

1. Petitioner is the owner and first user of the trademark "NCAA" used on T-shirts, shorts, sweaters, jackets and sports footwear, among others. The trademark "NCAA" has been continuously used on these goods and has been known throughout the world in relation to and in association with the name of Petitioner;

2. Respondent's knowledge of the existence of the "NCAA" name and trademark is reflected in the application of Petitioner's trademark "NCAA";

3. Respondent's adoption of Petitioner's trademark indicates an intent to capitalize on the goodwill and popularity of Opposer's "NCAA" trademark to Respondent's own benefits;

4. Respondent's trademark consists of the letters "NCAA" which are clearly and evidently identical in sound, meaning and appearance to the trademark of Opposer, and will definitely deceive the public into believing that the trademark is associated with or is under the sponsorship of Opposer;

5. In Decision No. 86-57 in an earlier case between the same parties docketed as IPC Case No. 1964 rendered on July 9, 1986, respondent has been declared not entitled to the registration of "NCAA" and its application therefore was accordingly declared ABANDONED.

On May 11, 1989, a Notice to Answer was sent to the Respondent-Registrant's Counsel through Registered Mail with Return Card bearing No. 3924.

For failure to prosecute for an unreasonable length of time, this case was dismissed *motu proprio* (Order No. 90-114 dated March 8, 1990)

On March 15, 1990, Petitioner through Counsel filed a Motion for Reconsideration praying that:

1. The order dated March 8, 1990 dismissing this case *motu proprio* be set aside;

2. Respondent-Registrant be declared in default and Petitioner be allowed to present evidence ex-parte

Order No. 90-331 dated June 14, 1990 was issued granting the Motion for Reconsideration and accordingly Order No. 90-114 dated March 8, 1990 dismissing this case for failure to prosecute was set aside and Respondent-Registrant declared in DEFAULT.

The issues to be resolved are the following:

1. Whether or not the trademark of Respondent-Registrant is confusingly similar with that of the Petitioner; and

2. Whether or not Petitioner has acquired priority of registration and goodwill over the mark "NCAA" to the exclusion of use/registration of the same by all others.

The trademark "NCAA" has been registered in many countries of the world particularly as follows:

1. U.S.A., Certificate of Registration No. 1483616 issued on April 5, 1988 (Exhibit "G")

2. U.S.A., Certificate of Registration No. 976117 issued on January 1, 1974 (Exhibit "H")
3. U.S.A., Certificate of Registration No. 906,963 issued on January 26, 1971 (Exhibit "J")
4. Malaysia – Certificate of Registration No. M-86885 issued on June 21, 1980 (Exhibit "K")
5. Sabah – Certificate of Registration No. S-26349 issued on June 21, 1980 (Exhibit "LL")
6. Benelux – Certificate of Registration No. 390922 issued on January 7, 1983 (Exhibit "N")
7. Canada – Certificate of Registration No. 278028 issued on March 25, 1983 (Exhibit "O-1")
8. France – Certificate of Registration No. 1239953 issued on January 7, 1983 (Exhibit "R-1")
9. Great Britain and Northern Ireland – Certificate of Registration No. 1,245,401 issued on July 4, 1985 (Exhibit "S")
10. Argentina – Certificate of Registration No. 457792 issued on November 14, 1986 (Exhibit "T", "T-1", "T-2")
11. Spain – Certificate of Registration No. 1,041,698 issued on July 5, 1983 (Exhibit "U")
12. Sweden – Certificate of Registration No. 195,803 issued on April 19, 1985 (Exhibit "V")
13. W. Germany – Certificate of Registration No. 333525 issued on October 19, 1984 (Exhibit "W-1")
14. Korea – Certificate of Registration No. 70028 (Exhibit "X")
15. Taiwan – Certificate of Registration No. 136,299 issued on July 16, 1990 (Exhibit "Z")
16. Sarawak – Certificate of Registration No. 21636 issued on June 26, 1980 (Exhibit "DD")
17. Brunei – Certificate of Registration No. 9982 issued on July 25, 1980 (Exhibit "FF")
18. Japan – Certificate of Registration No. 138684 issued on July 31, 1979 (Exhibit "HH")

Based on the evidence submitted, the Respondent-Registrant's trademark "NCAA" is confusingly similar with the Petitioner's mark as both marks are the same in spelling and pronunciation. Both consist of only one word which is "NCAA". There can be no doubt and in fact obviously identical and considering that the goods covered by both marks are the same as they belong to same class of goods.

The goods covered by the Respondent-Registrant's trademark as shown in the Certificate of Registration No. 6513 are the following, namely: shirts, t-shirts, sportshirts, sweatshirts, undershirts, briefs, bra, nighties, panty, socks, dresses, pants, jeans, blouses, shorts, skirts, jackets, jogging suits, swimningsuits, falling under Class 25 of the international classification of goods.

On the other hand, the Petitioner's mark covers the goods, wearing apparel namely: caps, visors, jerseys, t-shirts, shorts, sweaters and jackets in Class 25 (Reg. No. 1,483,616) Exhibit "G", Regn. No. 1,135,202 (Exhibit "Q-1") for the goods, wearing apparel, namely: sports, footwear.

Our Trademark Law, particularly Section 4(d) thereof, provides as follows:

"Sec. 4. Registration of trademark, tradenames and service marks on the Principal Register. – There is hereby established a register of trademarks, tradenames and service marks which shall be known as the principal register. the owner of a trademark, tradename or service mark used to distinguish his goods,, business or service from the goods, business or services of others shall have the right to register the same on the Principal Register unless it:

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(d) Consists of or comprises a mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers".

Petitioner presented proofs showing that the mark of Respondent-Registrant and that of the Petitioner are identical. It is further established that Petitioner owns the mark "NCAA" through prior and continuous use of the same in many countries throughout the World to merit protection as well-known mark.

Besides, the issuance of the Certificate of Registration to Respondent-Registrant for the trademark "NCAA" Registration No. SR-6513, did not even give rise to any presumption of validity of registration, ownership, and exclusive right to use the mark (Sec. 20, R.A. No. 166, as amended).

WHEREFORE, the Petition is GRANTED. Consequently, Certificate of Registration No. SR-6513 issued to Respondent-Registrant is hereby CANCELLED.

Let the records of this case be forwarded to the Patent/Trademark Registry and EDP Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director