

TOMINAGA BOEKI KAISHA LTD.,  
Opposer,

INTER PARTES CASE NO. 4042  
Opposition to:

-versus-

Serial No.: 75744  
Date Filed: April 18, 1991  
Trademark: "BLUE DIAMOND"

JAMES CHUA,  
Respondent-Applicant

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Decision No. 97-05

## DECISION

This pertains to a Verified Notice of Opposition filed by the herein Opposer, Tominaga Boeki Kaisha Ltd., a joint stock company duly organized under the laws of Japan with office at 3, Koyo-cho, Nishi-2-chome, Higashinada-ku, Kobe, Japan in the matter of the application for registration of the mark "BLUE DIAMOND" for jeans, pants, t-shirts, polo and jackets, filed on April 18, 1991 under Serial No. 75744 in the name of James Chua, which was published on page 23, Vol. VII, No, 2 issue of the Official Gazette released on May 12, 1994.

James Chua, the herein Respondent-Applicant, is a Filipino citizen doing business under the Name & Style of CBG Marketing located at Mariano Ponce Street, Caloocan City, Metro Manila.

The grounds for the Opposition are as follows:

"1. The trademark "Blue Diamond" of Respondent-Applicant so resembles Opposer's trademark "Blue-Dia", which has been previously used in commerce by Opposer and not abandoned, as to be likely, when applied to or used in connection with the goods of Respondent-Applicant, to cause confusion, mistake and deception on the part of the purchasing public.

"2. The registration of the trademark "Blue Diamond" in the name of Respondent-Applicant will violate Section 37 of Republic Act No. 166, as amended, and Section 6bis and other provisions of the Paris Convention for the Protection of Industrial Property to which the Philippines and Japan are parties.

"3. The registration and use by Respondent-Applicant of the trademark "Blue Diamond" will diminish the distinctiveness, dilute the goodwill and unduly restrict the potential expansion zone of Opposer's trademark "Blue-Dia"

"4. The registration of the trademark "Blue Diamond" in the name of the Respondent-Applicant is contrary to other provisions of the trademark law."

Opposer relied on the following facts to support its Opposition

"1. Opposer is manufacturer of a wide range of footwear bearing the trademark "Blue Dia" which have been marketed and sold by Opposer in various countries prior to the use of "Blue Diamond" by Applicant.

"2. Opposer is the owner of the trademark "Blue Dia" which is currently registered with the Japanese Trademark Office under Registration No. 684981 issued on September 03, 1965.

On the basis of the above-stated Japanese Registration No. 684981, Opposer has applied with this Office for the registration of the trademark "Blue Dia" in the Principal Register on March 18, 1991 under Serial No.75416.

"3. Opposer is the first user of the trademark "Blue Dia" on the goods included under the above described registration which have been sold and marketed in various countries.

"4. By virtue of Opposer's prior and continued use of Blue Dia, said trademark has become popular and has established valuable goodwill for Opposer among consumers who have identified Opposer as the source of the goods bearing the said trademark.

"5. The registration and use of the a confusingly similar trademark by Respondent-Applicant for use on identical or related goods will tend to deceive and/ or confuse purchasers into believing that Respondent-Applicant's products emanate from or are under the sponsorship of Opposer for the following reasons:

- a. The marks are similar in terms of their dominant feature the word mark Blue Dia – their overall commercial appearance and other particulars.
- b. The marks are used on identical or related goods;
- c. The parties are engaged in competitive business; and
- d. The goods on which the marks are used are purchased by non-discriminating purchasers and flow through the same channel of trade."

On September 08, 1994, James Chua, the herein Respondent-Applicant filed his Answer specifically denying the material allegations in the Opposition.

The sole issue to be resolve in this particular case is WHETHER OR NOT the mark "BLUE DIAMOND" of the herein Respondent-Applicant is confusingly similar with the mark "BLUE-DIA" of the herein Opposer.

