

JOCKEY INTERNATIONAL, INC.
Opposer,
- versus -

IPC 14-2006-00095

Opposition to:
TM Application No. 4-2004-000272
(Filing Date: 13 January 2004)

MYRICH APPAREL SHOPPE,
Respondent-Applicant.
x-----x

TM: "JOCKS"

Decision No. 2007-22

DECISION

Before us is a Notice of Opposition filed by Jockey International Inc., a company duly organized under the laws of the State of Wisconsin, U.S.A. with principal office at 2300 60th Street, Kenosha, Wisconsin, U.S.A. for the registration of the mark "JOCKS" used for T-shirts in Class 25 which application was filed by Myrich International Apparel Shoppe on January 13, 2004 with address at 4469 Gen. T. de Leon, Santolan, Karuhatan, Valenzuela City.

The subject trademark application was published for opposition in the IPO Electronics Gazette, which was officially released for circulation on March 28, 2006.

Opposer relied on the following grounds for opposition:

"1. Opposer is the prior user and rightful owner of the trademark JOCKEY in the Philippines under the following registration Certificates issued long before Applicant's appropriation of the trademark JOCKS:

25	JOCKEY	047749	May 15, 1986
25	Jockey For Her With Half Jockey Design	059543	December 16, 1992
25	Soft Elegance By Jockey With Female Head Design	062771	December 27, 1993
25	Jockey	4-1994-099085	November 9, 1999

Opposer is the registered owner of the trademark JOCKEY for goods in Class 25 (specifically, knit and woven underwear, shorts, hosiery, sport shirts, sport shorts, sweat shirts, bath kilts, pajamas, robes, sport jackets, swimwear, pants jean, hosiery and knitwear, all for men and women, boys and girls) and is the applicant for the trademark JOX under Application No. 4-2004-008812 and JOCKS under Application No. 4-2004-9656 filed with the Intellectual Property Office (IPO) on September 17, 2004, both for goods in Class 26. Opposer is the prior user and registered owner of the trademark JOCKEY and JOX in countries worldwide long before applicant appropriated the mark "JOCKS" for its own products. The marks JOCKS and JOX are shorthand expressions for the Opposer's well-known mark JOCKEY, and have the same meaning as the latter. Thus, the registration of the mark JOCKS in the name of the Applicant will likely mislead consumers into believing that Applicant's products, which are similar and belong to the same class as Opposer's goods, originate from Opposer.

"2. Applicant's trademark JOCKS is a derivative of Opposer's trademark and tradename JOCKEY AND IS A VARIATION of Opposer's trademark JOX 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 by misleading them into thinking that Applicant's goods either come from Opposer or are sponsored or licensed by it.

"3. The registration and use by Applicant of the trademark JOCKS will diminish and distinctiveness and dilute the goodwill of Opposer's trademark and tradename JOCKEY, and trademarks JOX and JOCKS, which are arbitrary trademarks when used on Opposer's products.

"4. Applicant appropriated and used the confusingly similar trademark JOCKS on its own goods with the obvious intention of misleading the public into believing that its goods bearing the trademark originate from, or are licensed or sponsored by opposer, which has been identified in the trade and by consumers as manufacturer of goods bearing the trademark and trade name JOCKEY from which the marks JOX and JOCKS were derived.

"5. The allowance of applicant's trademark JOCKS is based on the false representation that it is the originator, true owner and first user of the trademark, which was merely derived from Opposer's JOCKEY trademark and tradename.

"6. Opposer is the first user of the trademark and tradename JOCKEY in the U.S.A. and other countries of the worldwide.

"7. Opposer is the first user of the trademark and tradename JOX in numerous countries worldwide.

"8. Applicant's appropriation and use of the confusingly similar trademark JOCKS infringe upon Opposer's exclusive right to the registered trademark and tradename JOCKEY and trademark JOX, which are well-known trademarks protected under Section 147 and 165 (2) (a) of the Intellectual Property Code (the "IP Code"), Article 6bis of the Paris Convention and Article 6bis of the Paris Convention and Article 16 of the Agreement on Trade Related Aspects of Intellectual Property Rights (the TRIPS Agreement) to which the Philippine and the United States of America adhere.

