95 Phil. 1

[G.R. No. L-5378. May 24, 1954]

IN RE PETITION FOR REGISTRATION OF TRADEMARK "FREEDOM" UNDER SECTION 4 OF REPUBLIC ACT NO. 166 FILED IN THE PHILIPPINE PATENT OFFICE BEARING SERIAL NO. 38. CO TIONG SA, APPLICANT PETITIONER, VS. DIRECTOR OF PATENTS, RESPONDENT, SAW WOO CHIONG & CO., OPPOSITOR.

D E C I S I O N

LABRADOR, J.:

This is an appeal filed by Co Tiong Sa, applicant for registration of the trademark "FREEDOM" and its corresponding design, against a decision of the Director of Patents sustaining the opposition thereto of Saw Woo Chiong & Co., and denying the application. The applicant in said registration proceeding, now petitioner in this Court, has used the trademark on undershirts and T-shirt since March, 1947. The trademark sought to be registered is "FREEDOM". The word "FREEDOM" is in hand print, with a slight slant to the right. In the facsimiles attached to the original application, there are no letters, lines, or figures around the word, but in the label, Exhibit D-1, the said word is preceded by a triangle, with the letter "F" inside and small letters "H.L." under. A capital letter "L" is on the lower right-hand corner; and all of these are enclosed in a rectangle of double lines. In Exhibit D-2, the label is the same word "FREEDOM" with a capital letter "M" above it, a flourish under the word "FREEDOM", and the words "HIGH QUALITY " thereunder. The label used for boxes is similar to label Exhibit D-1, except that the rectangle is in a heavy line and is longer.

The label presented by Saw Woo Chiong & Co., oppositor-respondent herein (Exhibit D-3), consist of the word "FREEMAN" in hand print, with a right slant, above the middle of which is a vignette of a man wearing a tophat, which vignette is preceded by

the small word “The” in print and followed by two parallel lines close to each other, and the words “PERFECT WEAR ” in smaller letters under the word “FREEMAN”. This trademark was registered in 1947 in the Bureau of Commerce and re-registered in the Patent Office on September 22, 1948. This trademark is used not only on shirts, but also on polo shirts, undershirts, pajamas, skippers, and T-shirts, although in the year 1947 Saw Woo Chiong & Co. discontinued manufacturing skippers and T-shirts on the ground of scarcity of materials. This trademark has been used since 1938, and it had been advertised extensively in newspapers, magazines, etc.

The applicant-petitioner claims that in sustaining the objection of the oppositor-respondent, the Director of Patents erred: (1) in holding that in determining an opposition in the registration of trademarks, attention should be centered upon the central idea of each trademark, disregarding their differences in details; (2) in holding that if the central idea of each trademark gives the same general impression, the two trademarks should be adjudged as confusingly similar; (3) in holding that the word “FREEDOM” and “FREEMAN” convey the same general impression, hence must be adjudged to be confusingly similar; (4) in holding that if the word “FREEDOM” is allowed to be registered as trademark, although no confusion and deception will actually take place, the oppositor will nevertheless be damaged; and (5) in holding that the oppositor is not required to introduce testimony to substantiate the claim made in its opposition.

The first four assignments of error are related to each other and may be considered together. There is no question that if the details of the two trademarks are to be considered, many differences would be noted that would enable a careful and scrutinizing eye to distinguish one trademark from the other. Thus, we have the vignette of a man wearing a tophat, which would distinguish the oppositor’s label from the triangle with the letter “F” on the right hand corner of applicant’s label. Then we also have the rectangle enclosing the applicant’s mark, which rectangle is absent in that of the oppositor’s. But differences of variations in the details of one trademark and of another are not the legally accepted tests of similarity in trademarks.

It has been consistently held that the question of infringement of a trademark is to be determined by the test of dominancy. Similarity in size, form, and color, While relevant, is not conclusive. If the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place. Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate. (G. Heilman Brewing Co. vs. Independent Brewing Co., 191 F., 489, 495, citing Eagle White Lead Co. vs. Pflugh (CC) 180 Fed. 579.) The question at issue in cases of infringement of trademarks is whether the use of the marks involved would be likely to *cause confusion or mistake in the mind of the public or to deceive purchasers.*
(Auburn Rubber Corporation *vs.* Honover Rubber Co., 107 F. 2d, 588, citing Procter and Gamble Co. vs. J. L. Prescott Co., 49 F. 2d, 959, 18 CCPA, Patent, 1433; Pepsodent Co. vs. Comfort Manufacturing Co., 83 F. 2d, 906, 23 CCPA, Patents, 1224.)

When would a trademark cause confusion in the mind of the public or in those unwary customers or purchasers? It must be remembered that infringement of a trademark is a form of unfair competition (Clarke vs. Manila Candy Co., 36 Phil, 100), and unfair competition is always a question of fact. The universal test has been said to be whether the public is likely to be deceived. (Alhambra Cigar & Cigarette Co. vs. Mojica, 27 Phil., 266.)

