

PEPE (U.K.) LIMITED,)	INTER PARTES CASE NO. 3077
Opposer,)	
)	OPPOSITION TO:
)	
)	Application Serial No. 53589
)	Filed : April 11, 1984
)	Applicant : Juan Loa
- versus -)	Trademark : PEPPER
)	Used on : Jeans, t-shirt.
)	jackets, shirts,
)	briefs, panties,
)	socks & handkerchief
)	
)	<u>DECISION NO. 92-19 (TM)</u>
JUAN LOA,)	
Respondent-Applicant.)	August 5, 1992
x-----x)	

DECISION

On June 8, 1988, "PEPE (U.K.) LIMITED", a company organized and existing under the laws of England and having an Office at Pepe House, 34 Bridge Road, London, NW10 9BX, England, filed its Verified Notice of Opposition (Inter Partes Case No. 3077) to Application Serial No. 53589 for the trademark "PEPPER" used on jeans, t-shirts, jackets, briefs, panties, socks and handkerchiefs, which application was filed on April 11, 1984 by Juan Loa, a Filipino, with address at 1399 E. delos Santos Avenue, Caloocan City, Metro Manila, Philippines which was published in the Official Gazette, a monthly publication of the Bureau of Patents, Trademarks and Technology Transfer, Volume 1, No. 2, Page 63, released for circulation on April 8, 1988.

Opposer stated as basis for its Opposition are the following:

1. The trademark "PEPPER" sought to be registered by the respondent-applicant is not only confusingly similar but identical to the trademark "PEPE", "PEPE & DEVICE", "PEPE IIXL" of the herein Opposer, which it had much earlier adopted and used in commerce in the Philippine and has become publicly known as a trademark belonging to the Opposer and for which it has existing trademark registrations in the Philippines and in other countries of the world;
2. The Opposer has spent much for the advertisement and promotion of the trademarks "PEPE", "PEPE & DEVICE", "PEPE & DEVICE OF A TREE WITHIN A SQUARE" and "PEPE IIXL" and its business and goodwill will clearly be damaged and will suffer irreparable injury;
3. The trademark "PEPPER" of the respondent-applicant so resembles the trademarks "PEPE", "PEPE & DEVICE", "PEPE & DEVICE OF A TREE WITHIN A SQUARE" and "PEPE IIXL" of the Opposer as to be likely, when applied to or used in connection with the goods of the respondent-applicant, to cause confusion, mistake or to deceive purchasers (Sec. 4(d) R.A. 166, as amended).

Opposer relies on the following facts to support its Opposition:

1. The trademark "PEPE & DEVICE" and "PEPE & DEVICE OF A TREE WITHIN A SQUARE" has been used in commerce by the Opposer since 1972 and in the Philippines through its licensee American Jeans and Sportswear Inc., since April 6, 1980 and therefore, has an exclusive right to use said trademarks to the exclusion of others including the respondent;

2. Aside from the prior adoption and continuous and exclusive use of the trademarks "PEPE & DEVICE", "PEPE & DEVICE OF A TREE WITHIN A SQUARE" the said trademarks are duly registered with the Bureau of Patents, Trademarks and Technology Transfer under Certificate of Registration Nos. 33378 and 5656 issued on June 22, 1984 and August 17, 1981 respectively;
3. Opposer is also the registered owner of the trademark "PEPE IIXL" in England, its home country, as evidenced by Certificate of Registration no. 1,247,982, a copy of which is hereto attached as Annex "C" and make an integral part hereof;
4. The word "PEPE" is a part of the tradename of the Opposer and as such, it is entitled to protection under the provisions of Article 8 of the Convention of Paris for the Protection of Industrial Property without the obligation of filing or registration, whether or not it forms part of the trademark;
5. Opposer had long been using the trademark "PEPE" in several countries of the world including the Philippines. Due to promotion and advertising campaigns, its trademarks has become even more famous in major countries of the world including the Philippines, and identified with the products put up by Opposer;
6. On April 11, 1984, respondent-applicant, with obvious knowledge of the popularity of the opposer's trademark "PEPE" and the registration thereof in the Philippines, filed an application for the registration of the confusingly similar if not identical mark "PEPPER" alleging use in commerce on March 10, 1978, such use being likely to cause confusion or mistake or to deceive purchasers or the public;
7. More specifically, the public and patronizers of opposer's products are deceived into buying respondent's goods or are under the impression and mistaken belief that respondent's goods are identical with or come from the same source as opposer's products or that the respondent is an affiliate or a licensee of the opposer, which he is not;
8. Opposer's products have acquired immense popularity and goodwill and as a consequence of the sale of respondent's using the identical and/or confusingly similar trademark "PEPPER", respondent is thereby infringing the mark of the opposer which has consequently suffering damage due to the dilution of the value or goodwill of the mark and loss of prestige.

The sole issue to be resolved in this case is:

WHETHER OR NOT THE TRADEMARK "PEPPER" SOUGHT TO BE REGISTERED BY RESPONDENT-APPLICANT IS CONFUSINGLY SIMILAR TO THE MARK "PEPE" OF THE OPPOSER AS TO BE LIKELY, WHEN APPLIED TO OR USED IN CONNECTION WITH THE GOODS OF RESPONDENT, TO CAUSE CONFUSION, MISTAKE OR TO DECEIVE PURCHASERS PURSUANT TO SECTION 4(D) OF THE R.A. NO. 166, AS AMENDED.

Our Trademark Law, particularly Section 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 service 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 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”.

On September 26, 1988, Opposer through Counsel filed an Ex-Parte Motion to Declare Respondent-Applicant in Default for failure to file an Answer within the period set by the Rules, and be allowed to present its evidence ex-parte.

The Motion to declare Respondent-Applicant in Default has been GRANTED (Order No. 88-485 dated 10 November 1988).

Pursuant to the Order of default, Opposer presented its evidence Ex-Parte consisting of Exhibits “A” to “I-C” and its corresponding submarkings.

The evidence show that Respondent-Applicant’s trademark “PEPPER” is identical to Opposer’s trademark as both trademarks contained the same letters only that the Respondent-Applicant’s trademark has the letter “R” but as to appearance or in the manner of display, both marks are similar as well as in pronunciation, and considering further that the goods or products covered by the competing marks belong to Class 25. Hence, there is a factual basis to hold that Respondent-Applicant’s trademark is confusingly similar with the Opposer’s trademark.

Therefore, Opposer deserves protection under Section 4(d) of R.A. No. 166, as amended.

WHEREFORE, the Opposition is GRANTED. Application Serial No. 53589 filed by Juan Loa, for the trademark “PEPPER” 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. Likewise, let a copy of this Decision be furnished the Trademark Examining Division for information and to update its record.

SO ORDERED.

IGNACIO S. SAPALO
Director