

JOCKEY INTERNATIONAL,
INC.,
Opposer,

INTER PARTES CASE NO. 2019

OPPOSITION TO:

Appln. Serial No. 44853
Filed : May 12, 1981
Applicant : Crispa, Inc.
Trademark : HOCKEY
Used on : Jeans, jackets,
polos, sport
shirts, etc.

- versus -

CRISPA, INC.,
Respondent-Applicant.
x-----x

DECISION NO. 89-103 (TM)
December 19, 1988

DECISION

This is an opposition by Jockey International, Inc. to the registration of the trademark "HOCKEY" for jeans, jackets, polos, sportshirts, coats, barongs, pants, dresses, slacks, garments, knitted fabrics, netted fabrics, belts, bracelets, bags, wallets, etc. in International Classes Nos. 18, 24 and 25 filed with this Bureau on May 12, 1981 by Crispa, Inc. under Application Serial No. 44853, which was published on Pages 83-84 of the Official Gazette, Vol. 81, No. 47 dated November 25, 1985 and officially released on August 25, 1986.

Opposer is a foreign corporation duly organized and existing under the laws of the State of Wisconsin, United States of America, located and doing business at 2300 60th Street, Kenosha, Wisconsin, United States of America, doing business in the Philippine through its local licensee, V. Lilaram Development Corporation, while Respondent-Applicant is a domestic corporation organized and existing under the laws of the Philippines, with business address at Barrio Caniogan, Pasig, Metro Manila, Philippines.

Opposer filed on September 24, 1986 an Unverified Notice of Opposition and a verified one on December 19, 1986 based on the following grounds:

"1. The Opposer is the owner-registrant and has used the trademark "JOCKEY" in trade and commerce in the Philippines since December 31, 1937 under International Class No. 25.

2. The trademark above-mentioned which the Opposer has created and adopted is well known in the Philippines and throughout the world."

The Opposer cited the following facts in its Notice of Opposition:

"a) The Opposer has used the trademark 'JOCKEY' in trade and commerce in the Philippines long prior to the alleged date of first use by Respondent-Applicant of June 9, 1979. Said trademark is covered by Certificate of Registration No. R-557 (Cooper's Incorporated changed to Jockey International, Inc.) issued on May 19, 1969.

b) Opposer's trademark mentioned above is well known in the Philippines and has enjoyed enviable reputation in the Philippines because of the high and superior quality of Opposer's products as well as the wide circulation of advertisements for Opposer's products.

c) The application of Respondent-Applicant which is the subject of this opposition was filed on May 12, 1981 and Respondent Applicant claims first use of the trademark 'HOCKEY' in trade and commerce only since June 9, 1979.

d) Applicant's alleged mark 'HOCKEY' is confusingly similar to Opposer's trademark JOCKEY. Moreover, the goods covered by both marks belong to the same class of goods of the International Classification of goods and services, per Patent Office Administrative Order No. 20, dated 9 February 1978, specifically under International Class 25.

e) The registration of applicant's alleged mark would violate Opposer's rights and interests in its trademark JOCKEY because said mark objected to is confusingly similar so that confusion between Opposer's and Respondent-Applicant's respective business and products, as well as the resulting dilution and loss of distinctiveness of Opposer's trademark becomes inevitable. This is not to mention the likelihood that the use of Applicant-Respondent's trademark sought to be registered might convey the impression that it is related to or originated from Opposer."

In its Answer filed on February 6, 1987, Respondent denied all the material averments made in the said Notice of Opposition and invoked thereby the following affirmative defenses:

"1. For over twenty-eight (28) years, or since at least 1958, the trademark 'CRISPA' has been used by Applicant in trade and commerce, and because of its own long-standing and well-deserved reputation for superior quality products, as well as its extensive and varied advertising and promotion, Applicant enjoys a great amount of business goodwill for itself, its products and its trademarks, including the mark, subject of its present application.

