

TANNING RESEARCH LABORATORIES,  
Opposer,

INTER PARTES CASE NO. 4041 & 4143

Opposition to:

Serial. No.: 82401  
Filed: September 7, 1992  
Trademark: "HAWAIIAN TROPIC"

-versus-

and

Serial No.: 81997  
Filed: August 13, 1992  
Trademark: "HAWAIIAN TROPIC"

CYMAR INTERNATIONAL INC.,  
Respondent-Applicant.

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DECISION NO. 97-15

### DECISION

This is an Opposition filed by Tanning Research Laboratory Inc., a corporation duly organized under the laws of Florida, U.S.A. with office at RFD # 1 U.S. Highway # 1, North Toroka Estates, Osmond Beach, Florida 32074, U.S.A. against Application Serial No. 82401 for the trademark HAWAIIAN TROPIC for t-shirts, short, polo, polo shirt, sando, jacket, dresses, pants, jeans, brief, blouses, short, tank tops, swimsuit, beach robe, swimming trunk, swimming short, brassiere, lady panties, cap towel, handkerchiefs and Application Serial No. 81997 for the trademark HAWAIIAN TROPIC used on footwear garments, leather goods (bag belt, wallet) beach accessories and others (promotional items such as key chain, car wind shield, paper weight, bracelet) docketed as IPC Nos. 4041 & 4133, respectively.

In view of the similarity of issues and parties and considering that these two cases involve the same trademark and common question of law, these cases were consolidated by Order No. 96-58, dated January 24, 1996. In consequence thereof, the evidence in IPC No. 4041 were considered in IPC No. 4133.

The Opposer submitted separate Notices of Opposition to the aforementioned Application alleging as common grounds the following:

"1. Opposer is the first user and registered owner of the registered trademark HAWAIIAN TROPIC for sunscreens, tanning oils and lotions and windscreens, Opposer's HAWAIIAN TROPIC trademark is known trademark for cosmetic preparations including sunscreens, tanning oils, lotions and windscreens. Opposer's trademark HAWAIIAN TROPIC has been used not only on goods sold to the general public but also in advertising and Opposer's other extensive promotional activities. Applicant's alleged used of Opposers HAWAIIAN TROPIC trademark for goods in Classes 6, 18, 22, 24, 25 & 28 so resembles Opposer's trademark HAWAIIAN TROPIC, as to be likely, when applied to or used in connection with the goods of Applicant, to cause confusion, mistake and deception on the part of the purchasing public by misleading them into thinking that Applicant's goods either come from Opposer or are sponsored or licensed by it.

"2. The registration of the trademark HAWAIIAN TROPIC in the name of the Applicant will violate Section 37 of Republic Act No. 166, as amended and Sec. 6bis and other provision of the Paris Convention for the Protection of Industrial Property to which the Philippines and the United States of America are parties.

"3. The registration and use by Applicant of the trademark HAWAIIAN TROPIC will diminish the distinctiveness and dilute the goodwill of Opposer's trademark HAWAIIAN TROPIC.

"4. Applicant adopted Opposer's self-promoting trademark HAWAIIAN TROPIC on its own goods with the obvious intention of misleading the public into believing that its goods bearing the trademark originate, from or are licensed or sponsored by Opposer, which has been identified in the trade and by consumers as the source of goods bearing the trademark HAWAIIAN TROPIC.

"5. The approval of the Applicant's trademark HAWAIIAN TROPIC is based on the fraudulent misrepresentation that it is the originator, true owner and first user of the trademark which was merely copied from Opposer's HAWAIIAN TROPIC.

"6. Applicant has not lawfully used the trademark in commerce in the Philippines for the required period prior to the filing of the application or has abandoned such use after the filing of the application.

"7. Applicant's appropriation and use of the trademark HAWAIIAN TROPIC infringe upon Opposer's exclusive right to use the trademark HAWAIIAN TROPIC, which is protected under Section 37 of the trademark law.

"8. The registration of the trademark HAWAIIAN TROPIC in the name of the Applicant is contrary to other provisions of the trademark law."

The Opposer relied on the following facts to support its Notice of Opposition-

"1. Opposer has adopted and used the trademark HAWAIIAN TROPIC for cosmetic preparations, including sunscreen, tanning oil and lotions and wind screens. Opposer has expanded the use of HAWAIIAN TROPIC trademark to many other kinds of products, including clothing, footwear, sunglasses, other health and beauty aids such as hair care preparations and skin moisturizers and sail boarding equipment. Opposer has been commercially using the trademark HAWAIIAN TROPIC prior to the appropriation and use of the trademark HAWAIIAN TROPIC by Applicant.

"2. Opposer is the owner of the trademark HAWAIIAN TROPIC which has been registered in its name with the Bureau of Patents Trademarks and Technology Transfer under Registration No. 32955 dated January 16, 1984 for cosmetic preparations, including sunscreens, tanning oils and lotions and wind screens. Opposer has also used and registered or applied for the registration of the trademark HAWAIIAN TROPIC in many countries worldwide.

"3. Opposer's trademark HAWAIIAN TROPIC is an arbitrary trademark as applied to the goods relevant to this action and accordingly, is entitled to broad legal protection against unauthorized users such as Applicant who is attempting to appropriate it for its own goods.

"4. Opposer is the first user of the trademark HAWAIIAN TROPIC for the above-mentioned goods. Applicant has appropriated Opposer's trademark HAWAIIAN TROPIC for the obvious purpose of capitalizing upon the renown of Opposer's self-promoting trademark by misleading the public into believing that its goods originate from or are licensed or sponsored by Opposer.

