

H.D. LEE COMPANY, INC.,
Opposer/ Petitioner,

INTER PARTES CASE NO. 1558

OPPOSITION TO:

Cert. of Regn. Nos. SR-5054
Issued : October 27, 1980
Registrant : Emerald Garments
Manufacturing Corp.
Trademark : STYLISTIC MR. LEE
Used on : Garments, particularly
shirts, T-shirts, pants,
jeans, blouses, socks,
briefs, jackets, jogging
suits, dresses, shorts,
skirts and lingerie

- versus -

- and -

INTER PARTES CASE NO. 1860

OPPOSITION TO:

Application Serial No. 42694
Filed : September 25, 1980
Applicant : Emerald Garments
Manufacturing Corp.
Trademark : STYLISTIC MR. LEE
Used on : Same as above

EMERALD GARMENTS MANUFACTURING
CORPORATION,

Respondent-Registrant/
Applicant.

x-----x

DECISION NO. 88-49 (TM)
July 19, 1988

DECISION

This is a Petition for Cancellation of trademark "STYLISTIC MR. LEE" under Certificate of Registration No. SR-5054 for garments, particularly shirts, T-shirts, pants, jeans, blouses, socks, briefs, jackets, jogging suits, dresses, shorts, shirts and lingerie under Class 25; and Opposition to trademark "STYLISTIC MR. LEE" under Serial No. 42694 for goods under the same class as Certificate No. SR-5054 filed on February 2, 1982 and October 12, 1984, respectively, by Petitioner, H. D. Lee Company, Inc.

Petitioner is a foreign corporation organized under the laws of Delaware, U.S.A., located and doing business at 90001 West 67th Street, Merriam, Kansas, U.S.A., whereas Emerald Garments Manufacturing Corporation, Respondent herein, is a domestic corporation organized and existing under Philippine laws, with business address at No. 46 9th Avenue Extension, Bo. Galinao, Quezon City, Philippines.

The records reveal that Petitioner is the duly registered owner of the following trademarks:

- (1) "LEE" (Exhs. "A" and "A-1")
- (2) "LEE RIDER" (Exh. "B")
- (3) "LEE LEENS" (Exh. "C")
- (4) "LEE" (Exh. "C-1")

and claiming November 2, 1967 as its date of prior use in the Philippines (Exh. "A"), whereas Respondent-Registrant is the owner of trademark "STYLISTIC MR. LEE" (Exhs. "1", "1-A" to "1-D") claiming May 1, 1975 as its date of prior use.

Petitioner alleged that the trademark registered in the name of Respondent-Registrant would cause confusion, mistake and deception to the buying public because it is similar to Petitioner's trademark. And as grounds for cancellation, Petitioner invoked Section 37 of Republic Act 166 and Article VIII of the Paris Convention for the Protection of Industrial Property.

Respondent-Registrant alleged that Petitioner's grounds for cancellation are not among those enumerated by Section 17 of Republic Act 166, and that its mark and design do not resemble the trademark of Petitioner. Respondent-Registrant further argued that the issuance of the certificate of registration was legally justified.

Both testimonial and documentary evidences were introduced before this Bureau. Respondent-Registrant adduced proof consisting of a pair of maong jeans bearing the trademark "STYLISTIC MR. LEE" and pictures of its products on display at various department stores, to establish that since 1975 it has sold several pants bearing the trademark "STYLISTIC MR. LEE" to various department stores and bazaars (Exhs. "E" and "1-F" to "1-0") and advertised on radio (Exhs. "4" and "4-A" to "4-G") and showrooms of department stores (Exhs. "3", "3-A" to "3-H"). Respondent-Registrant introduced the testimonies of several witnesses (Exhs. "13" to "18") including the testimony of the Assistant City Fiscal of Caloocan City, Metro Manila (Exh. "7") to prove that since 1975 Emerald Garment Manufacturing Corporation had been manufacturing and selling goods bearing the trademark "STYLISTIC MR. LEE" and there never was an instance wherein the public was confused about the origin of the goods; and said trademark is not confusingly similar with Petitioner's trademark.

