

L.C. LICENSING, INC.,	)	INTER PARTES CASE NO. 3620
Opposer,	)	
	)	OPPOSITION TO:
	)	
	)	Application Serial No. 67617
	)	Filed : September 1, 1988
- versus -	)	Registrant : Joyce Tiu
	)	Trademark : TRIANGULAR DESIGN
	)	Used on : Medicated cream
	)	
	)	DECISION NO. 94-42 (TM)
	)	
JOYCE TIU,	)	November 15, 1994
Respondent-Registrant.)	)	
x-----x		

DECISION

On September 1, 1988, Application Serial No. 67617 for the trademark "TRIANGULAR DESIGN" for medicated cream, under the style KENLENE LABORATORY. The application was published for Opposition in the Office Gazette of the Bureau of Patents, Trademarks and Technology Transfer, Volume III, No. 5, and officially released on October 31, 1990.

The herein Opposer L.C. Licensing, Inc., a company of the State of Delaware, United States of America, with business address at 1441 Broadway, New York, United States of America, believes that it would be damaged by such registration, filed a verified Notice of Opposition on January 25, 1991 (Inter Partes Case No. 362).

The grounds upon which Opposer bases its Opposition are as follows:

1. The Opposer is the owner of the trademark "TRIANGULAR DESIGN" having been the first to adopt the same in trade and commerce for goods falling under International Classes 18, 24, 25, 9, 16, 18 & 34;
2. The aforesaid trademark was registered by Opposer in the United States of America as early as 15 March 1988 and in this jurisdiction as early as 7 August 1989 under Registration No. 38253;
3. The foregoing trademark registrations have not been abandoned and are currently in force;
4. The "TRIANGULAR DESIGN" trademark which Opposer created is likewise registered in other countries and as such, has gained international acclaim and are now distinctive of superior quality goods falling under International Classes 18, 24, 25, 9, 16, 18 & 34. Thus reputation is true even in the Philippines."

Opposer relies on the following facts to support its Opposition.

1. The trademark "TRIANGULAR DESIGN" of Respondent-Applicant is a flagrant and veritable imitation of herein Opposer's trademark as likely to cause confusion, mistake and deception to the buying publics as to the source of Respondent-Applicant's goods;

2. Opposer had invested tremendous amount of resources in the promotion of its "TRIANGULAR DESIGN" trademark, i.e. advertisement in well-known newspapers, magazines and other publications around the world. It is the resultant popularity of Opposer's trademark that Respondent-Applicant wishes to exploit and capitalize;

3. The registration of Respondent-Applicant's mark would violate Opposer's and Respondent-Applicant's respective business and will most assuredly cause the dilution and loss of distinctiveness of Opposer's "TRIANGULAR DESIGN" mark."

On January 9, 1991, this Bureau sent a Notice to Answer with enclosed copy of the Notice of Opposition to Respondent at her address on record by registered mail with return card. The Notice required Respondent-Applicant to file an Answer within fifteen days from receipt thereof, otherwise, Respondent will be declared in Default.

On April 17, 1991, Opposer through Counsel, filed a Motion to Declare Respondent-Applicant in Default on the grounds that the Answer to the Notice of Opposition was not filed within the reglementary period or for more than three months since January 8, 1991. The Motion being meritorious, she was declared in Default (Order No. 91-351) dated April 22, 1991.

Pursuant to the Order of Default, Opposer presented its evidence ex-parte consisting of Exhibits "1" to "25" inclusive of submarkings.

The main issue to be resolved in this case is:

WHETHER OR NOT THE RESPONDENT-APPLICANT'S TRADEMARK "ALYSON AND TRIANGULAR DESIGN" SHOULD BE GRANTED REGISTRATION UNDER SECTION 4(d) OF R.A. NO. 166, AS AMENDED WHEN IT SO RESEMBLES THE OPPOSER'S TRADEMARK "TRIANGULAR DESIGN".

The ultimate issue to be resolved is the existence or non-existence of "CONFUSING SIMILARITY" between the two trademarks.