2. Applicant's trademark 'HOCKEY' as used on labels conspicuously contains the words 'Made in R.P. by Crispa', hence, the mark distinctly and unequivocally indicates the origin and ownership of the articles to which it is affixed. Accordingly, it cannot at all be said that the use of the trademark sought to be registered might convey the impression that it is related to or originated from Opposer. On the contrary, Applicant clearly intends to rely solely on its own enviable reputation.

3. Viewed as a whole, Applicant's trademark 'HOCKEY' bears no resemblance, much less any confusing similarity, to Opposer's trademark 'JOCKEY'. The test is not simply to take the words and compare the spelling and pronunciation; rather, it is to consider the two marks in their entirety, as they appear in the respective labels. The discerning eye of an unbiased observer must focus not only on the predominant words but also on the other features appearing on both labels.

4. An examination of Applicant's 'HOCKEY' mark in its details vis-a-vis the Opposer's trademark presents little or negligible similarity. The trademark sought to be registered is longer, consisting of a representation of a red hockey stick and puck on a solid blue field, with the word 'HOCKEY' in wide blue letters. On the other hand, Opposer's mark carries a stylized representation of a jockey with the black lettering all on a plain white background. Aside from the color, design lettering and size, even the meanings of the principal words are completely different: one refers to a sport, the other to a person. There is, therefore, no likelihood whatsoever of confusion, mistake or deception, even from the point of view of an ordinary purchaser, notwithstanding the fact that the products covered by both marks belong to the same class. Nor is dilution or loss of distinctiveness of Opposer's trademarks an inevitable consequence of the registration of the Applicant's totally dissimilar mark."

In the pre-trial conference, Opposer manifested in open court that his client shall withdraw its Opposition if Respondent-Applicant would make visible and prominent "Made in

R.P.” in its label mark, to which counsel for Respondent counter manifested that his client is already doing that. After several hearings, the parties on January 25, 1988 submitted a joint motion to dismiss these cases on the basis of the Compromise Agreement signed by the parties through their respective counsels duly empowered to do so under their respective powers of attorney, which provides as follows:

“1. The Opposer is the registrant of the mark JOCKEY and respondent of the mark CRISPA, respectively, with the Philippine Patent Office.

2. The respondent CRISPA hereby recognizes the right of the Opposer JOCKEY INTERNATIONAL, INC. to the use and existence of the trademark ‘JOCKEY’ as owners of the mark thereof.

3. The respondent hereby, by reason of or pursuant to this agreement, shall henceforth undertake to use the trademark HOCKEY herein applied for under Serial No. 44853 in the manner as hereinafter set forth, as follows:

‘To always use the trademark HOCKEY by affixing the words: Made in R.P. by CRISPA in bold letters conspicuously imprinted on the face of the label as to reflect the source or origin of the product in all goods comprised under International Classification No. 25.’

4. The Opposer hereby allows the Respondent to proceed with its application for registration of the trademark 'HOCKEY', conditioned upon the compliance by CRISPA of its undertaking as hereinbefore provided in paragraph (3); any breach or violation of such undertaking shall cause the invalidation or cancellation of the instant registration applied for by respondent and in case of breach or violation of the undertaking, shall be a ground for cancellation of this registration applied for upon proper showing or proof of such breach/ violation thereof. This agreement shall apply to the use of the trademark by respondent in its domestic and world markets or outlets.

5. The Opposer Jockey International, Inc. agrees to allow the Respondent to deplete its current stock of labels subject of this opposition within a period of six (6) months from date hereof.”

WHEREFORE, the herein Notice of Opposition is hereby DISMISSED. Accordingly, Application Serial No. 44833 for the registration of the mark “HOCKEY” for the articles enumerated should be given due course.

Let the records of this case be transmitted to the Trademark Examining Division for appropriate action in accordance herewith.

SO ORDERED.

IGNACIO S. SAPALO
Director