

NBA PROPERTIES, INC.
Opposer,

INTER PARTES CASE NO. 3647
Opposition to:

- versus-

Appln. Serial No. 45212
Filed: 24 June 1981
Trademark: "CELTICS"
Used on: Footwear, shoes and
sandals for men and women
and children, pants, caps
socks, leather bags, sports
bags & towel shirts.

PARAMOUNT VINYL PRODUCTS
CORPORATION,
Respondent-Registrant.
X-----X

DECISION NO. 97-14

DECISION

This case pertains to an Opposition filed by NBA Properties, Inc., a U.S. Corporation with principal address at Olympic Tower, 645 Fifth Avenue New York, New York 10022, United States of America, to the application for registration of the trademark CELTICS for footwear, shoes and sandals for men, women and children; pants, caps, socks, leather bags, sports bags and towels; shirts, in classes 18, 24, 25, & 28 under Serial No. 45212 filed on 24 June 1981 by Paramount Vinyl Products Corporation, which was published on page 217 of the Official Gazette No. 6, Volume III and officially released for circulation on 31 December, 1990.

The grounds for Opposition are as follows:

"1. The mark CELTICS under Serial No. 45212 of respondent-applicant is confusingly similar to Opposer's trademark BOSTON CELTICS which the opposer owns and has not abandoned.

"2. The Opposer will be damaged and prejudiced by the registration of the mark CELTICS in the name of Respondent-Applicant and its business reputation and goodwill will suffer great and irreparable injury.

"3. Respondent-Applicant's use of the mark CELTICS for footweares, shoes, and sandals, for men, women and children, pants, cans, socks, leather bags, sports, hags and towels, shirts in classes 18, 24, 25 and 28 is identical to the trademarks owned and used by Opposer, and hence, constitutes an unlawful appropriation of a trademark owned and currently used by opposer."

To support its Opposition, Opposer relied upon the following facts:

"1. The trademark CELTICS of Respondent-Applicant is confusingly similar to Opposer's mark BOSTON CELTICS as to be likely, when applied to the goods, or when used in connection with the goods and services of Respondent-Applicant, to cause confusion or to mislead consumers as to the actual source or origin of the goods of Respondent-Applicant and falsely suggests a connection between Respondent-Applicant's mark and Opposer's world-famous mark.

"2. Opposer's trademark BOSTON CELTICS has long been established and has obtained general international consumer recognition and goodwill as belonging to one owner or origin, the Opposer herein.

"3. Opposer's BOSTON CELTICS mark is well known throughout the world and in the Philippines and said mark has become distinctive of Opposer's goods and business.

“4. Opposer is the owner of the symbol of the National Basketball Association and individual NBA team symbols including name, symbols, colors, insignia and any designs/logos relating thereto which includes the mark BOSTON CELTICS.

“5. The allowance of the trademark Serial No. 45212 will be violative of the treaty obligation of the Philippines under the Paris Convention for the Protection of Industrial Property, to which the Philippines and the United States of America are parties.

The Notice to Answer was sent by registered mail with return card to herein Respondent-Applicant on 7 May 1991, which was received by the latter on 13 May 1991.

In Order No. 91-736 dated 3 September 1991 the above case was dismissed for failure of the Opposer to prosecute and likewise, for failure to answer on the part of Respondent-Applicant for an unreasonable length of time.

However, on 18 September 1991, a Motion for Reconsideration with Prayer to Declare Respondent-Applicant In Default was filed by Opposer thru Counsel which motion was granted per Resolution No. 91-18, dated 22 October 1991, lifting and setting aside Order No. 91-736.

Subsequently, on 29 June 1992, herein Opposer filed its Formal Offer of Evidence and submitted the following Exhibits which were admitted in evidence per Order No. 92524 dated 13 July 1992:

EXH.	NATURE	PURPOSE
“A”	Legalized and authenticated statement / affidavit with Annexes executed by the Opposer	To show Opposer's rights over the BOSTON CELTICS trademark and Opposer's opposition to the application for registration in the Philippines of the confusingly similar mark “CELTICS”
“A-1” & “A-2”	Pages showing Consular Legalization and authentication of the statement /affidavit Exh. “A”.	To show that the document had been duly authenticated by the Philippines Consulate and executed before the competent authorities in the place of execution
“A-3” & “A-11”	Copies of Registrations in various countries worldwide of Opposer's trademark “BOSTON CELTICS” annexed to and forming integral part of Opposer's statement/affidavit Exh. “A”.	To show that Opposer's trademark “BOSTON CELTICS” is a world-renowned mark registered in various intellectual property offices of a number of countries in the world.
“B”	Certificate of Copyright Registration No. 04957 issued by the National Library of the mark “BOSTON CELTICS”	To show that the mark BOSTON CELTICS is duly protected by copyright in the Philippines
“C”	Schedule of televised games of NBA in the Philippines	To show that games of NBA and the BOSTON CELTICS team has been shown and widely broadcast by television in the Philippines
“D” and submarkings	Official Merchandise Catalog of Opposer	To show the various articles on which the mark “BOSTON CELTICS” is being used

		and further to show that respondent-applicant uses the mark CELTICS on similar goods or goods in the natural area of expansion of Opposer's activities
"E"	Respondent-Applicant's mark as published in the Official Gazette of the Bureau of Patents, Trademarks and Technology Transfer	To show the appearance of the applicant's mark and the goods on which applicant uses the mark as confusingly similar to Opposer's mark

