JANTZEN, INC.,
Opposer,

- versus

JANTON GARMENT MFG. CO.,
Respondent-Applicant.
x----------x

INTER PARTES CASE NO. 1312

OPPOSITION TO,

Application Serial No. 27380
Filed : April 16, 1975
Applicant : Janton Garment Mfg. Co.
Trademark : JANTON
Used on : Men`s, ladies and children`s wear

DECISION NO. 88-64 (TM)
August 3, 1988

DECISION

Jantzen, Inc., on September 19, 1979, lodged its opposition to the registration of the trademark "JANTON" for men's, ladies' and children's wear, applied by Janton Garment Mfg. Co., bearing Serial No. 27380, which was published on Page 5270, No. 26, Volume 75 of the Official gazette dated June 25, 1979, released for circulation on August 25, 1979.

Opposer is a foreign corporation organized and existing under the laws of the State of Nevada, U.S.A., doing business at Portland, Oregon, U.S.A., while Respondent-Applicant is a domestic partnership in the Philippines with business address at No. 914 Juan Luna, Binondo, Manila, Philippines.

The grounds alleged in the verified opposition filed on November 6, 1979 are:

> "1. The applicant's trademark JANTON is confusingly similar to the trademark JANTZEN owned by opposer and not abandoned, as to be likely, when applied to or used in connection with the goods of the applicant, to cause confusion or mistake or to deceive purchasers thereof.
>
> 2. That the registration of trademark JANTON in the name of Janton Garment Manufacturing Co. will cause great and irreparable injury and damage to the Opposer x x x."

In its Answer, Respondent-Applicant contends that the mark "JANTON" and "JANTZEN" are not confusingly similar; the Opposer will not be damaged by the registration of the mark "JANTON" because the trademark "JANTZEN" is not used in the Philippines; and there is a previous registration of the mark "JANTON" in the name of Respondent-Applicant but was cancelled for failure to file the requisite Affidavit of Use. The present applicantion is a re-registration of the trademark "JANTON".

Failing to arrive at a compromise settlement, the case was heard on the merits.

Opposer presented evidence that it is the holder of Certificate of Registration No. R-1495 in the Philippine for the mark "JANTZEN" issued on July 7, 1975 (Exhs. "A", "A-1" and "A-2") which is a renewal of Certificate of Registration No. 4936 issued December 16, 1945 (Exhs. "A-3-a" and "A-4-a") used on men's, women's and children's apparel, namely, swimming suits, trunks, sweaters, jerseys, scarves, garment belts, gloves, mittens, shoes, underwear, socks, trousers,

jackets, coats, vests, etc. (Exhs. “A-2-a” and “A-4-b”) and facsimiles on the mark “JANTZEN” (Exh. “A-2-a”) as compared to Respondent’s mark “JANTON” (Exh. “B”).

Respondent-Applicant, on the other hand, presented documentary evidence showing that it filed its applicantion for registration of the mark “JANTON” on April 16, 1975 (Exh. “1”) with its alleged first use of the mark on January 2, 1965 (Exh. “1-a”) for men’s, ladies’ and children’s wear; its allowance by the Trademark Examiner for publication (Exhs. “2”, “2-a”, “2-b”, “2-c” and “2-d”); the cloth label of the trademark “JANTON” (Exh. “4”); and the Notice of Publication of said mark for opposition purposes (Exh. “5”).

The issue to be resolved, therefore, is whether or not the mark “JANTON” is confusingly similar to the Opposer’s mark “JANTZEN”.

Opposer contends that “JANTZEN” and “JANTON” are confusingly similar because their first four letters and last letter are identical; their sounds are similar (idem sonans); and the goods in respect of which registration is used are identical. Opposer cited a list of marks found to be confusingly similar:

“ARROW” and “AIK-O”

“BEEP” and “VEEP”

“BELLOWS” and “FELLOWS”

“CAT TRAC” and “KATRAK”

“COCA COLA” and “CLEO COLA”

“COCA COLA” and “CUP-O-COLA”

“COLLEGIENKE” and “COL EEJUNS”

“COMSAT” and “COMSET”

“CYGON” AND “PHYGON”, etc.

(See Mc Cartney Trademarks and Unfair Competition, 1973, Vol. 2, pp. 43-44.)

-oo0oo-

“GOLD DUST” and “GOLD DROP”

“JANTZEN” and “JAS SES”

“SCLVENTOL” and “SCLVITE”, etc.

(See Nims, Unfair Competition and Trademarks, 1974, Vol.1, pp, 708-709)

In determining whether the marks “JANTZEN” and “JANTON” are confusingly similar, their meaning sound (idem sonans), and appearance must be considered. As to meaning, they gave none but both are parts of their respective corporate names. As to sound, the initial syllables “JANT” are identical, but their second/last syllables “TZEN” and “TON” sound different. As to appearance (Exhs. “A-2-a” and “2-C”), their letters “J” and small letters “t” are similar in style. It can readily be seen that Junior Party-Applicant patterned the letter “J” and small letter “t” with an elongated cross of the mark “JANTON” after that of the mark “JANTZEN” to stimulate the latter’s appearance.

On this matter, an authority on trademarks and unfair trade competition commented:

> "Lost businessmen know enough not to adopt a mark identical to that already in use in the market. But the pressures of competition may prompt a seller to get as close as he can to a well-known mark, in an attempt to share the wealth of a good reputation and goodwill built up at another's expense." (J. Thomas Mc Cartney, Trademarks and Unfair Trade Competition, Vol. 2, 1973 ed., p. 40)

In this jurisdiction, the Supreme Court declared confusingly similar, as to sound, the marks "SAPOLIN" and "LUSOLIN", thus:

> "As to the syllabication and sound to the two tradenames, "SAPOLIN" and "LUSOLIN" being used for paint, it seems plain that whoever hears or sees them cannot but think of paint of the same kind and make. In a case to determine whether the use of the trade-name 'STEELPENS BLUE BLACK INK', it was said and held that there was in fact a violation; and in other cases it was held that trade-names idem sonans constitute a violation in matter of patents and trademarks and trade-names." (Sapolin o., Inc. vs. Balmaceda, et al., 67 Phil. 705, 706, citing Nims of Unfair Competition and Trade-marks, Sec. 54, pp. 141-147; and N.K. Fairbanks Co. vs. Ogden Packing & Provision Co., 220 Fed, 1002)

In other case, in regard to similarity in appearance, the high court said:

> "No producer or manufacturer may give a monopoly of any color scheme or form of words in a label. But when a competitor adopts a distinctive or dominant mark or feature of another's trademark and with it makes use of the same color ensemble, employs similar words written in a style, type and size of lettering almost identical with these found in the other trademark, the intent to pass to the public his product as that of the other is quite obvious." (Phil. Nut Industries, Inc. vs. Standard Brands, Inc., 65 SCRA 575; underscoring supplied)

There are strong indication showing that Respondent-Applicant, in adopting the mark "JANTON", attempted "to get as close as he can" to an already existing mark "JANTZEN". Hence, confusing similarity of the two contesting marks inevitably takes place.

WHEREFORE, the herein Notice of Opposition is SUSTAINED. Accordingly, Respondent's Application Serial No. 27380 for the registration of the mark "JANTON" is REJECTED.

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

SO ORDERED.

IGNACIO S. SAPALO
Director