

WRANGLER APPAREL CORP.,	}	IPC No. 14-2004-00110
Opposer,	}	Opposition to:
	}	
-versus-	}	Serial No. 4-1993-089698
	}	Date Filed: 03 December 1993
SUSAN QUE,	}	Trademark: "WINGLER &
Respondent-Applicant.	}	HORSE DEVICE"
x-----x	}	Decision No. 2006-116

DECISION

This pertains to the Notice of Opposition to the application for registration of the mark "WINGLER" bearing Application Serial No. 4-1993-089698 filed on 03 December 1993 for garments namely jeans, pants, t-shirts, blouses, long sleeves, short sleeves, short pants, briefs, jogging pants and sweat shirt falling under Class 25 of the International Classification of Goods, which application was published for opposition in Vol. VII, No. 2, page 124 of the IPO Official Gazette which was officially released for circulation on June 7, 2004.

The Opposer in the above-entitled case is Wrangler Apparel Corporation, a corporation duly organized and existing under the United States law with business address at 3411 Silverside Road 201 Baynard Building Wilmington, Delaware 19810 USA.

Respondent-Applicant, on the other hand, is Susan Que with registered address at 1995 Juan Luna Street, Pritil, Tondo, Manila.

Accordingly, the grounds for opposition as stated in the Verified Notice of Opposition dated 06 October 2004 are as follows:

"1. Respondent's mark is confusingly similar to opposer's mark which is registered in the Philippines and not abandoned and is likely to cause confusion, deception or mistake among purchasers when applied to or used on identical goods.

"2. The mark "WINGLER", differing by only one (1) letter from opposer's mark "WRANGLER", was adopted by the respondent-applicant knowingly and willfully with prior knowledge of the fame and existence of the opposer's mark, in bad faith with an intention of cashing-in on the fame and repute of opposer's mark by colorably imitating for use on identical products.

"3. Opposer's mark is an internationally famous and well-known trademark entitled to protection under the Paris Convention and the Intellectual Property Code.

In support of the above opposition, Opposer relied on the following facts and circumstances:

"1. Opposer is the owner by prior adoption and use of the world famous trademark "WRANGLER" and has, through its predecessor, continuously used, since its adoption, said trademark on jeans and clothing apparel and on various other related items. The "WRANGLER" trademark was first used in the Philippines in February 1959 on clothing and has continuously been used by opposer and its authorized distributors and licensees. The mark was first registered in the name of Blue Bell, Inc. in the Philippines on February 4, 1960 under Reg. No. 2443

in respect of goods in international Class 25 with Philippine registration certificates, including Reg. No. 2443 WRANGLER (Stylized) and Reg. No. 62356 TIMBER CREEK WRANGLER. In addition, opposer owns pending applications for WRANGLER HERO App. No. 4-1999-01043 and HERO BY WRANGLER (Stylized) App. No. 4-2002-003949.

"2. In addition, opposer has registered its trademark "WRANGLER" in various forms in more than 145 countries and territories throughout the world with list of its registrations worldwide for the "WRANGLER" trademark in various forms.

"3. Opposer is also the owner of the trademark "HORSE LOGO" with registrations in several countries.

"4. All goods bearing the "WRANGLER" trademark have a distinctive style, widespread recognition and a strong reputation worldwide. Its goods, which feature the "WRANGLER" mark, have recorded a high level of brand awareness among consumers, ranking consistently among the most recognized and prominent brands of jeans wear clothing. In addition, opposer often uses the "WRANGLER" mark in a stylized format.

"5. In the course of sales to consumers, opposer promotes its goods bearing the "WRANGLER" mark through catalogs, retail store displays and banners to emphasize the importance of its mark as an identifying feature of opposer's goods. Opposer also promotes "WRANGLER" goods on its web site, accessible worldwide at "www.wrangler.com". Opposer's promotions reach consumers around the world, including the Philippines, increasing consumer's awareness of the "WRANGLER" trademark.

"6. Sales figure worldwide for products bearing the trademark "WRANGLER" for the periods 2003, 2002 and 2001 are: US\$ 1, 434, 722, 000.00; \$ 1, 534, 233, 000.00; and \$ 1, 579, 931, 000.00, respectively.

