

CAROLCO INTERNATIONAL, N.V.,)	INTER PARTES CASE NO. 3329
Opposer,)	
)	OPPOSITION TO:
)	
)	Application Serial No. 61454
)	Filed : April 10, 1987
- versus -)	Applicant : Virgilio Tan
)	Trademark : RAMBO
)	Used on : Shoes
)	
)	<u>DECISION NO. 91-1 (TM)</u>
VIRGILIO TAN,)	
Respondent-Applicant.)	January 8, 1991
x-----x)	

DECISION

This is an opposition to the registration of the trademark RAMBO applied for by Virgilio Tan under Application Serial No. 61454.

Opposer, Carolco International, N.V., is a corporation organized and existing under the laws of the State of Netherlands, with registered offices at Polarisweg 35A, Willenstads, Curacao Netherlands Antilles. On the other hand, Respondent-Applicant Virgilio Tan is a Filipino citizen with residence at No. 3 Paraiso Street, Parang, Marikina, Metro Manila.

Office records show that on April 10, 1987, Respondent-Applicant filed an application for registration of the trademark RAMBO for shoes. The application was designated Serial No. 61454. In due time, the application was examined and allowed for publication in the Official Gazette on 20 December 1988. On 19 January 1989, opposer filed this present Opposition to the registration of subject mark. Respondent-Applicant failed to file an Answer upon due Notice of Opposition and was declared in default per Order No. 89-795.

In its ex-parte presentation of evidence, Opposer filed copies of the U.S. Certificates of Registration of the trademark RAMBO covering goods falling under International Classes 14, 34, 30, 8, 18, 9, 28, 25, 16 (exhibits "B", "C", "D", "E", "F", "G", "H", "I", and "J") Opposer likewise presented an affidavit (Exh. "A") of its Attorney-in-Fact; Darnell L. Young, to the effect that the adoption of RAMBO as a trademark was encouraged by the international fame of the RAMBO character in the motion picture "RAMBO: FIRST BLOOD PART II". Lastly, opposer presented its Philippine Certificate of Registration No. 46340 of the trademark RAMBO for goods falling under International Classes 3, 5, 8, 13, 14, 18, 30, 32, and 34 (exhibit "K"). In connection with the last piece of evidence, we take notice of the fact that said registration was applied for on 22 July 1985 with legalized and authenticated certified copies of US Certificates of Registration as bases.

We grant the Petition.

As between the parties, Petitioner was the first to apply for the registration of the trademark RAMBO on 22 July 1985 (Serial No. 56913) as against Respondent-Applicant's filing on 10 April 1987 (Serial No. 61454). Nine (9) months after filing of this Opposition on 19 January 1989, or on 11 September 1989, Application Serial No. 56913 matured into registration with Certificate No. 46340. Under Sec. 20 of RA 166, as amended, "(a) Certificate of Registration of a mark or tradename shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark or trade-name, and of the registrant's exclusive right to use the same in connection with the goods, business, or services specified in the certificate, subject to any conditions or limitations stated therein". Thus, Respondent-Applicant, in a deliberate assumption of risk for neglecting to defend its interests, necessarily submitted to the presumptions granted by law on the petitioner's Certificate of Registration.

We note, however, that Petitioner's Certificate of Registration No. 46340 for the mark RAMBO does not cover class 25 to which this opposition addresses. Thus, although the certificate of registration grants ownership of the trademark RAMBO to the Petitioner, it does not preclude the use of such mark on goods not covered by said certificate (Sec. 20, RA 166). However, under the Expansion Theory, we find that shoes are well within Petitioner's zone of potential or natural and logical expansion of its goods covered by its registration certificate no. 46340, i.e. luggage, hand bags, purses, wallets, jewelry and watches. (Esso Standard Eastern, Inc. vs. CA, 166 SCRA 336-345). And this is strengthened by the registration of the subject mark for footwear in class 25 in the United States (exhibit "I").

What is more we cannot discount the possibility that the simultaneous use of the same mark by the petitioner and Respondent-Applicant could lead to confusion of purchasers as to the origin of the goods. By appropriating the mark RAMBO, respondent-applicant's products are likely to be mistaken as having been produced by the petitioner. (Converse Rubber Corp. vs. Universal Rubber Products, Inc., 147 SCRA, 154, 165).

WHEREFORE, registration of the trademark RAMBO under application Serial No. 61454 in the name of Respondent Virgilio Tan is hereby DENIED.

Let the records of this case be forwarded to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director