Petitioner adduced proof consisting of the original Certificate of Registration No. SR-1094-A issued on March 17, 1972 for "LEE"; Certificate of Registration No. 19360 issued on July 2, 1973 for "LEE RIDER"; Certificate of Registration No. 19207 issued on June 19, 1973 for "LEE LEENS"; Certificate of Registration No. SR-1520 issued on June 20, 1972 for "LEE" to show that it was the senior registrant of the trademark "LEE", having allegedly used it in the Philippines as early as 1967 (Exhs. "A", "B", "C" and "C-1") and Respondent-Registrant's "STYLISTIC MR. LEE" jeans is confusingly similar to the original "LEE" jeans (Exhs. "N", "N-1", "U", "W", "O", "Q", "Q-1"). Proof of advertisement and promotion in various medium of communications (TV, radio, etc.) were also introduced by Petitioner (Exhs. "G", "G-1" to "G-4"; "J", "J-1" to "J-3"; "M", "H-6", "I", "I-1", "Q", "Q-1" and "Q-2"; "P", "P-1" and "P-2", "K", "F", "F-1" to "F-59").

The sole issue in this case is whether or not Respondent-Registrant's trademark is confusingly similar with Petitioner's trademark.

The evidence (Exhs. "U", "W" and "N") disclose that Respondent-Registrant's jeans bearing the trademark "STYLISTIC MR. LEE" are exactly alike that manufactured by Petitioner; the buyers of the goods belong to the class of "ordinary purchasers" who, ordinarily, will not examine the small letterings printed on the leather patch or label but will simply be guided by the presence of the striking mark "LEE". It is true that there are other words, such as "STYLISTIC", printed in Respondent-Registrant's leather patch label, but this word is printed in such small letters over the word "LEE" that it is not conspicuous enough to draw the attention of the ordinary buyer, whereas the word "LEE" is printed in such big letters and of the same color, style, type and size of lettering as the trademark of the Petitioner.

In determining confusing similarity, a side-by-side comparison of the marks, emphasizing differences in detail, is not the appropriate test. The key inquiry is not similarity per se but rather whether a similarity exists which is likely to cause confusion. (See Exxon Corp. vs. Zoil Energy Resources, Inc., 552 F. Supp. 1008, 1016, 216 USPQ 634, 641-642 (S.D.N.Y.). This test must be applied from the perspective of purchasers. Thus, it must be determined whether the impression which the infringing mark makes upon the consumer is such that it is likely to believe the product is from the same source as the one he knows under the trademark (McGregor-Doniger, Inc. vs. Drizzle, Inc., 599 F. 2d at 1133, 202 USPQ 81, 86-7). In making this determination, it is the overall impression of the marks as a whole that must be considered. (See Armstrong Cork Co. vs. World Carpets, Inc., 597 F 2d 496, 502.) Likewise, it has been consistently held that infringement of a trademark is to be determined by the test of dominance. Similarity in size, forms and colors, while relevant, is not conclusive. If the competing trademarks contain the main essential or 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, G.R. No. L-5372, May 24, 1954).

It is the word "LEE" which draws the attention of the buyer and leads him to conclude that the goods originated from the same manufacturer. It is undeniably the dominant feature of the mark.

To prove that it has sold substantial quantity of its products in the local market, Petitioner introduced the letter from the Board of Investments dated July 24, 1981 giving it authority to sell 30% of its production to the local market (Exh. "V-3"), "Point-of-Purchase" advertising materials and "STANDS" provided to its authorized dealers (Exhs. "J", "J-1" to "J-3"; "F" and "F-1" and "K"), and to further increase its sale in the local market, Petitioner advertized its products in newspapers and magazines, like "The Bulletin Today" and "Manila Women's Wear" /MWW/ (Exhs. "G", "G-1" to "G-4", "I" and "I-1").

Having proven priority of registration in the Philippines of the trademark "LEE", and that it had been using the mark in the Philippines, and that the Respondent's registration was obtained contrary to Section 4(d) of the Trademark Law, Petitioner has successfully established his case.

WHEREFORE, the herein Petition for Cancellation and Opposition for registration are hereby GRANTED.

Let the records of these cases be forwarded to the Trademark Examining Division for proper action in accordance herewith.

SO ORDERED.

IGNACIO S. SAPALO
Director

