

FILCON MANUFACTURING CORP.,
Opposer,

INTER PARTES CASE NO. 4104
Opposition to:

- versus-

Serial No.85094
Date Filed 16 March 1993
Trademark: "LAKE OF THE
WOODS & DEER DEVICE"

SHIRLEY G. REYES,
Respondent-Applicant
X-----X

DECISION NO. 97-30

DECISION

On November 03, 1994, Filcon Manufacturing Corporation, a corporation duly organized and existing under the laws of the Republic of the Philippines with office address at No. 333 Juan Luna Street, Binondo, Manila, filed its verified Notice of Opposition to the application for registration of the mark "Lake of the woods and Deer Device" for shoes, sandals, and slippers, filed on March 16, 1993 under Serial No. 85094 in the name of Shirley G. Reyes, which was published for opposition in the July-August issue of the BPTTT Official Gazette.

Respondent-Applicant Shirley G. Reyes, is a Filipino citizen with residence at 1945 Jose Abad Santos Avenue, Tondo, Manila.

The grounds for the opposition are as follows:

- "1. The registration of the trademark "Lake of Woods and Deer Device" in favor of the respondent is contrary to Section 4(d) of Republic Act 166, as amended;"
- "2. Respondent-Applicant is not entitled to register the trademark 'Lake of Woods and Deer Device" in her name;"
- "3. The registration of the trademark "Lake of Woods and Deer Device" in favor of the Respondent-Applicant will cause grave and irreparable damage and injury to Opposer."

Opposer relied on the following facts to support its opposition:

- "1. Opposer is an established manufacturer, distributor and seller of wide range of goods falling under Class 25 including polo shirts, shoes, slippers, boots, t-shirts, pants, Jeans, shorts;
- "2. Opposer adopted and has been using since then the trademark "LAKEWOODS and Deer Device" for the various goods it manufactures, distributes and sells;"
- "3. The trademark which Respondent-Applicant seeks to register, namely, "Lake of the Woods and Deer Device" is confusingly similar, if not identical to Opposer's "Lakewoods and Deer Device;"
- "4. Respondent-Applicant is not entitled to register the trademark "Lake of the Woods and Deer device" in her name. Respondent-Applicant has not used in lawful commerce the trademark "Lake of the Woods and Deer Device";
- "5. Opposer has established sufficient goodwill through its long continued use of the trademark "Lakewoods and Deer Device" and sustained promotional efforts and expense to popularize said mark";

"6. Respondent-Applicant has never raised any objection or opposition to Opposer's open and continuous use of the trademark "Lakewoods and Deer Device";

"7. The registration of the trademark "Lake of the Woods and Deer Device" in favor of Respondent-Applicant will cause grave and irreparable damage or injury to Opposer;

On November 14, 1994, this Office issued a Notice to Answer, which was sent to Respondent-Applicant via registered mail No. 93-314 requiring her to answer the verified Notice of Opposition within fifteen (15) days from receipt, which notice was received by her on January 17, 1995. Respondent-Applicant however did not file any answer prompting Opposer to file a Motion to Declare Respondent-Applicant in default on February 10, 1995.

On February 16, 1995, the Bureau issued Order No. 95-123 declaring respondent in default for failure to file her answer within the reglementary period and Opposer was allowed to present its evidence ex-parte on March 23, 1995.

Subsequently, on June 19, 1995, Opposer submitted its Formal Offer of Exhibits consisting of Exh. "A" to "D" inclusive of submarkings which the Bureau admitted in Order No. 95-336 dated July 04, 1995. Thereafter, Opposer filed its Memorandum in support of its opposition on August 16, 1995.

The sole issue to be resolved in this case is whether or not the mark "Lake of the Woods and Deer Device" is confusingly similar with that of Opposer's "Lakewoods and Deer Device".

A comparison of the two marks will readily show that aside from being used under the same class (Class 25) there is apparently a confusing similarity in appearance, spelling and sound so much so that the buying public will be deceived or mistaken that the product originate from one another.

Although a cursory viewing of the mark "Lake of Woods" would reflect a slight variation in design, this does not depart from the fact that there is violation of the law more particularly Section 4(d) of Republic Act 166, as amended, to wit:

"Section 4. Registration of trade-marks, trade-names and service-marks on the principal register. - 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 distinguished his goods, business or services from the goods, business or services of others shall have the right to register the same in the principal register, unless it: x x x

(d) Consist of or comprises mark or trade-name which so resembles a mark or trade-name registered in the Philippines or mark or trade-name previously used in the Philippines and 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."

x x x

Further under Philippine jurisprudence, colorable imitation implies similarity; however, this does not mean such similitude as amount to identity. One test given is that the form, marks, contents, words or other special arrangement or general appearance of the words of the alleged infringer are such as would be likely to mislead persons in the ordinary course of purchasing the genuine articles, then the similarity is such as entitles the injured party to equitable protection.

Having determined confusing similarity between the two marks the issue boils down to which of the contending parties is entitled to adopt and use the mark "Lake of the Woods and Deer device".

The records of the case will reveal that Opposer, as appearing in its Sales Invoice No. 69901 dated November 09, 1992, (Exhibit "B") has been using the subject mark since 1992. Respondent-Applicant's trademark application show that her date of first use is on June 08, 1980.

However, Rule 173 of the Rules of Practice in Trademark Cases specifically provides, thus:

"173. Allegations in the application not evidence on behalf of the Applicant. In all inter partes proceedings, the allegation of the date of use in the application for registration of the application of the registrant cannot be used as evidence in behalf of the party making the same. In case no testimony taken as to the date of use, the party will be limited to the filing of the application as the date of first use." (Underscoring ours)

Therefore, in the instant case, the Bureau can only take cognizance of the date of filing of herein Respondent-Applicant, March 16, 1993, as the date of first use, the Respondent-Applicant not being able to adduce evidence on the date of actual use by reason of her being declared in default.

It is thus clear that Opposer has prior right to adopt and use the mark "Lake of the Woods and Deer device" for shoes, slippers, boots, and other goods such as t-shirts, pants, jeans, and shorts over the Respondent as it is ahead by more than four (4) months, i.e. November 09, 1992, compared to March 16, 1993, in using the mark.

Noteworthy to mention also is the apparent lack of interest on the part of Respondent-Applicant in controverting the evidence of the Opposer due to her failure to file an Answer to the Opposition. This amounts to an acknowledgement of the Opposer's right to use and adopt the mark "Lake of the Woods and Deer Device"

WHEREFORE, the Notice of Opposition filed by Opposer is, as it is hereby SUSTAINED. Accordingly "Lake of the Woods and Deer Device" filed by Respondent-Applicant on March 16, 1993 bearing Serial No. No. 85094, is hereby REJECTED.

Let the filewrapper of this case be forwarded to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, October 27, 1997.

EMMA C. FRANCISCO
Director