

Title:

Amigo Manufacturing, Inc. vs. Cluett Peabody Co., Inc., G.R. No. 138506, 406 Phil. 905 (1999)

Facts:

- Cluett Peabody Co., Inc. (respondent), a New York corporation, claimed exclusive ownership of several trademarks, including "GOLD TOE," used on men's socks.
- Amigo Manufacturing Inc. (petitioner), a Philippine corporation, used the trademark "GOLD TOP."
- Cluett filed a case for the cancellation of Amigo's trademark, asserting confusion with its own trademarks.
- The trademarks under contention included "GOLD TOE" and a device representation of a sock with a magnifying glass.
- Petitioner argued its actual use of "GOLD TOP and Device" began in September 1956, while respondent started using "GOLD TOE" on May 15, 1962.
- The Bureau of Patents, involving multiple hearing officers, initially ruled in favor of Cluett, citing confusing similarities between the trademarks.
- The CA reversed the Bureau's ruling on September 29, 1998, but on January 14, 1999, upon reconsideration, reverted to affirming the Director of Patents' decision.
- Amigo's subsequent motion for reconsideration was denied by the CA.

Issues:

1. **Date of Actual Use:** Whether the petitioner's trademark usage predated the respondent's, challenging the CA's failure to recognize this.
2. **Confusing Similarity:** Whether "GOLD TOP" is confusingly similar to "GOLD TOE" in appearance and sound, thus misleading consumers.
3. **Paris Convention:** Whether the CA erred in applying the Paris Convention to accord exclusive rights to respondent's trademark without considering actual use in the Philippines.

Court's Decision:

First Issue: Dates of First Use of Trademark

- The Court reaffirmed that Cluett used the trademarks prior to Amigo. The certificates of registration from the Bureau of Patents were prima facie evidence of the dates of the first use.
- Amigo failed to provide substantial evidence to refute the validity of these certificates.

- The registrations of Cluett's trademarks dated back to 1932 and 1952, demonstrating earlier use than Amigo's claim starting in 1956.

****Second Issue: Similarity of Trademarks****

- The court upheld the findings of the Bureau of Patents and CA that "GOLD TOP" and "GOLD TOE" are confusingly similar in their entirety.
- Both marks employed a representation of a sock with a magnifying glass and were printed in identical lettering.
- Dominant features like the gold checkered lines, black background, the use of "linenized," and similar representations created overall confusion.

****Third Issue: The Paris Convention****

- The court upheld that the Paris Convention applied as the Philippines and the USA are parties to it, guaranteeing trademark protection.
- Cluett's earlier registrations in the USA and the Philippines rendered them eligible for protection under the Convention.
- The prima facie presumption of the date of first use applies, and without refutation by Amigo, Cluett's trademark rights were preserved.

Doctrine:

- ****Doctrine of Confusing Similarity:**** For trademarks, the focus should be on the entirety of similarities rather than individual elements alone. The overall impression matters, impacting whether trademarks cause consumer confusion.
- ****Prima Facie Evidence in Trademark Registration:**** Certificates of registration from the Bureau of Patents serve as prima facie evidence of the validity and ownership of trademarks. These should be contested with substantial counter-evidence.
- ****Paris Convention Protection:**** Trademarks registered under this Convention are protected even without actual use in the member country, given the conditions stipulated by the Convention.

Class Notes:

- ****Key Elements:****
- ****Actual Date of Use:**** Critical in determining precedence in trademark disputes.
- ****Confusing Similarity:**** Evaluated through the Dominancy Test and the Holistic Test.
- ****Prima Facie Evidence:**** Certificates of Trademark Registration.
- ****Paris Convention:**** International treaties play a pivotal role in trademark protection

across member countries.

- **Statutory Provisions:**
- **Republic Act No. 166 (Sections 5 and 20):** Requirements for registration and prima facie evidence.
- **Paris Convention:** International protection norms for intellectual property.
- **Application:**
- The Dominancy Test focuses on main features likely to cause confusion.
- The actual date of use must be earlier than the posted date in official registrations to challenge trademark ownership successfully.

Historical Background:

- The case underscores the evolving nature of intellectual property laws in the Philippines and their alignment with international standards. The use of historical trademarks and their protection under international conventions like the Paris Convention exemplify the legal frameworks that support global commerce and brand protection. The decision also stresses the importance of administrative agency rulings and the respect given to their expertise in specific domains.

This succinct presentation serves as a comprehensive analysis for academic and practical legal reference.