

BENITO LIM,	}	IPC No. 14-2005-00047
Opposer,	}	Opposition to:
	}	
-versus-	}	Appl. Ser. 4-1999-006995
	}	Date Filed: September 16, 1999
LETICIA CHUA,	}	
Respondent-Applicant.	}	Trademark: "WEST STREET AND DEVICE"
	}	
x-----x	}	Decision No. 2007-30

## DECISION

The instant case is an Opposition filed by Benito Lim (Opposer), a resident of No. 39 Kennedy Street, North Greenhills, San Juan, Metro Manila, on 13 April 2005 against Application Serial No. 4-1999-006995 for the registration of the trademark "WEST STREET & DEVICE" for jeans, short, skirts, dresses, jumper & vest falling under class 25 of the International Classification of Goods, filed by herein Respondent-Applicant Leticia Chua of No. 953 Espelita Street, Sta. Cruz, Manila.

The grounds for Opposition to the registration of the mark are as follows:

1. The approval of the application in question is contrary to Section 123.1 (d) and (f) of Republic Act No. 8293;
2. The approval of the application in question will violate Opposer's right to the exclusive use of the trademark WALL STREET which is duly registered in its favor and the extension of the use of said registered mark to other goods;
3. The approval of the application in question has caused and will continue to cause great and irreparable damage and injury to herein Opposer;
4. Respondent-Applicant is not entitled to register the trademark WEST STREET & DEVICE in its favor.

To support its Opposition, the Opposer relied on the following facts:

- a. That long before September 16, 1999 when Respondent-Applicant filed her application in question for the registration of the trademark WEST STREET & DEVICE, Opposer had adopted and has been using the trademark WALL STREET for shirts, t-shirts, sweaters, pants, jeans, socks, stockings, men's and women's underwears;
- b. That the trademark WALL STREET is duly registered in favor of Opposer under Registration Certificate No. 37759 issued on January 6, 1988, a copy of which is hereto attached as Annex "A" and made integral hereof;
- c. That the Opposer has not abandoned the use of the trademark WALL STREET. On the contrary, it has continued such use up to the present;
- d. That the trademark WEST STREET & DEVICE being applied for registration by Respondent-Applicant nearly resembles and/or

otherwise, confusingly similar to the trademark WALL STREET duly registered in favor of Opposer;

- e. That the approval of the application in question is violative of the right of Opposer to the exclusive use of the trademark WALL STREET and the right to extend the use of said mark to other goods;
- f. That Opposer has spent a substantial amount of money to popularize and promote its WALL STREET branded products;
- g. That through extensive advertising and promotional campaigns and because of the high quality of Opposer's products bearing the trademark WALL STREET, the mark WALL STREET has become distinctive of Opposer's products and has established valuable goodwill in favor of Opposer.
- h. That the approval of the application in question has caused will continue to cause great and irreparable damage and injury to Opposer;
- i. That Respondent is not entitled to register the trademark WEST STREET & DEVICE in its favor.

On 16 May 2005, this Office sent a Notice to Answer to Respondent-Applicant wherein she was required to file its Answer fifteen (15) days from receipt thereof.

On 14 June 2005, Respondent-Applicant's Counsel filed its Entry of Appearance with Motion for Extension of Time (to file Answer) which was granted thru Order No. 2005-388 giving them additional fifteen (15) days until June 26, 2005 within which to file its Answer to the Notice of Opposition.

To date, Respondent-Applicant did not file her Answer.

On 25 May 2006, a Notice to Comply with Office Order No. 79 (Amendment to the Regulations on Inter Partes Proceedings), prescribing therein the summary rules which took effect on September 1, 2005 was sent to the Opposer, and a part of the body of the notice reads, a viz;

"Considering that no answer has been filed in this instant case, and that this case is mandatorily covered by the summary rules per section 11 (pertaining to "Effect on Pending Cases") of Office Order No. 79, a copy furnished opposing party/counsel this Office hereby directs:

Opposer/Petitioner to file within a period of thirty (30) days from receipt of this Notice all evidences in the required form consisting of one [1] original and two [2] duplicate copies and duly marked in accordance with Section 7 and Subsection 7.1 xxx"

After securing an extension of time to submit his evidences, Opposer on 25 July 2006 seasonably filed its Compliance to Office Order No. 79, and submitted Exhibits "A" to "D" inclusive of submarkings to support its Notice of Opposition. On the other hand, Respondent did not file any compliance nor complied with the requirement of Office Order No. 79.

