

MARIA GENE L. TAN  
Opposer,  
- versus -

IPC 14-2006-00163

GREYHOUND COMPANY LTD.,  
Respondent-Applicant.

Opposition to:  
TM Application No. 4-2004-004344

TM: "PLAYHOUND"

x-----x

Decision No. 2007 – 84

## DECISION

For decision is this Notice of Opposition filed by Maria Gene L. Tan, opposer, resident of No. 218 Mayo Street, Quezon City, against Application Serial No. 4-2004-004344 for the registration of the trade name PLAYHOUND used for retailing and wholesaling management services for clothing products: all included in class 35, by Greyhound Company limited with address at 27/1 Soi Sukhumvit 53, Sukhumvit Road. Klongtonnua, Vadhana, Bangkok 10110 Thailand.

The grounds for the opposition are as follows:

1. Respondent-applicant is not legally authorized to engage in the Philippines in the business /services sector which it is seeking to register the tradename PLAYHOUND;
2. The application in question does not comply with the requirements set fourth in IP Code and the Rules and Regulations on Trademark etc. and its examination and approval for publication was done hastily and haphazardly;
3. The approval of the application in question is contrary to Section 123.1 (d) of Republic Act No. 8293, as the tradename nearly resembles, and/or is confusingly similar to, the trademark GREYHOUND AND REPRESENTATION OF GREYHOUND which is duly registered in favor of Opposer under Registration No. 4-2000-010234;
4. Application Serial No. 4-2004-004344 was filed in bad faith and its approval has caused and will continue to cause great and irreparable damage and injury to herein Opposer."

A Notice to Answer was sent on 27 April 2006 but no Answer was filed. In compliance with the Office Order no. 79, Series of 2005, submitted the following evidence in support of its opposition:

- "A"- "A-1" to "A-17" Certified copies of the entire records of Application Serial No. 4 -2004-004344 for the registration of the tradename "PLAYHOUND" filed by Respondent-applicant.
- "B" Computer printout of the E-Gazette giving the details of Respondent-Applicant's Application Serial No. 4-2004-004344 released on July 17, 2006;
- "C" Certification duly issued by the Director of the Project Evaluation and Registration Department of the Board Investment, Department of the Trade and Industry dated October 12, 2006;
- "D" Certified copy of Certificate of Registration No. 4-2000-010234 for the trademark "GREYHOUND AND REPRESENTATION OF GREYHOUND" issued in favor of Opposer;

- “E” Copy of Opposer’s Answer to Petition for Cancellation of Registration No. 4-2004-10234 filed by Suyen Corporation (Inter Partes Case No. 14-2004-00073)
- “F” Certified copies of Opposer’s Exhibit “1” to”7-c” submitted in Inter Partes Case No. 14-2004-00073;
- “G” Duly notarized affidavit of Maria Gene L. Tan

The main issue of concern is whether the tradename is registrable under the provisions of the IP Code, particularly, whether the application is contrary to Section 123.1 (D), republic act 8293?

The pertinent provision of law provides:

“Section 123.1. Registrability. 123.1 A mark cannot be registered if it:

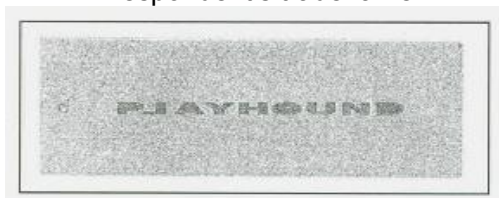
(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or
- (ii) Closely related goods or services, or
- (iii) If I nearly resemble such a mark as to be likely or to deceive or cause confusion”

Turning to the names adopted by the parties, “it must be emphasized that in the trademark cases in the Philippines, particularly in ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, no set of rules can be deduced. Each case must be decided on its own merits. (Emerald Garment Manufacturing Corporation v. Court of Appeals, 251 SCRA 600) in *Esso Standard, Inc. v. Court of Appeals* (116 SCRA 336), we ruled that the likelihood of confusion is a relative concept; to be determined only according to the particular, and sometimes peculiar, circumstances of each case.

With that in mind, the marks of the contending parties are reproduced hereunder for comparison:

Respondent’s tradename



Opposer’s registered trademark



Jurisprudence has developed two tests in determining the issue of confusing similarity. Notably, the Supreme Court in *McDonald’s Corporation v. L.C. Big Mak Burger, Inc.*, G.R. No. 143993, dated 18 August 2004 declared that the test of dominancy has now been incorporated in the law. The Court held:

In determining likelihood of confusion, jurisprudence has developed two tests, the dominancy test and the holistic test. The dominancy test focuses on the similarity of prevalent features of competing trademarks that might cause confusion. In contrast, the holistic test requires the court to consider the entirety of the marks as applied to the products, including the labels and packaging, in determining confusing similarity. xxx

The test of dominancy is now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code which defines infringement as the “colorable imitation of a registered mark xxx or a dominant feature thereof.”

Applying the dominancy test, the Court finds that the respondents use of the “Big Mak” mark results in likelihood of confusion. First “Big Mak” sounds exactly the same as “Big Mac”. Third, the first two letters in “Mak” are the same as the first two letters in “Mac”. Fourth, the last letter in “Mak” while a “K” sounds the same as “c” in spelling, and thus “Caloocan” is spelled Kaloocon”. (Underscoring supplied)

The Supreme Court, had relied on the dominancy test in its earlier decisions. In *America Wire & Cable Co. vs. Director of Patents*, 31 SCRA 544, it held:

“The question is, when is a trademark likely to confuse or to cause the public to mistake one for another. Earlier ruling of the Court seem to indicate its reliance on the dominancy test or the assessment of the essential or dominant feature in the competing labels to determine whether they are confusingly similar.

xxx

Along the same line are the ruling denying registration of a mark containing the picture of a fish (Bangus), as label for soy sauce, for being similar to another registered brand of soy sauce that bears the picture of the fish carp; or that of the mark bearing the picture of two roosters with the words “Bantam”, as label for foods seasoning (vetsin), which would confuse the purchasers of the same article bearing the registered mark “Hen Brand” that features the picture of a hen.

