

WILFREDO LUMINLUN	)	INTER PARTES CASE NO. 3624
Opposer,	)	
	)	OPPOSITION TO:
	)	
	)	Application Serial No. 70199
	)	Filed : November 29, 1989
	)	Applicant : Alexander Julian, Inc.
- versus -	)	Trademark : COLOURS BY ALEXANDER
	)	JULIAN
	)	Used on : Suits, sportscoats,
	)	coats, pants, ties,
	)	shirts, sweaters,
	)	jackets, socks and
	)	hosiery
	)	
	)	<u>DECISION NO. 92-34 (TM)</u>
	)	
ALEXANDER JULIAN, INC.,	)	December 10, 1992
Respondent-Applicant.)	)	
x-----x	)	

DECISION

On January 18, 1991, Wilfro P. Luminlun, a Filipino citizen and with business address at 959 Soler Street, Binondo, Manila, filed his Verified Notice of Opposition (Inter Partes Case No. 3624) to Application Serial No. 70199 for the trademark "COLOURS BY ALEXANDER JULIAN" used on clothing and accessories namely suits, sportscoats, pants, ties, shirts, sweaters, jackets, socks and hosiery, under Class 25, which application was filed by ALEXANDER JULIAN, INC. on November 29, 1989, a North Carolina Corporation of New York, New York, U.S.A. which was published for opposition on page 94 of Vol. No. III, issue No. 6 dated November - - December 1990 of the Official Gazette of this Office and officially released for circulation on December 31, 1990.

Opposer stated as basis for his opposition are as follows:

1. The approval of Application Serial No. 70199 is contrary to section 4(d) of Republic Act No. 166, as amended;
2. As of the date of the filing of Application Serial No. 70199 on November 29, 1989, respondent-applicant was not entitled to register the trademark "COLOURS BY ALEXANDER JULIAN" in its favor in the Philippines;
3. The Opposer will be damaged and prejudices by the registration of the trademark "COLOURS BY ALEXANDER JULIAN" in the name of respondent-applicant and his business reputation and goodwill will suffer great and irreparable injury.

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

1. That opposer adopted and started the use of the trademark "COLOURS" on January 1, 1982 in good faith;
2. That opposer is the registered owner of the trademark "COLOURS" for use on shoes, sandals, slippers, boats jeans, pants, t-shirts, shirts, briefs, shorts, socks, handkerchiefs, belts, jogging pants and sweat shirts

under Registration Certificate No. 54870 issued on July 26, 1989 without any opposition is still in full force and effect;

3. That opposer has been using the trademark "COLOURS" in lawful commerce in the Philippines since January 1, 1982 continuously up to the present;

4. That the trademark "COLOURS BY ALEXANDER JULIAN" being registered by respondent and/or the dominant feature thereof, namely, COLOURS, is identical and/or confusingly similar to opposer's registered trademark "COLOURS";

5. That opposer has spent a considerable amount of time, money and efforts to advertise and promote his products bearing his registered trademark "COLOURS" so much so that said mark has become distinctive of opposer's goods and received the consumer's goods and received the consumer's recognition and goodwill;

6. That considering that the goods upon which respondent-applicant uses its subject trademark, are identical and/or related to the goods upon which opposer uses his registered trademark "COLOURS" likelihood of confusion, deception or mistake; as to the actual source or origin of respondent-applicant's goods is likely;

7. That the allowance of Application Serial No. 70199 is clearly violative of Section 4(d) of R.A. No. 166 as amended;

8. That as of November 29, 1989 when it filed Application Serial No. 70199, Respondent-Applicant was not entitled to register the trademark "COLOURS BY ALEXANDER JULIAN" under Sec. 37 of R.A. No. 166 as amended;

9. That respondent is now precluded by the equitable principles of acquiescence, estoppel and laches from registering the trademark "COLOURS BY ALEXANDER JULIAN";

10. That the allowance of Application Serial No. 70199 will damage and prejudice Opposer and his business reputation and goodwill will suffer great and irreparable injury.

On February 22, 1991, respondent-applicant filed its Answer raising the following special/affirmative defenses:

1. That the trademark "COLOURS BY ALEXANDER JULIAN" applied for registration in this jurisdiction had long enjoyed trademark protection in its home country, United States of America, as well as in other countries abroad;

2. Anent the foregoing, the fact that the trademark at issue had long been registered in Respondent-Applicant's mark deceptively suggests a connection between the parties respective business;

3. Respondent-Applicant's trademark had been in continuous use since the time of its adoption, hence, the same had gained tremendous goodwill for the Respondent-Applicant and has become clearly distinctive on the products it manufactures and distributes;

