

LEVI STRAUSS & CO.,	}	INTER PARTES CASE No. 3753
Opposer,	}	Opposition to:
	}	Application Serial No. 70959
-versus-	}	Date filed: February 22, 1990
	}	Trademark: "DOCKLAND"
	}	
ARTHUR SORIANO,	}	
Respondent-Applicant.	}	
	}	
	}	Decision No. 2001-27
x-----x		

DECISION

This is an Opposition to the registration of the mark "DOCKLAND" under Application Serial No. 70959 filed by Respondent-Applicant Arthur Soriano.

The file wrapper of the subject application shows that on February 22, 1990, Arthur Soriano (hereafter "Respondent") filed with the then Bureau of Patents, Trademarks and Technology Transfer his application for registration of the trademark "Dockland" for use on shoes under Class 25 of the International Classification of Goods, claiming first use of the mark in the Philippines on October 1, 1989.

On September 5, 1990, the Bureau of Patents, Trademarks and Technology Transfer sent Respondent a letter (Paper No.3) advising him that the subject mark is confusingly similar with the mark "Dockers" in the name of Levi Strauss & Co. under Registration No. 45556 issued on June 30, 1989, and with the mark "Docksides" and Device being applied for registration by Adel Morales under Serial No. 67771 dated April 26, 1989.

On October 15, 1990, the Bureau of Patents Trademarks and Technology Transfer declared the subject application as Abandoned for the failure of Respondent to reply and submit the additional requirements requested by the Bureau of Patents Trademarks and Technology Transfer.

On February 6, 1991, herein Respondent filed his Petition for Revival declaring that he had no intention of abandoning his application. Respondent further alleged that his mark had a different spelling, pronunciation and meaning, and that the marks mentioned in Paper No. 3 covered distinct and different products, hence, confusion is remote. Finding meritorious grounds therein, the Bureau of Patents Trademarks and Technology Transfer granted the petition to revive the abandoned application in accordance with Paper No. 6 (Office Memorandum) and on May 16, 1991, recommended the publication of the application after finding that the mark had complied with the requirements of the law. Respondent's application was published for opposition in the November-December 1991 issue of the Bureau of Patents Trademarks and Technology Transfer Official Gazette, Volume IV, No. 6 that was released for publication on December 31, 1991.

On January 31, 1992, Levi Strauss & Co. (hereafter "Opposer") filed its Notice of Opposition alleging that it would be damaged by the registration of Respondent's mark based on the following grounds:

- "1. That the Opposer is the owner-registrant of the trademark DOCKERS (registration No. 45556) and DOCKERS Design (registration No. 46619) which has been continuously used in trade and commerce on goods covered in Class 25, and, specifically, which use has not been abandoned.

"2. That the trademark DOCKLAND is confusingly similar to opposer-registrant's trademark, to wit:

"(a) That the trademark DOCKLAND of Respondent-Applicant is nearly if not completely identical and therefore confusingly similar to the trademark DOCKERS used and owned by the opposer on essentially the same goods. Thus, the use in the Philippines of the trademark DOCKLAND by the Respondent-Applicant constitutes an unlawful appropriation of a mark previously used and registered and not abandoned, a statutory violation of Section 4 (d) of Republic Act No. 166, as amended.

"(b) That the use of Respondent-Applicant's mark DOCKERS on the goods mentioned in the application will likely cause confusion or mistake, or will likely deceive purchasers who may be led to believe that the mark of Respondent-Applicant and the goods on which Respondent-Applicant's mark are used or to be used are those of the Opposer herein, and vice versa.

"3. For the reasons set forth in paragraph 2 above, Opposer will be damaged by the registration of the trademark DOCKLAND in the name of Respondent-Applicant and further, should the respondent-applicant's product be of an inferior quality to that of the Opposer's, Opposer's business reputation and goodwill will suffer grave and irreparable injury."