The issue to be resolved in this case is whether or not the Respondent-Applicant's "WEST STREET & DEVICE" is confusingly similar to Opposer's "WALL STREET" trademark.

The determinative factor in a contest involving registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark would likely cause confusion or mistake on the part of the buying public. X X X The law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it. (American Wire and Cable Company v. Director of Patents, 31 SCRA 544)

In ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, two kinds of test have been developed – the Dominancy Test applied in *Asia Brewery, Inc. v. Court of Appeals*, 224 SCRA 437; *Co Tiong v. Director of Patents*, 95 Phil. 1; *Lim Hoa v. Director of Patents*, 31 SCRA 544; *Philippine Nut Industry, Inc. v. Standards Brands, Inc.*, 65 SCRA 575; *Converse Rubber Corp. v. Universal Rubber Products, Inc.*, 147 SCRA 154; and the Holistic Test developed in *Del Monte Corporation v. Court of Appeals*, 181 SCRA 410; *Mead Johnson & Co. v. Director of Patents*, 17 SCRA 128; *Fruit of the Loom, Inc. v. Court of Appeals*, 133 SCRA 405.

As its title implied, the test of dominancy focuses on the similarity of prevalent essential or dominant features of the competing trademarks which might cause confusion or deception. On the other side of the spectrum, the holistic test mandates that the entirety of the marks in question must be considered in determining confusing similarity.

In the case of *McDonald's Corporation v. L.C. Big Mak Burger, Inc.*, 47 SCRA 10, the Supreme Court has relied on the dominancy test resolving the issue of likelihood of confusion. It was ruled that:

“This Court, however, has relied on the dominancy test rather than the holistic test. The dominancy test considers the dominant features in the competing marks in determining whether they are confusingly similar. Under the dominancy test courts give greater weight to the similarity of the appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding minor differences. Courts will consider more the aural and visual impressions created by the marks in the public mind, giving little weight to factors like prices, quality, sales outlets and market segments”.

Thus, in the 1954 case of *Co Tiong Sa v. Director of Patents*, 95 Phil. 1, the Supreme Court held that:

“x x x It has been consistently held that the question of infringement of a trademark is to be determined by the test of dominancy. Similarity in size, form, and color, while relevant, is not conclusive. If the competing trademark contains the main or 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. The question at issue in cases of infringement of trademarks is whether the use of the marks involved would likely to cause confusion or mistakes in the mind of the public or deceive purchases”.

In comparing the Opposer's “WALL STREET” trademark to that of the Respondent's “WEST STREET & DEVICE”, it appears that the common word in both marks is the word “STREET” which is the dominant feature in both marks. The only difference between the two marks can be seen on their respective first word, and that it “WEST” for the Respondent and “WALL” for the Opposer. Nevertheless, this Bureau still finds that there is a strong visual and aural resemblance, and taken into consideration is the fact that the goods involved here belong to the same classification. Hence, the resemblance and the relatedness of the goods are more than enough to cause confusion to the buying public.

Sec. 123.1 (d) of R.A. 8293 (I.P. Code of the Philippines) provides that:

Sec. 123. Registrability – 123.1 A mark cannot be registered if it:

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or
- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely deceive or cause confusion;

It is also worth mentioning that as per record, the Opposer first used and has secured registration of the trademark "Wall Street" since January 6, 1988 under Registration Certificate No. 37759 (Annex A) which is more than ten (10) years before Respondent has filed its application.

WHEREFORE, premises considered, the Notice of opposition is, as it is hereby SUSTAINED. Consequently, the trademark application bearing Serial No. 4-1999-006995 filed on September 16, 1999 by Leticia Chua for the mark "WEST STREET & DEVICE" is hereby REJECTED.

Let the filewrapper of the trademark "West Street & Device" subject matter under consideration be forwarded to the Bureau of Trademarks (BOT) for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, 06 March 2007.

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