

GREAT EASTERN RESINS  
INDUSTRIAL CO., LTD.,  
Opposer,

- versus -

INTER PARTES CASE NO. 3510

OPPOSITION TO:

Application Serial No. 65982

Filed : October 14, 1988

Applicant : Topformer  
Corporation

Trademark : GRECO

Goods : Industrial  
adhesives

TOPFORMER CORPORATION  
Respondent-Applicant

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DECISION NO. 90-46 (TM)  
December 27, 1990

### DECISION

On January 11, 1990, Great Eastern Resins Industrial Co, Ltd. a Corp duly organized and existing under the laws of Taiwan Republic of China, with address at 88-8, Taichung Kang Road, 3rd Section, Taichung, Taiwan, Republic of China, filed its verified Notice of Opposition (Inter Partes Case No. 3516) to Application Serial No. 65982 for the trademark "GRECO" used on Industrial adhesives which application was filed on October 14, 1983 by Top Former Corporation, a domestic corporation with business address at 38 Sauyo Road, Bagbag, Novaliches Quezon City, which was published in the Official Gazette of the Bureau of Patents, Trademarks and Technology Transfer, Volume 11, No. 10, Page 2.

The grounds of the opposition are as follows:

- 1) The approval of the application in Question is contrary to Section 4, paragraph (d) of R.A. No. 166 as amended, as well as the provisions of the Paris Convention for the Protection of Industrial property;
- 2) Respondent-Applicant is not entitled to register the trademark "GRECO" in its favor at the time it filed its application;
- 3) The approval of the application in question will cause great and irreparable damage and injury to herein Opposer.

Opposer relied on the following facts to support its opposition:

- 1) Applicant's trademark "GRECO" is identical or at the very least, confusingly similar to the trademarks "GRECO and G with A Globe Device Inside" of Opposer which it adopted and has been using since 1955. First, in Taiwan including the Philippines for all kinds of adhesives and other related goods;
- 2) That opposer's trademarks "GRECO and G with A. Globe Device Inside" are internationally and/or world-famous as they have been used and are known in and registered in many countries in favor of opposer;
- 3) That the trademarks "GRECO and G with A Globe Device Inside" have acquired extensive and substantial goodwill and reputation through long and continued use thereof by opposer, both as a trademark and as a trade-name;
- 4) That on the other hand, Respondent-Applicant had never used the trademark "GRECO" as its own trademark whether at the time or before the filing of the application in question;

- 5) That Respondent-Applicant was guilty of fraud in filing the application in question and in stating therein under oath that it believes itself to be the owner of the trademark "GRECO" knowing fully well that said trademark belongs to herein opposer;
- 6) That the registration of the trademark "GRECO" in the name of the applicant will cause great and irreparable damage and injury to herein opposer;

For failure to file an Answer, and upon opposer's motion, Respondent-Applicant was declared in default. Accordingly, Opposer was allowed to present its evidence ex-parte (ORDER NO. 90-219).

The issue to be resolved is:

I. Whether or not the trademark "GRECO" applied for registration by the Respondent under Application Serial No. 65982 is confusingly similar to the trademark "GRECO" owned by the oppose.

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

*"SEC. 4. Registration of trademarks, trade-names and service marks the principal register. - There is hereby established a register of trade-marks, trade-names and service marks which shall be known as the Principal Register. The owner of a trademark, tradenames and servicemark 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 trade-name 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"

As gathered from the evidences offered Respondent-Applicant-s trademark "GRECO" is identical to Opposer's trademark "GRECO and G with A Globe Device Inside" in spelling, sound and appearance. The only difference is the presence of G with A Globe Device Inside. Both parties' goods belong to the same class (class 1) and therefore flow through the same channels of trade, hence, there is factual basis to hold that Respondent-Applicant's trademark is confusingly similar with Opposer's trademark.

Opposers trademark "GRECO" has been registered in Taiwan, republic of China since November 16, 1979 under Regn- No. 123862 (Exh. "E") and likewise in three other Asean Countries namely Malaysia, Indonesia and Thailand as early as 1979 (Exhs. "F", "G" and "H"); used in the Philippines as early as January 2, 1955 (Exh. "I").

It must be pointed out that opposer has been exporting goods to the Philippines bearing the trademark "GRECO" Export documents consisting of sales invoices and packing lists showing sales by opposer of "GRECO" adhesives and other related products to various Philippine consignees have been offered and marked as Exhs. "J", "J-1", "J-2", "J-3", "K" and "K-1".

In-view of the foregoing circumstances it has been established that opposer is actually using the trademark "GRECO" on its adhesive products not only in the Philippines but also in foreign countries and as such, pursuant to Section 2-A of R.A. No. 166 as amended, considered the owner of the trademark "GRECO".

It may also be stated that Respondent-Applicant exerted no effort to defend its rights in this case. In fact, Respondent did not file its Answer to this opposition, hence, it was declared in default.

WHEREFORE, premises considered, herein Notice of Opposition is hereby SUSTAINED. Accordingly, Respondent's Application Serial No- 65982 for the trademark "GRECO" is hereby REJECTED.

Let the records of this case be transmitted to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO  
Director