

WARNACO, INC.,)	INTER PARTES CASE NOS. 1819 & 1820
Opposer,)	
)	OPPOSITION TO:
)	
)	Application Serial No. 37306
)	Filed : January 15, 1979
)	Applicant : Vicente Sitosta
)	Trademark : WARREN & DEVICE
)	Used on : Briefs
- versus -)	
)	- and -
)	
)	Application Serial No. 40846
)	Filed : March 7, 1980
)	Applicant : Vicente Sitosta
)	Trademark : WARREN
)	Used on : Cotton Briefs
)	
)	<u>DECISION NO. 92-1 (TM)</u>
VICENTE SITOSTA,)	
Respondent-Applicant.)	January 20, 1992
x-----x)	

DECISION

On 25 May 1984, Warnaco, Inc., a corporation duly organized and existing in the States of America, filed its Verified Notice of Opposition (Inter Partes Case No. 1819) to Application Serial No. 40846 for the trademark "WARREN" used on briefs class 25 which application was filed on 7 March, 1980 by Vicente Sitosta, a Filipino citizen doing business under the name Warren Mfg. at Paseo de Blas, Valenzuela, Metro Manila which was published in page6478, volume 79, No. 45 of the Official Gazette dated 7 November, 1983 and was officially released for circulation on 3 February, 1984.

Opposer stated as the basis for its opposition are the following:

1. The registration of the trademark "WARREN" as applied for by Respondent-Applicant, Vicente Sitosta, will violate the rights and interests of the Opposer over its registered trademark "WARNERS" covered by Certificate of Registration No. R-1972 issued on 23 October, 1978 for the goods under class 25.
2. The registration of the trademark "WARREN" as applied for by Respondent-Applicant will mislead the purchasing public and make it convenient for unscrupulous dealers to pass off the goods of Respondent-Applicant as those of the Opposer to the injury of both Opposer and the public.
3. The registration of the trademark "WARREN" in the name of the Respondent-Applicant will violate and run counter to Section 4(d) of R.A. No. 166 as amended, because its sound is so confusingly similar to the trademark "WARNERS" for the same class of goods registered in the name of Opposer under Certificate of Registration No. R-1972 and which Opposer still uses and has not abandoned.

The Respondent-Applicant in his Answer to the Notice of Opposition denied all the salient allegations upon which was predicted his claim of damage including those pertaining to likelihood of confusion. He also raised the following special/affirmative defenses:

1. That Respondent is the registered owner of the trademark "WARREN" and has used the same since 12 October, 1968 up to the present as evidenced by the following Certificates of Registration issued by the honorable Director of Patents;

- a. Registration Certificate No. 15544 issued on 28 May, 1970 (class 25);
- b. Registration Certificate No. 23479 issued on 23 June, 1978 for class 41;
- c. Registration Certificate No. 18466 issued on 14 February, 1873 for class 25;
- d. Registration Certificate No. 19760 issued on 14 August, 1973 for goods under class 25;
- e. Registration certificate No. 18949 issued on 16 May, 1973 for goods under class 25;
- f. Registration Certificate No. 25752 issued on 21 March, 1978 for men's wear class 25;
- g. Registration Certificate No. 29658 issued on 4 August, 1981 for briefs under class 25;
- h. SR – 2349 issued on 6 January, 1976 for nylon briefs, class 25 SR – 2377 issued on 4 February, 1976 for class 25;
- j. SR – 5858 issued on 15 February, 1982 for briefs, class 25.

2. That there is no confusing similarity between Opposer's "WARNERS", and Respondent's "WARREN" and consequently, if there is any party who has been considerably damaged as will be damaged, it will be the Respondent-Registrant who has been advertising his trademark "WARREN" since 1969 up to the present;

3. That the Respondent's trademark "WARREN" has gained considerable popularity and goodwill with the purchasing especially in briefs which the Respondent specializes in and the Respondent's trademark "WARREN" has been closely associated with cotton and nylon briefs, of superior quality.

The main issue to be resolved is whether or not the trademark "WARREN" is confusingly similar with the trademark "WARNERS".

The records of this case consist of the pleadings, Respondent-Applicant's Application File, and pre-trial briefs. No additional documentary or testimonial evidence was presented. Both parties agreed and submitted that the only issue to be resolved is whether or not the trademark "WARREN" or "WARNERS" is confusingly similar.

In the case before this Office the conflicting marks, namely "WARREN" of the Respondent-Applicant and "WARNERS" of the Opposer contained identical prefix WAR. The suffix of Opposer's mark is "TERS". When pronounced, likelihood of confusion between the two marks is very unlikely because it is clearly and distinctly so dissimilar in sound. The suffix of Opposer's mark "TERS" and Respondent-Applicant's "REN" do not look or sound alike, nor do they have the same connotation, therefore, it is not believed that confusion in trademarks would be likely to arise from their contemporaneous use in commerce. (see also Heilman v. A & M Records, Inc. 98 USPQ 640.)

Although a trademark should be considered in its entirety however at times the Bureau of Patents, Trademarks and Technology Transfer (BPTTT) may dissect the Trademark because

there is still a place for the argument that the dissimilar features of each mark will present any likelihood of confusion (Ex Parte Acme Industries, Inc. 109 USPQ 120).

The competing marks "WARREN" and "WARNERS" are distinct and different from each other both in SOUND, APPEARANCE and MEANING.

Similarity or dissimilarity of trademarks is not limited to the ear or eye. The mental impact of the meaning of the marks may be so pervasive as to outweigh any usual or phonetic differences. The trademark "WARREN" of the Respondent-Applicant does not convey the same meaning with "WARNERS" to the purchasing public. Dissimilarity in meaning is a factor in reaching a conclusion that the marks are not confusingly similar.

The term "WARREN" as Webster's New World Dictionary defines is an area especially of uncultivated ground for the breeding of rabbits; any building or buildings crowded like a rabbit warren.

On the other hand, the term "WARNER'S" as what the dictionary defines means one who gives a warning.

This Bureau is convinced that the differences between the subject trademarks as to their spelling, pronunciation, and meaning, are substantial and striking to the eye. Thus, the Supreme Court has ruled in *Etepha vs. Director of Patents* (SCRA 495, 501) that:

As we take up Pertussin and Atussin, we cannot escape notice of the fact that the two words do not sound alike When pronounced. There is not much phonetic similarity between the two. The Solicitor General well observe that in Pertussin the pronunciation of the prefix "PER", whether correct or incorrect, include a combination of three letters P, E, and R; whereas, in Atussin the whole word starts with the single letter A added to the suffice "tussin". Appeals to the ear are dissimilar. And this, because in a word-combination, the part that comes first is the most pronounced. xxx (Underscoring supplied.)

After a careful review of the records in the present case, this Bureau holds that no confusing similarity exists between the subject trademarks. It concludes that Respondent-Applicant's mark "WARREN" will not diminish the distinctiveness and dilute the goodwill of Opposer's trademark "WARNER'S".

WHEREFORE, the Opposition is DISMISSED; Application Serial No. 40846 is GIVEN DUE COURSE.

Let the records of this case be demanded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director