

ANG KA YU.	)	INTER PARTES CASE NOS. 1717 & 1852
Opposer,	)	OPPOSITION TO:
	)	
	)	Serial No. 36990
	)	Filed : December 5, 1978
	)	Applicant : Wilson Chua
	)	Trademark : SKIVA & CROCODILE
	)	DEVICE
	)	
- versus -	)	- and -
	)	
	)	Serial No. 41193
	)	Filed : April 25, 1980
	)	Applicant : Wilson Chua
	)	Trademark : SKIVA & ALLIGATOR
	)	DEVICE
	)	
WILSON CHUA,	)	<u>DECISION NO. 94-18 (TM)</u>
Respondent-Applicant.)	)	
	)	February 14, 1994
x-----x	)	

DECISION

This is a consolidated opposition (Inter Partes Case No. 1852) and (Inter Partes Case No. 1717). Wilson Chua the Respondent-Applicant in both cases with address at Obando Bulacan, Philippines whereas the Opposer in both cases is ANG KAYU, of age, a citizen of the Philippines with business address at 825 Reina Regente St. Binondo, Manila.

The mark subject of this opposition is "SKIVA & CROCODILE DEVICE" bearing Serial No. 41193 filed April 25, 1980 and Serial No. 36990 filed on December 5, 1978 by Wilson Chua which was published in Volume 78, No. 42 of the Official Gazette dated October 18, 1982 which was officially released on 22 May 1984. The grounds for the opposition are as follows:

1. The Opposer is the owner of the trademark "CROCODILE" used on sportshirts for men and women, T-shirts, Sandos for the last twenty (20) years, more or less;
2. The mark "CROCODILE" and/or its picture device which Opposer had adopted and used, as well as succeeded from its predecessors in interest, Mr. KEE BOC since 1951, is well known and very popular in the Philippines; and
3. The mark of the Respondent-Applicant which is "SKIVA" and "CROCODILE DEVICE", is confusingly similar to Opposer's aforescribed trademarks, because of the use of said devise and thus, the public will be misled into believing that the business of Respondent-Applicant is related to that of Opposer.

Opposer relies on the following facts to supports its opposition.

- "1. The Opposer is the registered owner of the trademark "Crocodile and Device" as shown in Certificate of Registration No. 7142 issued on February 16, 1959 in Favor of Kee Boc, who has assigned said registration to herein opposer on August 15, 1974, Xerox copy of said assignment is herewith attached as Annex "A" and made an integral part hereof;

2. That the mark "Crocodile" was likewise registered by opposer as shown by Certificates of Registration Nos. 22748 and 22749, both issued on December 17, 1975; and Certificate of Registration No. 2022 issued on October 4, 1974, all under Class 25;

3. That the application subject of the opposition was filed on December 5, 1978 and respondent-applicant claims first use of the same in trade and in commerce in the Philippines only on December 1, 1975;

4. That respondent-applicant's alleged mark "SKIVA & Crocodile Device" is confusingly similar to and a colorable imitation of the trademark "Crocodile Device" in appearance, meaning, style of the picture of a crocodile;

Moreover, the goods covered by both marks belong to the same class of goods (25) of the official classification of the Philippine Patent Office; and

5. That the registration of respondent-applicant's alleged mark "SKIVA & Crocodile Device" would violate opposer's rights and interests in its trademarks "Crocodile" and "Crocodile Device" because opposer and applicant's businesses and products and the dilution and loss of distinctiveness of opposer's valuable trademark is inevitable.

On March 18, 1983 Respondent-Applicant "WILSON CHUA" filed his answer to the notice of opposition.

Wilson Chua raised the following special/affirmative defenses:

1. That the opposition states no causes of action;

2. That under the equitable principles of laches, estoppel and acquiescence opposer is now barred in opposing the registration of subject mark considering that it is already duly registered in the Philippines Patent Office under Certificate of Registration No. SR-2843 issued on June 1, 1977 which is still in full force and effect; and

3. That the failure of the opposer to attach copies of certificates of registrations upon which he predicates his Notice of opposition in accordance with Sec. 8 of R.A. 166 as amended, is a fatal defect and render the same dismissable.

This issues having been joined, the office set the case for pre-trial conference on April 21, 1983 and no amicable settlements having been reached the parties decided to go into trial where they adduced their respective testimonial and documentary evidence.

The core issue to be resolved in this case is whether or not the Respondent-Applicant's trademark "SKIVA & ALIGATOR DEVICE" is confusingly similar with Opposer's "CROCODILE" word and "CROCODILE & DEVICE" trademarks as would likely cause confusion, mistake or deception of the public.

