

FRUIT OF THE LOOM,
Opposer,

INTER PARTES CASE NO. 3636
Opposition to:

-versus-

Appln. Serial No. 68729
Date Filed: 07-27-89
Trademark: "LOOMS"

VICENTE VILLANUEVA,
Respondent-Applicant.

DECISION NO. 98-17

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DECISION

This pertains to an Opposition filed by FRUIT OF THE LOOM, INC., a foreign corporation duly organized under the laws of the State of New York, U.S.A., with principal address at One Fruit of the Loom Drive, Bowling Green, Kentucky, U.S.A., against Application Serial No. 68729 for the trademark "LOOMS" used on infants and children's wear for mittens, binders, face towel, bibs, diaper, blanket, bath towel, baby dress, tieside, short, briefs, panties, sandos, pajama, pants and t-shirts under Class 25 (International Classification of Goods).

In the verified Notice of Opposition, Opposer alleged the following grounds:

- "1. The trademark "LOOMS" so resemble Opposer's registered trademark, trade name 'FRUIT 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 'LOOMS' 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 Industrial Property to which the Philippines and the United States of America are parties;
- "3. The registration and use by applicant of the trademark "LOOMS" will diminish the distinctiveness and dilute the goodwill of Opposer's trademark and trade name 'FRUIT OF THE LOOM';
- "4. The registration of the trademark 'LOOMS' in the name of applicant is contrary to other provisions of the trademark law."

The facts relied upon by oppose in support of its Opposition were as follows:

- "1. Opposer is a manufacturer of a wide range of clothing bearing the trademark 'FRUIT OF THE LOOM' which have been marketed and sold in the Philippines and in other parts of the world. Opposer has been commercially using the trademark 'FRUIT OF THE LOOM' internationally and in the Philippines prior to the use of 'LOOMS' by Applicant;
- "2. Opposer is the owner of the trademark and trade name 'FRUIT OF THE LOOM' which was previously registered with the Bureau of Patents, Trademarks and Technology Transfer under Registration Certificate No. 37087 dated April 08, 1987 for goods in class 24 and 25. Opposer has also registered and used 'FRUIT OF THE LOOM' as trademark for clothing in the United States of America and in other countries;

- “3. Opposer is the first user of the trademark ‘FRUIT OF THE LOOM’ on the goods included under the above described registration which have been sold and marketed in various countries worldwide;
- “4. By virtue of Opposer’s prior and continuous use of ‘FRUIT OF THE LOOM’ 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 oppose as the source of the goods bearing the said trademarks and tradenames;
- “5. The registration and use of the confusingly similar trademark by the applicant for use on identical or related goods will tend to deceive and/or confuse the purchasers into believing that applicant’s products emanate from or under the sponsorship of oppose. 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 and tradenames.”

On March 14, 1991, Respondent-Applicant filed his Answer to the Verified Notice of Opposition specifically denying the material allegations in the Notice of Opposition and in addition raised the following special and affirmative defenses:

- “7. Opposer has no cause of action. Assuming it has, the same has been extinguished or barred by laches and estoppel;
- “8. The registration of Opposer’s trademark was obtained irregularly and in violation of Section 4(c) and (d) of Republic Act No. 166;
- “9. Opposer’s trademark is descriptive of the goods or business to which it is applied or used; hence incapable of exclusive appropriations;
- “10. Respondent was first to adopt, use and register the trademark ‘LOOMS’ in the Philippines. Consequently, assuming there is confusing similarity between Respondent’s said trademark and Opposer’s ‘FRUIT OF THE LOOM’ trademark, the latter’s registration was illegally procured and must be cancelled;
- “11. Respondent is only the lawful user of the trademark ‘LOOMS’ in the Philippines and her use thereof cannot possibly deceive or confuse the purchasing public;
- “12. Respondent’s herein application is merely for the re-registration of her trademark ‘LOOMS’ which she has not abandoned having continuously used the same since 1954 to identify his goods and to distinguish them from those sold and made by others, by among others prominently displaying the marks on her goods, their wrappers and the displays and various types of advertising materials associated therewith;
- “13. By reason of Respondent’s long, prior and continued use in the Philippines of the aforesaid trademark and extensive advertising thereof, the said trademark has acquired a meaning exclusively identified with the goods or products of Respondent and gained wide acceptance among the consuming public. Having established an extensive goodwill of her own, Respondent cannot possibly, nor does she intend to trade on the alleged goodwill of Opposer.”

The issues having been joined, pre-trial conference was set on May 07, 1991, and there being no amicable settlement reached by the parties, trial on the merit ensued.

From the various issues raised by both Opposer and Respondent-Applicant, the controversy boils down to one common and main issue – WHETHER OR NOT CONFUSING SIMILARITY EXISTS BETWEEN OPPOSER’S MARK “FRUIT OF THE LOOM”, AND RESPONDENT’S “LOOMS” TRADEMARK.

With the enactment of the R.A. 8293, otherwise known as the “Intellectual Property of the Philippines” which took effect on January 01, 1998, the application for registration of the mark “LOOMS” 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. 68729 was filed on 27 July 19889 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 amendments are not made, the prosecution of said application shall be proceeded with and the registration thereon granted in accordance with the Acts under which said application was filed and said acts hereby continued in force to this extent only notwithstanding the foregoing repeal thereof.”

Considering however, that this application has already been allowed and published, 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. 236, supra), this Office undertakes to resolve the case under the former law, R.A. 166, as amended, more particularly Section 4(d) which provides:

“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 a trademark, trade name or service mark used to distinguish his goods, business or service from the goods, business or service of others shall have the right to register the same on the principal register unless it:

XXX

(d) Consist of comprises a mark or trade name which so resembles a mark or trade name registered in the Philippines or a mark or tradename 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 consumers.”

