

SARA LEE CORPORATION,	}	Inter Partes Case No. 3912
Opposer	}	Opposition to:
	}	
-versus-	}	Application. Serial No.: 78870
	}	Date Filed : December 10, 1991
	}	Trademark : "HANS"
TESSIE CHUA UY	}	
Respondent-Applicant.	}	
x-----x	}	Decision No. 2003-04

DECISION

On September 27, 1993, an opposition was filed against the registration of the mark "HANS" filed on December 10, 1991 bearing Serial No. 78870 for goods falling under class 25 of the International Classification of goods and which Trademark application was published in Volume VI, No. 2, March to April 1993 issue of the Bureau of Patents, Trademarks and Technology Transfer Official Gazette and officially released on May 31, 1993.

The Respondent-Applicant is "TESSIE CHUA UY", proprietor of FOUR "R" Marketing, Filipino citizen, which address at Lot 9 Blk. 2, Ocean Park Subdivision Sauoy, Novaliches, Quezon City, Metro Manila.

On the other hand, the herein Opposer is "SARA LEE CORPORATION", a corporation organized and existing under the laws of Maryland, United States of America with principal office at 470 Hanes Mill Road, Winston-Salem, North Carolina, United States of America, 27105.

The grounds for the opposition are as follows:

- "1. The trademark "HANS" is deceptively similar to Opposer's trademark, previously used upon and in relation to articles of clothing in the Philippines and in a large number of countries throughout the world, and not abandoned, as to be likely, when applied to or used in connection with the goods of the Respondent-Applicant, to cause confusion, mistake or deception on the part of the purchaser.
- "2. The registration of the trademark "HANS" in the name of Respondent-Applicant will be violative of paragraph d, Section 4 of the Republic Act No. 166, as amended, and Article 6 bis and other provisions of the Paris Convention for the Protection of Industrial Property to which the Philippines and United States are signatories.
- "3. The registration and use by Respondent-Applicant of the trademark "HANS" shall diminish the distinctiveness and dilute goodwill of Opposer's trademark "HANES".

To support this opposition, Opposer will prove and rely on the following facts:

- "1. The Opposer is the owner of Registration No. 26883 issued by the Philippine Patent Office on February 15, 1979, class 25. This registration is in force and effect. A certified copy of Registration No. 26883 will be presented during the proceedings.
- "2. Opposer is likewise the owner of Registration No. 14101 issued on August 22, 1968, by the Philippines Patent Office for the mark HANES in script for. This registration has been renewed and is in force and effect. Attached hereto as Annex "A" is a copy of registration No. 14101.

- “3. Opposer further owns Philippine Registration No. 42160 issued on December 1, 1988 for the mark HANES in block letter form covering classes 10, 20 and 25. Attached hereto as Annex “B” is a copy of Registration 42160.
- “4. Opposer first adopted and used the mark in its home country, the United States, on November 28, 1914. Attached hereto is a copy of U.S. Registration No. 630,339 (for HANES SHIELD DESIGN) as Annex “C”; U.S. Registration No. 719,339 (for HANES in script form) as Annex “D”; and U.S. Registration No. 847,649 (for HANES in block letter form) as Annex “E”. Certified copies of the aforementioned United States registrations, with updated chain of title, will be presented during the proceedings.
- “5. Opposer further owns registrations and has filed applications for registration of the mark “HANES” in numerous countries all over the world.
- “6. From its adoption and first use of the mark, Opposer has continuously used the mark “HANES” and has not abandoned the mark. In the Philippines, Opposer has actually used the mark in commerce and has not abandoned such use. Enclosed are copies of the 5th and 10th anniversary affidavits of use for Opposer’s Registration No. 26883 filed with and duly accepted by the Bureau of Patents, Trademarks and Technology Transfer (respectively Annexes “F” and “G” hereof).
- “7. Opposer has extensively advertised its mark in the Philippines and abroad. The mark has achieved tremendous goodwill and international reputation by virtue of Opposer’s long use and extensive efforts to promote the mark.
- “8. The Opposer will sustain injury and damage from the existence and registration of the mark “HANS”.
- “9. The trademark “HANS” of Respondent-Applicant is deceptively similar to Opposer’s trademark as to be likely, when applied to the goods, or when used in connection with the goods of Respondent-Applicant, to cause confusion or deceive purchasers as to the actual source or origin of the said goods.”

The trademark application subject of the instant opposition proceedings was filed on December 10, 1991, and the governing law at the time is Republic Act No. 166, as amended, specifically Section 4(d) provides:

“Section 4 – Registration of trademarks, trade names and service marks on the Principal Register. There is hereby established a register of trademarks, trade names and service marks which shall be known as the principal register. 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:

“x x x

“(d) Consist of or comprises a mark or trade name which so resembles 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 service of the applicant, to cause confusion or mistake or to deceive purchasers.”

