

COLT INDUSTRIES, INC.,)	INTER PARTES CASE NO. 3331
Opposer,)	
)	OPPOSITION TO:
)	
)	Application Serial No. 62847
)	Filed : October 5, 1987
)	Applicant : Carr International
)	Trademark : CARR INTERNATIONAL
)	& LOGO DEVICE
- versus -)	Used on : Indent, import and
)	export business
)	
)	<u>DECISION NO. 92-7 (TM)</u>
CARR INTERNATIONAL,)	
Respondent-Applicant.))	April 7, 1992
x-----x)	

DECISION

This is an opposition to Application Serial No. 62847 for the trademark CARR INTERNATIONAL & LOGO filed by Carr International on 01 October 1987. The service mark is allegedly being used for indent, import and export business under Class 35.

Opposer, COLT INDUSTRIES, INC. is a corporation organized and existing under the laws of Pennsylvania, U.S.A. with principal Office at 430 Park Avenue, New York, N.Y., U.S.A., Respondent-Applicant, Carr International on the other hand, is a company organized and existing under the laws of the Philippines with business address at Suite 612-613 Bank of P.I. Building, 150 Plaza Cervantes, Manila.

It appears from the records that Respondent failed to file an Answer despite notice thereto. It likewise failed to take any step to protect its alleged mark despite service of orders and notices subsequent to its being declared in default. Thus, the trial proceeded and opposer was allowed to present its evidence ex-parte.

Opposer believes that it will be damaged by the registration of the subject mark applied for, alleging that --

“1. Opposer is the owner of the trademark “Colt Industries and Logo Device” having been first to adopt and use the same in actual trade and commerce for goods under International Class Nos. 6, 7, 9, 11 and 13;

2. The trademark “Colt Industries & Logo Device” has been registered in the United States under Certificate of Registration No. 908,893 issued on March 2, 1971 and in several countries, details of these registrations appear in the attached schedule marked Annex “A”;

3. The trademark “Colt Industries & Logo Device” which the Opposer has created and adopted is well known throughout the world for their good quality and high reputation.”

In support of these allegations, Opposer submitted in evidence the following documents:

a. Legalized and authenticated U.S. trademark Registration No. 908,890 for trademark COLT INDUSTRIES & LOGO DEVICE dated 2 March 1971 covering goods falling under Classes 6, 7, 9, 11 and 13 (Exhibit “B”); and

b. A list of 85 registrations of the trademark COLT INDUSTRIES & LOGO DEVICE for goods ranging from Class 6 to Class 13 from 29 countries, not including the Philippines (Exhibit "C").

Opposer then proceeded to argue that the subject service mark is confusingly similar to its trademark COLT INDUSTRIES & LOGO DEVICE in that the former intimately resembles the latter, specifically the "Logo Device" (pp 4-5, Memorandum for the Opposer). It is interesting to note that Opposer did not touch on the similarity of the word marks of the opposing parties where it counts most. Where the conflicting marks are composite marks, i.e. a part consists of a word and the other consists of a device, the word portion is controlling in determining the issue of likelihood of confusion since it is most likely to be impressed upon the purchaser's memory and to serve as indicium of origin, and since it is the portion of the mark purchasers refer, to order goods. (see *Jordache Enterprises vs. Davila, CA, G.R. Sp. Nos. 10997 and 10998, February 14, 1989, affirmed by the Supreme Court in G.R. No. L-87993-94, July 24, 1989*).

"Word portion of mark with design that is only literal portion of it is necessarily means by which purchasers identify, call for, or refer to goods sold under mark; use of 'Cheeselovers International' with representation of globe design, and of "The heart design is likely to cause confusion." (In re *Cheeselovers International Ltd./PO TM TAppBd/ 197 USPQ 632*)

"Word portion of mark that consists of both word and design features is portion utilized in calling for goods, and is most likely to be impressed upon purchaser's memory and to serve as indicium of origin." (In re *Mack / PO TM TAppBd/ 197 USPQ 755*)

"Words are controlling in determining issue of likelihood of confusion involving composite mark consisting of word and designs, ordinarily, since they are portion of mark used to refer to and order goods; principle has particular application in case in which design portion of composite mark has highly suggestive, if not virtually descriptive, character that makes no contribution toward distinguishing source of respondent's product from source of petitioner's product." (St. *Louise Janitor Supply Co. vs. Abso-Clean Chemical Co. /PO TM TAppBd/ 196 USPQ 778*)

In the case at bar, CARR INTERNATIONAL and COLT INDUSTRIES are far apart, in appearance and in sound. The manner in which both marks are used are entirely different.

And even assuming, arguendo, that there exists a similarity between the two composite marks, the likelihood of confusion on the part of the public is remote, on the following grounds:

1. Opposer's mark is applied on goods falling under Classes 6, 7, 9, 11 and 13 while Respondent's mark is used on services falling under Class 35.
2. Opposer never claimed, much more proved, that its mark was ever used in the Philippines. It merely stated that "Opposer is and has always been the owner and prior user of the trademark 'Colt Industries, Inc. & Logo Device' in the United States as far back as 1965 and in foreign countries (Exhs. "B" to "B-3" and Exh. "C")" (p.4, Memorandum for Opposer) . . . The foreign countries referred to do not include the Philippines.
3. Opposer's trademark/tradename "COLT INDUSTRIES, INC. & LOGO DEVICE" is not internationally well-known. The only evidence to prove such allegation of internationally well-known stature is its self-serving statement, that is, "due to the continuous publications and advertisements of said trademark in well-known newspapers and magazines in well-known countries like U.S. and Great Britain and a result of continuous usage and large expense, Opposer's trademark has acquired goodwill and reputation."

(pp.6-7, Memorandum for the Opposer). Which well-known newspapers and magazines? Did one of these ever reach Philippine soil? There is much to be desired of Opposer's allegations. (see Kabushiki Kaisha Isetan vs. IAC et. al., G.R. No. 75420, November 15, 1991).

WHEREFORE, the Notice of Opposition to Application Serial No. 62847 is hereby dismissed for lack of merit. Application Serial No. 62847 for the trademark CARR INTERNATIONAL & LOGO in the name of Carr International is given due course.

Upon finality of this decision, let a copy be served the Trademark Examining Division and the filewrapper be forwarded to Application, Issuance and Publication Division for proper action.

SO ORDERED.

IGNACIO S. SAPALO
Director