

REEMTSMA CIGARETTEN FABRIKEN)	INTER PARTES CASE NO. 3339
Opposer,)	
)	OPPOSITION TO:
)	
)	Application Serial No. 58372
)	Filed : February 18, 1986
- versus -)	Applicant : Fortune Tobacco
)	Corporation
)	Trademark : WESTPOINT
)	Used on : Cigarettes
)	
)	<u>DECISION NO. 94-2 (TM)</u>
)	
FORTUNE TOBACCO CORPORATION,)	January 12, 1994
Respondent-Applicant.))	
x-----x)	

DECISION

On April 28, 1989 REEMTSMA CIGARETTEN FABRIKEN GMBH, a corporation organized and existing under the laws of Germany with business address at Hamburg 52, Parkstrabo 51, West Germany, filed its verified Notice of Opposition (Inter Partes Case No. 3339) to Application Serial No. 58372 for the trademark "WESTPOINT" used on cigarettes which application was filed on February 18, 1986 by Fortune Tobacco Corporation of Marikina, Metro Manila which was published for opposition on page 35 of the Official Gazette No. 1 Volume II and officially released for circulation on January 30, 1989.

The grounds for the opposition are as follows:

1. The mark "WESTPOINT" under Serial No. 58372 of respondent-applicant is not only confusingly similar but identical to the trademark "WEST LABEL" and "WEST and LABEL DESIGN" of Opposer, which opposers own and have not abandoned;
2. The Opposers will be damaged and prejudiced by the registration of the mark "WESTPOINT" in the name of respondent-applicant and goodwill and will suffer great and irreparable injury;
3. Respondent-Applicant's use of the mark for cigarettes which mark so resembles/identical with the trademarks owned and used by Opposer, constitutes and unlawful appropriation of a trademark owned and currently used by Opposers."

Opposer will rely on the following facts to support the opposition:

1. The trademark "WESTPOINT" of respondent-applicant is identical to opposer's trademarks "WEST LABEL" and "WEST AND LABEL DESIGN" as to be likely, when applied to the goods or when used in connection with the goods of respondent-applicant, to cause confusion or mistake or to deceive purchasers as to the source or origin of the goods, products of respondent-applicant to such an extent that they may be mistaken by the unwary public as related to the products manufactured and sold by opposer;
2. Opposer's trademark "WEST LABEL" and "WEST AND LABEL DESIGN" are well-known throughout the world and said marks have become distinctive of opposer's goods and business.

3. Opposer's trademark "WEST LABEL" and "WEST AND LABEL DESIGN" have long been established and obtained general international consumer recognition and goodwill as belonging to one owner or origin, the opposer herein.

Records of the case show that Respondent-Applicant has been given an extension of ten (10) days from February 21, 1991 within which to file its Answer to the verified/authenticated Notice of Opposition (Order No. 91-212) dated February 28, 1991.

On March 8, 1991, Opposer through Counsel filed a Motion to Declare Respondent-Applicant in Default alleging therein that the extension given to Respondent-Applicant lapsed on March 3, 1991 and it did not file its Answer, nor file any extension thereof.

For failure of the Respondent-Applicant to file its Answers despite due notice and upon opposer's Motion it was declared in Default. Accordingly, Opposer was allowed to present its evidence ex-parte (Order No. 91-491) dated June 5, 1991.

Admitted as Opposer's evidence were exhibits "A" to "F" inclusive (Order No. 92-84) dated January 23, 1992.

The issue for resolution in this case is whether or not respondent's application bearing Serial No. 58372 for the trademark "WESTPOINT" should be given due course under the Trademark Law, R.A. No. 166 section 4(d), which provides:

Sec. 4. Registration of trademarks, tradenames and service marks on the principal register. - -There is hereby established a register of trademarks, tradenames and service marks which shall be known as the principal register. the owner of a trademark, tradename or service mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register unless it:

xxx

(d) Consists of or comprises a mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename 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 purchasers".

This Office in resolving the issue on confusing similarity between "WEST" for the Opposer and "WESTPOINT" for the respondent, the "test of dominancy" should apply. Accordingly, the common dominant features of the contending marks is the word "WEST".

The evidence show that Respondent-Applicant's trademark "WESTPOINT" is confusingly similar to Opposer's "WEST" used on identical goods as to be likely to cause confusion or mistake or to deceive purchasers as to the source or origin of respondent's goods or to create a likelihood of the public associating one product with the other.

The only difference is the word "POINT" appended to the word "WEST". Both parties goods belong to the same Class 34 and therefore flow through the same channels of trade.