The trademark of Opposer "CROCODILE and PRESENTATION of a CROCODILE" has been registered with the Bureau of Patents, Trademarks and Technology Transfer and having used the said mark since January 15, 1949 (Exhibits "A", "A-1", "B", "B-1", "C", "D", and "D-1".)

Opposer likewise submitted invoices proving that he used the subject trademark long before herein Respondent-Applicant started using the "CROCODILE DEVICE" (Exhibits "F", "F-1" and "F-2", "G", "G-1", "G-2", "G-3", and "G-4").

The evidence shows that Respondent-Applicant's trademark "SKIVA & CROCODILE DEVICE" Opposer's trademark "CROCODILE" and/or its picture Device contain the Device of a crocodile. The only difference is the word "SKIVA" appended to the crocodile Device. Both parties goods belong to the same class (25) and therefore flow through the same channels of trade. Hence, there is factual basis to hold that Respondent-Applicant's trademark is confusingly similar with Opposer's trademark which has been used since 1951.

Respondent-Applicant may not appropriate Opposer's trademark in toto and avoid likelihood of confusion by adding the word "SKIVA" thereto. Thus, in *Continental Connector Corp. vs. Continental Specialties Corp.*, 207 USPQ 60, IT HAS BEEN RULED THAT "Courts have repeatedly held that the word as the primary element in a trademark is not counteracted by the addition of another term". Examples: "MISS USA" and "MISS USA WORLD" (*Miss Universe, Inc. vs. Patricelli*, 161 USPQ 129); "GUCCI" and "GUCCHI-GOO" (*Gucci shops vs. R.H. Macy & Co.*, 446 F Supp. 838); "COMFORT" and "FOOT COMFORT" (*Scholl, Inc. vs. Tops E.H.R. Corp.*, 185 USPQ).

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

SEC. 4. Registration of trademark, tradenames and service marks on the principal register. There is hereby established a register of trademarks, tradenames and service marks which shall be known as the principal register. the owner of a trademark, tradename or service mark used to distinguish his goods, business or services from the 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 comprises 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 service of the applicant, to cause confusion or mistake or to deceive purchasers".

In cases involving infringement of trademark, it has been consistently held that there is infringement when the use of the trademark involved would likely cause confusion, mistake or deception upon purchasers as to the source or origin of the commodity (*Fruit of the Loom, Inc. vs. Court of Appeals*, 133 SCRA 405, citing *Co Tiong Sa vs. Director of Patents*, 95 Phil. 1: *Alhambra Cigar & Cigarette Co. vs. Mojica*, 27 Phil. 266; *Sapolin Co. vs. Balmaceda*, 67 Phil. 705; *La Insular vs. Lao Oge*, 47 Phil. 75). The Supreme Court even noted that Section 4(d) of R.A. No. 166, as amended, does not require that the articles of manufacture of the previous user and the late user of the mark should possess the same descriptive properties or should fall into the same categories as to bar the latter from registering his mark in the principal register. The meat of the matter is the likelihood of confusion, mistake or deception upon purchasers of the goods of the Junior user of the mark and the goods manufactured by the previous user (*Sta. Ana vs. Maliuat*, 24 SCRA 1018, citing *Chua Che vs. Philippine Patent Office*, 13 SCRA 67).

In the case of *Chuanchow Soy & Canning Co. vs. Director of Patents*, L-13947 June 30, 1960, the Court held and which was re-iterated in the case of *Lim Hoa vs. Director of Patents*, 100 Philippines 214, thus:

"When one applies for the registration of a trademark or label which is almost the same or 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

trademark, this is not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established good-will”.

It is therefore, not necessary that the matter sought to be protected be literally copied. Differences or variations or similarity in the details of one device or article of those of another are not legally accepted tests. It is sufficient that the substantial and distinctive part of the main or essential or dominant features of one mark is copied or imitated in another (Co Tiong Sa vs. Director of Patents, 95 Phil. 1).

Therefore, Opposer deserves protection under Section 4(d) of R.A. No. 166, as amended.

WHEREFORE, the Opposition is SUSTAINED. Application Serial No. 36990 and Serial No. 41193 filed by Wilson Chua for the trademark “SKIVA & ALIGATOR DEVICE” are both DENIED.

Let the filewrapper of these cases be forwarded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision. Likewise, let a copy of this decision be furnished the Trademark Examining Division for information and to update its record.

SO ORDERED.

IGNACIO S. SAPALO  
Director