On January 14, 1994, Respondent-Applicant through counsel filed her Answer denying all the material allegations in the Opposition and further alleged the following as her special and affirmative defenses:

- “1. The Opposer has no basis either in fact or in law to oppose withhold the application for registration of the trademark “HANS” under Application Serial No. 78870.
- “2. Respondent-Applicant’s adoption and use of the mark “HANS” is motivated by the famous Chinese Dynasty, the HAN Dynasty, which under Chinese history was marked by the development of bureaucratic centralized monarchy and revival of letters.
- “3. The trademark “HANS” is not confusingly similar with Opposer’s mark “HANES”. HANS is a single syllable word which is phonetically and connotatively different from the word HANES.
- “4. Respondent-Applicant’s application for HANS was recommended for allowance after a thorough examination and careful scrutiny by no less than the Principal Examiner, the Supervising Examiner, Chief Examiner and the Director.
- “5. Respondent-Applicant adopted and used the mark HANS in good faith, which has acquired its own goodwill and acceptance by the public by reason of the high quality of its goods and reasonableness of the price.
- “6. The Opposer has no legal capacity to institute this opposition as it is neither the registrant or assignee of the mark HANES, hence its opposition is fatally defective.”

The issues having been joined, this Office called this case for pre-trial conference. Failing to reach an amicable settlement, the parties went into trial, adduced testimonial and documentary evidences.

The only issue to be resolved in this case is WHETHER or NOT there exists confusing similarity between Respondent-Applicant’s trademark “HANS” and the Opposer’s mark “HANES”.

A cursory review of the documentary exhibits, actual labels of the mark of the Respondent-Applicant (Exhibit “A”) and the mark of the Opposer which was registered with the Philippines Patent Office, on February 15, 1979, Registration No. 26883 (Exhibits “B”, “E”, & “G”) will show that both trademarks contain the same four letters and their distinction lies only in the letter “E” in the Opposer’s trademark. However, apart from being almost similar in appearance and in presentation, Respondent mark HANS when pronounced, is *idem sonans* with Opposer’s mark, HANES.

The Supreme Court in the case (Chuan Show Soy & Canning Co. vs. Director of Patents and Villapanta, 108 Phil. 838,836) Ruled that:

“When one applies for the registration of a mark 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 protect an already used and registered trademark and an established goodwill.”

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks picture in their manner of display. Inspection should be undertaken from the viewpoint of prospective buyer. The trademark complained of should be compared and contrasted with the purchaser’s memory (not in juxtaposition) of the trademark said to be infringed. (87 C.F.S. pp. 228-291) Some such factors as sound; appearance, form, style, shape, size or format, color, ideas connoted by the mark; the meaning, spelling, and pronunciation of the words used; and the setting in which the words appear” may be considered. (87 C.F.S. pp. 291-292) For indeed, trademark infringement is a form of unfair competition. (Clarke vs. Manila Candy Co., 36 Phil., 100, 106; Co Tiong vs. Director of Patents, 95 Phil. 1, 4)

Confusion is likely between trademarks only if their over-all presentations in any of the particular sound, appearance or meaning are such as would lead the purchasing public into believing that the products to which the marks are applied emanated from the same source.

In the case at bar, the two competing trademarks are almost identical or the same. Their pronunciation are likewise almost the same. The composition as to letters are almost the same. The only difference is the presence of letter “E” in Opposer’s trademark, hence, confusing similarity is present and cannot be avoided.

In connection with the use of a confusingly similar or identical mark, it has been ruled, thus:

“Those who desire to distinguish their goods from the goods of another have a broad field from which to select a trademark for their wares and there is no such poverty in the English language or paucity of signs, symbols, numerals, etc. as to justify one who really wishes to distinguish his products from those of all others entering the twilight zone of a field already appropriated by another.” (Weco Products Co., vs. Milton Ray Co., 143 F. 2d, 985, 32 C.C.P.A. Patents 1214)

“Why of the million of terms and combination of letters and designs available, the appellee had to choose those so closely similar to another’s trademark if there was no intent to take advantage of the goodwill generated by the other mark.” (AMERICAN WIRE & CABLE CO. vs. Director of Patents, 31 SCRA 544)

“x x x Why, with all the birds in the air, and all the fishes in the sea, and all the animals on the face of the earth to choose fro, 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 a rooster for the product of defendant’s factory. Why did defendant select two rooster as its trademark?” (CLARKE vs. MANILA CANDY CO., 36 Phil. 100)

In American Wire and Cable Co., vs. Director of Patents, 31 SCRA 544, the Supreme Court held that the determinative factor in a contest involving the registration of trademark is not whether the challenge 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. In short, to justify a denial of an application for registration, the law does not require that the competing trademarks be so identical as to products actual error or mistake: it would be sufficient that the similarity be such that there is a possibility of likelihood that the purchasers mistake the older for the newer brand. Thus, the court found trademark “DYNAFLEX” for electric wires to be confusingly similar to “DURAFLEX”, also for electric wires.

Likewise in "OPERATORS, INC. vs. DIRECTOR OF PATENTS, L-17901," it was held that considering the similarity in APPEARANCE and SOUND between the marks "AMBISCO" for candy products was found to be confusingly with "NABISCO" for bakery products.

It may also be stated that Respondent-Applicant exerted no effort to defend her rights in this case. In fact, she failed to file her formal offer of evidence as contained in Order 2000-49 issued by this Office dated 18 January 2000.

WHEREFORE, premises considered the herein Notice of Opposition is, as it is hereby SUSTAINED. Accordingly, application bearing Serial No. 78870, filed on December 10, 1991 by TESSIE CHUA UI for the mark "HANS" under class 25 is hereby REJECTED.

Let the filewrapper of the trademark HANS 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 furnished the Bureau of Trademarks (BOT) for information and to update its records.

SO ORDERED.

Makati City, 27 January 2003.

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