

UNIVERSAL ROBINA CORPORATION,
Opposer,

INTER PARTES CASE NO. 3341
Opposition to:

-versus-

Serial No.: 61456
Date Filed: 10 April 1987
Trademark: "JACK n JILL"
Used On: Shoes

RODOLFO SANTOS,
Respondent-Applicant.

DECISION NO. 98-14

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DECISION

This pertains to an Opposition filed by Universal Robina Corporation, a corporation duly organized and existing under the laws of the Philippines with office address at URC Bldg., 110 E. Rodriguez, Jr. Ave., Libis, Quezon City against the application for the registration of trademark "JACK n JILL" for shoes filed on 10 April 1987 under Serial No. 61456 in the name of Rodolfo Santos of Calumpang, Marikina, Metro Manila, which was published on page 30 in the Official Gazette, Volume II, No. 1 of January 30, 1989.

The grounds for the Opposition are as follows:

- "1. The registration of the trademark "JACK n JILL" in the name of Respondent-Applicant is proscribed by Section 4(d) Republic Act No. 166, as amended, because said trademark "JACK n JILL" owned and not abandoned by Opposer, as to be likely, when applied to or used in connection with goods of the Respondent-Applicant, cause confusion or mistake and deceive or mislead purchasers thereof into thinking that they are products of herein Opposer.
- "2. The registration of the trademark "JACK n JILL" in the name of Respondent-Applicant will violate the rights and interest of Opposer over its registered trademark "JACK n JILL", and will cause great and irreparable injury and damage to herein opposer, within the meaning Section 8 of Republic Act. No. 166, as amended.
- "3. The registration of the trademark "JACK n JILL" in the name of Respondent-Applicant will mislead the purchasing public and enable Respondent-Applicant to pass it off as the goods of herein Opposer to the injury and damage of Opposer and the purchasing public.

Opposer relied on the following facts to support its opposition:

- "a. Opposer is the registered owner of the trademark "JACK n JILL" used on "Corn flakes, rice krispies, sugar frosted, frosties, cocoa, pops, strawberry pops and rainbow pops" in Class 30 under Trademark Registration Certificate No. 3984 (Supplemental Register) issued by the Philippines Patent Office dated April 19, 1979 and Trademark Registration Certificate No. 32577 (Principal Register) dated September 14, 1983.
- "b. Opposer has used its trademark "JACK n JILL" in the Philippines for its goods or products since August 26, 1978 and therefore long before the filing date of the application for registration of Respondent-Applicant (April 10, 1987).

- “c. Opposer has already spent a substantial amount of money in advertising and popularizing its products bearing its trademark “JACK n JILL”, and considered with the tremendous marketing of its said products, Opposer has already established a huge and valuable goodwill for the said trademark to the extent that the latter has become a very popular and distinctive mark of Opposer and its products.
- “d. The trademark “JACK n JILL” sought to be registered by Respondent-Applicant in his name for its product is identical and confusingly similar with Opposer’s registered trademark “JACK n JILL” used on the latter’s goods or products for many years already that it is obvious that said trademark has been allegedly used and adopted by Respondent-Applicant with the intent of riding on the popularity and goodwill of Opposer’s said registered trademark.
- “e. Since the trademark “JACK n JILL” sought to be registered by Respondent-Applicant in its name is clearly identical and confusingly similar with Opposer’s registered trademark “JACK n JILL”, when the same is applied to or used on the goods or products of Respondent-Applicant it will surely cause confusion or mistake and deceive purchasers as to the source or origin of Respondent’s goods or products in that respondent’s goods or product covered by the trademark “JACK n JILL” will be mistaken by the purchasing public to be goods or product manufactured and/or sold by Opposer and/or will cause the purchasing public to believe that Respondent-Applicant is connected with Opposer’s business or Opposer is connected with Respondent-Applicant’s business.

A Notice To Answer was sent by this Office to the herein Respondent-Applicant on 3 March 1983 requiring him to file his Answer within fifteen (15) from receipt thereof.

On 29 August 1990, this Office in its Order No. 90-454 MOTU PROPRIO dismissed this case and declared ABANDONED Application Serial No. 61456 for failure of the herein parties to prosecute for more than one year from the date of filing thereof, which is tantamount to lack of interest.

The Opposer on 27 September 1990 filed a Motion for Reconsideration praying for the reversal of the above Order of Dismissal which was GRANTED by this Office per Order No. 91-102 dated 30 January 1991 which set the case for hearing on the motion to have Respondent declared in default on 21 February 1991.

Thereafter, for failure of the Respondent-Applicant to file his ANSWER and to appear at the scheduled hearing on 21 February 1991 despite due notice, Respondent-Applicant was declared in default per Order No. 91-267 dated 18 March 1991 and set the case for the Ex-Parte presentation of Opposer’s evidence on 12 April 1991.