A cursory comparison of the two marks LOOMS of Respondent and Opposer’s FRUIT OF THE LOOM; (Exhibits B-14, B-14a to B-17, inclusive of sub markings; Exhibits “7” to “11”, inclusive of sub-markings) would disclose the following observations:

1. AS TO SIZE OF LETTERS – The trademark LOOMS is printed in bold capital letters with similar and uniform sizes inside an oval, whereas the mark FRUIT OF THE LOOM is written in fine letters also within an oval;
2. AS TO COLORS – The mark LOOMS consists of bands of black/blue, red and yellow colors, whereas the mark FRUIT OF THE LOOM is characterized by a variety of fruits in green, violet, red and dark brown colors appearing above the name FRUIT OF THE LOOM;
3. AS TO PICTORIAL ARRANGEMENTS – The mark LOOMS is situated within a middle red band in-between bands of black/blue on top, and yellow below,

whereas the mark FRUIT OF THE LOOM is laid out in a white oval with different types of fruits on top edge;

4. AS TO GRAMMATICAL PRESENTATION – The word LOOM in the mark LOOMS is a one-word plural noun, whereas the word LOOM in the mark FRUIT OF THE LOOM is part of a compound words in singular noun.

Upon a keen analysis of this comparison, one would inevitably be led to conclude that the Respondent's LOOMS trademark is NEITHER IDENTICAL TO, CONFUSINGLY SIMILAR WITH, NOR A COLORABLE IMITATION OF THE OPPOSER'S FRUIT OF THE LOOM TRADEMARK.

The distinctions in the aforementioned comparison are so glaringly prominent to cast away any iota of doubt as to the variance in the source or origin of these trademarks, to the extent that regular and new purchasers of the products bearing the subject marks would be drawn by the appearance of the fruit device in the mark FRUIT OF THE LOOM, or of the multi-colored backdrop in the trademark LOOMS more than the sight of the word LOOM found in both marks (Exhs. "B-24" to "B74", including sub-markings; "2-s", "2-t" and "2-t-1").

The pronunciation of the Supreme Court in FRUIT OF THE LOOM, INC. vs. Court of Appeals (133 SCRA 405-412), has put squarely to rest the arguments of Opposer, to wit:

“ x x x

The similarities of the competing trademarks in this case are completely lost in the substantial differences in design and general appearance of their respective hang tags. WE have examined the two trademarks as they appear in the hang tags submitted by the parties and We are impressed more by the dissimilarities than by the similarities appearing therein. WE hold that the trademarks FRUIT OF THE LOOM and FRUIT OF EVE do not resemble each other as to confuse or deceive an ordinary purchaser. The ordinary purchaser must be thought of as having, and credited with at least a modicum of intelligence (Carnation Co. vs. California Greeneries Wineries, 97 F 2d 80; Hiram Walke and Sons vs. Penn-Maryland Corp., 79 F. 2d 836) to be able to see the obvious differences between the two trademarks in question. Furthermore, WE believe that a person buys petitioner's products and starts to have a liking for it, will not get confused and reach out for private respondent's products when she goes to a garment store.

x x x”

Despite the impression that the FRUIT OF THE LOOM is an internationally well-known mark (Exhs. "B-18" to "B-23"), inclusive of sub-markings), and the fact that opposer had been and may have been continuously engaged in extensive advertising worldwide (Exhs. B-18 to B-21, B-22 to B-23, inclusive of sub-markings), the trademark LOOMS can stand by itself, and independently of, Opposer's mark because of the apparently distinctive appearance and features both marks portray. Invariably, the FRUIT OF THE LOOM AND LOOMS trademarks, throughout the years of their market exposure, have established goodwill and reputation between themselves so much to that purchasers would not get confused or be deceived by the representation of their respective marks.

And finally, as borne by evidence, respondent-applicant's "LOOMS" trademark has been in continuous use since 1954. It was registered in the Supplemental Register on 21 November 1958 under SR No. 208 (Exh. "1"), and was thereafter registered in the principal register under No. 2306 for children's and ladies' panties on 12 May 1976 (Exh. "2-a"). It is only due to respondent's failure to file an affidavit of use on the 15th anniversary from registration in the principal register which thus resulted in the cancellation of the said Registration No. 2306 that

herein applicant is re-applying for registration of the same. (Exh. "2"). However, respondent continued to use the mark "LOOMS" by engaging in various sales in the Philippines during this period as shown by Exhibits "5", "6", "7", "8", "9", "10", "11", "12".

These pieces of evidence would only show that applicant had established ownership of the mark "LOOMS" which have been known to have originated from the herein applicant. These further ruled out abandonment of the trademark.

In consequence thereof, this Office so holds that the Opposer's challenge to the ownership, possession, and use of herein applicant over the trademark "LOOMS" is devoid of merit.

WHEREFORE, the notice of opposition is, as it is hereby DENIED. Accordingly, Application Serial No. 68729 for the trademark "LOOMS" used for infant's and children's wear, etc. is GIVEN DUE COURSE.

Let the filewrapper subject matter of this case be forwarded to the Administrative, Financial and Human Resource Development Bureau for appropriate action in accordance with this DECISION, with a copy to be furnished the Bureau of Trademarks for information and update of its record.

SO ORDERED.

Makati City, 24 December 1998.

ESTRELLITA BELTRAN-ABELARDO
Officer/Officer-In-Charge