

CINDERELLA MARKETING CORP.,	}	Inter Partes Case No. 4083 and 4110
Opposer,	}	Opposition to:
	}	
	}	Serial No. : 75422 and 75423
-versus-	}	Date Filed : 18 March 1991/3
	}	March 1991
	}	Trademark : "SEVENTEEN"
	}	Goods : Ladies bag, attaché case, wallet,
	}	traveling bag, coin purse, suitcase, sport
	}	bag, golf bag, fashion bag.
JEANA Q. QUE,	}	
Respondent-Applicant.	}	Decision No. 2000- 02
x-----x		

### DECISION

This pertains to consolidated Inter Partes Cases filed by the herein Opposer, CINDERELLA MARKETING CORPORATION, a corporation duly organized and existing under the laws of the Republic of the Philippines with office address at 825 E. delos Santos Avenue, Quezon City, against the trademark applications bearing Serial No. 75422 and Serial No. 75423 filed on March 18, 1991 by JEANA Q. QUE, a Filipino citizen with address at 25 P. Sevilla St., Grace Park, Caloocan City for the registration of the trademarks "SEVENTEEN" and "SEVENTEEN with a ROYAL HORSE DESIGN" both used on ladies bag, attaché case, wallet, traveling bag, coin purse, suitcase, sport bag, golf bag, fashion bag and ladies bag, attaché case, wallet, traveling bag, coin purse, suitcase, sport bag, golf bag, fashion bag, which applications were published in Vol. VII, No. 3, page 19 of the May – June 1994 issue of the Official Gazette of the Bureau of Patents, Trademarks and Technology Transfer and released for circulation to the public on 07 July 1994.

The grounds for the opposition are as follows:

- "4.1 Opposer is the true and lawful owner of the mark "SEVENTEEN", which forms and integral part and is the dominant feature in the trademarks "CINDERELLA SEVENTEEN FOR GALS" and "CINDERELLA SEVENTEEN FOR GUYS" of Opposer.
- "4.2 Opposer's trademarks "CINDERELLA SEVENTEEN FOR GALS", "CINDERELLA SEVENTEEN FOR GUYS" and the mark "SEVENTEEN" have become distinctive of the goods of the Opposer through the latter's exclusive and continuous use thereof.
- "4.3 The mark "Seventeen and Design" sought to be registered by respondent-applicant is identical or confusingly similar to the trademarks "CINDERELLA SEVENTEEN FOR GALS" and "CINDERELLA SEVENTEEN FOR GUYS" owned and being used by the Opposer.
- "4.4 In the case at bar, the trademark "Seventeen and Design" sought to be register by the respondent-applicant is identical to the dominant feature of the trademarks of the Opposer as to likely deceive purchasers of goods on which it is to be used to an extent that said goods may be mistaken by the unwary public to be manufactured by the Opposer.
  - "4.4.1 In both the Respondent-Applicant's and the Opposer's trademarks, the word "SEVENTEEN" (except for the letter "S" in Respondent-Applicant's

mark) is printed in bold, straight lower-case letters, which makes the marks confusingly similar.

- “4.5 There is no reasonable explanation for Respondent-Applicant’s use of the word “SEVENTEEN” in its trademark, which word is the dominant word of Opposer’s registered trademark and its other trademarks which have been applied for registration.
- “4.6 In this regard, Section 4 of Republic Act No. 166, as amended, otherwise known as the Trademark Law, 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 trademarks, tradenames and service marks 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:

x x x

- (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 goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers; or

x x x”

- “4.7 The registration of the mark “Seventeen and Design” in the name of the Respondent-Applicant will violate the propriety rights/interests, business reputation and goodwill of the Opposer over and in its trademarks “CINDERELLA SEVENTEEN FOR GALS” and “CINDERELLA SEVENTEEN FOR GUYS”. Considering that the distinctiveness of the mark “SEVENTEEN” will be diluted, thereby causing great and irreparable injury to the Opposer.

