

MAJOR LEAGUE BASEBALL PROPERTIES, INC., Opposer,	}	INTER PARTES CASE No. 3843
	}	Opposition to:
	}	Serial No. 75095
	}	Date filed: 14 February 1991
-versus-	}	
	}	Trademark: "BLUE JAYS & DEVICE"
ELAINE RASPADO. Respondent-Applicant.	}	
x-----x	}	Decision No. 2001-16

DECISION

On February 22, 1993, MAJOR LEAGUE BASEBALL PROPERTIES, INC. an entity organized and existing under the laws of the State of New York of the United States of America located and doing business at 350 Park Avenue, New York, New York 10022, U.S.A., filed its Verified Notice of Opposition denominated as Inter Partes Case No. 3843, to application bearing Serial No. 75095 for the registration of the trademark "BLUE JAYS & DEVICE" used on shirts, pants, jeans, jackets, socks, dressed in class 25 of the International classification of goods filed on February 14, 1991 by ELAINE RASPADO of the City of Manila, which application was published on Page 26, Vol. V, No. 5 of the Official Gazette issue of September-October 1992, released for circulation on October 28, 1992.

The grounds upon which the Opposer bases its opposition are as follows:

- "1. The grant of registration of the application for registration in the Principal Register of the mark "BLUE JAYS & DEVICE" in the name of Respondent-Applicant is a blatant violation of Sec. 4 (d) of Republic Act 166, as amended because this mark is patently confusingly similar to the Opposer's registered trademarks TORONTO BLUE JAYS and TORONTO BLUE JAYS LOGO under Classes 16 and 25 which are being continuously in use all over the world as well as in the Philippines up to present, thus the same has never been abandoned by the Opposer.
- "2. The registration of the mark "BLUE JAYS & DEVICE" in the name of the Respondent-Applicant will cause grave and irreparable injury and damages to the Opposer within the meaning of Section 8 of Republic Act 166, as amended.

Opposer relied on the following facts to support its opposition:

- "1. The Opposer is the registrant in the Philippines and worldwide, of the trademark TORONTO BLUE JAYS, having issued by the Bureau of Patents, trademarks & Technology Transfer (BTTT) Trademark Certificate of Registration No. 52683 registered on June 19, 1992 for the goods under Classes 16 and 25. Photocopy of this Trademark Registration is made an integral part of this Opposition and is hereto attached as Annex "A".
- "2. The Opposer is likewise the registrant in the Philippines and worldwide, of the trademark TORONTO BLUE JAYS LOGO having been issued

by the Bureau of Patents, trademarks & Technology Transfer (BTTT) Trademark Certificate No.49553 on November 27, 1990 for the goods under Classes 16 and 25. Photocopy of this Trademark Registration is made an integral part of this Opposition and is hereto attached as Annex "B".

- "3. Opposer's registered trademarks TORONTO BLUE JAYS and TORONTO BLUE JAYS LOGO have been made popular by the Toronto Blue Jays Baseball team for decades. Since then up to the present, these marks have been continuously and extensively used in various products falling under various International Classes one of which is Class 25. These products and services have been sold, marketed, promoted and used in various countries all over the world including the Philippines and is continuously used in commerce worldwide and in the Philippines up to the present.
- "4. Opposer has obtained registration of aforesaid trademarks for goods falling under Class 25 and also for good and services falling under other Classes in most of the countries of the worlds which have a system of a trademark protection.
- "5. The Opposer's aforesaid trademarks, which covered a wide ranging variety of goods as shown in the foregoing paragraphs, became popular and known worldwide because of Major League Baseball which was and still is an American national pastime. However, baseball has since become an international sport which is now an Olympic sport that is followed by hundreds of millions of fans around the world. The universal impact of Major League Baseball is reflected by the international broadcasting of the Major League Baseball through radio and television and the following Major League Baseball by people of virtually every country in the world via the printed world and photographic coverage in newspapers and magazines. Baseball is played in more than sixty (60) countries with more than 1,000,000 players participating in the sport worldwide and the Philippines is definitely one of these countries. Major League Baseball and the Major League Baseball teams being the originators of baseball, the Major League Team and league marks registered in the name of herein Opposer worldwide are surely known by the citizens of these sixty (60) countries, which include those in the Philippines.
- "6. Opposer's registered marks TORONTO BLUE JAYS and TORONTO BLUE JAYS LOGO have a very valuable worldwide goodwill as they were and are continuously made famous , well-known and celebrated marks in most countries in the world including here in the Philippines primarily due to the

