

JANTZEN, INC.,  
Opposer,

INTER PARTES CASE NO. 3148

OPPOSITION TO:

- versus -

Application Serial No. 50923  
Filed : April 23, 1987  
Applicant : Jaime G. Lopez  
Trademark : THE GOLDEN GIRL  
JANTZEN  
Used on : Ladies shoes

JAIME G. LOPEZ  
Respondent-Applicant.

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DECISION NO. 89-42 (TM)  
July 10, 1989

### DECISION

On July 7, 1988, Jantzen, Inc. (herein Opposer) lodged its opposition to the registration of the trademark "THE GOLDEN GIRL JANTZEN" with Application Serial No. 50923 for ladies' shoes in the name of Jaime G. Lopez (herein Respondent Applicant).

Opposer is a foreign corporation organized and existing under the laws of the State of Nevada, U.S.A., doing business at Portland, Oregon, U.S.A., while Respondent-Applicant is a citizen of the Philippines, with business address at 1891-93 C. M. Recto Avenue, Metro Manila, Philippines.

The only issue raised by the Opposer is whether or not Respondent-Applicant's trademark "THE GOLDEN GIRL JANTZEN" is confusingly similar with Opposer's trademarks "JANTZEN" and "DIVING GIRL". At the pre-trial conference, both parties agreed, that this issue be submitted for decision based on the memoranda of the parties in support of their respective pleadings and annexes submitted. Both parties, therefore, did not present evidence.

However, office records show that Opposer is the registered owner of the trademarks "JANTZEN" under Registration Certificate No. 4936 (now R-1495) issued December 16, 1954, and "DIVING GIRL DEVICE" under Registration Certificate No. 5280 (now R-1669) issued on September 6, 1956. Both marks are used on men's, women's and children's apparel, namely, swimming suits, trunks, sweaters, jerseys, scarves, garment belts, mittens, gloves, shoes, underseas, socks, trousers, jackets, coats, vests, hats, caps, outer shirts, outer shorts, suits and outer skirts for women and children, and foundation garments, girdles and brassieres all under Class 25. The required affidavits of use for both certificates were filed on time. Accordingly, both certificates of registration still remain in force. These are the bases of the Opposer.

On the other hand, Respondent-Applicant relied heavily upon the theory that his is a composite mark and should not be dissected. This contention must fail. In *Philippine Nut Industry, Inc. vs. Standard Brands, Inc.*, 65 SCRA 5759, the Supreme Court held that "PHILIPPINE FLAPPERS CORDIAL PEANUTS" is confusingly similar with "PLANTERS COCKTAIL PEANUTS", saying that the word "PLANTERS" printed across the upper portion of the label in bold letters easily attracts and catches the eye of the ordinary consumer and it is that word and none other that sticks in his mind when he thinks of salted peanuts. To this point, the Supreme Court ruled:

"Whether or not a trademark causes confusion and is likely to deceive the public is a question of fact which is to be resolved by applying the 'test of dominancy', meaning,

if the competing trademark contains the main or essential or dominant features of another by reason of which confusion and deception are likely to result, then infringement takes place; that duplication or imitation is not necessary, a similarity, in the dominant features of the trademarks would be sufficient.”

A perusal of Respondents-Applicant's mark readily feature that the word “JANTZEN” is the dominant feature of the mark. The words “THE GOLDEN GIRL” are written in bold, small letters while the dominant word “JANTZEN” appears in italicized letters about twice the size of the former. Being in italics and in bigger letters, the word "JANTZEN" alone catches the buyer's eyes and is retained in his memory.

Further to this point, Respondent-Applicant admits that the mark "THE GOLDEN GIRL-JANTZEN" is used solely for ladies' shoes which are of low quality and of low category. Precisely, this situation is one of the problems which the law seeks to rectify, In *Converse Rubber Corp. vs. Universal Rubber Products, inc.*, 147 SCRA 154, 163, in applying the dilution theory, the Supreme Court said:

"(b)ut even assuming, arguendo, that the trademark sought to be registered by the respondent is distinctively dissimilar from those of the petitioner, the likelihood of confusion would still subsist, not on the purchasers' perception of the goods but on the origins thereof. By appropriating the word CONVERSE, respondent's products are words likely to be mistaken as having been produced by petitioner. The risk of damage is not limited to a possible confusion of goods but also includes confusion of reputation in the public could reasonably assure that the goods of the parties originate from the same source.

In view of the foregoing, Respondent-Applicant's mark "THE GOLDEN GIRL JANTZEN" is held to be confusingly similar with the Opposer's mark “JANTZEN”.

WHEREFORE, the opposition is hereby SUSTAINED. Accordingly, Respondent-Applicant's Application Serial No. 50923 for the registration of the mark “THE GOLDEN GIRL JANTZEN” is REJECTED.

Let the records of this case be forwarded to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO  
Director