

SAKS AND COMPANY,  
Opposer,  
  
- versus -  
  
JIMMY K. SIY,  
Respondent-Applicant.)  
x-----x

INTER PARTES CASE NO. 3121  
  
OPPOSITION TO:  
Application Serial No. 56033  
Filed : March 27, 1985  
Applicant : Jimmy K. Siy  
Trademark : SEVENTH AVENUE  
Used on : "Men's, women's  
infant's and  
children's  
wear, etc. in  
Classes 24 & 25  
  
DECISION NO. 91-12 (TM)  
September 27, 1991

DECISION

This case pertains to a Notice of Opposition filed by SAKS and CO., a company duly organized and existing under the laws of the state of New York, U.S.A. and having its principal address at 611 5<sup>th</sup> Avenue, New York, New York 10022 U.S.A.; to the application for registration of the mark SEVENTH AVENUE, bearing Serial No. 56033 for men's, women's, infant's and children's wear in classes 24 and 25, filed on March 27, 1985 by Jimmy K. Siy, a Filipino citizen with address at 141 del Mundo St., Caloocan City.

The grounds for opposition are as follows:

"1. The opposer is the owner of the trademark SAKS FIFTH AVENUE with the following Philippine Registrations:

"a. Philippine Trademark Certificate of Registration No. 33015 issued February 15, 1984 covering the goods all articles of wearing apparel for men and boys, and for women, misses, children and infants, exclusive of boots and shoes and other items of outer footwear, under Class (es) 25.

"b. Philippine Trademark Certificate of Registration No. 39295 issued June 13, 1988 covering the services retail services, under Class (es) 35.

"The trademark "SEVENTH AVENUE" sought to be registered by the respondent-applicant so resembles the aforementioned marks of the opposer that the use of the respondent-applicant's aforesaid mark on its goods will cause confusion and mistake, or will deceive the purchasers thereof, such that the public will be misled to believe that the mark of respondent-applicant and the goods on which respondent-applicant's mark is used are those of SAKS AND COMPANY, the opposer herein.

"2. The opposer herein believes that the registration of the trademark "SEVENTH AVENUE" in the name of respondent-applicant, JIMMY K. SIY, will cause great and irreparable injury and damage to herein opposer, pursuant to Section 4(d), Chapter II of Republic Act No. 166, as amended."

Opposer relied on the following facts to support its Opposition:

"1. That the mark "SEVENTH AVENUE" appearing on the label as actually used on the goods (men's, women's, infant's & children's wears, etc.) of respondent-applicant, closely resembles - - in fact is almost identical to - - opposer's aforementioned mark SAKS FIFTH AVENUE (clothing [all articles of wearing apparel for men and boys, and for women, misses, children and infants, exclusive of boots and shoes and other items of outer footwear]).

"2. That the opposer's aforementioned trademarks have already acquired a considerable amount of goodwill through its long and exclusive use in the Philippines as early as 1968 on the aforementioned products and said marks are well-known in the Philippines and United States of America.

"3. It may be further noted that the mark applied for registration in the Philippine Patent Office by the respondent-applicant is used on goods similar to and/or related with (both are in Class 25.) Those bearing the aforementioned marks of the opposer herein."

Immediately upon receipt of the Verified Notice of Opposition filed on July 28, 1987, this Office sent a Notice to Answer requiring herein Respondent-Applicant to file his Answer requiring herein Respondent-Applicant to file his Answer to the attached Notice of Opposition within fifteen (15) days from receipt thereof. Said Notice to Answer was received by Mr. Sit Pua for the Respondent, Jimmy K. Siy. Although the date of receipt was not indicated, it appears that the Notice for said registered mail was stamped by the Bureau of Posts of Caloocan City with the date August 12, 1988.

On September 21, 1989, Opposer, through Counsel filed a Motion to Declare Respondent in Default for having the reglementary period. This Office granted said motion in its Order No. 89-779 dated September 25, 1989 declaring Respondent-Applicant in Default and allowing Opposer to present its evidence Ex-Parte on October 31, 1989.

On March 12, 1990, this Office dismissed the case motu proprio for failure of Opposer to prosecute for an unreasonable length of time, it appearing that this case has been dormant for more than six (6) months, with no motion or manifestation coming from the parties, dismissal of this case is in order pursuant to Section 3 Rule 17 of the Rules of Court.