After several postponement of the hearing for the Ex-Parte presentation of Opposer’s evidence, the Opposer formally offered his Exhibits consisting of “Exhibits “A” to “W” and their corresponding sub markings on 09 September 1991 which was admitted in evidence per Order No. 92-48 dated 16 January 1992, where the Opposer was directed to file its memorandum in support of its position in this case, within ten (10) days from receipt thereof.

For non-compliance by the Opposer with the above-mentioned Order this case was deemed submitted for Decision per Order No. 95-83 dated 2 February 1995.

The main issue to be resolved in this case is whether or not registration of trademark “JACK n JILL” bearing Serial No. 61456 filed by the Respondent-Applicant is contrary to Section 4(d) of R.A. No. 166, as amended.

Our Trademark Law, particularly Section 4 (d) thereof provides as follows:

SEC. 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) Consists of or comprise 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 services of the applicant, to cause confusion or mistake or to deceive purchasers;”.

As shown by the labels and drawing submitted by Respondent and the exhibits submitted by Opposer (Exhs. “A” to “S” inclusive); the spelling, style and appearance in the trademark “JACK n JILL” used by both parties in this case, are almost identical. However, an important factor to be considered in infringement of trademark is whether the goods of the two contending parties using the same trademark are so related as to mislead or deceive the public. The Supreme Court held that:

Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, textures or quality. They may also be related because they serve the same purpose or are sold in grocery stores. Thus, biscuits were held related to milk because they are both food products. Soap and perfume, lipsticks and nail polish are similarly related because they are common household items nowadays. (ESSO Standard vs. Court of Appeals, 166 SCRA 336)

In the case at bar, the goods covered by Respondent’s trademark “JACK n JILL” is shoes under Class 25 while that of Opposer’s trademark “JACK n JILL” as shown in the Certificate of Registration No. 32577 and per Exhibits “B” to “S” cover the following: Corn flakes, rice krispies, sugar frosties flakes, frosties, cocoa pops, strawberry pops and rainbow pops, all falling under classification 30.

As indicated above, the goods of the herein parties belong to different classes and are different and distinct from each other and therefore, non competing, hence, the ownership and exclusive right of such mark is not an absolute bar to the use and registration of the same by another. Sec. 4(d) quoted-above clearly provides that registration by another is barred only when used in connection with the goods specified in the application or to goods which is likely to cause confusion or mistake or to deceive purchasers.

In this case of “Acoje Mining Co. Inc. vs. Director of Patents (G.R. No. 28744, April 23, 1971, 38 SCRA 480) the Supreme Court held that the trademark “LOTUS” for soy sauce and “LOTUS” for edible oil were held not confusingly similar because there is quite different between soy sauce and edible oil. If one is in the market for the former, he is not likely to purchase the latter just because of the trademark “LOTUS”

Likewise, the trademark “CAMIA” for ham and “CAMIA” for lard, cooking oil, abrasive detergents, polishing materials and soap were held not confusingly similar because the products are unrelated and while ham and some of the products of the Junior user fall under the same classification as prescribed by the Philippines Patent Office, that fact alone may not be a decisive factor in the resolution as to whether or not the goods are related, the emphasis being on the

similarity of the products and not on arbitrary classification or general description of their properties or characteristics. (Philippine Refining Co. Inc. vs. Ng Sam, G.R. No. 2606 July 30, 1982; 115 SCRA 472)

Also, in this case of Shell Company of the Philippines, Ltd. vs. Court of Appeals, G.R. No. 49145, June 23, 1979, the court affirmed the Patent Office's registration of the trademark "SHELL" as used in the cigarettes manufactured by Fortune Tobacco Corporation notwithstanding Shell Company's opposition thereto as the prior registrant of the same trademark for its "GASOLINE" and other petroleum trademarks.

Therefore, based on the foregoing and despite the Order of Default rendered against herein Respondent-Applicant, this Office is constrained to hold in favor of Respondent-Applicant.

In Gochanco vs. CFI Negros, 157 SCRA 40 (1988), the court ruled that "a defaulted defendant is not actually thrown out of Court. x x x If the evidence presented should not be sufficient to justify a judgment for the plaintiff, the complaint must be dismissed."

WHEREFORE, premises considered, the herein Notice of Opposition is hereby DENIED. Accordingly, application bearing Serial No. 61456 for the registration of the trademark "JACK n JILL" used on shoes filed on April 10, 1987 by RODOLFO SANTOS, Respondent-Applicant is, as it is hereby GIVEN DUE COURSE.

Let the file wrapper of this case forwarded to Administrative Financial and Human Resource Development Bureau in accordance with this Decision with a copy thereof furnished the Bureau of Trademark for information and update of its record.

SO ORDERED.

Makati City, December 21, 1998.

ESTRELLITA BELTRAN-ABELARDO
Caretaker/Office-In-Charge