

TIFFANY AND COMPANY  
Opposer,

-versus-

DEWEY CHOACHUY,  
Respondent-Applicant.

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IPC No. 14-2003-00004  
Opposition to:

Appln. Ser. No. 4-2000-00530  
Date Filed: 01-25-00  
TM: "TIFFANY"

Decision No. 2005-27

## DECISION

The instant case is an opposition filed by Tiffany and Company (Opposer) a corporation duly organized under the laws of New York, USA with offices at 727 Fifth Avenue, City and State of New York, USA against Application Serial No. 4-2000-000530 filed on January 25, 2000 for the registration of the trademark Tiffany for pillow, foam, mattress, spring mattress, cushions, spring bed, sofa bed, beddings, filed by herein Respondent-Applicant, Dewey Choachuy of Mandaue City, Philippines.

The application was published in page 45, Vol. V, No. 13 of the Official Gazette, which was officially released for circulation on January 8, 2003.

On February 12, 2003, a Verified Opposition to Application Serial No. 4-2000-00530 was filed before this Office by Opposer's counsel.

The grounds for opposition of the registration of the mark are as follows:

- "1. The trademark TIFFANY so resembles Opposer's well known trademark TIFFANY, which has been previously used in commerce and registered in the United States of America and other parts of the word including the Philippines, and not abandoned, as to be likely, when applied to or used in connection with the goods of Applicant, to cause confusion, mistake and deception on the part of the purchasing public.
- "2. The registration of the trademark TIFFANY in the name of the Applicant will violate Secs. 123.1 (f) and 147.2 of Republic Act No. 8293, Section 6bis of the Paris Convention for the protection of Industrial Property and article 16 (2) of the Agreement on Trade Related aspects of Intellectual Rights to which the Philippines and the United States are parties.
- "3. The registration by Applicant of the trademark TIFFANY will diminish the distinctiveness and dilute the goodwill of Opposer's trademarks TIFFANY and TIFFANY & CO., which have been registered, approved and/or applied for registrations in various classes of goods with the Bureau of Trademarks.
- "4. The registration by Applicant of the trademark TIFFANY will amount to an infringement of Opposer's tradename TIFFANY & CO., which is protected under the Paris Convention "without the obligation of filing or registration", and under section 165 of R.A. 8293 "even prior to or without registration."
- "5. The registration of the trademark TIFFANY in the name of the Applicant is contrary to other provisions of the aforementioned international agreements and R.A. 8293.

To support its opposition, Opposer relies on the following facts:

- “1. Opposer is manufacturer and seller of luxury goods bearing the trademarks TIFFANY and TIFFANY & CO., Opposer has marketed and sold these goods in many countries worldwide. Opposer has been commercially using the trademarks TIFFANY and TIFFANY & CO., domestically and internationally prior to the use of TIUFFANY by applicant.
- “2. Opposer is the owner of trademarks TIFFANY and TIFFANY & CO. which has been registered in its name and used worldwide.
- “3. In the Philippines, Opposer is the first user and owner of the trademarks TIFFANY and TIFFANY & CO., under the following registrations, approved applications and/or pending applications for the specific classes of goods:

Regn/Appln. No.	Mark	Date	Class
61471	TIFFANY	August 22, 1995	3
85344	TIFFANY & Co.	April 7, 1993	14
114365	TIFFANY & CO.	September 27, 1996	16
114364	TIFFANY & CO.	September 27, 1996	8
114368	TIFFANY & CO.	September 27, 1996	25
114366	TIFFANY & CO.	September 27, 1996	18
114367	TIFFANY & CO.	September 27, 1996	21

A copy of Opposer’s Registration No. 61471 for TIFFANY dated August 22, 1995 is hereto attached and made part hereof as Annex “A”.

- “4. Opposer is known as a source of luxury goods of all kinds bearing the trademarks TIFFANY and TIFFANY & CO. Applicant’s unauthorized appropriation and use of the mark TIFFANY on goods in Class 20 is likely to damage Opposer’s goodwill to the well-known marks TIFFANY and TIFFANY & CO., and preclude Opposer’s use of its mark to goods in Class 20, which are within the natural expansion of Opposer’s business.
- “5. Opposer is the first user of the trademarks TIFFANY and TIFFANY & CO. for various classes of goods which Opposer has sold and marketed in various countries worldwide.
- “6. By virtue of Opposer’s prior and continued use of TIFFANY both as a trademark and tradename in many countries of the world, said trademark and tradename have become popular and internationally well-known for luxury goods, and recognized as such by courts or administrative bodies in the United States, South Korea, Taiwan, People’s Republic of China and other countries. They have established valuable goodwill for Opposer among consumers who have identified oppose as the source of luxury goods bearing the said trademark and tradename, including baby gifts, picture frames, candle sticks, vases, as well as jewelry, and other luxury goods for the home.
- “7. Applicant appropriated Opposer’s world famous mark TIFFANY and used in on his products to ride on its renown and falsely suggest and association or connection with Opposer. This is likely to damage Opposer’s interest by preventing its use of its well known trademark on other goods that are within the natural zone of expansion of its business.

- “8. The registration and use of an identical trademark by Applicant will diminish the distinctiveness and dilute the goodwill of Opposer’s above trademark and tradename.

Immediately, a Notice to Answer to the Verified Notice of Opposition dated March 10, 2003 was sent to herein Respondent-Applicant. However, for failure to file the required Answer to the Verified Notice of Opposition despite notice thereof, Respondent-Applicant was declared in DEFAULT per Order NO. 2003-391 dated September 24, 2003.

Pursuant to Order of Default, Opposer presented its evidence ex-parte. Opposer submitted its Formal Offer of Evidence consisting of Exhibits 1 to 29 inclusive of sub-markings, which are admitted by this Office as evidence for the Opposer (Order No. 2004-530 dated September 9, 2004.)