"5. Applicant has fraudulently misrepresented that it is the originator and first user of the trademark HAWAIIAN TROPIC or that it has lawfully used the trademark in commerce in the Philippines for the required period before the filing of the application.

"6. Applicant's alleged use of the trademark HAWAIIAN TROPIC, which is an exact copy of Opposer's registered/protected trademark is not lawful use of the trademark in commerce and cannot be the basis for the trademark pre-emption.

"7. The registration and use of an identical trademark by the Applicant will tend to deceive and or confuse purchasers into believing that Applicant's products emanate from or under the sponsorship of Opposer. Applicant obviously intends to trade and is trading on Opposer's goodwill.

"8. The registration and use of an identical trademark by Applicant will diminish the distinctiveness and dilute the goodwill of Opposer's trademark."

Respondent was sent a Notice to Answer the Verified Opposition in IPC No. 4041 and 4133 respectively. However despite receipt of both notices, Respondent failed to answer or file any responsive pleading relating thereto. Thus, this Office declared Respondent in default, as per Order Nos. 94-904 and 95-559.

The sole issue to be resolved in the instant case is whether or not the registration of the mark "HAWAIIAN TROPIC" will violate Section 4(d), and 37 of Republic Act No. 166, as amended, and Article 6bis and other provisions of the Paris Convention for the Protection of Industrial Property.

Section 4 (d) and 37 of Republic Act No. 166, as amended, read as follows;

"Sec. 4. Registration of trademarks, tradenames and service-marks on the principal register. - There is hereby established a register of trademarks, tradenames and service-marks which shall be known as the principal register. The owner of a trademark, tradenames and service marks used to distinguish his goods, business or services of other shall have the right to register the same, on the principal register, unless it.

xxx

(d) Consists of or comprises a mark or tradenames 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 services of the applicant, to cause confusion or mistake or to deceive purchasers.

"Sec. 37. - Rights of foreign registrant - Persons who are nationals of, domiciled in, or have a bonafide or effective business or commercial establishment in any foreign country which is a party to any foreign country, which is a party to any international convention or treaty relating to marks or tradenames or the repression or unfair competition to which the Philippines may be a party, shall be entitled to the benefits and subject to the provisions of this Act to the extent and under conditions essential to give effect to any such convention and treaties so long as the Philippines, shall continue to be a party thereto, except as provided in the following paragraphs of this section.

No registration of a mark or tradename in the Philippines by a person described in the preceding paragraph of this section shall be granted until such mark or tradename has been registered in the country of origin of the applicant, unless the applicant alleges use in commerce."

In the case at bar, it is indubitably clear that there is not only similarity in spelling and pronunciation of Opposer's and Respondent's mark "HAWAIIAN TROPIC" but there is also actual confusion among the purchasing public as to which source such product originate in the event that both marks are allowed to be sold and distributed to the public.

In Mead Johnson & Co. vs. N.V. Van Dorf, Ltd. (7SCRA 286) and Mead Johnson & Co. vs. Director of Patents, et. al, (17 SCRA 128-129), the Supreme Court, held, thus;

“In determining whether two trademarks are confusingly similar, the test is not simply to take their words and compare the spelling and pronunciation of said words. Rather it is consider to the two marks in their entirety, as they appear in the respective labels, in relation to the goods which they are attached” x x x

As borne out by evidence, Opposer has been using the mark "HAWAIIAN TROPIC" since June 20, 1969 (Exhibit "C-1") and that the same had been registered in U.S.A. under Registration No. 994840 on October 01, 1974, Opposer's mark "HAWAIIAN TROPIC" was also proven to be a well-known trademark having been registered in eighty (80) countries worldwide (Exhibits "D-1" to "D-20"). The trademark is widely popular especially among sun bathers during summer seasons because the product is being applied as sun screens, tanning oils, and lotions, and wind screens.

In the Philippines, Opposer's "HAWAIIAN TROPIC" was issued Certificate of Registration No 32955 as early as January 31, 1978 by the Philippine Patent Office. Furthermore, as shown by evidence, Exhibits "E" and Opposer's mark was first used in the Philippines on January 5, 1990.

In contrast, Respondent-applicant filed its application bearing Serial No. 82401 for the mark HAWAIIAN TROPIC only on September 7, 1992 for t-shirts, polo, polo shirt, sando, jacket, dresses, pants, jeans, briefs, blouses, shorts , tank tops, swimsuits, beach robe, swimming trunk, swimming short, brassiere, lady panties, cap, towel and handkerchiefs and another application bearing Serial No. 81997 for the same mark only on August 13, 1992 for footwear, garments, leather goods, belts, wallets, bags, accessories and other promotional items.

At this point, it is noted that Respondent did not seek exhaustive remedies to contradict Opposer's contention. In fact it did not even bother to answer the Verified Notice of Opposition filed by herein Opposer. Thus, this is interpreted as an acknowledgment Opposer's allegations and an affirmation of Opposer's exclusive right to adopt and use the mark "HAWAIIAN TROPIC" worldwide.

WHEREFORE, both Notices are as they are hereby, SUSTAINED. Accordingly, Application Serial Nos. 82401 and 81997 filed on September 07, 1992 and August 01, 1992 respectively, by Respondent-Applicant for the registration of the trademark "HAWAIIAN TROPIC" are REJECTED.

Let the filewrappers of the subject trademark be sent to the Application, Issuance and Publication Division for appropriate action with this Decision with a copy thereof furnished the Trademark Examining Division for information and to update its record.

SO ORDERED.

Makati City, October 25, 1997.

EMMA C. FRANCISCO  
Director