Opposer thereafter filed a Motion for Reconsideration of the aforesaid Order on the grounds stated therein which this Office granted per Order No. 90-202-A dated 30 March, 1990 setting aside Order No. 90-139 and reverting this case into its active status, at the same time set the case for ex-parte presentation of Opposer's evidence on April 04, 1990 at 2:30 P.M.

After the presentation of its witness Mr. Gerald Andrada, together with documentary evidences, the Opposer formally offered its evidence consisting of Exhibits "A" to "L" and submarkings.

The said Exhibits were all admitted by this Office in evidence for the Opposer Order No. 90-429, dated August 16, 1990 and at the same time advised Opposer to submit its Memorandum within fifteen (15) days from receipt of the Order. On August 27, 1990 Opposer filed its Memorandum in this case.

The only issue to be resolved in this case is whether or not the trademark SEVENTH AVENUE used on men's, women's, infant's and children's wear particularly pants, blouses, t-shirts, shorts, socks, shoes, jeans, skirts, polo-shirts, dusters, handkerchiefs, panties and dresses, pajamas and nightgowns sought to be registered by herein Applicant is confusingly similar to the trademark SAKS FIFTH AVENUE which has been registered and continuously being used by herein Opposer for all articles of wearing apparel for men and boys, and for women, misses, children and infants exclusive of boots and shoes and other item of outer footwear, covered by Certificate of Registration No. 33015 issued by February 15, 1984.

In determining whether or not confusing similarity exists between the two trademarks, the Supreme Court has repeatedly held that the question of infringement of trademark is to be determined by the test of dominancy. Thus, the Supreme Court held that –

“In the case involving infringement of trademark brought before the court, it has been consistently held that there is infringement of trademark when the use of the mark involved would be likely to cause confusion or mistake in the mind of the public or to deceive purchasers as to the origin or source of the commodity; 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 or 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 trademarks would be sufficient. (Philippine Nut Industry, Inc. vs. Standard Brands, Inc., 65 SCRA 575; pp. 579-580).” (Underscoring ours)

In the instant case, the comparison between the marks of Respondent as well as that of Opposer’s as reflected in Exhibits “D-1”, “E-1” and “K-1” reveal that both marks contain the dominant word “AVENUE” and a numeral before it, namely, “FIFTH” in Opposer’s trademark and “SEVENTH” in the Respondent’s trademark. The style and general appearance of the two marks as they appear on their labels are substantially similar. Even without examination of the same, by just listening to the sound of both marks when one is to read the same, would create confusion to the buying public.

Thus, in the same case of Philippine Nut Industry, Inc. vs. Standard Brands, Inc., 65 SCRA 565, the Supreme Court in holding that the trademark “Philippine Planters Cordial Peanuts” is confusingly similar to the trademark “Planters Cocktail Peanuts”, it stated that:

“The first argument advanced by petitioner which we believe goes to the core of the matter in litigation is that the Director of Patents erred in holding that the dominant portion of the label of Standard Brands in its cans of salted peanuts consists of the word PLANTERS which has been used in the label of Philippine Nut for its own product. According to petitioners, PLANTERS cannot be considered as one dominant feature of the trademarks in question because it is mere descriptive term, an ordinary word which is defined in Webster International Dictionary as one who or that which plants or sows, a farmer or an agriculturist (pp. 10-11, petitioner’s brief). We find the argument without merit. While it is true that PLANTER is an ordinary word, nevertheless it is used in the labels not to describe the nature of the product, but to project the source or origin of the salted peanuts contained in the cans. The word PLANTERS printed across the upper portion of the label in bold letters easily attracts and catches the eye of an ordinary consumer and it is that word and none other that sticks in his mind when he thinks of salted peanuts.”

Furthermore, in the case of Converse Rubber Corporation vs. Universal Rubber Products, Inc. (147 SCRA 154; p. 163), the Supreme Court held that:

“The determinative actor in ascertaining whether or not marks are confusingly similar to each other is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark would likely cause confusion or mistake on the [art of the buying public. It would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the new brand for it. Even if not all the details just mentioned were identical, with the general appearance alone of the two products,

any ordinary, or even perhaps even [sic] a not too perceptive and discriminating customer could be deceived x x x." (Underscoring ours)

"When the law speaks of purchaser, the reference is to ordinary average purchasers. It is not necessary in either case that the resemblance be sufficient to deceive experts, dealers, or other persons especially familiar with the trademark or goods involved.