Opposer relied on the following grounds to support its opposition:

- “5.1 The trademark “CINDERELLA SEVENTEEN FOR GALS” is registered with this Bureau under Certificate of Registration No.49296, issued on 30 October 1990, covering the goods ladies’ dresses, blouses, sweat shirts, skirts, pants, shorts, shoes, bags and belts under Classes 18 and 25, and is likewise applied for registration under Application Serial No. 92401 covering the goods undershirts, sandos,, socks, jogging attire, sandals, panties and underwears under class 18.
- “5.2 The trademark “CINDERELLA SEVENTEEN FOR GUYS” of Opposer is also being applied for registration under Serial No. 67756 covering the goods men’s T-shirts, polo shirts, sweat shirts, sandos, pants, shorts, shoes, bags, and belts under classes 18 and 25.
- “5.3 Opposer is and has always been prior user or adopter and owner of the mark “SEVENTEEN”, which is used by the Opposer on its wide variety of goods including ladies’ dresses, blouses, sweat shirts, skirts, pants, shorts, shoes, bags

and belts, undershirts, sandos, socks, jogging attire, sandals, panties and underwears, and men's t-shirts, polo shirts, sweat shirts, sandos, pants, shorts, shoes, bags and belts.

- "5.4 The Opposer has been using the trademarks "CINDERELLA SEVENTEEN FOR GALS" and "CINDERELLA SEVENTEEN FOR GUYS", both of which contain the word "SEVENTEEN" as their dominant feature, on its goods long before the respondent-applicant filed for registration of her mark on 18 March 1991.
- "5.5 The word "SEVENTEEN" is the dominant and central feature of the trademark "CINDERELLA SEVENTEEN FOR GALS" and "CINDERELLA SEVENTEEN FOR GUYS" of the Opposer and should, therefore be protected.
- "5.6 Opposer has been and is continuously using the word "SEVENTEEN" in commerce as part of its trademarks "CINDERELLA SEVENTEEN FOR GALS" and "CINDERELLA SEVENTEEN FOR GUYS", and goods bearing said trademarks are sold, promoted and advertised for sale on a wide scale, with various outlets in Metro Manila.
- "5.7 By reason of Opposer's continuous and uninterrupted use of the mark "SEVENTEEN", which forms part of its trademarks "CINDERELLA SEVENTEEN FOR GALS" and "CINDERELLA SEVENTEEN FOR GUYS", long before respondent-applicant filed for registration of the mark "Seventeen and Design", Opposer has established goodwill over the trademark "SEVENTEEN" such that it has acquired general consumer recognition as belonging to one owner or source, that is, belonging to the Opposer.
- "5.8 The registration of the mark "Seventeen and Design" by the respondent-applicant which mark is confusingly similar to Opposer's trademark will not only prejudice Opposer but will also cause respondent-applicant to unfairly benefit from, and get a free ride on, the goodwill of Opposer's well-known trademarks."

On December 23, 1994 Respondent-Applicant, JEANA Q. QUE, filed her Answer denying all the material allegations in the Notice of Opposition and alleged the following Affirmative Defenses:

- "3. Since 1968, long before she filed an application for registration of the trademark "Seventeen", respondent has been using said trademark in the goods she has been manufacturing particularly on ladies bags, coin purses, sports bags and the like.
- "4. It must be Opposer who ran into this mark on respondent's goods, came to like it, decided to use it on its products, and applied for its registration.
- "5. Apprehensive that respondent might contest its trademark application, Opposer decided to modify the mark by adding thereto the words "Cinderella for Gals" and "Cinderella for Guys" to differentiate it from respondent's mark.
- "6. Opposer was in bad faith in filing the present opposition, knowing as it does, that respondent is the original user and owner of the said mark.
- "7. The trademark applied for by the respondent cannot be said to be confusingly similar to that of Opposer.
- "7.1 The dominant element in Opposer's trademark is not "SEVENTEEN" but rather "CINDERELLA", a nationally known trademark which really distinguish is from other marks.