In his Answer dated June 19, 1992, Respondent denied the material allegation in the Opposition and interposed the following special defenses:

"4. It is clear from the alleged Notice of Opposition that Levi Strauss and Company, the alleged Opposer, is not a duly-registered entity in the Philippines nor does it have any authorized agent duly registered in the Philippines; hence, the alleged Opposer has no legal personality to sue in the Philippines.

"5. Being without any legal representative or authorized agent in the Philippines, the Notice of Opposition should be dismissed outright under Secs. 1 and 3 of Rule 3 of the Rules of Court, and that the alleged Opposer is not a legally registered juridical person in the Philippines, it cannot do business nor litigate in the Philippines.

"6. DOCKLAND being a distinct and different trademark from the so called DOCKERS, Respondent is legally entitled to maintain the same in his business.

"7. As author/creator of trade name DOCKLAND, respondent has caused a copyright registration thereof as evidenced by a Certificate of Copyright Registration hereto attached as Annex "1".

As no amicable settlement was arrived at by the parties during the pre-trial conference, the case proceeded to trial on the merits.

During trial, Opposer presented the testimonies of its witnesses, Ramon Martelino, Stephen Nathan Goldstein, and Bernabe Alajar. It also presented documents consisting of Exhibits "A" to "W" including their sub-markings that were admitted in evidence in accordance with Order No. 98-45 dated February 17, 1997.

For his part, Respondent failed to present evidence despite proper notices issued by the Bureau of Patents Trademarks and Technology Transfer. On motion of Opposer, Respondent was subsequently declared as having waived his right to present evidence under Order No. 2000-230 dated May 10, 2000. On August 7, 2000, Opposer filed its Memorandum, hence, this Decision based on the evidence of Opposer.

Under Section 21-A of Republic Act No. 166, any foreign corporation or juristic person to which a mark or trade name has been registered or assigned under said Act may bring an action for infringement, for unfair competition, or false designation of origin and false description, whether or not it has been licensed to do business in the Philippines under Act No. 1459, as amended, otherwise known as the Corporation Law, provided, that at the time it brings the complaint, the country of which said foreign corporation or juristic person is a citizen, or in which it is domiciled, by treaty, convention or law, grants a similar privilege to corporate or juristic persons of the Philippines. Being the holder of Certificates of Registration No. 45556 and 46619 issued by the Bureau of Patents Trademarks and Technology Transfer on June 30, 1989 and valid for a term of twenty (20) years, there is no question that Opposer has the legal personality to file the instant Opposition and has the exclusive right to use the marks "Dockers" and "Dockers and Design" for goods falling under Class 25.

Consequently, the only issue left to be resolved is whether Respondent's mark is confusingly similar to Opposer's mark as to preclude the registration of the former.

The law provides that the owner of a trademark, trade name or service mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register, unless it consists of or comprise a mark or trade name registered in the Philippines or a mark or trade name 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 purchasers. [Section 4 (d) Republic Act No. 166, as amended.]

The confusion referred to in the law exists when the ordinary prudent purchaser would be induced to purchase one product or service because of the similarity of the marks or trade names used thereon. In other words, a person's goods or services are purchased as those of another person, and the poorer quality of the former reflects adversely on the latter's reputation. [*Sterling Products International, Inc. v. Farbenfabriken Bayer*, 27 SCRA 1214 (1969)].

In this case, Respondent's mark "Dockland" appearing on the shoe label and in the bristol board contained in the file wrapper is written in capital letters with two (2) bold horizontal lines placed on the top and bottom portion. Located on the left side of the mark is a representation of a ship's anchor that is encircled by a rope. On the other hand, the mark of Opposer consists of the word "Dockers" written in capital letters placed above a device with a wing-shaped design consisting of four (4) solid, horizontal lines with each of the lines gradually decreasing in length from top to bottom. The words "since 1850" are also printed on top in a semicircular fashion, with an anchor and ribbon-like figure in the middle of the device with the word "LEVI'S" placed underneath. Both marks are used on goods falling under the same class - Respondent's mark on shoes in Class 25 and Opposer's mark on pants also in Class 25.