"The similarity in the general appearance of respondent's trademark and that of Petitioner's would evidently create a likelihood of confusion among the purchasing public. But even assuming, arguendo that the trademark sought to be registered by respondent is distinctively dissimilar from those of the petitioner, the likelihood of confusion would still subsists, not on the purchaser's perception of the goods but on the origins thereof. By appropriating the word 'CONVERSE', respondent's products are likely to be mistaken as having been produced by petitioner. The risk of damage is not limited to a possible confusion of goods but also includes confusion of reputation if the public could reasonably assume that the goods of the parties originated from the same source."

Finally, one would wonder as to the real intent and motive of Respondent-Application in choosing the word AVENUE as its trademark which incidentally, is printed in an almost identical manner to that of the Opposer's mark. Thus, in one case, the Supreme Court held that:

"A similar question was asked by this Court in *Clarke vs. Manila Candy Co.*, 36 Phil. 100, when it resolved in favor of plaintiff a case of unfair competition based on an imitation of Clarke's packages and wrappers of its candies the main feature of which was on rooster. The Court queried thus: x x x why with all the birds in the air, and all the fishes in the sea, and all the animals on the face of the earth to choose from, the defendant company (Manila Candy Co.) selected two roosters as its trademark although its directors and managers must have been well aware of the long-continued use of a rooster by the plaintiff with the sale and advertisement of its goods? x x x A cat, a dog, a carabao, a shark or an eagle stamped upon the container in which candies are sold would serve as well as a rooster for purposes of identification as the product of defendant's factory. Why did the defendant select two roosters as its trademark? (Philippine Nut Industry, Inc. vs. Standard Brands, Inc., *supra* p. 583).

It must also be emphasized at this point that both trademarks are being used on the same goods under Class 25 of the Official Classification of Goods. Respondent's SEVENTH AVENUE is being used in the following goods: Men's, women's, infants, & children's wear particularly pants, blouses, t-shirts, shorts, socks, shoes, jeans, skirts, polo-shirts, dusters, handkerchiefs, panties and dresses, pajamas and nightgown; while Opposer's trademark SAKS FIFTH AVENUE covers all articles of wearing for men and boys, and for women, misses, children and infants, exclusive of boots and shoes and other items of outer footwear", under Class 25, as reflected in its Certificate of Registration No. 33015 issued on February 15, 1984 and are therefore sold in the same channel of trade. Thus, the public may be led into believing that Respondent-Applicant's product are those of Opposer's or originated from Opposer.

Section 4 of R.A. 166, as amended, provides as follows:

"There is hereby established a register of trade-marks, trade-names and service-marks which shall be known as the principal register. the owner of a trade-mark, trade-name or service-mark used to distinguish his goods, business or services from the goods, business or services from the goods, business or services of another shall have the right to register the same on the principal register, unless it:

xxx

“(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 services of the applicant, to cause confusion or mistake or to deceive purchasers;”

Therefore, to allow Respondent-Applicant's application would be contrary to the aforementioned provision as it would result in a situation where the general buying public will be confused and/or mistaken into buying or believing that the products of Respondent-Applicant originated or came from Opposer's company since the trademark being applied for by Respondent is confusingly similar to the trademark of Opposer, hence, the trademark applied for by herein Respondent must perforce be DENIED registration.

Finally, the failure of Respondent-Applicant to file his Answer to the Notice of Opposition despite being given the opportunity to do so is a clear manifestation of Respondent-Applicant's lack of interest to pursue his application and to defend his right under said application.

WHEREFORE, the Notice of Opposition filed by Opposer SAKS AND COMPANY is, as it is hereby, SUSTAINED. Accordingly, Application Serial No. 56033 filed on March 27, 1985 by Jimmy K. Siy for the registration of the trademark SEVENTH AVENUE used on men's, women's, infant's, & children's wear particularly pants, blouses, t-shirts, shorts, socks, shoes, jeans, skirts, polo-shirts, dusters, handkerchiefs, panties and dresses, pajamas and nightgown is, as it is hereby, REJECTED.

Let the filewrapper of the above-mentioned application be forwarded to the Application, Issuance and Publications Division for proper action in accordance with this Decision. Likewise, let a copy of this Decision be furnished to the Trademark Examining Division for information and to update its own record.

SO ORDERED.

IGNACIO S. SAPALO  
Director