The Opposer's memorandum was filed on 21 September 1992 thereby submitting the above case for decision.

The main issue to be resolved in this case is "Whether or not Respondent-Applicant's trademark CELTICS used on footwear, shoes and sandals for men, women and children, pants, caps, socks, leather bags, sports bags and towels, shirts in classes 18, 24, 25 & 28 is confusingly similar to that of Opposer's "BOSTON CELTICS" used on sporting goods and outfits such as caps, jackets, sweatshirts, sweat pants, towels, bags, mugs etc.

There is no doubt that the mark "CELTICS" of herein Respondent-applicant is confusingly similar to the mark "BOSTON CELTICS" of herein Opposer and the dominant and distinctive word in the two competing marks. As was held in the case of Co Tiong Sa vs. Director of Patents, (L-17901, October 29, 1965, 95 Phil. 1, 15 SCRA 150):

"The question of infringement should be determined by the test of dominancy. The dissimilarity in size, form and color of the label and the place where applied are not conclusive. If the competing label contains the trademark of another, and confusion or deception is likely to result, infringement take place, regardless of the fact that the accessories are dissimilar. Duplication or exact imitation is not necessary; nor is it necessary that the infringing label should suggest an effect to imitate"

Likewise in the case of Philippine Nut industry, Inc., vs. Standard Brands, Inc. 65 SCRA-575- the Supreme Court similarly held 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 trademark 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, a similarity in the dominant features of the trademarks would be sufficient".

Moreover, Respondent-Applicant's use of the mark CELTICS for footwear, shoes and sandals for men, women and children, pants, caps, socks, leather bags, sports bags and towels, shirts under classes 18, 24, 25 & 28 which is almost identical or substantially similar to the mark BOSTON CELTICS owned and used on various articles shown in the latter's Exhibit D and its submarkings i.e. sportswear such as jackets, caps, sweatshirts, undershirts, towels will cause confusion, deception or mistake to purchasers, hence, constitutes an unlawful; appropriation of the trademark BOSTON CELTICS owned and currently used by Opposer, and therefore contrary to the provisions of Section 4 of R.A. 166, as amended.

Section 4 of R.A. 166 expressly provides that:

"Section 4. Registration of trademarks, tradenames and service marks on the Principal Register. - The owner of a trademark, tradename or service mark used to distinguish his 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 goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers”.

The trademark BOSTON CELTICS of Opposer is almost identical to the trademark CELTICS of Respondent-Applicant and as shown by Exh. “D” and submarkings and Respondent's application of the mark CELTICS, the goods of the parties are also similar or related and are sold in the same channel of trade. Therefore, the simultaneous use of both mark by the two contending parties involved herein would be likely to cause confusion or mistake in the mind of the purchasing public as to the origin or source of the commodity, hence, Respondent-Applicant's application should never be allowed.

It is likewise note-worthy to emphasize at this point that Respondent-Applicant was declared in default in accordance Rule 169 of the Revised Rules of Practice in Trademark Cases and with the Rules of Court for his failure to file his Answer despite notice within the reglementary period, and upon motion of Counsel for the Opposer (Order No. 91-18 dated 22 October 1991).

In this regard, it was recently held by the Supreme Court in DELBROS HOTEL CORPORATION VS. IAC SCRA 533, 543) (1988), that ---

“Fundamentally, default orders are taken on the legal presumption that in falling to file answer the Defendant does not oppose the allegations and relief commanded in the complaint.” (Underscoring ours)

Therefore, this Office cannot help but notice the lack of concern and interest the Respondent-Applicant had shown in protecting the mark which is contrary to the norm that: a person takes ordinary care of his concern.” (Sec. 3 (d) Rule 131 of the Rules of Court)

WHEREFORE, premises considered, the above Opposition is, as it is hereby SUSTAINED. Accordingly, Application Serial No. 45212 filed by Paramount Vinyl Products Corporation for the registration of the trademark CELTICS is, as it is hereby, REJECTED.

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

SO ORDERED.

Makati City, November 6, 1997.

EMMA C. FRANCISCO
Director