extensive exposure, use and promotional efforts directed to these marks by the Opposer which has expended substantial amounts of money, time and effort to increase the peoples' awareness all over the world of Opposer's trademarks and of the various products and services emanating from the Opposer under these trademarks. The trademarks TORONTO BLUE JAYS and TORONTO BLUE JAYS LOGO generally known and recognized the world over for decades up to the present which have captured widespread consumer recognition and appeal are automatically associated to the Opposer, by people from all over the world from all walks of life who are literate enough to read their own national newspapers or tabloids or to understand what is shown in their national television programs and movies.

- "7. The goods by both Opposer's aforesaid registered Trademarks and the Respondent-Applicant's mark belong to the same class of goods which is Class 25 as reflected in the Classification of Goods and Services provided for in Rule 82 of the Revised Rules of Practice in Trademark Cases.
- "8. A comparison of the Opposer's registered trademarks with that of the Respondent-Applicant's mark patently shows without doubt that the latter's mark is confusingly similar with the Opposer's aforesaid registered trademarks, in clear violation of Section 4 (d) of Republic Act No. 166, as amended.
- "9. The grant of registration of the Respondent-Applicant's mark BLUE JAYS & DEVICE will not only transgress on the rights and interest of herein Opposer over its aforesaid registered trademarks, but worse, it will tend to mislead the general public into believing that Respondent-Applicant's products are the products of the Opposer or they originated from the latter to the damage and injury to both the interest of the Opposer and the public at large, and on the other hand, to the underserved or even fraudulent gain of herein Respondent-Applicant. This is obviously the case because the Opposer is known all over the world as the sole rightful proprietor of the famous trademarks TORONTO BLUE JAYS and TORONTO BLUE JAYS LOGO, thus goods and services which carries these marks would be believed by the general public to be emanating from the Opposer. In todays fast changing world, wherein we are witnessing the emergence of corporate conglomerates, which owns world famous Trademarks, producing goods and services which are very divergent from each other more often belonging to different International Classification of Goods, the public at large, including those in the Philippines, is now very much aware of this, through widespread dissemination of information made possible by

modern mass media facilities worldwide and in the Philippines, such that the use of word famous trademarks on goods which are related and unrelated would lead the public at large to believe that these goods are made or authorized to be made by said conglomerates which originated and/or owns various world famous trademarks. Thus in this case on hand wherein Opposer's goods fall under the same class as those goods covered by Respondent-Applicant's mark, the grant of registration of Respondent-Applicant's trademark application for the mark BLUE JAYS & DEVICE would definitely cause confusion to the Philippine public wherein they would be mistakenly led to believe that the goods covered by the Respondent-Applicant's said mark is manufactured by the Opposer or that the Respondent-Applicant is authorized by the Opposer to manufacture and market said goods.

- "10. The foregoing clearly shows that the Opposer will be greatly and irreparably damaged by the grant of registration of the questioned mark in the name of Respondent-Applicant, particularly the Opposer's business reputation and goodwill not only here in the Philippines but internationally as well.

On March 1, 1993, this Office sent a Notice to Answer to the herein Respondent-Applicant which notice was received by the tenant on Respondent's address with the information that said party has already moves somewhere else but which is unknown to the tenant/or guard on duty.

On July 27, 1993, Order No. 93-494 was issued by this Office declaring the Respondent-Applicant in DEFAULT at the same time set this case for hearing on August 24, 1993 at 2:30 p.m. for the ex-parte presentation of opposer's evidence.

On December 29, 1993, pursuant to the Order of DEFAULT, Opposer formally offered its documentary exhibits consisting of Exhibits "A" to "YYYY" inclusive of submarkings.

The issue to be resolved in the present case is WHETHER or NOT Respondent-Applicant is entitled to the registration of the trademark "BLUE JAYS & DEVICE".

The applicable law is SECTION 4(d) of R.A. No. 166 as amended which provides.

