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| GOLDLION (FAR EAST) LTD., |) | INTER PARTES CASE NO. 3017 |
| Opposer, |) | |
| |) | OPPOSITION TO: |
| |) | |
| |) | Application Serial No. 53143 |
| |) | Filed : February 8, 1984 |
| - versus - |) | Applicant : Daniel O. Dionisio |
| |) | Trademark : GOLD LION & DEVICE |
| |) | Used on : Jeans, t-shirts |
| |) | polo shirts, blouses, |
| |) | pants and sports |
| |) | shirts |
| |) | |
| |) | <u>DECISION NO. 93-12 (TM)</u> |
| |) | |
| DANIEL O. DIONISIO |) | December 8, 1993 |
| Respondent-Applicant.) |) | |
| x-----x |) | |

DECISION

On December 17, 1987, Gold Lion (FAR EAST) Ltd., a company of Hong Kong with address at Wilson Industrial Building, 4th Floor, 5 Yok Yat Street, To Kwa Wan, Kowloon, Hong Kong, filed its Verified Notice of Opposition (Inter Partes Case No. 3017) to Application Serial No. 53143 for the trademark "GOLD LION & DEVICE" used on jeans, t-shirts, polo shirts, blouses, pants and sports shirts, which application was filed on February 08, 1984 by DANIEL O. DIONISIO, a Filipino citizen, of Manila Philippines which was published on October 14, 1987 in the Manila Bulletin, a Newspaper of general circulation, which was posted on October 19, 1987.

Opposer stated as basis for its opposition the following:

1. The trademark "GOLD LION & DEVICE" is identical to the trademark of herein Opposer, which it had much earlier adopted and used, and is being used worldwide for the same goods and has become internationally famous and for which it has existing registration and/or application;
2. The Opposer has spent much for the advertisement and promotion of the said trademark worldwide and its business will be clearly damaged and will suffer irreparable injury;
3. The word "GOLD LION" is the predominant feature of the Opposer's trade name and is entitled to protection under the terms of the Trademark Law and the Paris Convention;
4. The Respondent-Applicant is not entitled to the registration of the mark "GOLD LION & DEVICE" and/or has had no bonafide commercial use thereof before its application for its registration."

Opposer relies on the following facts to support its opposition:

1. The trademark "GOLD LION & DEVICE" is well-known in Hong Kong and in the Philippines by virtue of the proximity between both countries;
2. The trademark "GOLD LION & DEVICE" is the predominant feature of the Opposer's trade name which should be unconditionally protected under Article 8

of the Convention of Paris for the protection of Industrial Property without the obligation of filing or registration, whether or not it forms part of a trademark;

3. The trademark "GOLD LION & DEVICE" as applied for by Respondent-Applicant is identical in all respects to the trademark of Opposer which it has designed, adopted and used much earlier than that of the Respondent-Applicant;

4. That its adoption by the latter is clearly in bad faith or intention of having a free ride on the popularity and goodwill of herein Opposer's mark;

5. Respondent-Applicant has no bonafide commercial use of the mark "GOLD LION & DEVICE" before its application for its registration and consequently is not entitled to the registration thereof."

On February 01, 1988 Respondent-Applicant filed his Answer raising the following special/affirmative defenses:

"1. Respondent-Applicant incorporates by reference all the material, pertinent and relevant allegation contained in his Answer;

2. Respondent-Applicant adopted and started using, as he continues to use subject mark, in good faith;

3. In the actual use of subject mark as well as in the promotion and advertisement thereof, no attempts have been made to suggest that the goods upon which subject mark are being used come from Opposer or that Respondent's business is connected with the business of Opposer;

4. Opposer has no valid cause of action against Respondent-Applicant and that the above Notice of Opposition was filed purely for the purpose of harassment;

5. Despite the long and continued use by the Respondent-Applicant of the subject mark or his products which are being marketed openly and publicly, Opposer has not interposed any objection or protest until now implying, if not signifying, Opposer's acquiescence to the use of the subject mark by Respondent-Applicant. For all intents and purposes, Opposer is now estopped from opposing the application by Respondent-Applicant."

The main issue in this case is whether Respondent is entitled to register the trademark "GOLD LION & DEVIE" for t-shirts [other good claimed in the application, i.e. jeans, polo shirts, blouses, pants and sports shirts have been abandoned by Respondent in the course of the proceedings].

The corollary issue of similarity between opposer's mark on one hand and Respondent's mark on the other hand is conceded by the Respondent (pp. 9-11, TSN July 9, 1990). Rightly so, because the marks appear to be identical.

The only pertinent question thus left for this Office to decide is whether the goods, i.e. NECKTIES and Wallets [upon which opposer's mark has been in use in the Philippines prior to respondent's use of the identical mark (Exhibit "B-33", "B-44 to 52")] are related to T-SHIRTS to the extent that "the public may be, or is actually deceived and misled that they came from the same marker or manufacturer." (ESSO Standards vs. CS, 116 SCRA 336, 342 [1982]). In other words, are neckties and wallets on one hand and t-shirts on the other hand so related to each other that when identical marks are used on them it might be reasonably assumed that they originate from the same manufacturer?

What concerns us most in ruling for the Opposer is the identity of the contesting marks. In the spectrum of likelihood of confusion, we note that when the marks of the respective parties are identical, the relationship between the goods of the respective parties need not be as close as where differences exist between the marks.

When the goods or services of the respective parties are closely related, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services.

Given the general situation where the public is generally unaware of the specific corporate structure of those whose product it buys, but is aware that corporate diversification, mergers, acquisitions, and operations through subsidiaries is a fact of life, it is reasonable to believe that the application of the identical mark "GOLDLION & DEVICE" to t-shirts could lead to confusion as to sponsorship of either or both the neckties and the t-shirts.

Moreover, even without considering the identity of the marks we are convinced that shirts and neckties are not that unrelated as to avoid the test of likelihood of confusion. We note that the activities surrounding the marketing of both goods, i.e. shirts and neckties are similar, e.g. on display in department stores with emphasis on the mark, not on the maker. Thus, bolstering the mistaken belief that they originate from or in some way associated with the same source.

Another factor that leads us to our conclusion is the fact that "GOLDLION & DEVICE" is a strong mark because it is fanciful. Therefore, it deserves wider scope of protection. In contradistinction, a weak mark, i.e. descriptive and suggestive, deserves a narrow scope of protection. This must be the very reason why Respondent admittedly copied Opposer's mark, albeit allegedly in good faith.

WHEREFORE, the Opposition is GRANTED. Accordingly, Serial No. 53143 for the mark "GOLD LION & DEVICE" for the goods jeans, polo shirts, blouses, pants and sportshirts filed on February 08, 1984 by DANILE O. DIONISION, is hereby, REJECTED.

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

SO ORDERED.

IGNACIO S. SAPALO
Director