

BANANA REPUBLIC, INC.,  
Opposer,

INTER PARTES CASE NO. 3157

OPPOSITION TO:

- versus -

Application Serial No. 53643  
Filed : April 13, 1984  
Applicant : Claro C. Pablo  
Trademark : BANANA REPUBLIC  
Used on : Garments and ladies  
wear, etc.

CLARO C. PABLO,  
Respondent-Applicant.

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DECISION NO. 89-94 (TM)

November 16, 1989

### DECISION

On July 14, 1998, Banana Republic Inc. filed an unverified Notice of Opposition against the registration of the trademark "BANANA REPUBLIC & DESIGN" used on garments and ladies wear, such as running clothes, shirts, T-shirts, pants, sweat shirts, swimsuits, jackets, rainwear, caps hats, socks, jeans, bags and other related products applied for by Claro C. Pablo on April 13, 1984 under Application Serial No. 53643, published on Page 134 of the BPTTT Official Gazette, Volume I, No. 4, dated and released for circulation on June 17, 1998.

Opposer is a foreign corporation business address at 175 Bloxume Street, San Francisco, California 94102, United States of America, while Respondent-Applicant is a Filipino citizen with business address at 358 Shaw Boulevard, Mandaluyong, Metro Manila, Philippines.

The grounds alleged in the Opposition are:

"1. The mark BANANA REPUBLIC and Design under Serial No. 53643 of respondent-applicant is not only confusingly similar but identical to the trademark BANANA REPUBLIC of Opposer, which oppose owns and has not abandoned;

2. The oppose will be damaged and prejudiced by the registration of the mark BANANA REPUBLIC and Design in the name of respondent-applicant, and its business reputation and goodwill suffer great irreparable injury;

3. Respondent-Applicant's use of the mark BANANA REPUBLIC and design for garments and ladies wear- running clothes running clothes, shirts, T-shirts, pants, sweat shirts, swimsuits, jackets, rainwear, caps hats, socks, jeans, bags and other related products, which mark so resembles/identical with the trademark owned and used by Opposer, constitutes an unlawful appropriation of a trademark owned and currently used by Opposer.

On August 18, 1988, Respondent-Applicant was notified of this Opposition and was required to file its answer thereto within fifteen (15) days from the receipt of the notice.

For failure to file Answer, Respondent-Applicant was declared in default in Order No. 89-585 dated July 28, 1989 and Opposer was allowed to present its evidence ex parte.

Opposer presented its evidence ex-parte on August 31, 1989 consisting of Exhibits "A" to "D" inclusive, and formally offered them on September 14, 1989, which were all admitted in evidence for the Opposer, per Order No. 89-739 dated September 18, 1989.

The issue to be resolved, considering that respondent's mark "BANANA REPUBLIC & DESIGN" is identical to Opposer's mark "BANANA REPUBLIC" is: which of the parties is the first adopter, user and owner of the mark contest?

With the evidence presented, Opposer was able to convincingly establish that it has first used the mark in commerce in its Home State in 1978 (Exhs. "B-3" and "B-5"); that it has 161 registrations and/or pending applications of the contested mark (BANANA REPUBLIC) in 39 countries (Exhs. "B-1" to "B-89") indicating the status of said registrations and applications in the countries concerned, including the goods the mark is used on (Exh. "C"); and that the mark has also been used in the Philippines since August 1984 to July 1988. (Exh. "A").

On the other hand, Respondent-Applicant failed to prosecute his case; he did not file an answer despite receipt of the Notice of Opposition and was thus declared in default (*supra*), made no follow-up to know the status of his application and did not file any pleading whatsoever in connection with the case.

On the strength of the evidence presented, this Bureau is convinced that Opposer has better right over the mark in the contest.

WHEREFORE, this Notice of Opposition is GRANTED. Respondent's Application Serial Nos. 53643 is hereby REJECTED.

Let the records of the case be transmitted to the Application, Issuance and Public Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO  
Director