

COMPANIA COLOMBIANA DE	}	INTER PARTES CASE NO. 4298
TABACO S.A.,	}	Opposition to:
Opposer,	}	
	}	Application Serial No. 95560
-versus-	}	Filed : 29 September 1994
	}	Mark : "PIELROJA & Device"
	}	Goods : Cigarettes
ASSOCIATED ANGLO-AMERICAN	}	
TOBACCO CORPORATION	}	
Respondent-Applicant.	}	Decision No. 2000-15
X-----X	}	

DECISION

A Verified Notice of Opposition was filed on 4 June 1997 by herein Opposer Compania Colombiana de Tabaco S.A. against the application for registration of the trademark "PIELROJA & Device" with Serial No. 95560 filed by the Associated Anglo-American Tobacco Corporation.

Respondent's application for registration was published in Volume IX No. 5, Page 80 of the September-October 1996 issued of the BPTTT Official Gazette which issue was released for circulation on 07 February 1997.

Opposer, a foreign corporation duly organized and existing by virtue of the laws of Colombia with principal office address at Carrera 43A No. 1A Sur 143, Medellin, Colombia, filed the present opposition on the ground that it will be damaged by the registration of the mark PIELROJA & Device in the name of respondent, a domestic corporation with office address at 2646 Dimasalang Street, Pasay City.

Opposer opposes the application on the following grounds:

"4.1 The mark "PIELROJA & Device" sought to be registered by respondent-applicant is identical and confusingly similar to opposer's trademarks "PIELROJA" and "PIELROJA & Device".

"4.2 The Opposer is the prior adopter, user and owner of the trademarks "PIELROJA" and "PIELROJA and Device", having used the mark since 1922 or for over seventy years. Hence, it is the Opposer which has the exclusive right to the use, registration and protection thereof, including the right to exclude others from using and registering similar marks, under Republic Act No. 166, as amended, Rules 44 and 45 of the Revised Rules of Practice in Trademark Cases and the Paris Convention."

"4.3 Opposer's mark is an internationally well-known in accordance with Rule 45 of the Revised Rule of Practice in Trademark Cases and has become distinctive of the business and/or goods of the Opposer through the latter's long and exclusive thereof in international commerce.

"4.3.1. Even before respondent-applicant's alleged date of first use in Philippine commerce of the mark "PIELROJA and Device", Opposer had obtained and continues to maintain registrations of the

trademarks "PIELROJA" and "PIELROJA and Device" from the trademark or industrial property offices of various countries.

"4.3.2. Opposer's trademarks have long established goodwill and general international recognition as belonging to one owner or source, i.e., belonging to the Opposer.

"4.3.3. Through its long and continuous use of the trademarks "PIELROJA" and "PIELROJA and Device", it has become well-known in the international tobacco trade industry that the trademarks "PIELROJA" and "PIELROJA and Device" are owned by Opposer.

"4.4 Respondent-applicant's application is clearly fraudulent. Opposer is the owner of the trademarks "PIELROJA" and "PIELROJA and Device" having used the mark on cigarettes since 1922. The mark "PIELROJA and Device" sought to be registered by respondent-applicant is exactly identical; to the trademarks "PIELROJA" and "PIELROJA and Device" owned and being used by the Opposer. Hence, under Republic Act No. 166, as amended, Rules 44 and 45 of the Revised Rules of Practice in Trademark Cases and the Paris Convention, the Government of the Republic of the Philippines is bound to protect Opposer's trademarks by rejecting the application for registration of an identical mark.

"4.5 In view of the foregoing, respondent-applicant's trademark application under Serial No. 95560 should be denied in accordance with Republic Act No. 166, as amended, Rule 44 in relation to Rule 45 of the Revised Rules of Practice in Trademark Cases, and the Paris Convention.

"4.6 Respondent-Applicant is not the owner of the trademark "PIELROJA and Device" and, hence, is not entitled to registration. Respondent-applicant's application for registration of the mark "PIELROJA and Device" is tantamount to fraud as the use of the mark on goods covered by the application clearly infringes upon the established rights of the Opposer and is tantamount to an unlawful appropriation of Opposer's trademarks.

