

NABISCO, INC.,
Opposer,

INTER PARTES CASE NO. 2035

OPPOSITION TO:

Appln. Serial No. 51426
Filed : June 11, 1983
Applicant : Mansion Biscuits
Corporation
Trademark : NABISCO
Used on : Biscuits, cookies and
Wafers

- versus -

MANSION BISCUITS CORP.,
Respondent-Applicant.
x-----x

DECISION NO. 88-31 (TM)
June 10, 1988

DECISION

Nabisco, Inc. filed on January 20, 1987 its Unverified Opposition to the registration of the trademark "MABISCO" for biscuits, cookies and wafer was applied for on June 11, 1983 by the Mansion Biscuits Corp. under Application Serial No. 51426, published on Page 195 of the Supplement to the Official Gazette dated February 3, 1986 and released for circulation on December 23, 1986.

Opposer is a foreign corporation organized and existing under the laws of the State of New Jersey, U.S.A. with office at East Hanover, New Jersey 07956, U.S.A. while Respondent-Applicant is a domestic corporation domiciled and doing business at 770 Pasolo Street, Valenzuela, Manila, Philippines.

Opposer filed its Verified opposition to the herein subject mark on March 24, 1987 on the ground that:

- “1. Opposer is the owner of the trademark NABISCO used on biscuits, crackers, wafers, bread, cereals, cake, pastries, confectioneries and related foods:
2. Said trademark has been used by Opposer in trade and commerce world-wide, and in the Philippines it has been used in trade and commerce since 1930;
3. By reason of the long adoption and use of the trademark NABISCO in the Philippines and in other foreign countries in connection with quality goods belonging to Class 30, the said mark has acquired goodwill and a high business reputation;
4. The Philippine Patent Office has issued, in the name of Nabisco, Inc. a Certificate of Trademark Registration for NABISCO mark as early as January 7, 1930 under Reg. No. 9911; and on April 28, 1960 the said mark was re-registered bearing Reg. No. 51. Subsequently on November 4, 1982, the Philippine Patent Office issued a renewal Reg. No. 2918 in favor of Nabisco, Inc. for the trademark NABISCO covering class 30. x x
5. Respondent-Applicant's application for the registration of MABISCO in connection with biscuits, cookies. and wafers, if granted will damage Opposer because the similarity and closeness of the appearance as well as the sound of the two marks and the fact that Respondent-Applicant's MABISCO will be used in connection with exactly the same good in connection with which Opposer's trademark is used; the close similarity

between the parties' mark will also cause confusion and deception upon the buying public who will mistake the Respondent-Applicant's goods as one belonging or originating from Opposer;

6. NABISCO constitute Opposer's most important mark and serves as a house mark for almost all its products now being marketed worldwide;

7. Opposer holds in its favor Certificates of Registration issued by different countries in various parts of the world;

8. Any registration, adoption or use of the mark MABISCO as it appears in the mark subject of opposition will be contrary to Section 4 of Rep. Act No. 166, as amended x x x."

On May 26, 1987, the Office sent a Notice to the Respondent-Applicant to file its Answer within fifteen (15) days from receipt thereof.

For failure of the Respondent-Applicant to file its Answer within the fifteen-day period allowed by the Rules from receipt of the Notice, the Opposer filed on August 24, 1987 a Very Urgent Motion to declare the Respondent-Applicant in default.

Having verified from the records that the Respondent-Applicant had received the Notice to answer on June 2, 1987 and failed to file its Answer up to now despite the lapse of more than 80 days from receipt thereof, the Opposer's motion was granted and declared Respondent in default. The Opposer was allowed to present its evidence ex-parte on September 4, 1987.

During the hearing of September 24, 1987, Opposer presented its voluminous evidence (Exhs. "A" to "O"). Thereafter, counsel for the Opposer rested her case and was given thirty (30) days therefrom to submit her Formal Offer of Evidence.

On October 21, 1987, the Opposer's counsel submitted her Formal Offer of Evidence consisting of documentary exhibits showing that the legal counsel herein has been duly authorized to represent the Opposer in this case (Exhs., "A" and "B"); that Opposer is a holder of Certificate of Registration No. R-2918 for the mark NABISCO used on biscuits and was re-registered on November 4, 1982 (Exhs. "P", "P-1" and "P-1-a") which has been continuously renewed since January 7, 1930 and in respect of which an Affidavit of Use therefor was filed on March 20, 1985 (Exh. "P-2"); that Opposer also submitted evidence that its trademark "NABISCO" with respect to biscuits, crackers, cookies, wafers and similar bakery goods is internationally known and is a registered owner thereof in several countries, such as Brazil (Exhs. "C" and "C-1"); Chile (Exhs. "C-2" to "C-6"); France (Exh. C-7"); Haiti (Exh. "C-8"); Indonesia (Exh. "C-9"); Italy (Exh. "G-10"); New Zealand (Exh. "C-11"); Portugal (Exh. "G-12"), South Africa (Exhs. "C-13" and "C-14"); U.S.A. (Exh. "C-15") and London, England (Exh. "C-16") and 308 additional registrations and applications in different places (Exh. "D"), that the products bearing the trade-mark "NABISCO" have been extensively advertized and promoted to enhance the mark's goodwill involving large amounts of expenses (Exhs. "E" to "O").

The issue to be resolved is whether or not the Respondent-Applicant's trademark "MABISCO" should be granted registration under Section 4(d) of Republic Act No, 166 when it so resembles the Opposer 's mark , "NABISCO".

The ultimate issue to be resolved is the existence or non-existence of "confusing similarity" between the two marks - Respondent's "MABISCO" and Opposer's "NABISCO"

Opposer claims that the two competing marks are almost identical in sound (idem sonans) and appearance. The Office further observes that they are also almost similar in pronunciation and spelling. Their only difference is in the first letters: M for the Respondent, and N for the Opposer -- all the rest "ABISCO" are exactly identical.

The two marks are also used on identical products -- cookies, biscuits and wafer (Respondent's Application Serial No. 51426); biscuits, crackers, wafers, bread, cereals, cakes, pastries, confectioneries, etc- (Exhs. "E-1", "F-1", "G", "H", "I", "K", "L" and "M") -- which would cause the likelihood of confusion, mistake or deception as to the source or origin of the goods in the mind of the purchasing public.

Based on the foregoing circumstances, the Office agrees with the Opposer that the Respondent's mark "MABISCO" is confusingly similar to the Opposer's mark "NABISCO", as has been ruled in a similar case by the Supreme Court:

"x x x that whether or not a trademark causes confusion and is likely to deceive the public is a question of fact which is to be resolved by applying the test of dominancy, meaning if the competing trade-mark contains the main or essential or dominant features of another by reason of which confusion and deception are likely to result, then infringement takes place, that duplication or imitation is not necessary or similarity in the dominant feature of the trademark would be sufficient," (Co Tiong Sa vs. Director of Patents, 1954, 95 Phil. 1; Alhambra Cigar & Cigarettes vs. Mojica, 27 Phil 266).

The Court held in *Chuanchow Soy & Canning. Co. vs. Director of Patents*, L-13947, June 30, 1960, which was reiterated in the case of *Lim Hoa vs. Director of Patents*, 100 Phil. 214 thus;

"When one applies for the registration of a trademark or label which is almost the same or closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered trademark, this is not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill."

It may also be stated that the 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 GRANTED. Accordingly, Respondent's Application Serial No. 51426 for the trademark "MABISCO" is hereby REJECTED.

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

SO ORDERED.

IGNACIO S. SAPALO
Director