"7. Continuously since 1959, opposer has, by itself or through its related companies, promoted to consumers throughout the world goods and accessories featuring the "WRANGLER" mark with extensive advertising in all media. Estimated advertising expenses for the periods 1990 and 2003 are: US \$ 32, 000, 000.00; and \$ 77, 654, 000.00, respectively. Substantial additional sums were also spent by wholesalers, distributors, licensees and retailers.

"8. In the Philippines, historical sales figures from the period 1978 through 1985 indicate annual sales of "WRANGLER" products of between: US \$ 1, 800, 000.00; and \$ 4, 000, 000.00. More recently, sales figures of "WRANGLER" products, in the year 2002 and 2003 are: US \$ 2, 641, 000.00; and \$ 3, 162, 000.00, respectively.

"9. Advertising expenditures by opposer and its licenses for the promotion of "WRANGLER" products in the Philippines in

the years 2002 and 2003 are: US \$ 91, 000.00 and \$ 146, 000.00, respectively.

“10. The designation “WRANGLER” is the primary term in opposer’s trade name Wrangler Apparel Corp., which has been used since 1993 in the United States and throughout the world.

“11. Due to extensive distribution, sales and advertising in various media, opposer has established an exceptionally strong reputation for the mark “WRANGLER” in the Philippines and elsewhere. It is recognized in the Philippines and in many other countries as signifying fashionable and quality jeans wear and other related products originating only with Wrangler and its licensees.

“12. Respondent’s use of the confusingly similar trademark “WINGLER & Horse Logo” will cause consumer confusion, deception and damage on the part of the opposer. Purchasers or potential purchasers will be mislead into believing that respondent Susan Que’s products have either originated with opposer Wrangler, or is an authorized variant of opposer’s mark or have been endorsed or sponsored by Wrangler in some way to the damage and prejudice of opposer and opposer’s products. It indicates that respondent’s mark was created in bad faith with the intention of trading on the fame and goodwill of “WRANGLER”.

“13. Respondent has almost entirely appropriated opposer’s mark. It is noticeable that respondent’s mark “WINGLER” differs from opposer’s mark “WRANGLER” by only a single letter. The letters “ra” in opposer’s mark were simply replaced with the letter “l”.

A Notice to Answer was subsequently issued by this Bureau requiring the Respondent-Applicant to file its Answer to the Verified Notice of Opposition within fifteen (15) days from receipt of the said Notice.

For failure of the Respondent-Applicant to file her Answer within the reglementary period, Opposer filed a Motion to Declare Respondent-Applicant in Default. The same was granted by this Bureau under Order No. 2005-96 dated 16 February 2005. Thus, Opposer was allowed to present its evidence ex-parte.

Subsequently, in the advent of Office Order No. 79, which took effect on September 1, 2005, this case, as per manifestation of opposer’s counsel, was covered by the summary rules. Further, counsel moved that the instant case be submitted for decision on the basis of the following submitted evidences, in support of its opposition, to wit:

Exhibit	Description
“A”	Registration issued in the Philippines
“B”	Opposer’s registrations worldwide for the WRANGLER trademark in various forms
“C”	Registration certificates issued to opposer from Numerous countries for the WRANGLER Trademark

“D”	Registration Certificates issued to opposer for the HORSE LOGO
“E”	Advertising and promotional materials from 1987 up to the present, including samples of advertising in the Philippines
“F”	Certificate of Incorporation for opposer
“G”	Affidavit of Helen L. Winslow, witness for Opposer
“G-1”	Signature of Helen L. Winslow
“G-2”	Signature of Notary Public
“G-3”	Signature of the Secretary of State certifying the notary’s signature
“G-4”	Consular Authentication by the Philippine Consulate

The issues presented to this Bureau for resolution are as follows:

Whether or not Respondent-Applicant’s “WINGLER & HORSE DEVICE” mark is confusingly similar to Opposer’s trademark “WRANGLER”, and

Whether or not Opposer is the prior user and therefore, entitled to protection under the Trademark Law.

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

The applicable provision of the Trademark Law provides:

“Sec. 4. Registration of trademarks, trade names and service marks on the principal register. – x x x The owner of a trademark, trade name or services mark used to distinguish his goods, 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 used in connection with the goods, business or service of the applicant, to cause confusion or mistake or to deceive purchasers”.