"9. The registration of the trademark JOCKS in the name of Applicant is contrary to the other provisions of the IP Code.

To support this Opposition, Opposer relied upon, among other facts, the following:

"1. The Opposer is the manufacturer of the underwear and other goods in Class 25. Opposer adopted and has been commercially using the trademark and tradename JOCKEY for its goods long before Applicant has unauthorized appropriation of the confusingly similar trademark JOCKS. Moreover, Opposer itself has applied for the trademark JOCKS, under Application No. 4-2004-008656, and JOX under Application No. 4-2004-008812, both on September 17, 2004 for goods in Class 25.

"2. Opposer is the first user and registered owner of the trademark JOCKEY in the U.S.A., the Philippines and other countries of the worldwide. Opposer has also used, registered and applied for the registration of the trademark JOCKEY in many countries of the worldwide.

"3. Opposer is also the first user and registered owner of the trademark JOX in countries worldwide. Opposer has also used, registered and applied for the registration of the trademark JOX in the Philippines and in many other countries of the worldwide.

"4. Opposer's trademark JOCKEY, JOX and JOCKS are arbitrary trademarks and are entitled to broad legal protection against unauthorized users like Applicant who has appropriated the confusingly similar trademark JOCKS for its own goods.

"5. Opposer is the first user of the trademark JOCKEY and JOX for the above-mentioned goods. Applicant has appropriated the confusingly similar and derivative trademarks JOCKS in bad-faith for the obvious purpose of capitalizing upon the renown of Opposer's self-promoting trademarks by misleading the public into believing that its goods originate from, or are licensed or sponsored by Opposer.

“6. Opposer’s trademarks JOCKEY, JOX and JOCKS are well-known trademarks within the meaning of Section 123.1 (f) of the IP Code, Article 6bis of the Paris Convention and Article 16 of the TRIPS Agreement, and is entitled to broad protection against unauthorized users like Applicant who has appropriated the derivative trademarks JOCKS for its own goods, which are identical to those in respect of which the trademark has been registered.

“7. The registration and use of a confusingly similar trademark by Applicant will tend to deceive and/or confuse purchasers into believing that Applicant’s products emanate from or are under the sponsorship of Opposer and will damage Opposer’s interests for the following reasons:

- i. The trademarks are confusingly similar.
- ii. Applicant’s unauthorized appropriation and use of the trademark JOCKS will dilute the goodwill and reputation of Opposer’s trademarks JOCKEY, JOX and JOCKS among customers.
- iii. Applicant used JOCKS on its own products as a self-promoting trademark to gain public acceptability for them through their association with Opposer’s popular trademarks JOCKEY and JOX from which the trademarks JOCKS was derived.
- iv. The goods on which the trademarks are used are identical and are indicate and are sold and advertised to consumers through the same channels of trade.
- v. Applicant intends to trade, and is trading on, Opposer’s goodwill.

“8. The registration and use of an identical or confusingly similar trademark by Applicant will diminish the distinctiveness and dilute the goodwill of Opposer’s JOCKEY trademark.

A Notice to Answer dated July 19, 2006 was issued by this Bureau requiring Respondent-Applicant to file its Answer within thirty (30) days from receipt thereof. However, Respondent-Applicant failed to file its Answer within the elementary period despite receipt of the notice, for which reason it was deemed thereof per Order No. 2006-1433 dated October 19, 2006. Per the same Order, Opposer was directed to file its position paper and, if desired, a draft decision within a non-extendible period of ten (10) days from receipt of said Order. Thereafter, Opposer filed its Position Paper together with a Draft Decision on November 6, 2006.