"4.7 The registration of the mark "PIELROJA and Device" in the name of the respondent-applicant will violate the propriety rights/interests and goodwill of the Opposer over and in its trademarks "PIELROJA" and "PIELROJA and Device", thereby causing great and irreparable injury to the Opposer."

In its Opposition, the following facts and circumstances were raised by the Opposer as constituting its valid claims against Respondent's application for registration:

"5.1 Opposer is and has always been the prior user and adopter, and owner of the marks "PIELROJA" and "PIELROJA and Device", which is used by the Opposer on its goods, specifically, cigarettes in International Class 34.

“5.2 Opposer has been using the trademarks “PIELROJA” and “PIELROJA and Device” on its goods specifically, cigarettes, long before the respondent-applicant allegedly first started using the mark “PIELROJA and Device” in the Philippines on 06 July 1994. Opposer has in fact been using the trademark since 1922.

“5.3 The Opposer has secured registrations of the trademarks “PIELROJA” and “PIELROJA and Device” in trademark and industrial property offices in Colombia and other countries which are signatories to the Paris Convention. The countries in which the marks are registered are:

<i>COUNTRY</i>	<i>Registration Number</i>	<i>Date of Issue</i>
1. Bolivia	43.549-C	15 October 1984
2. Bulgaria	20.854	29 June 1993
3. Czech Republic	171.435	30 September 1992
4. Chile	228.065	18 February 1980
5. Ecuador	1020-76	5 April 1976
6. Hungary	133 616	26 April 1992
7. Mexico	444.311	15 October 1993
8. Peru	028759	8 July 1996
9. Polonia	74.787	28 February 1994
10. Russian Federation	106.524	24 July 1992
11. Venezuela	30.500-F	29 January 1957
12. Yugoslavia	38.175	20 June 1994
13. Colombia	106.833	11 September 1984

These registrations are subsisting and have not been abandoned.

“5.4 Further, Opposer has pending applications for registration of the marks “PIELROJA” and “PIELROJA & Device” in many other countries, such as:

<i>COUNTRY</i>	<i>Application Number</i>	<i>Date of Application</i>
1. Georgia	4026/03-93	28 July 1993
2. Lithuania	ZP 11160	10 September 1993
3. Romania	25.077	12 August 1991
4. Venezuela	92-006784	06 April 1992

“5.5 Through Opposer’s long and exclusive use of the trademarks “PIELROJA” and “PIELROJA & Device” in international commerce, the said mark has become internationally well-known.

“5.6 Opposer’s long and exclusive use of the trademarks “PIELROJA” and “PIELROJA and Device” has established goodwill for its trademark in various countries all over the world, such that the Opposer’s trademark has acquired general international recognition among consumers and the tobacco industry as belonging to only one owner or source, that is, belonging to the Opposer.

“5.7 The mark “PIELROJA & Device”, applied for registration by the respondent-applicant, which mark is a mere imitation of Opposer’s trademark and tradename, was adopted or used by the respondent-applicant for the purpose of getting a free ride on the goodwill of Opposer’s tradename and business reputation.”

A Notice to Answer dated 16 June 1997 was sent to Respondent-Applicant through registered mail. However, it failed to file the Answer despite notice and was subsequently declared in default, on motion of the Opposer, on 20 August 1997 per Order No. 97-401, Since Respondent neither filed a motion to set aside the order of default nor manifested any interest in the present Opposition against its application, the ex-parte presentation of the Opposer’s evidence was ordered by this Office in accordance with Rule 160-C of the Revised Rules of Practice in Trademark Cases.

The main issue to be resolved by this Office is whether or not Respondent’s trademark “PIELROJA” should be denied registration for being an exact imitation of the Opposer’s own mark. Furthermore, this Office would also resolve the issue of whether or not the Opposer’s mark can be considered internationally well-known such that the application for registration of a similar mark here in the Philippines shall be denied pursuant to the provisions of the Paris Convention which extended protection to marks that are well-known despite its non-registration in other jurisdiction.

