TOYOTA JIDOSHA KABUSHIKI KAISHA, Opposer, - versus - IGRI INDUSTRIES, INC., Respondent-Applicant.	)	INTER PARTES CASE NO. 3500 OPPOSITION TO: Application Serial No. 67867 Filed : May 5, 1989 Applicant : Igri Industries, Inc. Trademark : LEXUS Used on : Land motor vehicle <u>DECISION NO. 91-22 (TM)</u> November 29, 1991

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DECISION

On 05 February, 1990, Toyota Jidosha Kabushiki Kaisha, a corporation organized under the laws of Japan and having its registered office at No. 1, Toyota – Cho, Toyota-shi, Aiche-ken, Japan, filed its Verified and Authenticated Notice of Opposition (Inter Partes Case No. 3500) to Application Serial No. 67867 for the trademark “LEXUS” used on land motor vehicles, which application was filed on 05 May, 1989 by Igri Industries Incorporated of San Juan, Metro Manila, a corporation organized under the laws of the Philippines, which was published on page 24, Vol. 11, No. 9 issued of the Bureau of Patents, Trademarks and Technology Transfer Official Gazette which was officially released for circulation to the public on 02 October, 1989.

The ground for opposition is:

The Registration of the mark in the name of Respondent-Applicant is proscribed by Sec. 4 (d) of R.A. No. 166 as amended.

Opposer relies on the following facts to support its opposition:

1. Opposer is already the registered owner of the trademark “LEXUS” in International Class 12 for Motor Vehicles and other goods belonging to this class in Japan under Registration No. 21164475 dated 03 August, 1989. In <u>Great Britain</u> under Registration No. 1301387 dated 18 February, 1987 in class 12; in <u>Sweden</u> under Registration No. 207590 dated 09 October, 1987 in class 12; in <u>Austria</u> under Registration No. 116334 dated 18 February, 1987; in <u>West Germany</u> under Registration No. 1110623 dated 28 August, 1987 in class 12; in <u>Norway</u> under Registration No. 133271 dated 09 January, 1988 in class 12; in <u>Switzerland</u> under Registration No. 353762 dated 19 February, 1987 in class 12; in <u>Finland</u> under Registration No. 103214 dated 20 January, 1989 in class 12; in <u>France</u> under Registration No. 1398464 dated 13 March, 1987 in class 12; in <u>Austria</u> under Registration No. A460211 dated 18 February, 1987 in class 12; in <u>South Africa</u> under Registration No. 870936 dated 17 February, 1987 in class 12; and in <u>Benelux</u> under Registration No. 693390 dated 17 February, 1987 in class 12.

2. Opposer has adopted and used the trademark “LEXUS” in commerce in Japan in respect of its goods since 1987 and thereafter worldwide.

3. Opposer is the original creator of the mark “LEXUS” and has established a worldwide impressive reputation on “LEXUS” as a world power in luxury sedan cars.

4. The applicant's mark "LEXUS" is confusingly similar to the trademark "LEXUS" owned by the Opposer, thus, it would cause misunderstanding and confusion in the Philippines if the Respondent-Applicant other than the Opposer were to use the mark "LEXUS" on motor vehicles.

5. The registration of the mark "LEXUS" in the name of Igri Industries, Inc., the Respondent-Applicant, will cause great and irreparable injury and damage to Opposer within the meaning of Sec. 8 of R.A. No. 166 as amended.

6. As the result of the extensive use "LEXUS" established reputation worldwide by the Opposer, the mark "LEXUS" has become identified with the goods and business of the Opposer in the minds of the public here and abroad, and the use of any trademark which is identical thereto is likely to confuse the purchasing public, as well as to be confused by the purchasing public as a trademark belonging to or associated with the goods and/or business of the Opposer.

The main issue to be resolved is whether or not the registration of the mark "LEXUS" applied for by Respondent-Applicant for use on land motor vehicles is proscribed by Sec. 4(d) of R.A. No. 166 as amended.

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

"SECTION 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:

X
X
X

"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 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."

On 22 January, 1990 together with a copy of the Notice of Opposition, a Notice to Answer dated 16 January, 1990 was sent by registered mail to Respondent-Applicant, Igri Industries, Inc. requiring the same to submit its answer within fifteen (15) days from receipt of the notice.

For failure of the Respondent-Applicant to file its Answer within the reglementary period prescribed by the Rules, same was declared IN DEFAULT (Order No. 90-179) dated 20 March, 1990.

Pursuant to the Order of Default, Opposer presented its evidence ex-parte consisting of documentary exhibits marked as Exhibits "A" to "Z", inclusive of submarkings.

The evidence shows that Respondent-Applicant's trademark "LEXUS" is identical to Opposer's trademark "LEXUS" as both marks are the same in SPELLING, SOUND, PRONUNCIATION, and MEANING as well. Both parties' goods are the same, since Land Motor Vehicles belong to class 12 of the International Classification of goods. Hence, there is a factual

basis to hold that Respondent-Applicant's trademark is confusingly similar with Opposer's trademark.

On the basis of the evidence submitted, Opposer has shown enough proof that ownership of the mark "LEXUS" belongs to it and clearly established that Respondent-Applicant's application for the registration of the mark "LEXUS" in its name is in violation of Sec. 4(d) of R.A. No. 166 as amended.

The non-filing of the requisite Answer to the Notice of Opposition nor any Motion to Lift the Order of Default despite notice is indicative of Respondent-Applicant's lack of interest in its application; thus, it is deemed to have abandoned the same.

It must be pointed out that herein Opposer whose country of origin is a member of the Convention of Paris for which the Philippines is also a signatory. Under the said Convention, each country of the Union undertakes at the request of an interested party to prohibit the use of a trademark which constitutes a reproduction, imitation or translation of mark already belonging to a person entitled to the benefits of the Convention and use for identical or similar goods.

Where confusing similarity exists between the contending marks, our Supreme Court ruled:

> "In cases involving infringement of trademark brought before this Court, it has been consistently held that there is infringement of trademark when the use of the mark involved would be likely to cause confusion or mistake in the mind of the public or to deceive purchasers as to the origin or source of the commodity." (Fruit of the Loom, Inc. vs. Court of Appeals, et.al., 133 SCRA 405, CITING Co Tiong Sa vs. Director of Patents; 95 Philippines; Alhambra Cigar & Cigarette Co. vs. Mojica, 27, Philippines, 266, etc)

WHEREFORE, premises considered, the herein Notice of Opposition is, as it is hereby, SUSTAINED. Accordingly, Serial No. 67867 for the mark "LEXUS" in favor of the herein Respondent-Applicant is hereby REJECTED.

Let the records of this decision be remanded to the Applications, Issuance and Publications Division for appropriate action in accordance with this DECISION.

SO ORDERED.

IGNACIO S. SAPALO
Director