Respondent-Applicant may not appropriate Opposer's trademark in toto and avoid likelihood of confusion by adding the word "POINT" 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" and "MISS USA WORLD" (*Miss Universe, Inc. vs. Patricelli*, 161 USPQ 129) "GUCCI" and "GUCCHI-

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)

The use of the dominant word “WEST” will indeed, tend to create in the minds of unwary purchasers that the goods or products under such marks come from the same source or origin to the prejudice of Opposer’s products. On this score, the Supreme Court prescribed a guiding formula:

xxx that whether or not a trademark causes confusion and is likely to deceive the public is a question of fact which is to be resolved by applying the test of dominancy, meaning if the competing trademark contains the main or identical or dominant features of another by reason of which confusion and deception are likely to result, then infringement takes place, that duplication or imitation is not necessary or similarity in the dominant feature of the trademark would be sufficient.” (Co Tiong Sa vs. Director of Patents, 1954, 95 Phil. 1; Clark v. Manila Candy Co., 36 Phil. 100, Alhambra Cigar & Cigarettes vs. Mojica, 27 Phil. 266) furthermore, in meaningful prose, the Supreme Court, through Justice Cecilia Munoz Palma, stated:

“xxx Differences there will always be, but whatever differences exist, these pale into insignificance in the face of an evident similarity in the dominant feature and overall appearance of the labels of the parties.” (Phil. Nut Industry, Inc. v. Standard Brands, Inc. SUPRA)

As shown by the records on file, Respondent-Applicant’s date of first use as stated in its trademark application on file bearing Serial No. 58372 is December 2, 1985, while the Opposer’s trademarks has been registered in various countries of the world such as the following: (as shown in Exhibit “B” for the goods cigarettes under Class 34)

COUNTRIES	DATE REGISTERED
1. Republic Argentina	- August 2, 1983
2. Canada	- December 2, 1983
3. Kuwait	- Application filed on April 29, 1982 matured to Registration No. 13351 dated December 15, 1983
4. Malta	- April 24, 1984
5. Philippines	- May 30, 1986 and the application was filed on July 16, 1985 under Sec. 37 of R.A. 166 as amended.
6. Korea	- February 15, 1985
7. United States Patent and Trademark Office	- Regn No. 1,247,283 dated August 2, 1983
8. United States Patent and Trademark Office	- Regn No. 1,363,659 dated October 1, 1985

The herein Opposer is the registered proprietor of the trademark and the trademark “WEST” in the following countries (Exhibit “C”)

1. Federal Republic of Germany
Registration Date – 1st October 1980
Regn No. 100865
2. All countries belonging to the Madrid Convention Regn. No. IR No. 457694
3. Other countries where the mark is registered for cigarettes

COUNTRIES	REGISTRATION NO.
1. Argentina	- 10,68,727
2. Bahamas	- 01,844
3. Bolivia	- 9,507
4. Bulgaria	- 13,189
5. Canada	- 285,454
6. Chile	- 243,243
7. Cuba	- 114,921
8. Dominican Republic	- 35,594
9. Ecuador	- 942
10. El Salvador	- 147
11. Finland	- 86,977
12. Guatemala	- 44,872
13. Guayane	- 11,4084
14. Haiti	- 190/70
15. Honduras	- 30,613
16. Iceland	- 25/1984
17. Japan	- 1,688,489
18. Kuwait	- 13,351
19. Malta	- 16,095
20. Mexico	- 269,612
21. Nethal and Antilles	- 12,802
22. Nicaragua	- 14,570 C.C.
23. Panama	- 27,647
24. Paraguay	- 97,238
25. Peru	- 36,669
26. Philippines	- 7343
27. South Korea	- 110415
28. Suriman	- 10,407
29. Taiwan	- 343007
30. Thailand	- 98851
31. United Kingdom	- B,1,140,763
32. United States	- 1,217,283

From the foregoing, there is no doubt that Opposer has already appropriated the trademark "WEST" before that of the Respondent-Applicant.

Sec. 2-A R.A. No. 166 as amended reads:

SEC. 2-A. Ownership of trademarks, tradenames and service marks, how acquired. – Anyone who lawfully produces or deals in merchandise of any kind or who engages in any lawful business, or who renders any lawful service in commerce, by actual use thereof in manufacture of trade, in business, and in the service rendered, may appropriate to his exclusive use a trademark, a tradename, or a service mark not so appropriated by another, to distinguish his merchandise, business or service from the merchandise, business or service of others. The ownership or possession of a trademark, tradename or service mark, heretofore or hereafter appropriated, as in their section provided, shall be recognized and protected in the same manner and to the same extent as are other property rights known to the law.

Clearly, opposer is the prior user and adopter of the trademark "WEST". It is the owner of the mark in controversy and the Respondent-Applicant's application for the registration of the mark "WESTPOINT" is in violation of Section 4(d) of R.A. No. 166, as amended.

The non-filing of the requisite Answer to the Notice of Opposition nor any motion to lift the Order of Default despite due notice is indicative of Respondent-Applicant's lack of interest in its application; thus it is deemed to have abandoned its application.

WHEREFORE, premises considered, the herein Notice of Opposition is, as it is hereby, SUSTAINED. Accordingly, Application Serial No. 58372 filed by Fortune Tobacco Corporation on February 18, 1986 for the goods cigarettes is hereby REJECTED.

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

SO ORDERED.

IGNACIO S. SAPALO
Director