

BURLINGTON INDUSTRIES PHIL. INC.,
(Formerly Mil-Oro Manufacturing Corp.)
Opposer,

- versus-

CHONG YON YON,
Respondent-Registrant.
X-----X

INTER PARTES CASE NO. 3963
Opposition to:

Appln. Serial No. 75956
Filed: May 03, 1991
Trademark: "TAKING CAMP"

DECISION NO. 97-26

DECISION

This pertains to an opposition filed by the herein opposer, Burlington Industries Philippines, Inc. (formerly MIL-ORO Manufacturing Corporation) in the matter of the application for the registration of the mark "TAKING CAMP" for t-shirts under Application Serial No. 75956 filed on 03 May 1991 by CHONG YON YON of Paranaque, Metro Manila which was published on page 34, Vol. VI, No. 4 of the July-August 1993 issue of the Official Gazette of the Bureau of Patents, Trademarks and Technology Transfer and released for circulation on 20 September 1993.

The basis of the Opposition are the following:

"4. 1. The mark 'TAKING CAMP' sought to be registered by the respondent-applicant closely resembles the trademark 'CAMP' owned by Opposer. The Opposer has previously used in commerce in the Philippines its trademark "CAMP" on a date earlier than 15 June 1990, the alleged date of first use of the mark 'TAKING CAMP' by the respondent-applicant. Moreover, Opposer is the holder of a subsisting Certificate of Registration No. 22374 in the Principal Register over its trademark 'CAMP' issued on 23 May 1975.

"4.2. The mark 'TAKING CAMP' of the respondent-applicant would likely cause confusion and mistake and would deceive purchasers when applied in connection with the goods of respondent-applicant, as the said mark is confusingly similar to and identical with Opposer's trademark "CAMP" which is likewise used by Opposer on the same or closely related goods, namely socks, shirts and undershirts.

"4.3. Through its long and continuous use of the trademark 'CAMP' on its goods, Opposer has acquired tremendous goodwill. Hence, the use and/or registration of a confusingly similar trademark by respondent-applicant will clearly cause damage and Injury to Opposer's business and goodwill.

"4.4. Consequently, respondent-applicant cannot claim ownership and exclusive use of the mark 'TAKING CAMP'.

Opposer relied on the following facts to support its opposition:

"5.1. Opposer is well-known in the business community as a manufacturer of high-quality socks, shirts and undershirts. Opposer has promoted and popularized its trademark 'CAMP' through advertising media and its dealers nationwide.

"5.2. Opposer has been using its trademark 'CAMP' on its goods since 08 March 1972. Thus, Opposer's first use of its trademark 'CAMP' preceded the alleged first use by respondent-applicant of the mark 'TAKING CAMP'

"5.3. Opposer has been and is continuously using its trademark 'CAMP' in Philippine commerce, and goods bearing said trademark are sold, being sold and promoted or advertised for sale by the Opposer nationwide.

"5.4. By reason of Opposer's continuous and uninterrupted use of its trademark 'CAMP' long before respondent-applicant's alleged first use of the confusingly similar 'TAKING CAMP', Opposer has established goodwill for its said trademark in Philippine commerce such that Opposer's trademark has acquired or obtained general consumer recognition as belonging to one owner or source, that is, belonging to the Opposer.

"5.5. On May 1975, Opposer obtained Certificate of Registration No. 22374 in the Principal Register for its trademark 'CAMP'. Opposer has duly renewed its Certificate of Registration, hence, Opposer's registration subsists.

"5.6. Respondent-applicant's goods on which the mark 'TAKING CAMP' is allegedly affixed is in competition with Opposer's goods which bear its trademark 'CAMP'. Respondent-applicant intends to affix the mark 'TAKING CAMP' on t-shirts, the very goods manufactured and sold by Opposer bearing its trademark 'CAMP'. Moreover, respondent-applicant's goods is identical or related to Opposer's other goods, namely undershirts and socks, as to likely cause confusion among the consumers as to the origin or source of respondent-applicant's goods.

The main issue to be resolved in this particular case is whether or not the use of the trademark "TAKING CAMP" on Respondent-Applicant's goods would likely cause confusion, mistake or deception upon purchasers as to the source or origin in thereof.

The applicable provision of the Trademark Law, Section 4(d) provides as follows:

"SEC. 4. Registration of Trademark, 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 trade name which so resembles a mark or trade name registered in the Philippines or a mark or trade name 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".