After considering how the marks are written and spelled, and after evaluating the manner in which the marks and devices are placed along side each other, this Office finds confusingly similarity between the two marks that would lead an ordinary purchaser to believe that the shoes with the mark "Dockland" are also being manufactured and sold by Opposer. Colorable imitations exists in the general appearance of the mark as the two (2) marks both start with the four lettered word "DOCK" both written in CAPITAL LETTERS and contain an illustration of a ship's anchor encircled by a rope.

Colorable imitation is such a close or ingenious imitation as to be calculated to deceive ordinary persons, or such a resemblance to the original as to deceive an ordinary purchaser giving such attention as a purchaser usually gives, and to cause him to purchase the one supposing it to be the other. [*Etepha v. Director of Patents*, 16 SCRA 499(1966)]. It does not mean such similitude as amounts to identity, nor does it require that all the details be literally copied. Colorable imitation refers to such similarity in form, content, words, sound, meaning, special arrangement, or general appearance of the mark or trade name with that of the other

mark or trade name in their over all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article. [Agpalo, *The Law on Trademark, Infringement and Unfair Competition*, 2000 ed., p. 49; *Co Tiong Sa v. Director of Patents*, 95 Phil. 1 (1954)).

A visual comparison of "Dockers" and "Dockland" as they appear on the product labels shows that the first four letters spelled as "DOCK" is the dominant feature of these composite marks. This is the word that the ordinary buyer would remember and recall when shopping for similar goods in department stores. Aside from this, another common feature of the two marks is the use of a ship's anchor surrounded by a rope that appears to have been used to supplement the word "dock" which in the English language means to disembark or moor in a pier. While it may true that Respondent's mark also contains the additional word "land" after "Dock", it does not afford such a substantial difference as to prevent likelihood of confusion among the purchases. The format, design, and arrangement all point to the existence of confusing similarity between the marks of Respondent and Opposer. In addition, confusion of goods becomes more likely because pants and shoes flow in the same channel of trade and purchased by the same class of consumers aside from the fact that they fall under one international classification of goods i.e. Class 25.

The above finding is consistent with existing jurisprudence and decisions of the Supreme Court. As pointed out by Opposer in its Memorandum, the Supreme Court has previously held in *Marvex Commercial Inc. v. Petra Hawpia & Co.*, 18 SCRA 1178 (1966) that the marks "SALONPAS" and "LIONPAS" are confusingly similar. In *Sapolin v. Balmaceda*, 67 Phil. 705, (1939), the words "Sapolin" and "Lusolin" were also held to be confusingly similar. Also, this Office previously held in *Guess, Inc. v. The Clothes Shop, Inc.*, *Inter Partes Case No. 3899, Decision No. 97-19 dated November 13, 1997*, that the marks "GEORGE MACHADO" and "GEORGES MARCIANO" are confusingly similar. Likewise, in *General Garments v. Sadhwani*, *Inter Partes Case No. 322, Decision dated August 29, 1978*, it was held that the marks "PURITRON" and "PURITAN" are confusingly similar. And in *Jantzen, Inc. v. Janton Garment Manufacturing Co.*, *Inter Partes Case No. 1312, Decision No. 64 dated August 3, 1988*, this Office ruled that "JANTZEN" and "JANTON" are confusingly similar.

We find no reason to deviate from these rulings, and reiterate our findings on the existence of colorable imitation that is likely to cause confusion to the buying public.

In view of the foregoing, the instant Opposition is hereby SUSTAINED. Accordingly, the application for registration of the mark "Dockland" used on shoes under Serial No. 70959 filed by Arthur Soriano is hereby REJECTED.

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

SO ORDERED.

Makati City, December 17, 2001.

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