

BILL BLASS, LTD.,)	INTER PARTES CASE NO. 3181
Opposer,)	
)	OPPOSITION TO:
)	
)	Application Serial No. 53076
)	Filed : January 25, 1984
)	Applicant : Rosol Incorporated
- versus -)	Trademark : BLASSPORT & DESIGN
)	Used on : T-shirts, jeans,
)	socks, jackets,
)	and shorts
)	
)	DECISION NO. 92-6 (TM)
ROSOL INCORPORATED,)	
Respondent-Applicant.)	March 11, 1992
x-----x)	

DECISION

Submitted for decision is the Notice of Opposition filed by Bill Blass Ltd., to application for registration of trademark BLASSPORT or Design, with Serial No. 53076 in the name of Rosol Incorporated, said trademark allegedly being used on t-shirts, jeans, socks, jackets and shorts, falling under International Class 25.

Opposer, Bill Blass Ltd., is a corporation organized and existing under the laws of the State of New York, U.S.A. with Office address at 550 7th Avenue, New York, New York, 10018 U.S.A. Respondent, Rosol Incorporated, is a corporation organized and existing under the laws of the Philippines, with Office address at 1 New Orleans St., Quezon City.

The grounds for Opposition are as follows:

"1. Opposer is the owner and prior user of the trademark BLASSPORT;

"2. The Applicant's alleged mark BLASSPORT & DESIGN is confusingly similar to or resembles the internationally registered trademark of the Opposer. Moreover, the goods covered by both marks belong to the same class of goods of the international classification of goods and services, per Patent Office Administrative Order No. 20 dated 09 February, 1978 specifically under International Class 25;

"3. The trademark BLASSPORT which the Opposer has created and adopted is a well known mark throughout the world;

"4. The registration of applicant's alleged mark would violate Opposer's rights and interests in its trademark BLASSPORT because of the confusion that would rise between Opposer's and Applicant's respective business and products as well as the resulting dilution and loss of the distinctiveness of Opposer's trademark. This is not to mention the likelihood that the use of the applicant's trademark conveys the impression that its goods are related to or originated from the Opposer.

"5. The trademark of the Opposer enjoys the protection of our laws, Section 37 of our Trademark Law as well as the Convention Property dated 20

March, 1883, particularly Articles 2 and 8, affords protection to foreign trademark owners.

For failure to file Answer within fifteen (15) days from Notice to Answer (the reglementary period), Respondent was declared IN DEFAULT (Order No. 89-135). Respondent moved for Reconsideration to SET ASIDE default Order but was only denied under Order 89-171. Again, Respondent moved for a Reconsideration of the latter Order. In Resolution 89-11 and Order No. 91-691, this Office affirmed the Order of Default, thereby making good the loss of standing of the Respondent as a Party-Litigant in this case.

Opposer believes that it would be damaged by the registration of the subject trademark on the ground that it is the owner and prior user of the same. To prove ownership and prior use, Opposer submitted photocopies of the following:

- a) Certificate of Registration No. 1, 018,060, issued by the U.S. Patent Office on 12 August, 1976 (Exh. "C");
- b) Certificate of Registration No. B-386004 issued under Register Entry of Australia (Exh. "C-1");
- c) Certificate of Identification and Registration No. 1013512 issued in France on 05 April, 1977 (Exh. "C-3");
- d) Certificate of Registration copy of the Opposer's trademark in West Germany (Exh. "C-4");
- e) Certificate of Registration copy of trademark No. 95,367 of trademark BLASSPORT in South Korea (Exh. "C-5");
- f) Application for Registration of trademark BLASSPORT in Kowloon, Hongkong under Class 25, No. 155 (Exh. "C-6");
- g) Trademark Registration No. 1154249, dated 10 August, 1972 in Japan of trademark BLASSPORT (Exh. "C-8");
- h) Certificate of Registration of trademark BLASSPORT in the Republic of China under 219151 (Exh. "C-9").