- “7.2 In fact, “CINDERELLA”, which prefaces all other words in the Opposer’s trademark, is the catchy and distinctive component that readily indicates its manufacturer, or source.
- “7.3 The employment of the words “for Gals” and/or “for Guys” after “cinderella” in the trademark of Opposer unmistakably differentiates and sets it apart from the respondent’s trademark “Seventeen” in bold letters and followed with a Royal Horse design.
- “7.4 “Seventeen” which is placed between “Cinderella” and “For Gals” or “for Guys” in Opposer’s trademark is merely an additional descriptive feature. Unlike in respondent’s trademark “Seventeen” with a Royal Horse Design functions as the sole and dominant element in the trademark.
- “7.5 There are other glaring dissimilarities in the trademark of Opposer and that applied for by respondent which rejects confusion or mistake for one with the other or of deceiving the purchaser.
- “7.6 The size, configuration and color of the trademarks of the respondent and Opposer are strikingly dissimilar upon the faces.
- “7.7 The trademarks of Opposer covers a variety of goods particularly garments. That applied for by respondent is limited to ladies bags, coin purses and similar items.”

The issue having been joined, this Office called this case for pre-trial. However, for failure of the Respondent-Applicant and her counsel to attend the scheduled pre-trial conference on February 15, 1995, she was declared in Default.

The sole issue in this particular case is:

Whether or not applications Serial No. 75422 and Serial No. 75423 of Respondent-Applicant for the mark “Seventeen with Royal Horse” and “SEVENTEEN” are allowable considering that said marks are identical and/or confusingly similar to the Registered Marks of the Opposer.

The applicable law in resolving the issue involved in this opposition proceeding is R.A. No. 166 as amended, more particularly SEC. 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 trademarks, tradenames, and service marks 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:

x x x

- (e) 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 services of the applicant, to cause confusion or mistake or to deceive purchasers;

A cursory review of the documentary exhibits, Annex "A" of the Opposer which is the Certificate of Registration No. 49296 for the "SEVENTEEN" issued in the name of herein Opposer and the mark "SEVENTEEN" as shown in the drawings and facsimiles of the applications filed by the herein Respondent-Applicant, would reveal that both marks are substantially similar to each other as they are the same in spelling and sound as well and it is the dominant feature of Opposer's mark.

In Philippine Nut Industry, Inc. vs. Standard Brands, Inc., 65 SCRA 575, the Court held:

"In 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 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 dominance meaning if the competing trademarks contain 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"

Based on the foregoing, it is clear that Respondent-Applicant's trademarks "SEVENTEEN" and "SEVENTEEN with Royal Horse" would cause confusion or mistake, or to deceive purchasers that her products are those of the Opposer.

In another case, (CO TIONS SA vs. Director of Patents) 95 Phil. 1, the court ruled that the question of infringement should be determined by the test of dominance. The dissimilarity in size, form and color of the label and the place where applied are not conclusive. If the competing label contains the trademark of another and confusion or deception is likely to result, infringement takes place, regardless of the fact that the accessories are dissimilar. Duplication or exact imitation is not necessary, not it is necessary that the infringing label should suggest an effort to imitate.

It may also state that Respondent-Applicant exerted no effort to defend her rights in this case. In fact she failed to appear at the scheduled pre-trial conference in the instant cases despite due notice, hence she was declared as IN DEFAULT.

It was recently held by the Supreme Court in "DELBROS HOTEL CORPORATION vs. INTERMEDIATE APPELATE COURT", 159 SCRA 533, 543 (1988) that –

"Fundamentally, default orders are taken on the legal presumption that in failing to file an Answer, the Defendant does not oppose the allegations and relief demanded in the complaint"

Indeed, this office cannot but notice the lack of concern the Respondent-Applicant had shown in protecting the marks she had applied for registration contrary to the disputable presumption that: "A person takes ordinary care of his concern" enunciated in SEC 3 (d) of Rule 131 of the Rules of Court.

WHEREFORE, premises considered herein Notice of Opposition filed by Opposer are, as they are hereby, SUSTAINED. Accordingly, Applications bearing Serial No. 75422 and Serial

No. 75423 for the marks "SEVENTEEN with ROYAL HORSE DESIGN" and "SEVENTEEN" filed by JEANA Q. QUE, are hereby REJECTED.

Let the records of this case be forwarded to the Administrative, Financial and Human Resource Development Services Bureau for appropriate action in accordance with this Decision and copy furnished the Bureau of Trademarks for information and update of its records.

SO ORDERED.

February 2, 2000. Makati City.

ESTRELLITA BELTRAN-ABELARDO  
Director