The present case is governed by the principles laid down in the preceding cases. The similarity between the competing marks, DURAFLEX and DYNAFLEX, is apparent. Not only are the initial letters and the last haft of the appellations identical, but the difference exist only in two out of the eight literal elements of the designations. Coupled with the fact that both marks covered insulated flexible wires under class 20; that both products are contained in boxes of the same materials, color, shape and size; xxx”

Applying the foregoing precepts in the appreciation of these two marks, this Bureau assessed that the identical suffix HOUND when used in conjunction another one syllable word “PLAY” ending in the letter “Y”, sounds confusingly similar with the word GREYHOUND. It is also noted that although the first words of the names GREYHOUND and PLAYHOUND (spelled with an inverted L), namely “GREY” and “PLAY” are not the same, both words end in the letter “Y” the vowels “E” and “A” are phonetically the same when the words “GREY” and “PLAY” are pronounced. Moreover, both marks are presented in the same style or letter or font. In the instant case, the registered mark of opposer is applied to goods under class 25, namely; (Exhibit “D”) T-shirt, polo, polo shirts, jeans, pants, slacks, socks, belts, caps, shorts, blouses, jackets, sweatshirts, skirts, sandos, briefs, panties, stockings, coats, neckties, jogging suits, suspenders, shoes, slippers, sandals, boots. On the other hand, Opposer intends to use the confusingly similar trade name PLAYHOUND on retailing and management services although under class 35 nevertheless such services are to be used for “clothing” which compounds the likelihood of confusion. Without delving into the propriety of respondent’s engagement in the business of retailing and management services without the Board of Investment’s (BOI) registration as evidence by a certification from the BOI. (Exhibit “C”), respondent’s use of the tradename being applied for is our view prescribed given the confluence of law and jurisprudence on the matter.

The Court in *Marvex commercial Co., Inc. vs. Petra Hawpia & Co.* (18 SCRA 1178), cited several similar sounds in the area of trademark, it held:

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, *Unfair Competition and Trade Marks*, 1997. vol.1, will reinforce our view that

“SALONPAS” and “LIONPAS” are confusingly similar in sound: “Gold Dust” and “Gold Drop”, Jantzen and “Jazz Sea”; “Silver-splash” and “Supper-flash”; “Cascarete” and “Celborite”; “Celluloid” and “Cellonite”; and “Charseurs”; “Cutes” and “Cuticlean”; “Hebe” and “Meje”; “Kotex” and “Femetex”; “Zuso” and “Hoo-hoo” Leon amdur in his book “Trademark law and Practice”, pp. 419-421, cites as coming within the purview of the idem sonans rule. “Yusce” and “U-C-A”, “Steinway Pianos” and “Stienberg Pianos” and “Seven-Up” and Lemon-Up”. In *Co Tiong vs. Director of Patents*, this Court unequivocally said that “Celdura” and “Condura” are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name “Lusolin” is an infringement of the trademark “Sapolin” as the sound of the two names almost the same. In the case at bar, “SALONPAS” and “LIONPAS” when spoken sound very much alike. Similarity of sound is sufficient ground for this court to rule that the two are confusingly similar when applied to merchandise of the name descriptive properties. (See *Celanese Corporation of America vs. E.L. Du Pont*, 154 F. 2d 146, 148)

Finally, we note that the in *McDonald’s Corporation vs. Macjoy Fastfood Corporation*, G.R. No. 166115, dated February 2, 2007, the Supreme Court citing jurisprudence held:

“Moreover, in *Societe Des Produits Nestle, S.A. v. CA* the court, applying the dominance test, concluded that the use of by the respondent therein of the word “MASTER” for its coffee product “FLAVOR MASTER” was likely to cause confusion with therein petitioner’s coffee products “MASTER ROAST” and “MASTER BLEND” and further ruled:

xxx, the totality or the holistic test is contrary to the elementary postulate of the law on trademark and unfair competition that confusing similarity is to be determined on the basis of visual, aural or connotative comparisons of overall impressions engendered by the marks in controversy as they are encountered in the market place. The totality or holistic test only relies on the visual comparison between two trade makers whereas the dominance test relies not only on the visual but also on the aural and connotative comparisons and overall impressions between the two trademarks.

Applying the dominance test to the instant case, the Court Finds that herein petitioner’s “MCDONALD’S” and respondent’s “MACJOY” marks are confusingly similar with each other such that an ordinary purchaser can conclude an association or relation between the marks.

In the instant opposition, Opposer has already established ownership of the mark GREYHOUND in the Philippines. It has submitted proof of its commercial use of the mark GREYHOUND by various sales receipts ( Exhibit “F”). These evidence of use by opposer of the mark GREYHOUND on goods under Class 25 proves its better right to the mark that deserves protection from the use by others of confusingly similar names.

WHEREFORE, premises considered the instant Opposition is hereby SUSTAINED and Application Serial No. 4-2004-004344 for the registration of the tradename PLAYHOUND used for retailing and wholesaling management services for Clothing Products; all included in class 35, filed by Greyhound Company Limited with address 271 Soi Sukhumvit 53, sukhumvit road, klongtonnua, vadhana, Bangkok 10110 Thailand is hereby REJECTED.

Let the filewrapper of this case and a copy of this Decision be furnished to the Bureau of Trademark for appropriate action.

SO ORDERED

Makati City, 26 June 2007

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs  
Intellectual Property Office