When a person sees an object, a central or dominant idea or picture thereof is formed in his mind. This dominant picture or idea is retained in the mind, and the decorations or details are forgotten. When one sees the city hall of Baguio, the dominant characteristics which are likely to be retained in the mind are the portico in the middle of the building, the tower thereon, the four columns supporting it, and the wings on both sides. The features that are retained are the peculiar, dominant features. When one sees the Legislative Building in Manila, the picture that is retained is that of a majestic low building with concrete columns all around. In this mind-picture the slight or minor decorations are lost sight of, and the central figure only is retained. So is it with a customer or purchaser who sees a label. He

retains in his mind the dominant characteristics or features or central idea in the label, and does not retain or forgets the attendant decorations, flourishes, or variations. The ordinary customer does not scrutinize the details of the label; he forgets or overlooks these, but retains a general impression, or a central figure, or a dominant characteristic. The reason for the above has been explained in the following manner:

> * * * This rule has a basis in experience. The average person usually will not, and often can not, take in at a casual glance all, or even a large part of the details of what he looks at. What part or parts of two trademarks which are alleged to be similar does the average ordinary buyer see when he looks at them? What features of them are remembered by the average buyer? We do not really hear all that is spoken in our hearing. Far from all we see or hear casually is retained sufficiently clearly or insufficient detail for us to get a lasting impression of it which we can remember when we encounter the mark again. The importance of this rule is emphasized by the increase of radio advertising in which we are deprived of the help of our eyes and must depend entirely on the ear.
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> The average buyer usually seeks a sign, some special, easily remembered earmarks: of the brand he has in mind. It may be the color, sound, design, or a peculiar shape or name. Once his eyes see that or his ear hears it, he is satisfied. An unfair competitor need not copy the entire mark to accomplish his fraudulent purpose. It is enough if he takes the one feature which the average buyer is likely to remember. (Nims, The Law of Unfair Competition and Trademarks, 4th ed., Vol. 2, pp. 678-679).
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> The question of infringement 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. If the competing label contains the trademark of another, and confusion or deception is likely to result, infringement takes place, regardless of the fact that the accessories

> are dissimilar. Duplication or exact imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate. (G. Heilman Brewing Co. vs. Independent Brewing Co., 191 F., 489, citing Eagle Co. vs. Pflugh (C.C.) 180 F., 579.)
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> In order to constitute infringement, it is not necessary that the trademark be literally copied. * * *. Neither is it necessary that every word be appropriated. There may be infringement where the substantial and distinctive part of the trademark is copied or imitated * * *. Dissimilarity in size, form and color of the label and place where it is applied are not conclusive against infringement. * * *. The resemblances may so far dominate the differences as to be likely to deceive ordinary purchasers. (Queen Mfg. Co. vs. Isaac Ginsberg Bros. Co., 25 F 2d, 284, 287. See also Finchley, Inc. vs. George Hess Co., Inc., et al, 24 F., Supp. 94.)

Upon examination of the trademark of the oppositor-respondent, one will readily see that the dominant feature is the word "FREEMAN" *written* in a peculiar print, slightly slanting to the right, with a peculiarly written capital letters "*FF*" These dominant features or characteristics of oppositor's trademarks are reproduced or imitated in applicant's trademark. In the first place, the word "FREEDOM" conveys a similar idea as the word "FREEMAN". In the second place, the style in which both capital "F" are written are similar. The print and slant of the letters are also similar. An ordinary purchaser or an unsuspecting customer who has seen the oppositor's label sometime before will not recognize the difference between that label and applicant's label. He may notice some variations, but he will ignore these, believing that they are variations of the same trademark to distinguish one kind or quality of goods from another.

For purposes of illustration, the following words have been held to have the same significance or to have the same appearance and meaning.

> "CELDURA" and "COBDURA".—That both marks considered

> as a whole are similar in meaning and appearance can not be doubted. When spoken as written they sound very much alike. Similarity of sound alone, under such circumstances, is sufficient to cause the marks to be regarded as confusingly similar when applied to merchandise of the same descriptive properties. (Celanes Corporation of America vs. E. I. Du Pont de Nemours & Co. (1946), 154 F. 2d 146 148.)
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> "SKOAL" and "SKOL", "SKOAL" was held identical in sound and meaning to "Skol". (Skol Co., Inc., vs. Olson, 151 F. 2d, 200.)

In this jurisdiction we have held that the name "Lusolin" is an infringement of the trademark "Sapolin," as the sound of the two names is almost the same, and the labels of containers being almost the same in respect to color, size, and other characteristics. (Sapolin Co, vs. Balmeceda and Germann & Co., 67 Phil., 705.)

In the case of La Insular vs. Jao Oge, 47 Phil., 75, plaintiff's label represented an European female, while defendant's was a Filipino, but both labels exhibited a matron seated on a platform with a view of Manila Bay looking towards Mariveles at sunset. In spite of the fact that the posture and coloring were slightly different, defendant's labels were declared to constitute an infringement of plaintiff's labels.

After a careful study, we find that the dominant characteristic of oppositor's trademark "FREEMAN" has been imitated in applicants's trademark "Freedom," such as to confuse the public and unwary customers and purchasers, and to deceive them into believing that the articles bearing one label are similar or produced by the same manufacturer as those carrying the other label. The decision of the Director of Patents sustaining the opposition and denying the application must, therefore, be affirmed.

With respect to the fifth assignment of error (first in petitioner's brief), it must be remembered that the question of similarity or dissimilarity, while it is a question of opinion, is to be determined by the court mainly on the basis of the facsimiles or labels or

pictures submitted to the Director of Patents. In the case at bar, innumerable exhibits were presented to show the similarity. Similarity or dissimilarity can be determined by the Director of Patents, or by this Court on appeal, by a mere examination and comparison of the competing trademarks. Failure on the part of the oppositor to submit the testimony of witnesses, who are to give opinions on the alleged similarity or dissimilarity, can not, therefore, be a ground for a dismissal of an opposition. We hold that the Director of Patents did not err in denying the motion for dismissal presented by the applicant upon the failure of the oppositor to submit witnesses to sustain his opposition.

Finding no error in the decision appealed from, the same is hereby affirmed, with costs against the applicant-petitioner Co Tiong Sa.

Paras, C. J., Pablo, Bengzon, Montemayor, Reyes, A.,Jugo, Bautista Angelo, and *Concepcion, JJ.,* concur.

Date created: October 08, 2014