The principle primarily applied where the issue of identical or similar mark is raised is the rule in trademark cases which provides that a mark similar to another and applied to the same goods cannot be registered. Thus, the simple formula in determining when a mark should be denied registration or to be cancelled is: similar mark vis-à-vis similar goods. in the case at bar, the exact imitation of the mark “Pielroja” is a blatant violation of the intellectual property right of the Opposer.

As to the issue of whether the mark in question can be considered a well-known mark, Opposer presented two very recognizable exhibits which have persuasive effect in this Forum of its claim of being well-known: The Certified Copies of Registrations in other countries as well as the Certified Copy of Resolution No. 15852 dated 02 September 1993 issued by the Superintendent of the Industry and Commerce Division of Distinctive Signs declaring Opposer’s “PIELROJA and Device” as well-known offered as “Exhibit N-1” and the corresponding English translation thereof offered as “Exhibit N-3”.

Though the said evidence is merely persuasive in this jurisdiction, this Forum is inclined to give it considerable weight in light of the attendant circumstances. Note the fact that Respondent neither presented evidence to rebut the Opposer’s allegations nor showed any inclination to pursue its application. As in any judicial or quasi-judicial proceeding, a presumption that the Respondent has no valid defense arises in default cases.

Thus, the Certification issued by the Colombian Superintendent of Industry and Commerce is entitled not only to a credible weight but also to much respect for not being rebutted by Respondent. Under Republic Act 166, which is still applicable in the case at bar, a mark, can be considered well-known when any one of the following conditions or criteria or any combination thereof mentioned in the Ongpin Memorandum is met:

“(a) a declaration by the Minister of Trade and Industry that the trademark being considered is already well known in the Philippines such that permission for its use by other than its original owner will constitute a reproduction, imitation, translation or other infringement;

“(b) that the trademark is used in commerce internationally, supported by proof that goods bearing the trademark are sold on an international scale, advertisements, the establishment of factories, sales offices, distributorships and the like, in different countries, including volume or other measure of international trade and commerce;

“(c) that the trademark is duly registered in the industrial property office(s) of another country or countries, taking into consideration the dates of such registration;

“(d) that the trademark has been long established and obtained goodwill and general international consumer recognition as belonging to one owner or source;

“(e) that the trademark actually belongs to a party claiming ownership and has the right to registration under the provisions of the aforestated Paris Convention.”

Three of the above-mentioned criteria were actually met by herein Opposer.

Furthermore, “Article 6 *bis* of the Paris Convention adheres to the principle of territoriality not in the strict sense, in that use in the country where protection is sought is not required; it suffices that such marks are considered by the competent authority of the country where protection is sought to be well known in the country as being already the mark of a person entitled to the benefits of the Convention and used for identical or similar goods.” (Background Reading Material on the Intellectual Property System of the Philippines)

Thus, and needless to say, it is incumbent upon this forum to order the denial of Application Serial No. 95560 for the trademark “Pielroja and Device” as applied to cigarettes on the basis of the aforequoted authorities supporting this Office’s decision. No lengthy discussion of the authorities cited is needed for the obvious cannot be denied neither can this Office deny what otherwise is a blatant encroachment of the Respondent on the Opposer’s right to the mark “Pielroja and Device”.

WHEREFORE, after a consideration of the foregoing premises, this Office hereby SUSTAINS the Opposition filed by Compania Colombiana de Tabaco S.A. against Application Serial No. 95560 for the trademark “Pielroja and Device” as applied to cigarettes by Respondent Associated Anglo-American Tobacco Corporation and DENIES the registration of the same.

Let the filewrapper in this case be forwarded to the Administrative, Financial and Human Resource Development Services Bureau (AFHRDSB) for appropriate action in accordance with this Decision with a copy to be furnished the Bureau of Trademarks (BOT) for information and update of its records.

SO ORDERED.

Makati City, November 29, 2000.

ESTRELLITA BELTRAN-ABELARDO
Director