

VERA CRUZ, INC.,
Junior Party-Applicant

) INTER PARTES CASE NO. 3642

) INTERFERENCE BETWEEN:

) Application Serial No. 64102
) Filed : March 4, 1988
) Applicant : Vera Cruz, Inc.
) Trademark : LUMBERJACK
) Used on : Shoes and other leather
) products namely: sandals,
) belts, wallets,
) handbags, boots,
) slippers, suitcases and
) waling sticks

) - versus -

) - and -

) Application Serial No. 62925
) Filed : October 8, 1987
) Applicant : Calzaturificio
) Antonini S.p.A.
) Trademark : LUMBERJACK &
) STYLIZED LEAF DEVICE
) Used on : Articles of clothing,
) including shoes, boots,
) and slippers

) CALZATURIFICIO ANTONINI
) S.p.A.,
) Senior Party-Applicant.

) DECISION NO. 92-22 (TM)

) August 28, 1992

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DECISION

This is an interference case declared by the Bureau relative to:

“1. Application Serial No. 63925 filed on October 8, 1987 by CALZATURIFICIO ANTONINI S.P.A., the herein Senior Party-Applicant, for the trademark “LUMBERJACK & STYLIZED LEAF DEVICE” used on articles of clothing, including shoes, boots and slippers Class 25;

2. Application Serial No. 64102 filed on March 4, 1988 by VERA CRUZ, INC., the herein Junior Party-Applicant used on shoes and other leather products namely: sandals and belts.

The Junior Party-Applicant, Vera Cruz, Inc. is a corporation organized and existing under the laws of the Philippines with address at 213 M. Roxas Street, San Roque Marikina, Metro Manila and the Senior Party-Applicant, Calzaturificio Antonini S.P.A. is a corporation organized and existing under the laws of Italy with principal address at Via Right 5, 37135, Verona, Italy.

The above-marks applied for by the parties contained the common word “LUMBERJACK”, all used on goods falling under the same class of goods (Class 25) which this Bureau considers as CONFUSINGLY SIMILAR and a clear case for interference proceedings.

A Notice of Interference was sent to the parties pursuant to Rule 182 of the Revised Rules of Practice in Trademark Cases to adduce evidence for the Bureau to determine which between the parties has the prior use and adoption of the subject mark.

On April 2, 1991, the Junior Party-Applicant, through Counsel, filed a Motion to Dissolve Interference alleging the following grounds to wit:

- “1. That the right of VERA CRUZ, INC. to use the mark has already become incontestable;
2. That the Senior Party-Applicant could not be considered to have been unduly prejudiced;
3. That the trademarks of the Senior Party-Applicant and the Junior Party-Applicant per judicial admission of the Senior Party can be allowed registration because there is no likelihood of confusion; and thus, no interference in fact exist.”

The motion to dissolve interference filed by the Junior Party-Applicant on April 2, 1991 was DENIED by this Bureau (Order No. 91-527 dated June 26, 1991) because the issue of priority and adoption and use of the marks in controversy could not be determined without the presentation by the parties of their respective evidence.

On the hearing of July 14, 1991, Counsel for the Junior Party-Applicant moved in open court that the Senior Party-Applicant be declared as in default for failure to appear on the scheduled pre-trial conference.

The Senior Party-Applicant has been declared as in Default (Order No. 91-829 dated October 21, 1991).

Pursuant to the Order of Default, the Junior Party-Applicant, presented its evidence ex-parte on December 10, 1991 consisting of Exhibits “A” and “A-1” to “J-99” and their corresponding submarkings.

Between the parties, who is the prior adaptor and user of the trademark “LUMBERJACK”?

On the basis of the admitted evidence presented, Junior Party-Applicant has been using the trademark “LUMBERJACK” in the Philippines prior to 1978 (Exhibits “A” and “A-1” and Exhibits “J-1” to “J-7”).

On the other hand, the Senior Party-Applicant, is not using the trademark “LUMBERJACK” in the Philippines as proven by the fact that its application filed with this Bureau on October 8, 1987 bearing Serial No. 62920 was based on Italian Home Registration No. 478418 dated April 21, 1987, hence, it did not allege the date of use in the application and such being the case, it will be limited to the filing date of the application as the date of FIRST USE which is October 8, 1987 and this is pursuant to Rule 173 of the Revised Rules of Practice in Trademark Cases which provides:

“Rule 173. Allegations in the application not evidence on behalf of the applicant. – In all inter partes proceedings, the allegations of date of use in the application for registration of the applicant or the registrant cannot be used as evidence in behalf of the party making the same. In case no testimony is taken as to the date of use, the party will be limited to the filing date of the application as the date of his first use”.

The Bureau, applying the above-mentioned Rule 173 of the Revised Rules of Practice in Trademark Cases, consider October 8, 1987 as the date of Senior Party-Applicant first used the mark. Under such circumstances, Junior Party-Applicant would be the prior user of the mark "LUMBERJACK" and therefore, entitled to register the same under its name.

WHEREFORE, premises considered, Application Serial No. 64102 filed on March 4, 1988 by VERA CRUZ, INC., the herein Junior Party-Applicant is hereby GIVEN DUE COURSE. Accordingly, Application Serial No. 62925 filed on October 8, 1987 by CALZATURIFICIO ANTONINI S.P.A. is hereby ordered REJECTED.

Let the filewrappers 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 records.

SO ORDERED.

IGNACIO S. SAPALO
Director