

CLUETT PEABODY CO., INC.,
Petitioner,

INTER PARTES CASE NO, 1111

- versus -

PETITION FOR CANCELLATION
Cert. of Regn. No. SR-2206
Issued: July 10, 1975
Registrant: Amigo Mfg., Inc.
Trademark: GOLDTOP & DEVICE
Used on: Socks

AMIGO MANUFACTURING, INC.,
Respondent-Registrant.
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DECISION NO. 90-35 (TM)
September 3, 1990

DECISION

This is a Petition for Cancellation of trademark "GOLD TOP & DEVICE" bearing Certificate of Registration No. SR-2206 issued on July 30, 1975 used on socks, falling under Class 25 which was filed on September 9, 1974 by Amigo Manufacturing, Inc., hereinafter referred to as Respondent-Registrant.

Petitioner is a corporation organized and existing under and by virtue of the laws of the State of New York, U.S.A., whereas Respondent-Registrant is a domestic corporation organized and existing under and by virtue of the laws of the Philippines of the Philippines, with business address at 612 Old Wack Wack Road, Mandaluyong, Metro Manila, Philippines.

Petitioner claims ownership of the following trademarks and submitted documentary exhibits as basis thereof:

(a) GOLD TOP for men's socks

Registration No. 6797 issued on September 22, 1958 claiming March 16, 1954 as date of first use in commerce in the Philippines (Exhs. "I", "I-1", "I-2" and "I-3").

(b) REP. OF SOCK WITH MAGNIFYING GLASS for men's socks under Class 25

Registration No. 13465 (Exh. "J") issued on May 9, 1968 claiming February 1, 1952 as date of first use in commerce in the Philippines (Exh. "J-3"). Said mark is likewise registered in the United States Patent Office on May 26, 1964 under Registration No. 770,388 (Exh. "J-4")

(c) GOLD TOE REP. for men's socks (Class 25)

Registration No. 13887 issued on May 9, 1968 claiming January 20, 1932 as date of first use in commerce in the Philippines (Exh. "K-3").

This mark was likewise registered in the United States Patent Office on December 12, 1933 under Registration No. 308,608 (Exh. "K-4").

(d) LINENIZED for men's socks (Class 25)

Registration No. 15440 issued April 13, 1970 (Exh. "L-1") claiming February 28, 1952 as date of first use in commerce in the Philippines (Exh. "L-2-A").

The above-identified trademark is likewise registered in the United States Patent Office on June 13, 1950 under Registration No. 526,188 (Exh. "L-3").

The foregoing were likewise corroborated by Petitioner's witness, Mr. Frank Bendheim, which were made in answer to Cross-Interrogatories on June 30, 1987 at the Philippine Consulate General, New York, New York, U.S.A. before Consul Ariston E. Barsana (Exh. "R").

Based on the records of Respondent-Registrant's Registration No. SR-2206 consisting of the words "GOLD TOP, LININIZED and Rep. of sock with magnifying glass, and GOLD LINES", the alleged date of first use on the goods and in commerce in the Philippines is September 1, 1956.

The issues to be resolved are the following:

- (1) Whether or not Respondent-Registrant's trademark "GOLD TOP & DEVICE" is confusingly similar with the different trademarks registered in the name of the Petitioner; and
- (2) Whether or not Respondent-Registrant was entitled to register the mark "GOLD AND TOP & DEVICE" for socks under Class 25.

As shown by the drawings and labels on file the mark registered by Respondent-Registrant under Registration No. SR-2206 is a combination of the abovementioned trademarks registered separately by the Petitioner in the Philippines and the United States.

With respect to the issue of confusing similarity between the marks of the Petitioner and that of the Respondent-Registrant applying the tests of *idem sonans*, the mark "GOLD TOP & DEVICE" is confusingly similar with the mark "GOLD TOE". The difference in sound occurs only in the final letter at the end of the marks. For the same reason, hardly is there any variance in their appearance. "GOLD TOE" and "GOLD TOP" are printed in identical lettering. Both show representation of a man's foot wearing, a sock. "GOLD TOP" blatantly incorporates Petitioner's "LINERNIZED" which by itself is a registered mark.

Under Philippine jurisprudence, colorable imitation implies similarity; however, this does not mean such a similitude as amounts to identity. One test given is that if the form, marks, contents, words or other special, arrangement or general appearance of the alleged infringer's device as such as would likely to mislead persons in the ordinary course of purchasing the genuine articles, then the similarity is such as entitles the injured party to equitable production.

It is, therefore, not necessary that the matter sought to be protected be literally copied. Difference or variations or similarity in the details of one device or article of those of another are not legally accepted tests whether an action based on confusing similarity exists. It is sufficient that the substantial and distinctive part of the main or essential or dominant features of one mark is copied or imitated in another (Co Tiong Sa vs. Director of Patents, 95 Phil.1).

That Certificate No. SR. No. 2206 was merely registered in the Supplemental Register under Section 19-A, Republic Act 166, would not be a valid defense. Considered not registrable in the Supplemental Register are marks which are confusingly similar with those previously used by another in the Philippines. From the evidence presented, there is no doubt that Petitioner's trademarks having been used in commerce in the Philippines earlier, that Respondent-Registrant was not entitled to register its "GOLD TOP & DEVICE" mark in connection with goods in Class 25.

As to the argument that Petitioner slept on its right, if any, and therefore is guilty of laches since it filed this petition seven (7) years after the registration of Respondent's mark, the same is without merit. Respondent-Registrant cannot invoke estoppel, laches and/or acquiescence since

its adoption "GOLD TOP & DEVICE" was in bad faith as above discussed. It cannot rely on equity because he who comes into equity must come with clean hands. Equity refuses to lend its aid in any manner to one seeking its active interposition who has been guilty of unlawful or inequitable conduct in the matter with relation to which he seeks" (Pagasa Industrial Corp. vs. Court of Appeals, et al., G.R. No. 54158 August 3, 1984).

Besides, the issuance of the certificate of registration to Respondent-Registrant for the trademark "GOLD TOP & DEVICE", Registration No. SR-2206, did not even give rise to any presumption of validity of registration, ownership, and exclusive right to use the mark (Sec. 20, Republic Act 166).

WHEREFORE, the Petition is GRANTED. Consequently, Certificate of Registration No. SR-2206 issued to Respondent-registrant is hereby CANCELLED.

Let the records of this case be remanded to the Patent/Trademark Registry and EDP Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director