The determinative factor in a contest involving registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would *likely cause confusion or mistake* on the part of the buying public. The

law does not require that the competing trademarks must be so identical as to produce actual error or mistake. It would be sufficient that the similarity between the two trademarks is such that there is a *possibility or likelihood* of the older brand mistaking the newer brand for it.

In the case of *Etepha vs. Director of Patents* (16 SCRA 502), the Supreme Court ruled that:

“The essential element of infringement is colorable imitation. This term has been defined as “such a close or ingenious imitations to be calculated to deceive ordinary purchasers, or such resemblance of the infringing mark to the original as to deceive an ordinary purchaser giving such attention as a purchaser usually gives, and to cause him to purchase the one, supposing it to be the other.”

The Supreme Court has relied on the dominancy test or the assessment of the essential or dominant features in the competing trademarks, in the determining whether or not there is confusing similarity between trademarks. Even the spelling and the similarity in sounds and pronunciation are taken into consideration. In the case of *Co Tiong Sa vs. Director of Patents* (95 Phil 1) the application for the registration of the trademark “FREEDOM” was rejected due to the existing registration of the mark “FREEMAN” over the same class of goods.

In the case of *Marvex Commercial Co. vs. Hawpia & Co.* (18 SCRA 1178), the Supreme Court pronounced that:

“The tradename “LIONPAS” for medicated plaster cannot be registered because it is confusingly similar to “SALONPAS”, a registered trademark also for medicated plaster. x x x Although the two letters of “SALONPAS” are missing in “LIONPAS”, the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effect are confusingly similar. x x x”

The Supreme Court further observed in the case of *American Wire and Cable Co. vs. Director of Patents* (31 SCRA 544), that:

“The similarity between the two competing trademarks, DURAFLEX and DYNAFLEX is apparent. Not only are the initial letters and the last half of the appellations identical but the difference exists in only two out of the eight literal elements of the designations. Coupled with the fact that both marks cover insulated flexible wires under Class 20; x x x no difficulty is experienced in reaching the conclusion that there is a deceptive similarity that would lead the purchaser to confuse one product with the other.”

In the instant case, the only difference between the trademarks of opposer and that of respondent-applicant are the second and third letters “rag” of opposer which was replaced by a single letter “l” of respondent-applicant. All the other letters are the same such that when the two words are pronounced, the sound is almost the same. This is the application of the *idem sonans rule*, as illustrated in the case of *Sapolin Co. vs. Balmaceda* (67 Phil 795)

Both trademarks cover similar goods, i.e., garments, jeans, shirts and other clothing apparels. As such, both products flow through the same channels of trade such that confusion between the two trademarks is likely to result in the mind of the prospective buyers.

The purpose of the law in protecting a trademark cannot be over-emphasized. They are to point out distinctly the origin or ownership of the article to which it is affixed, to secure to him,

who has been instrumental in bringing into a market a superior article of merchandise, the fruit of his industry and skill, and to prevent fraud and imposition (Etepha vs. Director of Patents, *ibid*). Today, the trademark is not only a symbol of origin and goodwill. In other words, the mark actually sells the goods. The mark has become the "silent salesman". It has become a more convincing selling point that even the quality of the articles to which it refers. (Mirpuri vs. Court of Appeals, 318 SCRA 516)

In the instant case, evidence show that the trademark "WRANGLER" was first used by the opposer in January 1959. Said trademark has also been registered by the opposer in countries around the world. On the other hand, respondent-applicant's first use of its trademark "WINGLER & HORSE DEVICE" in the Philippines dates back to January 1990 only. Thus, it is clear from the foregoing that between the Opposer and the Respondent-Applicant, the former sufficiently proved prior use of its trademark and is therefore entitled to protection under the law.

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Accordingly, application bearing Serial No. 4-1993-089698 for the mark "WINGLER & HORSE DEVICE" filed in the name of SUSAN QUE on 03 December 1993 is hereby REJECTED.

Let the filewrappers of the trademark "WINGLER & HORSE DEVICE" subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 18 October 2006.

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