

STAR-KIST FOODS, INC.,
Opposer,

INTER PARTES CASE NO. 3156
Opposition to:

- versus -

Trademark: STAR-KIST

SNACKLINE MANUFACTURING CO.,
Respondent- Applicant.
X-----X

DECISION NO. 89-81 (TM)

DECISION

On July 14, 1988, STAR-KIST FOODS, INC. filed an unverified Notice of Opposition against the registration of the trademark "STAR-KIST" used on cheese curls, applied for by SNACKLINE MANUFACTURING CO. on September 17, 1985 under Application Serial No. 57389 published on page 139, Volume I, No. 4 of the BPTTT Official Gazette dated and released for circulation on June 17, 1988.

Opposer is a foreign corporation organized under the laws of the State of California, United States of America, with business address at 180 East Ocean Boulevard, Long Beach, California 90802, U.S.A., while Respondent-Applicant is a partnership duly registered with the Securities and Exchange Commission, with business address at O. Llanado Subdivision, Karuhatan, Valenzuela, Metro Manila.

The grounds alleged in the opposition are:

1. Opposer is the owner of the trademark STAR-KIST for canned tuna fish, canned tuna and noodles, frozen seafood product, namely pies, langostinos, lobster Newburg, tuna casserole and frozen fish, registered under Certificate of Registration No. 16494, issued on May 11, 1971 by the Philippine Patent Office.
2. On September 17, 1985, Respondent-Applicant filed with the Patent Office an application for registration of the mark STAR-KIST for cheese curls under Application Serial No. 57389 and said application was duly published in the Official Gazette, as aforementioned.
3. The registration of the trademark STAR-KIST in the name of Respondent-Applicant is in violation of and runs counter to Section 4(d) of Republic Act 166, as amended, because it is confusingly similar to the trademark of the Opposer Star-Kist Foods, Inc. as registered and previously used in the Philippines as to be likely, when applied to or used in connection with the goods of Respondent-Applicant, to cause confusion or mistake or deception to the purchasing public.
4. Opposer believes and therefore alleges that the registration of the mark STAR-KIST in the name of Respondent-Applicant will cause irreparable injury and damage to herein Opposer, pursuant to Section 8 of Republic Act No. 166, as amended.

On September 15, 1988, Respondent-Applicant was notified of this opposition and was required to file its Answer thereto within fifteen (15) days from receipt of said notice.

For failure to file its Answer, Respondent-Applicant was declared in default in Order No. 88-488 dated November 10, 1988 and Opposer was allowed to present its evidence ex-parte.

On February 1, 1989 Opposer presented its evidence ex-parte, consisting of Exhibits "A" to "D", inclusive, which were formally offered in writing on July 13, 1989 and admitted in evidence for the opposer in Order No. 89-510 dated July 17, 1989.

Since the Respondent's mark STAR-KIST is identical to that of the Opposer's, the issue to be resolved is: which of the parties is the first adopter, user and owner of the mark "STAR-KIST" in contest.

Opposer presented Certificate of Registration No. 16494 (Exh. "B-1") issued in the name of STAR-KIST FOODS, INC. on May 11, 1971, which has been applied for since February 19, 1969; indicating therein that Opposer first used the mark on November 20, 1958 and first used it in commerce in the Philippine on November 8, 1968 (Exh. B-3); that Opposer has in its favor/ predecessor 12 Certificates of Registration of the mark STAR-KIST in its home country dating as far back on May 13, 1940 (Exhs. C-1, C-2, C-3 to C-12); and that Opposer has sold more than \$500 million worth of its products per year bearing the mark STAR-KIST in various countries of the world (Exh. D).

From the above exhibits, Opposer has shown adequate proofs that it is the first and original user/owner of the mark STAR-KIST in its home country and even here in the Philippines. Respondent declared in its application that its first use of the mark STAR-KIST was on February 15, 1982 while the Opposer has filed its application for the use of the subject mark in the Philippines on February 19, 1969 and ripened into registration on May 11, 1971 (supra).

Respondent-Applicant neglected to follow-up its application, know the status of such application, comply with the processes of this Bureau, and to inform the Bureau of any change of address or other vital information relative and relevant to its person and its pending application, as required by Rule 85 of the Rules of Practice in Trademark Cases. For such neglect, Respondent is hereby presumed to have lost interest in the prosecution of its contested application.

WHEREFORE, herein Notice of Opposition is SUSTAINED. Respondent's Application Serial No. 57389 is hereby declared deemed ABANDONED.

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

SO ORDERED.

Makati, Metro Manila, October 23, 1989.

IGNACIO S. SAPALO
Director