"Section 4. Registration of trademarks, trade names and service marks, on the Principal Register. xxx- The owner of a trademark, trade name or service mark used to distinguish his goods, business or services of other shall have the right to register the same on the Principal register, unless it:

"x x x

"(d) Consists of or comprises a mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename 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. xxx”

WHETHER or not a trademark causes confusion and is likely to deceive the public is a question of fact which is resolved by applying the “TEST OF DOMINANCY”.

A cursory review of the documentary exhibits will show that both trademarks or the competing marks contain the words “BLUE JAYS” and the DEVICE of an EAGLE HEAD which are the dominant feature of the mark under question. They differ only in the presence of the word “TORONTO”.

Another point to be given due consideration is the fact that Respondent-Applicant’s mark “BLUE JAYS & DEVICE” is used on shirts, pants, jeans, jacket, socks and dresses (Class 25) which products are covered by Opposer’s mark namely clothing, footwear and head gears which belong to the same Class 25.

The Supreme Court in the case of PHILIPPINE NUT INC., vs. STANDARD BRANDS INC., et.al., 65 SCRA 575, 579, stated thus:

“In cases involving infringement of trademark brought before the Court, it has been consistently held that there is infringement of trademark when the use of the mark involved would be likely to cause confusion or mistake in the mind of the public or to deceive purchasers as to the origin or source of the commodity; 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 trademarks contain 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.” “CO TIONG SA vs. DIRECTOR OF PATENTS, 1954, 94 PHIL. 1, CITING VIZ CLARKE vs. MANILA CANDY CO., 36, PHIL. 100; ALHAMBRA CIGAR & CIGARETTE CO. vs. JAO OGE, 47, PHIL. 75, ETEPHA A.G. vs. DIRECTOR OF PATENTS and WESTMONT PHARMACEUTICALS INC., NO. L-20635, March 31, 1966, 16 SCRA 495)”

“In the case at BAR, likelihood of confusion can not be avoided by dealing the word “TORONTO”. Thus, in Continental Connector Corp., vs. Continental Specialties Corp., 207 USPQ160, the oft repeated rule was applied to wit: That the confusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term. Examples: “MISS USA” and “MISS USA WORLD” – (Miss Universe, Inc., vs. Patricelli, 161 USPQ129); “GUCCI-GOO” (Gucci shops vs. R.H. MACY & CO., 446 F. SUPP. 838) “COMFORT” and “FOOT COMFORT” (SCHOLL, INC., vs. TOPS E.H.R. Corp., 185 USPQ 754) “ACE” and “TEN-ACE” (Becton, Dickenson & Co. vs. Wigum Mills Inc., 199 USPQ 607)”

“Why, with all the birds in the air, and all fishes in the sea, and all the animals on the face of the earth to choose from, the defendant company (Manila Candy Co.) elected two roosters as its trademark, although its directors and managers must have been well aware of the long continued use of a rooster by the

plaintiff with the sale and achievement of its goods? x x x a cat, a dog, a carabao, a shark, or an eagle stamped upon the container in which candies are sold would serve as well as rooster for the product of defendant's factory. Why did defendant select two roosters as its trademark?" (Clarke vs. Manila Candy Co., 36 Phil 100)

To be noted is the fact that Opposer's trademark "BLUE JAYS & DEVICE" is a registered mark with the Bureau of Patents, Trademarks and Technology Transfer on June 10, 1992 and November 27, 1990 under Certificate of Registration No. 52683 and No. 49553 respectively (Exhibits "B" and "C").

When one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark, this is not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill. (CHUAN CHOW SOY & CANNING CO. vs. DIRECTOR OF PATENTS and VILLAPANTA, 108 Phil. 833, 836)

WHEREFORE, premises considered, Opposer deserves protection under Section 4 (d) of R.A. No. 166 as amended. Accordingly, the Opposition is hereby SUSTAINED. Consequently, Application bearing Serial No. 75095 for the trademark "BLUE JAYS & DEVICE" filed on February 14, 1991 by ELAINE RASPADO is hereby REJECTED.

Let the filewrapper of BLUE JAYS & DEVICE, subject matter of this case be forwarded to the Administrative, Financial and Human Resource Development Services Bureau (AFHRDSB) for appropriate action in accordance with this Decision with a copy to be furnished the Bureau of Trademarks (BOT) for information and to update its records.

SO ORDERED.

Makati City, November 13, 2001.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs