

TWENTIETH CENTURY FOX FILM,
Opposer,

INTER PARTES CASE NO. 4013
Opposition to:

-versus-

Serial No.: 81825
Date Filed: August 3, 1992
Trademark: "SIMPSONS"

JOAQUIN S. LAO,
Respondent-Applicant.

DECISION NO. 98-02

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DECISION

TWENTIETH CENTURY FOX FILM, the herein Opposer is a foreign corporation, duly organized and existing under the laws of the State of California, with offices at Box 990, Beverly Hills, California 90213, U.S.A.

The Respondent-Applicant in this particular case is JOAQUIN S. LAO, a Filipino citizen, with address at 2343 Colayco Street, Pasay City, Metro Manila and doing business under NELTEX PLASTIC MANUFACTURING.

On May 27, 1994, the herein Opposer commenced this instant Opposition proceedings in the matter of Application Serial No. 81825 for the registration of the trademark "SIMPSONS" for sanitary drinking straw under class 20, which application was published for opposition of page 81, Vol. VI, No. 6 of the Official Gazette of this Honorable Office and officially released for circulation on January 27, 1994.

The grounds for opposition are as follows:

- "1. The above trademark application was procured contrary to the provisions of Sec. 4(d) of Republic Act. No. 166, as amended: and
- "2. The approval of the above application will cause grave and irreparable damage and injury to herein opposer.

Opposer relied on the following facts to support its opposition.

- "1. Opposer produces and distributes a popular television series entitled "The Simpsons" which features a family of animated characters.
- "2. In connection with "The Simpsons" televisions series, oppose has promoted, and continues to promote, an extensive worldwide merchandising campaign to popularize the aforementioned television series.
- "3. Opposer is the duly registered owner of the trademark "The Simpsons" and "The Simpsons" logo on various goods including, but not limited to, Class Nos. 2, 3, 5, 9, 10, 11, 14, 15, 16, 18, 20, 21, 24, 25, 27, 28, 29, 30, 32, 35, 39, 41 and 42.
- "4. Opposer has applied for and registered the aforementioned marks in various countries worldwide. Copies of Opposer's registrations in various countries for the above trademarks are attached herewith as Annex "A".
- "5. The Trademark "SIMPSONS" respondent-applicant seeks to register is identical to and/or confusingly similar with, Opposer's trademarks "The Simpsons and The Simpsons Logo".

- “6. The use and approval of respondent-applicant mark will cause confusion, mistake and deception to the buying public relative to the source and origin of respondent-applicant’s goods, the buying public will be made to erroneously believe that respondent-applicant’s goods came from, or was authorized by opposer.
- “7. The approval of respondent-applicant is violative of Sec. 4 (d) of Republic Act No. 166-A.
- “8. The approval of the subject application will cause irreparable damage and injury to opposer.

On June 13, 1995, this Bureau sent a Notice to Answer to Respondent-Applicant requiring him to file his Answer thereto within fifteen (15) days from receipt of the same which the applicant did not do. On August 28, 1995, Counsel of Opposer filed a motion praying that Respondent-Applicant be declared in default for his failure to his Answer.

ORDER NO. 95-611 has been issued by this Office declaring Respondent-Applicant as in DEFAULT for his failure to file his Answer within the reglementary period prescribed.

Pursuant to the Order of Default, Opposer presented its ex-parte evidence consisting of Exhibits “G”, “G-1” and “G-2” to “H”.

The main issue to be resolved in this particular case is whether or not Respondent-Applicant’s trademark “SIMPSONS” is confusingly similar to Opposer’s trademark “THE SIMPSONS & LOGO”.

With the enactment of R.A. 8293, otherwise known as the “Intellectual Property of Code of the Philippines” which took effect on January 01, 1998, the application for registration of the mark “Videorche and Design” should have been prosecuted under the new law (R.A. 8293)

However, this Office takes cognizance of the fact that the herein Application Serial No. 81825 was filed on August 03, 1992 when the new law was not yet in force. Section 235.2 of R.A. 8293, provides, inter alia that: “All applications for registrations of mark or trade names pending in the Bureau of Patents, Trademarks and Technology Transfer at the effective date of this Act may be amended, if practicable to bring them under the provision of this Act. x x x x x. If such amendment is not made, the prosecution if said application shall be PROCEEDED WITH and registration thereon granted in accordance with the ACTS UNDER WHICH SAID APPLICATIONS WERE FILED AND SAID ACTS REPEAL THEREOF.

