

FRUIT OF THE LOOM,
Opposer,

INTER PARTES CASE NO. 3096

OPPOSITION TO:

Application Serial No.: 51274
Filed: May 24, 1983
Applicant: Fashion World
Garments Mfg. Corp.
Trademark: FRUIT OF HAWAII
Used On: T-shirts, polos, polo, shirts,
shorts, briefs, jackets, pants

- versus -

FASHION WORLD GARMENTS
MFG. CORP.,
Respondent-Applicant.
x-----x

DECISION NO. 90-14 (TM)
February 27, 1990

DECISION

On June 21, 1988, Fruit of the Loom filed an Unverified Notice of Opposition against the registration of the trademark "FRUIT OF HAWAII" used on T-shirts, polos, polo shirts, shorts, briefs, jackets and pants applied for by Fashion World Garments Mfg. Corp. on May 24, 1983 in Application Serial No. 51274, published on Page 87, Volume I, No. 3 of the BTTT Official Gazette dated and released for circulation on May 23, 1988.

Opposer is a foreign corporation organized under the laws of the State of New York, New York, U.S.A., while Respondent-Applicant is a domestic corporation with business address at 92 Engineering Street, Araneta University Village, Malabon, Metro Manila, Philippines.

The grounds alleged in the Verified Notice of Opposition later filed on August 9, 1988 are:

"1. Applicant is not entitled to register the trademark FRUIT OF HAWAII which is confusingly similar to opposer's trademark FRUIT OF THE LOOM and Design and FRUIT OF THE LOOM and Design, which have been registered with the BPTTT and used in commerce in the Philippines and other parts of the world long before applicant's date of first use alleged in the application. x x x

2. The registration of the trademark, FRUIT OF HAWAII by applicant will violate Section 37 of Republic Act No. 166, as amended, and Section 6 bis and other provisions of the Paris Convention for the Protection of Industrial Property to which the Philippines and the U.S.A. are parties.

3. The registration of and use by Applicant of the trademark FRUIT OF HAWAII will diminish the distinctiveness and dilute the goodwill of opposer's registered trademarks.

4. The registration of the trademark FRUIT OF HAWAII in the name of the applicant will contravene other provisions of Republic Act No. 166, as amended."

On August 11, 1988, Respondent-Applicant was notified of this and was required to file its Answer thereto within fifteen (15) days from receipt of the notice.

Respondent-Applicant failed to file any Answer within the period prescribed by the Rules. The case was dormant for almost a year so the Bureau, on August 7, 1989, sent a letter to the parties inquiring if they are still interested in litigating the case.

On August 22, 1969, Opposer filed a Compliance pleading and prayed therein that, for failure to file its Answer, Respondent should be declared in default and was so declared as such in Order no. 89-780 dated September 22, 1989.

Opposer presented on January 17, 1990 its evidence ex-parte consisting of Exhibits "1" and "2" pursuant to Order No. 89-750 and, in open court, were offered and admitted in evidence for the offeror.

The issue here is whether or not Applicant's trademark "FRUIT OF HAWAII" so resembles Opposer's trademark "FRUIT OF THE LOOM" as to be likely, when applied to or used in connection with the goods or business of the Applicant, to cause confusion or mistake to deceive purchasers.

Opposer contends that Respondent-Applicant's trademark "FRUIT OF HAWAII" is likely to be confused with Opposer's trademark "FRUIT OF THE LOOM" for the following reasons:

- (1) The marks are similar in terms of commercial appearance, pronunciation, spelling and other particulars;
- (2) The marks are used on identical goods;
- (3) The parties are engaged in competitive business; and
- (4) the Foods are purchased by the same class of purchasers and flow through the same channels of trade.

Though the aforecited marks are not identical, Opposer contends that one could be confused with the other because they have a common dominant feature in the word "FRUIT". In addition, both marks are used on identical or similar goods and therefore are engaged in competitive business, i.e., their goods are purchased by the same class of buyers through the same channels of trade. Opposer cited the following marks which were declared confusingly similar to each other because they contain the same dominant word and used on identical goods:

- (1) "BOND SPECIAL" and "RECORD STREET" – (Philip Morris Incorporated vs. La Perla Industries, Inc. in Inter Partes Case No. 276, Sept. 7, 1981)
- (2) "BOND SPECIAL" and "GOLD BOND" – (Gallagher Limited vs. La Perla Industries, Inc., Decision No. 306, Oct. 8, 1981)
- (3) "OSRAM" and "OSLAMP-POWERBRIGHT" – (Osram GmbH Kommandit Gesellschaft vs. Leviton Industries, Inc., Decision No. 227, Sept. 8, 1981)

A side-by-side comparison of the marks shows similarity in printing style used with a bunch of fruits logo. In such a case, the courts held:

"x x x If the competing trademarks 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. x x x The question at issue in cases of infringement of trademarks is whether the use of marks involved should be likely to cause confusion or mistake in the mind of the public or deceive purchasers." (Co Tiong vs. Director of Patents, G.R. No. L-26957, Feb. 18, 1970: 31 SCRA 428 and 548)

Opposer presented as proof of its ownership of the mark "FRUIT OF THE LOOM & DESIGN" Certificate of Registration No. 37087 issued by the then Philippine Patent Office (now Bureau of Patents, Trademarks and Technology Transfer) on April 8, 1987 indicating therein that the same mark has been issued in its favor in the United States of America under Registration No. 913, 840 issued on June 8, 1971 (Exh. "1"); that Respondent mark "FRUIT OF HAWAII" and Opposer's mark "FRUIT OF THE LOOM", both with bunch of fruits design, are likewise used in identical goods (Exh. "1" and label from Respondent's application file wrapper). Opposer presented another Registration Certificate No. 21999 likewise issued by the Philippine Patent Office on May 9, 1980 which is a renewal of the same mark "FRUIT OF THE LOOM" (Exh. "2").

We find the marks to be confusingly similar, and the evidence show the Opposer as the owner of "FRUIT OF THE LOOM" based on prior use and registration and the registered owner of one of the conflicting marks in litigation. Respondent-Applicant likewise failed to file its Answer and was thus declared in default.

WHEREFORE, this Notice of Opposition is SUSTAINED. Application Serial No. 51274 seeking the registration of the mark "FRUIT OF HAWAII" is REJECTED.

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

SO ORDERED.

IGNACIO S. SAPALO
Director