ROBERT S. JAWORSKI,
Opposer,

-versus-

FILKOR FOOTWEAR AND RUBBER CORPORATION,
Respondent-Applicant.
x----------x

INTER PARTES CASE NO. 3936
Opposition to:

Serial No.68251
Date Filed: June 16, 1989
Trademark: "BIG J"

DECISION NO. 97-09

DECISION

The instant case pertains to a Notice of Opposition filed by Mr. Robert S. Jaworski, of legal age, with principal office at No. 55 Annapolis Street, Greenhills, San Juan, Metro Manila to Application Serial No. 68251 for the registration of the trademark "BIG J" used for shoes and sandals filed on June 16, 1989 by Filkor Footwear and Rubber Corp., a corporation organized and existing under Philippine laws, with business address at 63 B. Serrano Street, corner 8th Avenue, Grace Park, Caloocan City.

The grounds for opposition are as follows:

"1. The approval of the application in question is contrary to Section 4(d) of Republic Act No. 166, as amended;

2. Respondent-Applicant committed fraud in filing the instant application to register the trademark "BIG J" in its favor."

Opposer relied on the following facts to support his opposition:

"1. That Opposer has been a well-known professional basketball player for eighteen (18) years and playing coach for the last ten years;

2. That as a popular basketball star, Opposer has invariably and frequently known and affectionately called as the "BIG J";

3. That on January 02, 1986, more than five years before Respondent-Applicant filed its application in question on October 22, 1991, Opposer has adopted and since then, has been using the trademark, Jaworski, Big J, Bobby J and Jawo for goods falling under Class 25.

4. That Opposer has not abandoned the use of the trademarks Jaworski, Big J, Bobby J and Jawo. On the contrary, he has intensified and continued use of said mark up to the present;

5. That the trademark Jaworski was registered in favor of Opposer on March 14, 1988 under Certificate of Registration No. 8090 for goods belonging to Class 25 including sports (athletics) shoes. A copy of Registration Certificate No. 8090 is hereto attached an Annex "A" and made an integral part hereof,

6. That in the sports shoes being made for and distributed by the Opposer, the trademarks Jaworski, Big J, Bobby J and Jawo, clearly and prominently appear;

7. That the trademark Big J being applied for registration by Respondent-Applicant is confusingly similar to the trademarks Jaworski, Big J, Bobby J and Jawo adopted and being used by Opposer, which use Opposer has not abandoned;

8. That the approval of the application in question is contrary to Section 4(d) of Republic Act No. 166, as amended;

9. That the approval of the application in question is violative of the rights of the Opposer to the exclusive use of the trademarks Jaworski, Big J, Bobby J and Jawo;

10. The Opposer has spent a substantial amount of money to popularize and promote his Jaworski, Big J, Bobby J and Jawo branded products, including shoes;

11. That because of Opposer's popularity as a basketball star and through extensive advertising and promotional campaigns and because of the high quality of his product bearing the trademarks Jaworski, Big J, Bobby J and Jawo, said marks have become distinctive of Opposer's products and have established valuable goodwill in his favor;

12. The Respondent-Applicant was not yet legally existing at the time it allegedly started using the trademark Big J on October 22, 1991;

13. That Respondent-Applicant knew that Opposer has been popularly and affectionately Known and called as the Big J whether inside or outside the basketball courts;

14. That Opposer never gave Respondent-Applicant consent to use the trademark Big J for its shoes;

15. The Respondent-Applicant is not entitled to register the Big J in its favor."

On September 29, 1993 a Notice of Opposition was sent by this Bureau and which was received on the same date by counsel for and on behalf of herein Respondent-Applicant.

On November 15, 1993, Opposer through Counsel, filed a Motion to Declare Respondent-Applicant In Default for failure to file its Answer to the verified Notice of Opposition within the reglementary period, and even up to this date.

By reason thereof on November 22, 1993, the Bureau, in Order No. 93-818; declared Respondent-Applicant IN DEFAULT for failure to file an answer to the verified Notice of Opposition. Consequently, Opposer was allowed to present his evidence ex-parte.