Opposer further seeks protection under 6bis of the Paris Convention claiming that its mark is internationally well-known. To prove this International stature, Opposer submitted the following:

- a) The Affidavit of the President of the Opposer firm, Bill Blass Ltd. duly authenticated by the Philippine Consulate of New York, consisting of five (5) pages (Exh. "A");
- b) Ratification by the Notary Public of the County of New York acknowledging the signature of the President, Bill Blass Ltd. as the same person who executed the said affidavit on 14 March, 1989 (Exh. "A-1");
- c) Certification by the County Clerk of the Supreme Court and State of New York that the said Notary Public (Terry S. Landau) was at the time of subscription was a duly qualified and authorized to take the oath of the said Affidavit as prescribed by law (Exh. "A-2").
- d) Certificate of Authentication by the Consul of the Philippine Republic for the district of New York of the qualification and competency of the

Notary Public, Norman Goodman, as County Clerk, New York County (Exh. "A-3");

e) An attachment to the Affidavit (Exhibit A) of its Annex A, a printout listing of the various products produced by the Opposer company and the various trademarks used in connection with the said products such as Bill Blass (Signature and black letters) Blassport and Blassauede, otherwise known internationally as Bill Blass trademarks, hereinafter marked as Exhibit "A-5" to "A-40" inclusive, consisting of thirty seven (37) pages (Exh. "A-4");

f) Proof of worldwide sales and of international stature of Opposer's products bearing the trademark BLASSPORT, promoted and advertised in many countries of the world. Representative samples of advertisement and promotional materials bearing BLASSPORT consisting of catalog listing in publications which are international in scope namely: Harper's Bazaar, Glamour and Cosmopolitan publications which have catalog customers in the Philippines (Exh. "B" to "B-15").

The sole issue advanced by the Opposer is whether who between the Opposer and Respondent has the better right to the title or ownership of the trademark BLASSPORT and to the consequent registration thereof.

The claim of Opposer that it has prior use of the trademark based on the photocopies of its various registrations/applications abroad is not convincing. In the first place, the photocopies submitted are not admissible in evidence pursuant to Sec. 3, Rule 128 in connection with Sec. 3, Rule 130 of the Rules of Court, which provides that "no evidence shall be admissible other than the original itself". And even assuming, arguendo, that the photocopies submitted are admissible in evidence, the fact that Opposer's trademark BLASSPORT has been registered in other countries does not extend protection in the Philippines (Sterling Products International, Inc. v. 27 SCRA 1214).

On the other hand, claim of the Opposer that its mark is Internationally well-known is well taken. Various samples of advertisements (Exhibits "B" to "B-15") on 15 different International magazines promoting "BLASSPORT by BILL BLASS" mark give credence to the Opposer's claim that its BLASSPORTS mark is tied-up and intimately related with BILL BLASS and BB LOGO marks, such that the goodwill and reputation of one is the same as the others. In this connection, Opposer filed a list of 228 registrations and applications of its marks BLASSPORTS, BILL BLASS and BB LOGO Exhs. A-4 to A-40), most of which were issued or filed long before the filing of the subject application on 24 January, 1984. With this worldwide advertising and trademark registration or application for registration, we find no reason to disagree with the claim of Mr. Bill Blass, the President of Opposer, that its products bearing the trademark "BLASSPORTS" are being sold or have been sold with total yearly worldwide sales of U.S. \$ 7-7.5 Million (Affidavit, Exh. A). All told, this Office is convinced that the Opposer's mark. "BLASSPORTS" in connection with its other marks, has become internationally well-known at the time Respondent had adopted the same, obviously to ride on its popularity.

WHEREFORE, this Opposition is, as it is hereby, SUSTAINED. Application Serial No. 53078 filed by Rosol Incorporated is, as it is hereby, REJECTED.

Let the records of this case be forwarded to the Application, Issuance and Publication Division for appropriate action.

SO ORDERED.

IGNACIO S. SAPALO
Director