

FRUIT OF THE LOOM, INC.
Opposer,

INTER PARTES CASE NO. 3842
Opposition to:

-versus-

Appln. Serial No. 78938
Filed : 18 December 1991
Trademark : "FRUITS"

ROGELIO S.J. BONALES,
Respondent-Applicant.

DECISION NO. 98-04

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DECISION

This pertains to a Verified Notice of Opposition by Fruit of the Loom, Inc., a corporation organized and existing under the laws of the State of New York, U.S.A., with business address at One Fruit of the Loom Drive, Bowling Green, Kentucky 42103, United States of America against Application Serial No. 78938 filed by Rogelio S. Bonales on December 18, 1991 for the registration of the trademark FRUITS used on pants, t-shirts, jogging pants and sweat shirts.

The grounds for Opposition are as follows:

- "1. The trademark "FRUITS" so resembles Opposer's trademark FRUITY OF THE LOOM, which has been previously used in commerce in the Philippines and other parts of the world and not abandoned as to be likely, when applied to or used in connection with the goods of applicant, to cause confusion, mistake and deception on the part of the purchasing public.
- "2. The registration of the trademark FRUITS in the name of the Applicant will violate Section 37 of Republic Act No. 166, as amended, and Section 6bis and other provisions of the Paris Convention for the Protection of the Industrial Property to which the Philippines and the USA are parties.
- "3. The registration and used by the Application of the trademark FRUITS will diminish the distinctiveness and dilute the goodwill of Opposer's registered trademark FRUIT OF THE LOOM.
- "4. The registration and used by the Applicant of the trademark FRUITS amount to an infringement of Opposer's registered trademark FRUIT OF THE LOOM and of its tradename FRUIT OF THE LOOM, INC., which is protected under Section 37 of the Trademark Law and under the Paris Convention.
- '5. The registration of the mark FRUITS in the name of the Applicant is contrary to other provisions of the Trademark Law."

To support its Opposition, Opposer relied on the following facts:

- "1. Opposer is a manufacturer of a wide range of clothing with the mark "FRUIT OF THE LOOM" which have been marketed and sold in the Philippines and other parts of the world including but not limited to, sweatshirts, socks and hosiery. Opposer has been commercially using the trademark FRUIT OF THE LOOM internationally and in the Philippines prior to the use of the "FRUITS" by Applicant.
- "2. Opposer is the owner of the trademark FRUIT OF THE LOOM & DESIGN, which it has registered with the Bureau of Patents, trademarks and Technology Transfer

under Registration No. 37087 dated April 8, 1987 for goods in Class 25. Opposer has also filed an application for FRUIT OF THE LOOM & DESIGN under Serial No. 76137 for textile, which the Bureau has already admitted for publication. Opposer has also registered and used FRUIT OF THE LOOM & DESIGN as a trademark for the same products in the United States of America and in many other countries. A copy of each of the above registration/application is hereto attached as Annexes "A" and "B", respectively.

- "3. Opposer is the first user of the trademark FRUIT OF THE LOOM AND DESIGN on the goods included under the above-described registration and application, which Opposer has sold and marketed in various countries worldwide.
- "4. By virtue of Opposer's prior and continued used of FRUIT OF THE LOOM & DESIGN both as a trademark and tradename in the Philippines, and other parts of the world, said trademark and tradename have become popular and internationally well-known and have established valuable goodwill for Opposer among consumers who have identified Opposer as the source of the goods bearing said trademark and tradename.
- "5. The registration and use of a confusingly similar trademark by the Applicant will tend to deceive and/or confuse purchasers into believing that Applicant's products emanate from or are under the sponsorship of Opposer, for the following reasons:
 - "i) the marks are similar in terms of pronunciation, spelling and other particulars;
 - "ii) the marks are applied on identical goods;
 - "iii) the parties are engaged in competitive business;
and
 - "iv) the goods on which the marks are used are brought by the same class of purchasers and flow through the same channels of trade.

Applicant obviously intends to trade, and is trading on, Opposer's goodwill.

- "6. The registration and use of a confusingly similar trademark by Applicant will diminish the distinctiveness and dilute the goodwill of Opposer's trademark."

Opposer filed its verified and authenticated Notice of Opposition on 12 February 1993. The Bureau served the Notice to Answer to Respondent-Applicant on 18 March 1993. However, despite the granting of time to file an Answer/Comment in Order Nos. 93-275, dated 23 April 1993; and 93-276 dated 3 May 1993, Respondent-Applicant failed to file his answer/comment on said Notice to date.

Thus, the bureau, through motion of herein Opposer, declare Respondent-Applicant in default for failure to file Answer/Comment to the Notice of Opposition under Order No. 93-488, dated 19 July 1993.

Consequently, after the evidence for Opposer were received ex-parte and on 3 October 1994, the Bureau admitted Opposer's Formal Offer of Evidence consisting of Exhibits "A-1" to "A-20" inclusive of submarkings.

The main issue to be resolved in this case is whether or not Respondent- Applicant's trademark "FRUITS" used on pants, t- shirts, shorts, jogging pants, and sweat shirts is

confusingly similar to that of Opposer's "FRUIT OF THE LOOM" mark used on clothing for men, women, and children.

