shall be known as the principal register. The owner of a trade-mark, trade-name or service-mark used to distinguished his goods, business or services from the goods, businesses or services of other shall have the right to register the same on the principal register, unless it:*

d) Consists of or comprises a mark or trade-name which so resembles a mark or trade-name registered 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 of mistake or to deceive purchasers; xxx."

There is no question that Respondent-Applicant's mark CAMEL & REPRESENTATION Thereof is confusingly similar to Opposer's mark CAMEL & REPRESENTATION as both marks consists of the same word CAMEL and device or representation of the same animal, CAMEL, hence, its registration in favor of herein Respondent is contrary to the aforequoted provision of the Trademark Law.

In this connection, the Supreme Court has ruled in several cases that:

“Why of the million of terms and combinations of letters and designs available, the appellee had to choose those so closely similar to another’s trademark if there was no intent to take advantage of the goodwill generated by the other mark (American Wire and Cable C., vs. Director of Patents, 31 SCRA 544)

xxx *Why with all the birds in the air, and all the fishes in the sea, and all other animals on the face of the earth to choose from the defendant company (Manila Candy Co.) elected two rooster as its trademarks, although its directors and managers must have been well aware of the long continued use of a rooster by the plaintiff with the sale and achievement of its goods?*
xxx *a cat, a dog, carabao, a shark, or an eagle stamped upon the container in which candies are sold would serve as a rooster for purposes of identification as the products of the defendant’s factory. Why did defendant select two roosters as its trademark? (Clarke vs. Manila Candy Co., 36 Phil. 100)*

The Supreme Court further rules:

“That objects of trademarks are to point out distinctly the origin or ownership of the article to which it is affixed, to secure to him, who has been instrumental in bringing into the market a superior article of merchandise; the fruit of his industry and skill, and to prevent fraud and imposition.” (Etepha vs. Director of Patents, 16 SCRA 495; LA CHEMISE LACOSTE, S.A. vs. Fernandez, 129 SCRA 373).

“The owner of a trademark or trade name has proprietary rights in which he is entitled to protection, since there is damage to him from confusion or reputation of the goodwill in the mind of the public as well as confusion of goods. The modern trend is to give emphasis to the acts and to treat the issue as a fraud.” (Ang vs. Teodoro, 74 Phil. 50; Arce Sons & Co. vs. SELECTA Biscuits Co. Inc., 1 SCRA 253).

Further, those who desire to distinguish their goods from another has a broad field from which to select a trademark for their wares and there is no such poverty in the English language or paucity of signs, symbols, numerals, etc. as to justify the one who really wishes to distinguish his products from those of all others in entering the twilight zone of the field already appropriated by another. (Weco Products Co. vs. Milton Ray Co., 143 F. 2d 985, 31 CCPA Patents 1214)

Having resolved the issue of confusing similarity the next issue to be resolved should be, who is the first to use the trademark CAMEL AND REPRESENTATION and is therefore, entitled to its registration?

In this case, Opposer was the first to use the trademark CAMEL & REPRESENTATION THEREOF on kitchen wares and utensils on June 1, 1980 (Exhs. “D-2B” and “E-2-B”) which use incidentally was known to Respondent-Applicant’s President William Chan as he used to buy the aluminum pans for his weighing scales from Opposer (TSN, October 9, 1995, pp. 6-9, 18);

Likewise, based on the evidence on record, Opposer Gamma Metal Industries Corporation was the first to use the trademark CAMEL & REPRESENTATION THEREOF for electric fans on August 14, 1989 (Exhibit “P-5”), as against Respondent-Applicant’s use on May 25, 1991 per its Exhibit “23”.

Section 2-A of R.A. 166, as amended, provides as follows:

“SEC. 2-A. Ownership of trademarks, trade names or service marks, how acquired – Anyone who lawfully produces or deals in merchandise of any kind or who engages in any lawful business, or who renders any lawful service in commerce, by actual use thereof in manufacture or trade, in business, and in the service rendered, may appropriate to his exclusive use a trademark, a trade name or a service mark not so appropriated by another, to distinguish his merchandise, business or service of others.

The ownership or possession of a trademark, trade-name or service-mark, heretofore or hereafter appropriated, as in this section provided, shall be recognized and protected in the same manner and to the same extent as are other rights known to the law. (As amended by R.A. No. 68)

Indeed, out of so many animals which Respondent-Applicant can adopt as a trademark for its electric fans, why did it have to adopt and use the mark CAMEL & REPRESENTATION THEREOF which was not only being used but is also registered in favor of Opposer?

Opposer Gamma Metal Industries Corporation is the rightful owner of the mark CAMEL & REPRESENTATION THEREOF for use not only on kitchen utensils but also for electric fans and as the rightful owner and prior user of the trademark "CAMEL AND REPRESENTATION THEREOF", Opposer should be given protection from unlawful copying or imitation by other person, such as Respondent.

WHEREFORE, the Notice of Opposition is hereby SUSTAINED. Accordingly, Application Serial No. 72791 for the trademark "CAMEL & REPRESENTATION THEREOF", filed by WILCHAN METAL INDUSTRIAL CORPORATION is, as it is hereby, REJECTED.

Let the filewrapper of trademark CAMEL & REPRESENTATION THEREOF subject matter of this case be forwarded to the Administrative, Financial and Human Resource Development Bureau for appropriate action in accordance with this DECISION with a copy furnished the Bureau of Trademarks for information and update of its records.

SO ORDERED.

Makati City, 28 December 1998

ESTRELLITA BELTRAN-ABELARDO
Caretaker/Officer-In-Charge