

VIVAT HOLDING PLC	}	INTER PARTES CASE NO. 3799
Opposer,	}	Opposition to:
	}	
	}	Serial No.: 77107
-versus-	}	Filed: 02 August 1991
	}	Trademark: "JCOOPER
	}	FASHION"
KEMPEE MARKETING/MANUEL	}	Used on: Clothings
SALVADOR	}	
Respondent-Applicant.	}	Decision No. 2001-31
x-----x		

DECISION

Before this Office is an Opposition filed by VIVAT HOLDINGS PLC, a corporation organized and existing under the laws of London in England, with business address at Denmark House, The Broadway, London NW9 7BU, England, against the registration of the trademark "JCOOPER Fashion" for goods under Classes 18, 24 and 25, with Application Serial No. 77107 and filed on 02 August 1991 in the name of KEEPEE MARKETING/MANUEL SALVADOR, a Filipino citizen with address at Manila, Philippines.

The subject application was published on Volume V, No.3, 1992 issue of the Official Gazette officially released for circulation on July 29, 1992. Opposer filed a Verified Notice of Opposition on November 05, 1992, having been granted by this Office an extension of time to do so, upon Motion for Extension filed by the Opposer on October 27, 1992.

The instant Opposition is predicated on the following grounds:

- "1. The Opposer is the owner of the trademark "LEE COOPER", having been the first to adopt the same in trade and commerce for goods falling under International Class 25;
- "2. The trademark "LEE COOPER" was registered by Opposer in the United Kingdom on 17 January 1980 under Registration No. 1.127.121 and in the Philippines on March 27, 1989 and October 30, 1990 under Registration Nos. 43592 and 49325, respectively. Registrations in countries all over the world have also been obtained.
- "3. The foregoing trademark registrations have not been abandoned and are currently in force.
- "4. The trademark "LEE COOPER" which Opposer originated and adopted is known in the Philippines and elsewhere in the world. Opposer's products carried under said mark had, through the years, earned international acclaim as well as the distinct reputation of high quality products.

Opposer relied on the following facts to support its contentions in this Opposition:

- "1. The trademark "JCOOPER FASHION" of the Respondent-Applicant is a flagrant and veritable imitation of herein Opposer's trademark as likely to cause confusion, mistake and deception to the buying public as to the source of Respondent-Applicant's goods.
- "2. Opposer had invested tremendous amount of resources in the promotion of its "LEE COOPER" trademark, i.e., advertisements in well-known newspapers, magazines, and other publications around the world. It is the resultant

goodwill and popularity of Opposer's trademark that Respondent-Applicant wishes to exploit and capitalize.

- "3. The application subject of this Opposition was filed only on 02 August 1991 whereas herein Opposer has been granted Certificates of Registration for its mark "LEE COOPER" in the United Kingdom as early as January 17, 1980 and on March 27, 1989 and October 30, 1990 in the Philippines. An application for registration of the instant mark has also been filed locally on June 25, 1991. Registrations and applications for trademark protection have also been obtained/filed in Europe, Asia, Africa and America.
- "4. The registration of Respondent-Applicant's mark would violate Opposer's rights and interests in its trademark, cause confusion between the Opposer's and Respondent-Applicant's respective businesses and will most assuredly cause the dilution and loss of distinctiveness of Opposer's "LEE COOPER".

The Notice to Answer dated November 12, 2000 was sent to Respondent-Applicant and based on the notation on the registry return receipt, the Applicant received said notice on December 03, 1992. For failure of the Applicant to file the required Answer within the prescribed period or within fifteen (15) days from receipt of aforesaid notice, Opposer moved to declare Respondent-Applicant in default and as per Order No. 9319, Respondent-Applicant was declared IN DEFAULT and Opposer was allowed to present its evidence ex-parte.

Admitted in evidence for the Opposer based on the records are Exhibits "A" to "Y" inclusive of submarkings which consisted of the Verified Notice of Opposition, Legalized Affidavit of Mr. Allan Jeffrey, Opposer's Company Secretary, certified true copy of Certificate of Trademark Registration from different countries including but not limited to the United States of America, England, Japan, Australia, Sri Lanka, Finland, France, Portugal, Singapore and Korea. Likewise included is its Philippine Certificate of Registration for the trademark LEE COOPER for the following goods: shirts, trousers, shorts, jeans, overalls, dungarees, T-shirts, sweatshirts, jumpers, skirts, blouses, jackets, wind-cheaters, slacks, sweaters, blouses, belts.

The lone issue to be resolved in this particular case is whether or not the trademark "JCOOPER" of Respondent-Applicant is confusingly similar to the "LEE COOPER" mark used and duly registered in the name of the Opposer.