Considering however, that this application subject of opposition proceeding has been filed under the Old Law and this case is now for resolution, thereby rendering impractical to so amend it in conformity with R.A. 8293 without adversely affecting right already acquired prior to the effectivity of the new law (Sec. 236, supra), this Office undertakes to resolve the case under the former law, R.A. 166 as amended, more particularly Section 4(d), which provided that:

“SEC.4. Registration of trademarks, trade names and service mark on the principal register. – there is hereby established a register of trademarks, trade names and service marks which shall be known as the principal register. The owner of a trademark, trade name or service mark used to distinguish his goods, business or services from the goods, business or services of other shall have the right to register the same on the principal register unless it:

- (d) Consists of or comprise a mark or trade name which so resembles a mark or trade name registered in the Philippines or a mark or trade name previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or service of the applicant, to cause confusion or mistake or to deceive consumers”.

Well settled is the rule that the determinative factor in a contest involving registration of trademarks is not whether the challenged mark would actually cause confusion or mistake on the part of the buying public. To constitute infringement, the law does not require that the competing trademarks be so identical as to produce actual error or mistake. It would be sufficient for that similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it (American Wire & Cable Co. vs. The Director of Patents, 31 SCRA 544)

Applying the principle or doctrine above-mentioned, the competing trademarks is confusingly similar to each other.

The Opposer’s trademarks “THE SIMPSONS” and “THE SIMPSONS LOGO” are registered in many countries of the world and presented by Opposer as Exhibits “B” to “B-45”:

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|---------------|------------------------------|
| 1. Argentina | 13. Japan |
| 2. Australia | 14. South Korea |
| 3. Benelux | 15. Mexico |
| 4. Brazil | 16. New Zealand |
| 5. Chile | 17. Singapore |
| 6. Finland | 18. South Africa |
| 7. France | 19. Spain |
| 8. Germany | 20. Sweden |
| 9. Greece | 21. Taiwan |
| 10. Hong Kong | 22. United Kingdom |
| 11. Ireland | 23. United States of America |
| 12. Italy | |

Likewise the same trademarks of Opposer have been advertising in the Philippines and being shown on Star TV and Radio Philippine Network, Channel 9 (Exhibit “E”)

Some worldwide titles, including those in the Philippines, which are licensed to sell goods bearing the subject marks of the Opposer related to “THE SIMPSONS” television series are being still shown which signify the actual and exclusive use in commerce and business of the herein Opposer.

Moreover, as shown by the evidence presented, the trademarks of the herein Opposer has been registered in its name in many countries of the world as early as the year 1990 (Exhibits “B” to “B-43”).

On the other hand, Respondent-Applicant has filed its trademark application in the Philippines (BPTTT Office) on August 3, 1992 and claiming date of first use as January 15, 1991.

Comparing the dates, above-mentioned, there is no question that the registration of Opposer’s trademarks antedates the Respondent-Applicant’s filing of his trademark application in the Philippines and so with his claim of FIRST USE. Therefore it is, very clear and no doubt whatsoever that Opposer is the PRIOR ADOPTER and USER of the trademark “THE SIMPSONS” and “THE SIMPSONS LOGO”, hence the registration of the same in the name of Respondent-Applicant is contrary to Section 4(d) of Republic Act No. 166, as amended., earlier quoted.

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Consequently, application bearing Serial No. 81825 for trademark "SIMPSONS" filed on August 3, 1992 by JOAQUIN S. LAO is hereby REJECTED.

Let the file wrapper of this case be forwarded to the Administrative Financial and Human Resource Development Bureau for appropriate action in accordance with this Decision with a copy thereof be furnished the Bureau of Trademark for information and update of its record.

SO ORDERED.

Makati City, 29 October 1998.

ESTRELLITA BELTRAN-ABELARDO
Caretaker/Officer-In-Charge