On June 10, 1994, Opposer submitted his formal offer of exhibits with this Bureau, on the same date, admitted in open court. Subsequently, on June 28, 1994, Opposer filed his memorandum.

The sole issue to be resolved in the instant case is whether or not Respondent-Applicant's mark "BIG J" is confusingly similar to Opposer's mark bearing the same name, which if resolved in the affirmative would constitute a violation of Section 4(d) of Republic Act No. 166, as amended.

Section 4(d) of Republic Act No. 166, as amended, reads:

> "SEC. 4. Registration of trademarks, trade names and service mark on the principal register. - There is hereby established a register of trademarks, trade names and service marks which shall be known as the principal register. The owner of a trademark, trade name or service mark used to distinguish his goods, business or services from the goods , business or services of others shall have the right to register the same on the principal register unless it:

x x x

> (d) Consists of or comprise a mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename 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 service of the applicant, to cause confusion or mistake or to deceive consumers".

The question of infringement of trademark is to be determined by the test of dominancy. The dissimilarity in size, form and color of the label and the place where applied are not conclusive. Duplication or exact imitation is not necessary nor is it necessary that the infringing label should suggest an effort to imitate. (Co Tiong Sa vs. Director of Patents, 95 Phil. 1; Operators, Inc. vs. The Director of Patents, et. al., 15 SCRA 147).

There is infringement when the use of the mark would be likely to cause confusion or mistake in the mind of the public. (Mead Johnson & Co. vs. Director of Patents, et. al., 17 SCRA 128-129; Phil. Nut Industry vs. Standard Brands, 65 SCRA 675). Thus, it is clear that the determinative factor in contest involving the registration of trademark is not whether the challenge mark would actually cause confusion or deception to the purchasers but whether the use of such mark would likely cause confusion or mistake on the part of the buying public. In short, to constitute an infringement of an existing trademark and warrant a denial of an application for registration, the law does not require that the competing trademarks must be identical as to produce actual error or mistake; it would be sufficient for purpose of the law, that the similarity between the two labels is such that there is possibility or likelihood of the purchaser of the other brand mistaking, the newer brand for it. (Acoje Mining vs. Director of Patents, 38 SCRA 480)

In the instant case, the dominant feature of the Opposer's and Respondent-Applicant's marks is the word "BIG J". Of course, everybody knows that the word "BIG J" is synonymous to Mr. Robert S. Jaworski, a very popular sports figure, as he has been known for years by such connotation.

As the evidence shows, Opposer Robert S. Jaworski, not only ventured to become a professional basketball player and coach of a professional basketball team but also expanded his craft in business specially in the field of manufacturer of sportshirts, socks, shoes bearing such marks like "Big, J", "Jaworski", Robert Jaworski (Exhibit "E").

Moreover, the mark "Big J" was first used by Opposer for his sport line since January 02, 1986 and has been extensively used in commerce in the Philippines (see Exhibit "A", "D", "D-1", "D-2". & "E"). Further, the same mark was registered by Opposer on March 14, 1988 under Certificate No. 8090 (Exhibit "A" & "E").

On the other hand, Respondent-Applicant's mark "Big J", as shown by its trademark application, was first used in the Philippines only on January 06, 1988. This clearly indicates that the Opposer has been adopting and using the mark two years ahead of Respondent-Applicant. Compounding to Respondent's woes is that its trademark "Big J" for shoes and sandals fall under Class 25, which is of the same class for which the Opposer's mark is categorized.

WHEREFORE, the Notice of Opposition is, as it is hereby, SUSTAINED. Accordingly, Application Serial No. 68251 filed by Filkor Footwear Rubber Corp. on June 16, 1989 for the trademark "*BIG J*" is hereby REJECTED.

Let the filewrapper of those cases be forwarded to Application Issuance and Publication Division for appropriate action in accordance with this Decision. Likewise, a copy of this Decision be furnished the Trademark Examining Division to update its records.

SO ORDERED.

City of Makati, December 23, 1997.

EMMA C. FRANCISCO
Director