The applicable provision of the Trademark Law, R.A. No. 166, as amended, specifically provides thus:

SEC. 4. Registration of trademarks, trade names and service mark 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 trademarks, trade names or service marks use to distinguish his goods, business or services from the goods, business or service of others shall have the right to register the same on the principal register unless it:

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(d) Consists of or compromise 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 consumers".

In resolving whether or not "BLUE DIAMOND" is confusingly similar with "BLUE DIA", the test is not simply to take their words and compare the spelling and pronunciation of said words. Rather it is to consider the two marks in their entirety as they appear in their respective labels in relation to the goods to which they are attached. (Mead Johnson & Co. vs. N.V.J. Van Dorp. Ltd., L-17501, April 27, 1963).

Trademarks having the same suffix and similar sounding prefixes but with strikingly different backgrounds are not apt to confuse prospective customers. As stated by the Supreme Court in the case "Bristol Myers Company, Petitioner vs. The Director of Patents and United American Pharmaceuticals, Inc., Respondent-Applicant (17 SCRA 1261). For though the words BIOFERIN and BUFFERIN have the same suffix and similar surrounding prefixes, they appear in their respective labels with strikingly different backgrounds and surroundings, as to color, size, and design.

In the case at bar, Respondent-Applicant's mark "BLUE DIAMOND" has rectangular design label or logo, with plain golden letters and brown background with floral design (Labels on file). On the other hand, Opposer's mark "BLUE-DIA" as appearing in exhibit "A-2" has a design of an oblong where the words "BLUE-DIA" is printed.

Attention must likewise be given to the fact that competing marks are composite. They have the word "BLUE" common but their accompanying words are distinct and from each other both in SPELLING, PRONUNCIATION, meaning as well as its composition.

Respondent's accompanying word "DIAMOND" means a precious stone because having high refractive and dispersive powers it shows when faceted a remarkable brilliances and play of prismatic colors and that when off-color or flawed is invaluable for industrial purposes. While Opposer's accompanying word "DIA" which means through, during, across made of or consisting of.

Thus, side-by-side comparison of the foregoing trademarks in their entirety would inevitably show that each is distinct from each other. In addition, it is not of itself a convincing proof that the words "BLUE-DIA" is the dominant feature of both trademarks. While this Office is willing to entertain the thought that the said words may be the dominant feature of Opposer's trademark since it is the mark itself, it cannot do so in regard to Respondent-Applicant's trademark. The presence of the word "DIAMOND" in prominent and bold golden letters is enough to preclude likelihood of confusion. Succinctly, one cannot say with definiteness that, in viewing Respondent-Applicant's trademark BLUE DIAMOND what attracts or is retained in his mind is the word "DIAMOND". In fact, on the contrary, it is even logical and reasonable for this Office to state that the word "DIAMOND" is the dominant feature therein.

Moreover as shown by Exhibits "B-1" and "B-2" the mark "BLUE DIA" covers principally footwear and other goods of Japanese Class 222, whereas Applicant's BLUE DIAMOND trademark covers jeans, pants, t-shirts, polo and jackets hence they are neither similar nor related to each other.

In fine this Office holds that the trademarks involved herein are not confusingly similar to each other and that there is no likelihood of confusion nor will the registration of the trademark BLUE DIAMOND be a violation of Sec. 37 of the Trademark Law or Art. 6bis of the Paris Convention for the Protection of Industrial Property.

WHEREFORE, viewed in the light of all the foregoing, this Office finds and so holds that Opposer has not successfully made out a clear case of Opposition. Hence, the instant Opposition is, as it is hereby, DENIED. Accordingly, Respondent-Applicant's trademark "BLUE DIAMOND", bearing Serial No. 75744 filed by him on April 18, 1991 is hereby GIVEN DUE COURSE.

Let the filewrapper of this case be forwarded to Application, Issuance and Publication Division for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, November 27, 1997.

EMMA C. FRANCISCO  
Director