

DELYN ENTERPRISES, INC.,)	INTER PARTES CASE NOS. 2056 & 3183
Petitioner,)	
)	INTER PARTES CASE NO. 2056
)	PETITION FOR CANCELLATION:
)	Cert. of Regn. No. 21770
)	Issued : April 8, 1974
)	Registrant : Hans Schwarzkopf
- versus -)	Trademark : WOMAN'S HEAD
)	DEVICE
)	Used on : Perfume, cosmetics
)	preparations, toilet
)	preparations, prepa-
)	rations for the hair.
)	
HANS SCHWARZKOPF,)	
Respondent-Registrant.)	
-----X)	
HANS SCHWARZKOPF,)	INTER PARTES CASE NO. 3183
Respondent-Registrant.)	OPPOSITION TO:
)	Application Serial No. 38032
)	Filed On : April 10, 1979
)	Applicant : Delyn Enterprises, Inc.
)	Trademark : YOURS & WOMAN'S
)	HEAD DEVICE
- versus -)	Used on : Cosmetics and toilet
)	preparations, cuticle
)	oil, baby oil, hand
)	baby lotion, cold
)	wave lotion, cuticle
)	remover, spray net,
)	setting lotion and
)	shampoo.
)	
)	<u>DECISION NO. 94-35 (TM)</u>
)	
DELYN ENTERPRISES, INC.)	June 30, 1994
Respondent-Applicant.))	
X-----X)	

DECISION

This is a consolidation of two Inter Partes Cases involving one foreign manufacturer, Hans Schwarzkopf GMBH (Hans), and one local manufacturer, Delyn Enterprises, Inc. (Delyn). The first case is for the cancellation of Certificate No. 21770 issued to Hans for its mark "BLACK HEAD DEVICE"; the second is an opposition to Application Serial No. 38032, for the second registration (The first registration was cancelled due to Delyn's failure to file the required affidavit of use.) of Delyn's "YOURS & DESIGN" mark.

Both the Petition for Cancellation and the Opposition raise the issue of whether or not there is confusing similarity between Delyn's "WOMAN'S HEAD DEVICE" and Hans' "BLACK HEAD DEVICE". In resolving this issue, the tests for determining the likelihood of confusion should be applied to the facts involved.

Hans' mark, as registered in Germany, is called "BLACK HEAD DEVICE", while Delyn's mark is referred to as "WOMAN'S HEAD DEVICE". And as the labels submitted by both parties illustrate their respective marks, Hans' mark comprises of a man's, or of an effeminate person's head, while Delyn's mark shows a woman's head. Delyn's head device as used in Hans' presentation of its mark on its labels. Delyn's head device is designed inside a circle, in contrast to Hans' plain head device. Furthermore, the word Schwarzkopf is always written below or beside Hans' trademark. On the other hand, Delyn's trademark is "YOURS & DESIGN", showing the word "Yours" clearly and distinctly written in script below the head device. There is a big difference in the appearance of the two trademarks.

In *Texwood Ltd. v Andres T. Lim*, it was held that when the mark in question is a combination mark, meaning, it consists partly of a word and partly of a device, it is the word portion which determines the existence of likelihood of confusion. The word portion is that which is "most likely to be impressed upon the purchasers' memory and to serve as indicium of origin, and since it is the portion of the mark purchasers refer, to order goods." in a case decided by the Court of Appeals, *Jordache Enterprises v. Davila*, it was ruled:

The words "RAWHIDE" and "JORDACHE", which are printed boldly on the trademarks, more easily attract and catch the eye of the consuming public, and it is those words which would stick in their minds, not the horsehead design, when the public thinks of buying clothes, the customer would be more likely to say that he wants to buy "RAWHIDE" or "JORDACHE" pants, instead of saying that he wants the pair of jeans with a horsehead design."

Applying the doctrine to this case, a buyer who uses the products manufactured by Delyn would likely see and remember the word "Yours" and buy the goods with this brand name. He/she would not look for the product with the head device on its label, because the word "Yours" is the dominant feature of Delyn's mark. If a buyer would buy Delyn's products, it would likely be because "Yours" has been his trusted brand.

In consideration of the trademarks in their entirety as they appear in their respective labels, the court in *Etepha v Director of Patents* said that there was no confusing similarity between the trademarks involved therein "since the respective labels are entirely different in colors, contents, arrangement of words thereon, sizes, shapes, and general appearance." This test, if applied to the case at hand, would reveal that the over-all presentation of the labels of the opposing parties' product are different in all aspects. Moreover, there would be no confusion on the source of the goods, as "Yours" would have been very well associated with its producer, Delyn Enterprises, Inc., it being always indicated in Delyn's labels. This is in contrast to the word "Schwarzkopf" on Hans' labels. Given the big differences in labels of the products of the opposing parties, the cautious buyer would not be confused into buying the wrong products.

Regard must also be given to the nature of the goods and the class of persons who buy the products. Delyn's and Hans products comprise of cosmetics, skin and hair preparations, essential oils, etc. -- products mostly for women's use. It is not surprising for Delyn to use the "WOMAN'S HEAD DEVICE" on its labels. Hans' registered the mark is a weak mark in the sense that it is not uncommon for manufacturers to include in their labels human figures or parts of the body in order to indicate their targeted buyers. Furthermore, the goods identified by the trademarks are such that purchasers are careful in buying them, for it is their appearance or complexion that depends upon the use of the chosen products.

There being no confusing similarity between Hans' "BLACK HEAD DEVICE" and Delyn's "YOURS & DESIGN", the two marks can co-exist in the market. Their co-existence will not cause or injury neither to the consumers nor to themselves.

The other grounds for opposition premised on the presence of confusing similarity between the two trademarks are similarly untenable.

There is also no need to give a lengthy discussion regarding Hans' contention that its mark should be protected as a well-known mark pursuant to Article 6bis of the Paris Convention. Such protection is given only against users of marks identical or confusingly similar to the well-known mark.

The allegation that Delyn has abandoned its mark and therefore should not be entitled to registration is untenable. The first registration of Delyn's mark was cancelled due to non-filing of the required affidavit of use on its fifth anniversary. However, despite this cancellation, Delyn continued the use of its mark. The basis of ownership being actual use and not registration, Delyn retained ownership of its trademark. Delyn is still the exclusive owner of its mark and is still entitled to registration. Delyn has not abandoned its mark. In fact, it asserts its intention to continue the exercise of its rights over the mark through this application for re-registration opposed by Hans.

On the other hand, Delyn's contention that the registration of Hans' trademark should be cancelled on the ground of abandonment should be rejected. In fact, the Bureau had accepted the affidavits of non-use which Hans submitted within one year from the marks, fifth and tenth and fifteenth anniversaries.

Delyn fails to convince this office that there are grounds to overturn its previous acceptance of the said affidavits.

WHEREFORE, the confusing similarity between Hans' "BLACK HEAD DEVICE" and Delyn's "YOURS & DESIGN" and after due consideration of the other issues raised by the parties:

1. the Petition for Cancellation of Certificate No. 21770 issued to Hans Schwarzkopf GMBH; and
2. the Opposition to Application Serial No. 38032 for the registration of Delyn's trademark are hereby DENIED.

Let a copy of this Decision be furnished the Trademark Examining Division for appropriate action.

SO ORDERED.

IGNACIO S. SAPALO
Director