4. That when herein opposer attempted to register "COLOURS", respondent-applicant did not bother to oppose the said application because it believed that no confusing similarity exist, or was there any likelihood of confusion that may arise;

5. That the Supreme Court had ruled that in determining whether two (2) trademarks are confusingly similar;

"The discerning eye of the observer must focus not only on the predominant words but also on the other features appearing on both labels, such as differences in sizes of the product's respective containers, differences in the colors of their respective labels, the manner and color in which the trademarks are presented, and differences in the purposes for which the products are to be used. (Mead Johnson & Co. vs. N.U.I. Van Dorp. Ltd. 7 SCRA 768).xxx the test is not simply to take their words and compare the spelling and pronunciation of said words. Rather, it is to consider the two marks in their entirety as they appear in their respective labels, in relation to the goods to which they are attached." (Bristol Myers Co. vs. Director of Patents, 17 SCRA 131)".

6. Moreover, the mark of the respondent-applicant is not used partly as "COLOURS" but is it used in its entirety, as "COLOURS BY ALEXANDER JULIAN" thus no confusing similarity exists.

Neither party took testimony or adduced documentary evidence. They submitted the case for decision based on the pleadings which together with the pertinent records have all been carefully considered.

Accordingly, the only issue is whether or not the herein opposer would likely be damaged by the registration of the trademark "COLOURS BY ALEXANDER JULIAN" sought by the respondent-applicant on the ground that it so resembles the trademark "COLOURS" allegedly used and owned by the opposer to be "likely to cause confusion, mistake or to deceive purchasers".

There can be no doubt that respondent-applicant sought to register trademark "COLOURS BY ALEXANDER JULIAN" is confusingly similar to opposer's trademark "COLOURS".

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".

The Supreme Court in the case of "Philippine Nut Industry, Inc. vs. Standard Brands Incorporated, et.al., 65 SCRA 575, 579, it stated:

"In the cases involving infringement of trademark brought before the court, it has been consistently held that there is infringement of trademark when the use of the mark involved would be likely to cause confusion or mistake in the mind of the public or to deceive purchasers as to the origin or source of the commodity; 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 essential 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 a similarity in the dominant features of the trademarks would be sufficient". (Co Tiong Sa vs. Director of Patents, 1954, 94 Phil. 1, citing

viz. Clarke vs. Manila Candy Co., 36 Phil. 100; Alhambra Cigar & Cigarette Co. vs. Jao Oge, 47 Phil. 75 Etepha, A.G. vs. Director of Patents and Westmont Pharmaceutical Inc. No. L-20635, March 31, 1966, 16 SCRA 495).

Respondent-Applicant can not avoid likelihood of confusion by adding the words "BY ALEXANDER JULIAN" thereto. Thus, in Continental Connector Corp. vs. Continental Specialties Corp. 207 USPQ 60, the oft-repeated rule was applied to wit: 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 WORDL (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); "WASHINGTON MINT" ad "EO WASHINGTON MINT" (George Washington Mint, Inc. vs. Washington Mint, Inc.; 176 USPQ 251) and "ACE" and "TEN-ACE" (Becton, Dickinson & Co. vs. Wiguam Mills, Inc., 199 USPQ 607).

In the case at bar, the word "COLOURS", which is registered in the name of the opposer, is the most prominent and distinctive feature of respondent-applicant's trademark "COLOURS BY ALEXANDER JULIAN". It is the word "COLOURS" which draws the attention of the buyer and leads him to conclude that the goods originated from the same manufacturer. The disclaimer made by the respondent-applicant of "COLOURS" apart from the mark as shown will not avoid confusion among consumers nor prevent inflicting damage to the opposer because it merely means that respondent does not have any proprietor right to it but he may use it just the same.

Moreover, what should be disclaimed are matters not capable of exclusive appropriation. In the present case, "COLOURS" is capable of exclusive appropriation. In fact, it was registered in favor of the herein opposer.

It must be noted that Opposer's trademark "COLOURS" has been registered with this Office under Registration No. 45840 dated July 26, 1989 which Certificate of registration is prima facie evidence of validity of opposer's ownership of the said trademark "COLOURS" as provided under Section 20 of R.A. No. 166 as amended which provides:

Sec. 20. Certificate of registration prima facie evidence of validity. A certificate of registration of a mark or trade-name shall be prima facie evidence of the validity of the registration the registrant's ownership of the mark or trade-name, and of the registrant's exclusive right to use the same in connection with the goods, business or services specified in the certificate subject to any conditions and limitations stated therein".

WHEREFORE, pursuant to the provisions of Section 4(d) of the Trademark Law, the Opposition is SUSTAINED. Application Serial No. 70199 filed by Alexander Julian, Inc., is REJECTED

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

SO ORDERED.

IGNACIO S. SAPALO  
Director