The issues to be resolved herein are as follows:

1. Whether the mark “JOCKS” applied for registration by respondent-applicant is identical with, or confusingly similar to Opposer’s mark “JOCKEY and JOX;
2. Whether opposer has acquired a goodwill to the mark “JOCKS” on which Respondent-Applicant hinges its application for registration; and
3. Whether respondent-applicant is entitled to register the mark “JOCKS” for T-shirts under Class 25 and;
4. Whether Opposer’s JOCKEY and JOX is a well-known mark.

The limited right over a trademark is reflected in Republic Act 8293 otherwise known as the Intellectual Property Code of the Philippines which is the law governing the instant opposition considering that the application was filed during the effectively of the said statute. Under Sec. 123 (d) of the said statute, registration of a trademark which is identical with another already registered mark or a mark with an earlier filing date or priority date shall be denied, where t allows such registration could likely result in confusion, mistake or deception to the consumers.

Conversely, where no confusion is likely to arise, registration of a similar or even identical mark may be allowed.

The right to register trademark is based on ownership. When the applicant is not the owner of the trademark being applied for, he has no right to apply for its registration. Under the Trademark Law, only the owner of the trademark, trade name, or service mark used to distinguish his goods, business, or service from the goods, business or service of others is entitled to register the same.

In the case at bar, Opposer was able to prove that it is the registered owner of the trademark JOCKEY for goods in Class 25, by presenting copies of registration certificates issued by the Bureau of Patents, Trademark and Technology Transfer in favor of Opposer (Exhibits F-1 to F-4). One of these Certificates of Registration was issued way back April 10, 1990 which proves that it has been using the trademark "JOCKEY" long before Respondent-Applicant filed the application subject for opposition in the instant case. Likewise, Opposer has pending applications for the trademarks "JOX" (Exh. J) and "JOCKS" (Exh. K) both filed on September 17, 2004. Opposer also presented copies of foreign certificates of registrations for the marks "Jockey" and "Jox" included in Exhibit "F".

Notwithstanding the fact that Respondent-Applicant's application for registration of the mark "JOCKS" was filed earlier (January 13, 2004) than Opposer's application for the same mark and for the mark "JOX", which were both filed on September 17, 2004, this does not imply its entitlement for the registration of the mark "JOCKS". As stated earlier, Opposer's trademark "JOCKEY" was issued long before Respondent-Applicant filed its application for registration of the mark "JOCKS". As aptly observed by Opposer, Respondent-Applicant's trademark "JOCKS" is a derivative and a variation from Opposer's trademark JOCKEY and JOX. Undeniably, Respondent-Applicant's "JOCKS" appear to be confusingly similar with Opposer's trademark- JOCKEY and JOX. Respondent-applicant has a *boundless choice of words, phrases and symbols to adopt as a mark sufficient unto itself to distinguish its service from those of opposer's and other's marks*. Respondent-applicant's JOCKS appears to be almost identical to opposer's marks. Therefore, there is no reasonable explanation as to why Respondent-Applicants choose the "JOCKS" mark for its goods except that it intends to cash in on the goodwill of opposer's marks already acquired.

Another factor why Respondent's application should be denied is the fact that the goods of the parties covered by the competing marks show that they fall under the same classification, which is Class 25. Opposer's and respondent-applicant's goods covered by their respective marks, serve the same purpose and flow through the same channel of trade; hence, they are considered as RELATED GOODS. When goods are so related that the public may be, or is actually, deceived and misled that they come the same maker or manufacturer, trademark infringement occurs.

In the case of ESSO STANDARD EASTERN, INC., the Supreme Court ruled:

"Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores. Thus, biscuits were held related to milk because they are both food products. Soap and perfume, lipstick and nail polish are similarly related because they are common household items nowadays. The trademark "Ang Tibay" for shoes and slippers was disallowed to be used for shirts and pants because they belong to the same general class of goods. Soap and pomade, although non-competitive, were held to be similar or to belong to the same class, since both are toilet articles"

Applying these legal precepts to the instant case, Respondent-Applicant's use of the trademark "JOCKS" is likely to cause confusion or mistake or to deceive the consumers of either

the goods of the Opposer and that of the Respondent-Applicant or both as to the identify of the goods, their source and origin, or identity of the business of Opposer and Respondent-Applicant. Their respective trademarks are being used on almost identical goods since they belong to the same class of goods, Class 25.