Considering that the Application subject of the instant opposition was filed under the old Trademark Law (R.A. 166, as amended), this Office shall resolve the case under said law so as not to adversely affect rights already acquired prior to the effectivity of the new Intellectual Property Code (R.A. 8293).

The applicable provision of the Trademark Law, Section 4(d) 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, business or services from the goods, business or service of others shall have a right to register the same on the Principal Register, unless it:

"x x x

"(d) Consists 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 in connection with the goods, business or service of the applicant, to cause confusion or mistake or to deceive purchasers."

This Office finds merit in the contentions of the instant Opposition.

The trademark "JCOOPER fashion" applied for by Respondent-Applicant although not identical with Opposer's mark "LEECOOPER" will nevertheless impress upon buying public that they are the same or related as to source not only because these marks are used on the same goods, but the presentation of Respondent-Applicant's mark is such that purchasers may likely be mistaken or confused that such mark is related to or an offshoot or a derivative of Opposer's mark. The mark "JCOOPER fashion" of Respondent-Applicant is indubitably confusingly similar to the trademark "LEECOOPER" of Opposer which the latter owns and has not abandoned. Respondent-Applicant's mark "JCOOPER" likewise constitutes the dominant part of Opposer's trademark, the dominant part being the word COOPER which is present in Respondent's JCOOPER mark.

The Supreme Court in Emerald Garment Manufacturing Corp. vs. Court of Appeals, 251 SCRA 600 stated that: *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 trademark contains 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 trademark would be sufficient.*

Likewise in the case of Co Tiong Sa vs. Director of Patents, 95 Phil. 1, 4 (1954); and reiterated in Lim Hoa vs. Director of Patents, 100 Phil. 214, 216-217 (1956), the dominancy principle in trademark was formulated when it ruled that:

"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."

Respondent-Applicant in its effort to give distinctiveness and variation to the mark inserted the letter "J" in place of the prefix LEE in Opposer's mark but failed because the prefix or letter "J" while obviously different in pronunciation, sound and meaning to the prefix "LEE" of Opposer, nevertheless, it is printed or stylized in a manner that it may be read or interpreted as letter "L", which may cause the purchaser to mistake the product of Opposer as that of the Respondent-Applicant, because the prefix "J" in Respondent-Applicant's mark when construed as "L" may mean the "LEE" of Opposer's mark. Bolstering this observation is the pronouncement by the court in the case of Forbes, Munn & Co. (Ltd.) vs. Ang San To, 40 Phil. 272, 275) where it stated that *the test was similarity or "resemblance between the two (trademarks) such as would be likely to cause the one mark to be mistaken for the other. . . . [But] this is not such similitude as amounts to identity. "*

Moreover, not only are the goods/products of both parties involved belong to the same class or are related thereto but the presentation of the mark was such as may convince this Office that indeed Respondent-Applicant has in all approach desired to have the mark appear to be that of Opposer's.

Note should be taken as well of the fact that Respondent-Applicant was validly served with summons, and was afforded the opportunity to refute the claim of and/or controvert the allegation of confusing similarity between the subject trademarks if he filed an Answer but he defaulted. Obviously, therefore, pursuant to Rules of Practice in Trademark Cases, and after Opposer was allowed to present and substitute its claim ex-parte, the case shall be decided on the basis of the evidence thus presented.

Further, the Opposer has sufficiently corroborated its claim that it is the first adopter and registrant of the mark "LEE COOPER" on the same and related goods. Opposer has offered

adequate evidence during trial, foremost is the home registration in the United Kingdom (Exhibit "U"), a decade previous to application Serial No. 77107 of Respondent-Applicant. Worth mentioning likewise is the Certificate of Registration (Exhibit "M") for the mark "LEE COOPER" issued by BPTTT in favor of herein Opposer effective for 20 years from October 30, 1990. In less than a year from date of issuance of Opposer's registration, Respondent-Applicant applied for the registration of its questioned mark. Necessarily therefore, the inevitable conclusion is that Application Serial 77107 can not have any right superior to that of the trademark registration issued in favor of the Opposer.

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Consequently, Application bearing Serial No. 77107 filed by Respondent-Applicant for the registration of the mark "JCOOPER Fashion" used on clothings is hereby REJECTED.

Let the filewrapper of JCOOPER Fashion subject matter of this case be forwarded to the Administrative, Financial and Human Resource Development Services Bureau for appropriate action in accordance with this DECISION with a copy furnished the Bureau of Trademarks for information and update of its record.

SO ORDERED.

Makati City, December 19, 2001.

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