With the enactment of R.A. 8293, otherwise known as the "Intellectual Property Code of the Philippines" which took effect on January 01, 1998, the application for registration of the mark "FRUITS" should have been prosecuted under the new law (R.A. 8293)

However, this Office takes cognizance of the fact that the herein Application Serial No. 78938 was filed on 18 December 1991 when the new law was not yet in force. Section 235.2 of R.A. 8293, provides, inter alia that "All applications for registration of marks or trade names pending in the Bureau of Patents, Trademarks and Technology Transfer at the effective date of this Act may be amended, if practicable to bring them under the provision of this Act.

x x x

If such amendment are not made, the prosecution of the said application shall be PROCEEDED WITH and registration thereon granted in accordance with the ACTS UNDER WHICH SAID APPLICATION WERE FILED AND SAID ACTS HEREBY CONTINUED IN FORCE TO THIS EXTENT ONLY NOTWITHSTANDING THE FOREGOING REPEAL THEREOF." (Underscoring supplied).

Considering however, that this application subject of opposition proceeding is now for resolution, thereby rendering impractical to so amend it in conformity with R.A. 8293 without adversely affecting rights already acquired prior to the effectivity of the new law (Sec. 326, supra), this Office undertakes to resolve the case under the former law, R.A. 166 as amended, more particularly Section 4 (d) which provided:

"Sec 4. Registration of trademarks, trade names and service mark on the principal register. - There is hereby established a register of trademarks, trade names and service marks which shall be known as the principal register. The owner of the trade mark, trade name or service mark used to distinguish his goods, business or services from the goods, business or services of the others shall have right to register the same on the principal register unless it:

x x x

(d) Consist of or comprise a mark or trade name which so resembles a mark or tradename registered in the Philippines or a mark or trade name registered in the Philippines or a mark or trade name previously used in the Philippines by another and not goods, business or service of the applicant, to cause confusion or mistake or to deceive consumers".

x x x

In the case at bar, it can easily be discerned that the word FRUIT is the dominant feature of both marks, the trademark in question being a mere word mark "FRUITS".

Thus, as is aptly stated by our Supreme Court:

"It has been consistently held that the question of infringement is to be determined by the test of dominancy. Similarity in size, form and color, while relevant is not conclusive. If the competing trademark contain the main or essential dominant features of another, and confusion and deception is likely to result, infringement takes place. Duplication or imitation is not necessary, nor is it necessary that the infringing label should suggest an effort to imitate." (Co Tiong Sa vs. Director of Patents, 95 Phil. 1, cited in American Wire & Cable vs. Director of Patents; G.R. No. L-26559, February 18, 1970, 31 SCRA 428)

Moreover, applicant's "FRUITS" trademark is being used on identical and similar goods i.e., pants, t-shirts, shorts, jogging pants, and sweat shirts whereas Opposer's FRUIT OF THE LOOM is being used on underwear, lingerie, dress, shirts, sports and knit shirts, slacks, pants, jeans, shorts, blouses, pajamas, sleepers, waterproof pants, bibs, aprons, gym shorts and play suits, bloomers, robes, ties, belts, gloves, handkerchiefs, scarfs, raincoats, capes and jackets, socks, hosiery, leotard tights, shoes, sneakers, boots and rubbers which are identical and/or related goods.

"Goods are related when they belong to the same class or have the same descriptive properties, when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality." (ESSO Standard Eastern, Inc., vs. Court of Appeals, 116 SCRA 341)

Thus, trademark being applied on the same class of goods, will be sold in the same channels of trade, i.e. through department stores and clothing suppliers and are therefore competitive.

Furthermore, as testified by Ms. Joyce M. Russel, Opposer's witness Opposer is the first user of the trademark FRUIT OF THE LOOM in commerce in the U.S.A. since 1856 on a variety of goods just enumerated. It established valuable goodwill for Opposer among consumer who have identified Opposer as the source of goods bearing the trademark.

In contrast, applicant is merely a subsequent user of the trademark FRUITS. It is well settled that between a first user and subsequent user of the same or confusingly similar trademark that, the right of a first user to the exclusive use of such trademark must always prevail.

The Supreme Court has held that conflicting claims to a trademark should be resolved in favor of the prior user. (Gabriel vs. Perez, 55 SCRA 406). The prior user is entitled to protection in the trade he has built up and the goodwill he has accumulated from the use of the trademark. (Sterling Products International, Inc. vs. Farbenfabriken Bayer Aktiengesellschaft, 27 SCRA 1214).

Hence, Opposer's right to the exclusive use of the trademark FRUIT OF THE LOOM must prevail over applicant's FRUITS.

IN VIEW OF THE FOREGOING REASONS, this Office is convinced that the registration of FRUITS in favor of the applicant would cause confusion, fraud and deception on the buying public.

WHEREFORE, the Notice of Opposition is, as it is hereby SUSTAINED. Accordingly, Application Serial No. 78938 filed by Respondent-Applicant Rogelio S.J. Bonales for the registration of the mark "FRUITS" used on pants, t-shirts, shorts, jogging pants, sweatshirts, is hereby REJECTED.

Let the file wrapper subject matter of this case be forwarded to the Administrative, financial and Human Resource Development Bureau for appropriate action in accordance with this Decision to be furnished the Bureau of Trademarks for information and update of the its own record.

SO ORDERED.

Makati City, November 02, 1998.

ESTRELLITA BELTRAN-ABELARDO
Caretaker/Officer-In-Charge