The issues to be resolved in this case are:

- A. WHETHER OR NOT OPPOSER’S MARK “TIFFANY” IS AN INTERNATIONALLY WELL-KNOWN MARK AND THEREFORE ENTITLED TO BROAD PROTECTION UNDER SEC. 123 (F), 147 OF THE INTELLECTUAL PROPERTY CODE OF THE PHILIPPINES, AND ART. 6bis OF THE PARIS CONVENTION.
- B. IS PUBLIC CONFUSION AS TO THE ORIGIN OF THE PARTIES’ GOODS LIKELY TO RESULT FROM THE CONCURRENT USE BY THE PARTIES OF THE TIFFANY TRADEMARK?

The Opposer argues that its mark “TIFFANY” is a well-known mark, which deserves protection as a consequence of our adherence to the Paris Convention. In support of its position, it submitted various certificate of registrations in many countries of the world (Exhibit 19-A to 19-L) including the Philippines, as well as various publications, articles, advertisements and clippings. We do not agree with the argument under the prevailing standards and criteria.

Under the Memorandum of the Minister Luis R. Villafuerte dated 20 November 1980, directing the Director of the Philippine Patent Office to reject all the pending registration of signature and other world famous trademarks by applicant other than its original owner’s or users of the trademarks are enumerated therein, Opposer’s trademark is not one of them.

Likewise, under the Memorandum of the then Minister of Trade and Industry Roberto Ongpin dated October 25, 1983, it laid down the guidelines of implement Article 6bis of the Paris Convention as follows:

- “a.) The mark must be internationally well-known;  
“b.) The subject of the right must be a trademark, not a patent or copyright or anything else;  
“c.) The mark must for use in the same or similar class of goods; and  
“d.) The person claiming must be the owner of the mark.”

Even if “TIFFANY” is a well-known mark, thus deserves a broader scope of protection (see KINNER PARKER TOYS, INC. VS. ROSE ART INDUSTRIES, INC., USPQ 1453 [Fed. Cir. 1992]), such broader scope of protection may be invoked only when the mark is used for identical or similar goods by another which creates confusion pursuant to Article 6bis of the Paris Convention.

As shown by the records, the herein Opposer is using the mark TIFFANY in the Philippines for products belonging to classes 3, 8, 14, 16, 21 and 25 while the Respondent-Applicant is using the mark TIFFANY only for goods falling under the Class 20. Thus, Opposer failed to comply with the third requirement of the Memorandum above stated, that the mark must be used on the same or similar goods.

From the evidence presented, the registrations and/or pending applications of the "TIFFANY" mark in the Philippines falls under Classes 3, 8, 14, 16, 18, 21, 25 of the International Classification of Goods (Exh. 22-A to 22-D), Opposer has no registration for goods under Class 20 for the goods namely: pillow, foam, mattress, spring mattress, cushions, beds, etc. Thus, mistake or deception upon purchasers is nil as the products of the contending trademarks are entirely distinct and different from each other hence, confusion is not present.

In the case of PHIL. REFINING CO., INC. VS. SAM (115 SCRA 472), the Supreme Court stated:

"The right to a trademark is limited one, in the sense that others may use the same mark on unrelated goods. The mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description."

This was reiterated in the case of FABERGE, INCORPORATED VS. INTERMEDIATE APPELLATE COURT (215 SCRA 316):

"One who has adopted and used trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description. xxx The certificate of registration issued by the Director of Patents confer upon the Petitioner the exclusive right to use its own symbol only on those goods specified in the Certificate, subject to any condition and limitation stated therein."

Likewise, in CANON KABUSHIKI KAISHA VS. CA AND NSR RUBER CORP. (GR NO. 120900 promulgated on July 20, 2000), the Supreme Court again rules that the certificate of registration confers upon the trademark owner the exclusive right to use its own symbol only to those goods specified in the certificate.

Moreover, the Opposer was not able to prove that the use of the mark in relation to Respondent-Applicant's products would indicate a connection to Opposer's goods or services, an essential requirement under Section 123, 123.1 and 123(f) of R.A. 8293, to wit:

"Sec. 123. Registrability. 123.1 A mark cannot be registered if it:

"123(f) is identical with, or confusingly similar to, or constitute a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, that the use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark; Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use." (Underscoring provided)

WHEREFORE, in view of the foregoing, the Notice of Opposition filed by the Opposer is, as it is hereby DENIED.

Considering however that, as shown by the records, Respondent-Applicant despite due notice failed to file its Answer to the Notice of Opposition nor filed any motion to lift the Order of default, such act of Respondent-Applicant is indicative of his lack of interest in his application, thus he is deemed to have abandoned the same.

Furthermore, under Rule 602 of the Rules and Regulations on Trademarks, Service marks, Trade Names and marked of Stamped Containers, the law imposes upon the Respondent-Applicant the duty to look after his own interest in the prosecution of his application.

On the contrary, the applicant in this case appears to have no interest in defending his application, which is the subject of this Notice of Opposition.

IN VIEW THEREOF, Application Serial No. 4-2000-00530 for the mark "TIFFANY" used for pillow, foam, mattress, spring mattress, cushions, spring bed, sofa bed, beddings under Class 20 filed on January 25, 2000 by Respondent-Applicant, DEWEY CHOACHUY is hereby considered ABANDONED by Respondent due to his lack of interest to prosecute subject application.

Let the file wrapper subject matter of this case be forwarded to the Administrative, Financial, Human Resources Development Services Bureau (AFHRDSB) for appropriate action in accordance with this decision a copy furnished the Bureau of Trademarks (BOT) for information and update of its records.

SO ORDERED.

Makati City, December 23, 2005.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs