

PACIFIC PAINTS & OIL
MFG. INC.,

Opposer,

INTER PARTES CASE NO. 3259

OPPOSITION TO:

Appln. Serial No. 57564
Filed : October 15, 1985
Applicant : Tiu Chiong King
Trademark : KING EAGLE
Used on : Latex, flat enamel,
exterior and interior
paints

- versus -

TIU CHIONG KING

Respondent-Applicant.

x-----x

Decision No. 88-113 (TM)
December 13, 1988

DECISION

Pacific Paints & Oil Mfg. Inc. filed on October 27, 1988 its Opposition to the registration of the trademark "KING EAGLE" with an eagle picture design for latex, flat enamel, exterior and interior paints applied for on October 15, 1985 by Tiu Chiong King in Application Serial No. 57564 published on Page 55 of the BPTTT Official Gazette, Volume I, No. 7 dated September 27, 1988 but was released for circulation on September 30, 1988.

Opposer is a corporation duly organized and existing in accordance with Philippine laws with principal office at 292 D. Tuazon, Quezon City; while Respondent-Applicant is a Filipino citizen doing business under the business name "King Master Industries", with business address at 1339 Alvarado Extension, Tondo, Manila.

The grounds alleged in the Notice of Opposition are:

"1. The Opposer is the Licensee of Walter N. Boysen Co., a Delaware corporation of the United States engaged in the manufacture of paints and is the exclusive owner and has the exclusive right and title to the use of the trademark Boysen widely known in the United States of America for its paints and related products x x x.

2. That Opposer, as Licensee, has the privileged of manufacturing paints pursuant to approved formulation and using on the products the following trademark:

The word Boysen on top of an eagle whose wings are spread wide with the head of the eagle lower than the upper edge of the two spread wings more or less forming a straight line, looking towards the left, and has been adopted and used in actual trade and commerce in the Philippines since 1960 much ahead than that of the applicant-respondent's use of its trademark which it claims to be in use since January 2, 1983 only.

3. That the trademark of applicant-respondent is very much similar to the above described trademark of the Opposer especially in the posture of the eagle.

4. That x x x the use and registration of applicant-respondent's trademark is for reaping benefits from the popularity and wide acceptance by the public of the Opposer's trademark.

5. That the use and registration of applicant-respondent's trademark is undoubtedly a violation of Opposer's proprietary rights over its trademark.

6. That the use of the applicant-respondent's trademark will most likely cause, as it is actually causing confusion, mistake and deception to the buying public as it creates the impression that it is associated or manufactured by the Opposer and the public is likely to believe that applicant-respondent's products are that of the Opposer's x x x"

Respondent-Applicant, on November 11, 1988, was sent a Notice to Answer this Notice of Opposition within fifteen (15) days from receipt thereof. Instead of filing its Answer, Respondent-Applicant wrote a letter dated November 19, 1988 addressed to the Opposer proposing an amicable settlement of the herein case on the following terms and conditions:

- (a) Respondent-Applicant will not use the "EAGLE (BIRD) TRADEMARK" any longer but will use the word trademark "KING EAGLE" only, without the "Eagle picture";
- (b) Respondent-Applicant is allowed to dispose of its current stock of:
 - 1) 180 cartons (720 cans) of 4 liters latex paint;
 - 2) 80 cartons (960 cans) of 1 liter latex paints; and
 - 3) 15,000 pieces of unused labels (gallon and quart)

The foregoing proposed terms and conditions were accepted by the Opposer. Thus, on December 1, 1988, counsel filed a Manifestation stating "that it is withdrawing its Opposition to the application of Respondent-Applicant on condition that the 'KING EAGLE' only without the 'Eagle Picture' as proposed by Respondent's letter to the Opposer, hereto attached as Annex A" be given due course.

WHEREFORE, the herein Notice of Opposition is DISMISSED. Accordingly, Respondent's Application Serial No. 57564 for the word mark "KING EAGLE" only without the eagle picture and further subject to the above terms and conditions agreed upon by the parties shall be given due course.

Let the records of this case be forwarded to the Application, Issuance & Publication Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director