For failure of the Respondent-Applicant to file the required Answer to the verified Notice of Opposition despite Notice thereof, he was declared in DEFAULT per ORDER No. 94-380 dated 24 May 1994.

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

The evidence shows that the trademark applied for registration by the herein Respondent-Applicant CHONG YON YON for the mark "TAKING CAMP" used on t-shirts is confusingly similar to the trademark "CAMP" of the Opposer as both marks contained the word "CAMP" (Exhibits "B-2") and in the drawings of Respondent-Applicant's trademark being opposed bearing Serial No. 75956.

More importantly, the confusing similarity on the trademark of both parties is further compounded by the fact that the goods or products covered by the competing trademarks are

similar and they belong to the same class (25) of the International classification of goods, hence, there is factual basis to hold that Respondent-Applicant's trademark is confusingly similar with the Opposer's trademark.

When one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be, rejected and dismissed outright even without any opposition on the part of the owner and user of a previously registered label or trademark. This is not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill (CHUAN CHOW SOY & CANNING CO. VS. DIRECTOR OF PATENTS AND VILLAPANTA, 108 PHIL. 833,836)

It has been observed that Respondent-Applicant did not appropriate Opposer's trademark in toto to avoid the likelihood of confusion by adding the word "TAKING" thereto. 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 are: "MISS USA" and "MISS USA WORLD" (*MISS UNIVERSE INC. VS. PATRICELLI* 161 USPQ 129); "GUCCI" and "GUCCHI-GOO" (*Gucci Shop vs. R.H. Macy & Co.*, 446 F. Supp.838); "COMFORT" and "FOOT COMFORT" (*Schooll Inc. vs. Tops E.H. R. Corp.*, 185 USPQ 754), "ACE" and "FEN-ACE" (*Becton, Dickenson & Co. vs. Wigwam Mills, Inc.*, 199 USPQ, 607).

One significant factor to be given consideration in this particular case is the fact that Opposer's trademark "CAMP" is registered in this Bureau bearing Reg. No. 22374 on May 23, 1975 (Exhibit "A") covering the goods "men's and children's socks, shirts and undershirts (Exhibit "D-2"), which registration has already been renewed.

Moreover, the merchandise or goods being sold by the parties herein are ordinary commodities purchased by average persons who are at times ignorant and unlettered. These are the persons who will not, as a rule, examine the printed small letters on the container but will simply be guided by the striking dominant mark "SUPER" on the labels. Differences there will always be, but whatever they are, these play into insignificance in the face of and evident similarity of the dominant feature (the word super) and overall appearance of the labels (*Philippine Nut Industry Inc. Vs. Standard Brand Inc.*, 65 SCRA 575).

Finally, those who desire to distinguish, their goods from the goods of another have a broad field from which to select a trademark for their wares and there is no such poverty in the English language or paucity of signs, symbols, numerals, etc., as to justify one who really wishes to distinguish his product from those of all others in entering the twilight zone of the field already appropriated by another (*Weco Products Co. vs. Milton Ray Co.*, 143 F. 2d 985, 31 I C. C.P.A. Patents 1214).

It is thus clear that Respondent-Applicant merely adopted its trademark "TAKING CAMI" from opposer. The inescapable conclusion is that Respondent-Applicant is merely riding on the reputation of Opposer's mark, for, in the unlimited field of choice, what could have been Respondent-Applicant's purpose in selecting "TAKING CAMP" if not for its fame?

Thus the Supreme Court held that -

"Why of the million of terms and combination of letters and designs available, the appellee had to choose those separately similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark (*American Wire and Cable co., vs. Director of Patents*, 31 I SCRA 544). x x x

Why with all the birds in the air, and all the fishes in the sea, and all the animals on the face of the earth to choose from the defendant company (*Manila Candy Co.*) elected two roosters as its trademark, although its directors and managers must have

been well aware of the long continued use of a rooster by the plaintiff with the sale and achievement of its goods? x x x a cat, a dog, a carabao, a shark, or an eagle stamped upon the container in which candies are sold would serve as well as a rooster for the purposes of identification as the product of defendant's factory. Why did defendant select two roosters as its trademark? (Clarke vs. Manila Candy Co. 36 Philippines 100)

WHEREFORE, the Notice of Opposition is hereby SUSTAINED. Accordingly, Application Serial No. 75956 for the trademark "TAKING CAMP" filed by CHONG YON YON is hereby REJECTED.

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

SO ORDERED.

Makati City, October 25, 1997.

EMMA C. FRANCISCO
Director