

PARAMOUNT PICTURES CORP.)  
Opposer, )

INTER PARTES CASE NO. 3265

OPPOSITION TO:

- versus - )

) Application Serial No. 60022  
) Filed : October 3, 1986  
) Applicant : Arsenio T. Chingkoe  
) Trademark : TOP 20 & DEVICE  
) Used on : Briefs, jogging  
) suits, t-shirts,  
) sweat shirts

) DECISION NO. 92-17 (TM)

ARSENIO T. CHINGKOE, )  
Respondent-Applicant. )

August 4, 1992

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### DECISION

On November 29, 1988, Paramount Pictures Corporation, a corporation organized and existing under the laws of the State of Delaware, with offices at 5555 Melrose Avenue, Los Angeles, California 90038-3197, filed its Verified Notice of opposition in the matter for registration of the trademark "TOP 20 & DEVICE" bearing Serial No. 60022 used on briefs, jogging suits, t-shirts, sweat shirts in Class 25 which application was filed on October 3, 1986 by ARSENIO T. CHINGKOE, a Filipino citizen of Quezon City, Metro Manila which application was published for opposition on page 34, Volume 1, No. 7 of the BPTTT Official Gazette of September 27, 1988 and officially released on September 30, 1988.

The grounds for opposition are as follows:

1. The registration of the trademark TOP 20 & DEVICE in the name of the respondent-applicant will violate and contravene the provisions of Section 4(d) of Republic Act No. 166, as amended and Section 5 (d) of Presidential Decree No. 49 because said mark is confusingly similar to the trademark TOP GUN Logo and the copyrighted work TOP GUN (The Movie) owned and unabandoned by the opposer, as to be likely, when applied to or used in connection with the goods of the respondent-applicant to cause confusion or mistake or deceive purchasers thereof;
2. The instant application for the registration of the trademark TOP 20 & Device violates Section 2 of the Republic Act No. 166, as amended because respondent-applicant has no bonafide actual use in commerce in the Philippines of the subject trademark prior to the instant application thereof in the Principal Register;

3. The trademark TOP GUN Logo is known all over the world, including the Philippines, to be exclusively owned by the opposer. Hence, the registration in the name of respondent-applicant of the confusing trademark TOP 20 & Device will be a breach of the clear provisions of Article 6bis of the Paris Convention for the Protection of Industrial property which is now enforced in this jurisdiction by virtue of the Memoranda of then Minister of Trade dated November 20, 1980 and October 25, 1983 directing the Director of Patents to cancel and/or reject/refuse all unauthorized registration of world-famous trademarks;

4. The registration of the trademark TOP 20 & Device in the name of the respondent-applicant will cause grave and irreparable injury and damage to the opposer within the meaning of Section 8 of Republic Act No. 166, as amended.”

The Opposer relies on the following facts:

“1. The Opposer is the creator, producer and copyright owner in the United States and the rest of the world of the top grossing movie TOP GUN under Registration No. PA293-347;

2. Opposer has applied for the registration of the TOP GUN Logo as a trademark in the United States and other parts of the globe for a variety of products namely, clothing including jackets, shirts and caps, posters, books, video games, sunglasses, jewelry, and mugs;

3. Opposer has been using the trademark TOP GUN Logo for different goods since May 23, 1986 long before respondent-applicant filed the instant application for the registration of the trademark TOP 20 & Device. Hence, the Opposer is a clear senior-user of the trademark;

4. Opposer has built an immense and valuable goodwill for its trademark TOP GUN Logo due mainly to the box office success of the movie TOP GUN and the large sums of money it has spent for advertising popularizing its goods bearing the TOP GUN Logo;

5. The use and registration of the trademark TOP 20 & Device by the respondent-applicant for its goods is likely to cause confusion, mistake and deception to the buying public as to the origin of the goods and will definitely dilute the value of opposer’s trademark TOP GUN Logo because the marks of the herein parties are confusingly similar. In fact, it is safe to state that the trademark TOP 20 & Device of the respondent-applicant is a clear colorable imitation of the trademark TOP GUN Logo of the opposer;

6. Further, the use and registration of the mark TOP 20 & Device by respondent-applicant will cause grave and irreparable damage or injury to the opposer within the meaning of the Trademark Law.

The main issue to be resolved in this case is:

WHETHER OR NOT RESPONDENT-APPLICANT'S TRADEMARK  
"TOP 20 & DEVICE" IS CONFUSINGLY SIMILAR TO OPPOSER'S  
TRADEMARK "TOP 20 LOGO"

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 services from the goods, business or services of others shall have the right to register the same on the Principal Register unless it:

xxx

(d) Consists of or comprises a mark or trade name which so resembles a mark or tradename registered in the Philippines or a mark or trade name 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."

On March 15, 1990, opposer through Counsel filed a Motion for Reconsideration as to the Order of this Office (ORDER NO. 90-120 dated March 9, 1990) and further prayed that Respondent-Applicant be declared in Default for failure to file an Answer to the Notice of Opposition despite the fact that he received the Notice to Answer sent on December 6, 1988. Consequently, Respondent-Applicant was declared in DEFAULT (ORDER NO. 90-341 dated June 15, 1990).

Pursuant to the Order of Default, Opposer on July 5, 1990 presented its evidence Ex-Parte consisting of Exhibits "A" to "A-33", which were formally offered and admitted in evidence for the Opposer.

An examination of Respondent-Applicant's trademark "TOP 20 & LOGO" disclose that it is confusingly similar with the "TOP GUN" trademark of the Opposer. It is stressed that the design in "TOP 20" and that of "TOP GUN" as shown by opposer's evidence are identical. The two marks viewed in their entirety are well-nigh identical. The goods or products covered by both marks are likewise the same and fall under the same class of goods Class 25 in the International Classification of goods.

There is also sufficient evidence on file to show that there is reasonable basis to make the conclusion that the mark "TOP GUN" of the opposer is well-known hence may be protected under Article 6bis of the Paris Convention.

WHEREFORE, premises considered, the herein Notice of Opposition is hereby GRANTED. Accordingly, Application Serial No. 60022, for the trademark

"TOP 20 & Device" filed on October 3, 1986 by ARSENIO T. CHINGKOE, is hereby REJECTED.

Let the filewrapper of this case be forwarded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision and a copy of this Decision be furnished the Trademark Examining Division for information and to update its records.

SO ORDERED.

IGNACIO S. SAPALO  
Director