The Opposer's trademark "TRIANGULAR DESIGN" was registered in the Philippines on goods falling under Classes 18, 24, 25 (Exhibit "1", "3", "5") and Exhibit ("9") on goods under Classes 9, 16, 18 and 34. The registered trademark of the herein Opposer is a Triangular Design with a division starting from the right lateral side, parallel to the left lateral slide and ending to base, whereas the Respondent-Applicant's trademark although with the presence of the word "Alyson" contained a Design consists also of a Triangle Design but the division starts from the left lateral side parallel to the right lateral side and ending to base.

The evidence show that Respondent-Applicant's trademark is confusingly similar to Opposer's trademark Triangular Design which was registered with this Bureau (Exhibit "2" and "23") and the only difference is the presence of the word "Alyson" in Respondent-Applicant's trademark.

Respondent-Applicant may not appropriate Opposer's trademark in too and avoid likelihood of confusion by adding the word "Alyson" thereto. Thus, in *Continental Connector Corp. vs. Continental Specialties Corp.*, 207 USPQ 60, it has been ruled that "Courts have repeatedly held that the confusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term." Examples: "MISS USA WORLD" (*Miss Universe, Inc. vs. Patricelli*, 161 USPQ 129); "GUCCI" and "GUCCI-GOO" (*Gucci Shops vs. R.H. Macy & Co.*, 446 F. Supp. 838); "Comfort" and "Foot Comfort" (*Scholl, Inc. vs. Tops E.H.R. Corp.*, 185 USPQ 754); "Washington Mint" and "Geo Washington Mint" (*George Washington*

Mint, Inc. vs. Washington Mint, Inc., 176 USPQ 251); and “ACE” and “TEN-ACE” (Becton, Dickson & Co. vs. Wiguaram Mills, Inc., 199 USPQ 607);

Opposer’s trademark “Triangular Design” is registered in the United States of America, Exhibits “2”, “4” and “6” for the goods falling under Classes 16, 18, 24, 25 and 34.

Thus, in Mine Safety Appliance Co. vs. Management Science America, Inc., 212 USPQ 105, it was ruled that:

“There is no requirement that goods or services be identical or even competitive in nature in order to find that likelihood of confusion exists; rather, it is sufficient that there be some relationship between involved goods or services and/or that circumstances surrounding their marketing would cause to be encountered by same persons who might, because of similarity of marks, mistakenly believe that they have common origin or are somehow associated with same producer.”

In determining confusing similarity, a side-by-side comparison of the marks, emphasizing differences in detail is not the appropriate test. The key inquiry is not similarity *per se* but rather whether a similarity exists which is likely to cause confusion. (see Exxon Corp. vs. Zoil Energy Resources, Inc., 552 F. sup. 1008, 1016, 216 USPQ 634, 641-642 [S.D.N.Y.]). This test must be applied from the perspective of purchasers. Thus, it must be determined whether the impression which the infringing mark makes upon the consumer is such that it is likely to believe the product is from the same source as the one he knows under the trademark. (Mc Gregor-Doniger, Inc. vs. Drizzle, Inc. 599 F. 2d at 1133, 202 USPQ 81, 86-7). In making this determination, it is the overall impression of the marks as a whole that must be considered. Likewise, it has been consistently held that infringement of a trademark is to be determined by the test of dominancy. Similarity in size, forms, and colors, while relevant, IS NOT CONCLUSIVE. If the competing trademarks contain the main essential or dominant features of another, and confusion and deception is likely to result, infringement takes place. Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate (Co Tiong Sa vs. Director of Patents, G.R. No. L-5372, May 24, 1954).

WHEREFORE, the Opposition is given due course. Accordingly, Application Serial No. 67617 filed on September 1, 1988 by Joyce Tiu for the trademark “ALYSON” and “TRIANGLE DESIGN” is hereby REJECTED.

Let the filewrapper of this case be remanded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision be furnished the Trademark Examining Division for information and to update its records.

SO ORDERED.

IGNACIO S. SAPALO  
Director