As to the contention of Opposer that its mark is a well-known mark which deserves protection as a consequence of our adherence to the Paris Convention, this Bureau rules in the negative.

Section 123.1, paragraph (e) of the Intellectual Property Code provides that in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark.

Anent thereto, the then Minister of Trade and Industry, Hon. Roberto V. Ongpin, issued the Ongpin Memorandum which establishes the guidelines in the implementation of Article 6bis of the Treaty of Paris relating to the protection of intellectual property rights regarding well known marks. These conditions are:

- a.) the mark must be internationally known;
- b.) the subject of the right must be a trademark, not a patent or copyright or anything else;
- c.) the mark must be for use in the same or similar kinds of goods and;
- d.) the person claiming must be the owner of the mark.

It bears stressing that the evidence presented by opposers in terms of the duration and geographical extent of the advertising or publicity of opposer's products does not qualify opposer's trademark to be well-known. Opposer alleges through its witness, Mr. Mark S. Jaeger, that the "Opposer has also extensively and continuously promoted and heavily advertised its JOCKEY trademark and the products bearing its trademark, in various media, including print, broadcast and the internet, thus incurring substantial advertising and promotional expenditures" (See affidavit of Mr. Mark S. Jaeger). To prove such allegation, opposer appended to said witness's affidavit samples of advertisements (Exhibits "B") and copy of Opposer's Product Catalog. It also alleged that Opposer has an Internet site, www.Jockey.com

However, a perusal of the said exhibits does not definitely and evidently show the geographical areas or extent to which opposer's mark and products have been advertised and promoted in order that said mark and products may be considered well-known for purposes of the Rule and the law: Essentially, the bulk of opposer's evidence to prove the advertising and promotion of its mark and products consist of billboards located in the Philippine such as in Iloilo City, Tagum City, Bacolod Mandalagan and General Santos City; pictures taken in Carrefour Department Store, Parkson Department Store and Gateway Shopping Mall all located at Shanghai, China; Myer Department Store in Australia; and a handful of stores/oulets located in India, Budapest and UK and advertisements in newspapers such as Philippine Star, Libre, Cebu Daily News and Sun Star Cebu. Such evidences can hardly hold the premise that opposer's mark is internationally well-known.

Opposer likewise failed to submit evidence of the use of its mark through commercial sales such as sales invoices or receipts to establish sales of its products in the Philippines. Although Opposer submitted copies of the brochures/catalogs of its products, the same not being one of the criteria would not make the mark well known.

Furthermore, even if Opposer submitted representative sampling of registration certificates (Exh. D); a list of the registrations for the trademark "JOCKEY" worldwide and a list of

the registrations and applications for the trademark "JOX" worldwide (Exh. E) the same had not validly established its claim that the mark "JOCKEY" is an internationally well-known mark.

Lastly, as shown by the records, Respondent-Applicant despite due notice failed to file its Answer to the Notice of Opposition such inaction is indicative of respondent-applicant's lack of concern in protecting its mark which is sanctioned under Sec. 3 (d) Rule 131 of the Rules of Court which states that "a person takes ordinary care of his concern" and the pronounced policy of the Supreme Court laid down in the case of PAGASA INDUSTRIAL CORP. v. COURT OF APPEALS L-54158, 118 SCRA 526, 533-534, 1982 that "it is precisely the intention of the law to protect only the vigilant, not those guilty of laches."

WHEREFORE, in view of the foregoing, the Notice of Opposition filed by the Opposer is, as it is hereby SUSTAINED. Accordingly, Application Serial No.2004-000272 for the mark "JOCKS" being used for t-shirts filed by Respondent-Applicant, Myrich Apparel Shoppe is, as it is hereby REJECTED.

Let the filewrapper of "JOCKS" subject matter of this case together with this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 27 February 2007.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office