

EAST LAND SHOE MFG. CORP.
Opposer,

INTER PARTES CASE NO. 3742
Opposition to:

-versus-

Serial No.71682
Date Filed: April 24, 1990
Trademark: "EASTLAND DENISE
DEE TAN"

DENISE DEE TAN
Respondent-Applicant.
x-----x

DECISION NO. 97-32

DECISION

This pertains to an opposition to the application for registration of the trademark for "Eastland" for shoes with Serial No. 71682 under the name and business style of Denise Dee Tan, a citizen of the Philippines and a single proprietor with postal address at 10 4th Avenue, Grace Park, Caloocan City. The said application was published on page 83, Volume IV, No 6 of the BPTTT Official Gazette, November-December 1991 Issue.

The Opposer is a corporation organized and existing under the laws of the State of Maine, U.S.A, with office at 106 Park Street, Freeport ME 114032, United States of America.

Opposer relied on the following grounds to support its opposition:

1. That the trademark Eastland is part of the corporate name of the Opposer; hence, it is protected by R.A. 166.
2. That the trademark Eastland is known all over the world to be exclusively owned by the Opposer. The registration of an identical trademark EASTLAND in the name of Respondent-Applicant will be a breach of the clear provisions of Article 6bis of the Paris Convention for the protection of industrial property,
3. Respondent-Applicant's trademark EASTLAND is confusingly similar to that of opposers "Eastland and Device" trademark that the registration of the former will cause grave and irreparable injury to the Opposer;
4. Respondent was declared as in default for its failure to file an Answer. It has not even made any kind of response to this Honorable Bureau's order of default. This lack of interest on the part of respondent can only be construed as an admission that she is not the owner of the mark and has no intention of protecting the same.

On the basis of the evidence submitted by Opposer, the ultimate facts are as follows;

1. The Opposer is the lawful owner of the trademark "Eastland and Device" and has registered said trademark in the United States of America, Canada, Italy and France which are major countries and business centers of the world and are all members of the Paris Convention (Exhibits "D" to "G" and their submarkings);
2. The Opposer has pending applications of its trademark "Eastland and Device" in the following countries; Benelux, Denmark, Germany, Greece, HongKong, Iceland, Japan, South Korea, Spain, Sweden, Switzerland and United Kingdom (Exhibit "C" and its submarkings);

3. The worldwide annual sales for goods bearing the Opposer's trademark "Eastland and Device" from 1987 to 1991 are as follows:

Year	Sales in US\$
1987	23,000,000
1988	34,000,000
1989	41,000,000
1990	46,000,000
1991	48,000,000

4. The trademark "Eastland and Device" are being distributed in Japan (Exhibits "J", "K", "L", "M", "N", "O", "P", "Q", "R", and its submarkings); Cyprus, Canada, (Exhibits "U", "W", and its sub-markings), and has appeared in trade advertisements in various publications such as "Footwear News", "Footwear focus", "Kids Fashion", "Footwear Plus" (as shown in Exhibits "FFF", "GGG", "HHH", "III", "JJJ", "LLL", "MMM", "OOO", "PPP", "QQQ", "RRR", "SSS", "TTT", "UUU", billboards and radio advertisements; Exhibits "XXX", "YYY", "ZZZ" and "AAA").

On 20 March 1992, a Verified Notice of Opposition was filed, through Counsel, by herein Opposer. Correspondingly, a notice to answer was sent by registered mail to respondent requiring him to answer the opposition within fifteen (15) days from receipt of notice. However, as the records of the case will show, respondent did not file an answer nor any other responsive pleadings thereto.

Thus, on 25 January 1993, Opposer filed an urgent motion to declare Respondent-Applicant in default for failure to file an answer on time. In Order No. 93-87, dated 01 February 1993. Respondent was declared in default and Opposer was ordered to present its evidence ex-parte.

In compliance with our Order made in Open Court dated 18 March 1993, Opposer submitted its Formal Offer of Evidence with original exhibits and answers attached therein dated 29 March 1993. Subsequently, the Bureau, in Order No. 93-226 dated 5 April 1993, admitted the evidence for Opposer.

The issues to be resolved in this case are as follows:

- a) Whether or not Opposer has proven that it is the legal owner of the trademark "Eastland and Device" and is entitled to protection under Republic Act No. 166;
- b) Whether or not respondent-Applicant's trademark "Eastland" is confusingly similar to Opposer's trademark "Eastland and Device";
- c) Whether or not Respondent's application for registration of the trademark "Eastland" should be allowed.

As shown by the records of this case, the Opposer has sufficiently established that it is the prior user and lawful owner of the trademark "Eastland and Device", the same having been registered in the U.S.A., Canada, Italy and France, thus;

- a) United States of America
Registration No. : 1,253,838
Date of Registration : October 11, 1983

Class of Goods : 25
Goods : Men's, women's, misses', and boy's footwear
namely, shoes, boots and moccasins
Date of First Use : March 30, 1982; in commerce; March 30, 1982

b) *Canada
Registration No. : TMA 364, 181
Date of registration : January 12, 1990
Goods : Men's, women's, misses', and boy's footwear,
namely shoes, boots and moccasins.

*Used in Canada since at least as early as September 30, 1975

c) France
Registration No. : 1,688 632
Registration Date : 23 Aug. 1991
Class of Goods : 25

d) Italy
Registration No. : 531038
Registration Date : 23 giv. 1980
Class of Goods : 25

In comparison, Respondent-Applicant filed its application for registration only on 24 April 1990 under Application Serial No. 71682 for the same trademark before this Bureau barely or long after it has, been registered in the aforementioned countries. There are also pending applications of Opposers mark in other countries. Hence, applying therein the doctrine of prior use, Opposer does have the right to appropriate to its exclusive use the trademark "Eastland and Device" in conformity with Section 2-A of Republic Act No. 166.

Moreover, Opposers trademark EASTLAND Device has generated immense goodwill through extensive advertisements and authorized distributorship of its products worldwide.

In regard to the issue of confusingly similarity of the two trademarks, undoubtedly, there is an attempt on the part of the Respondent to ride on the goodwill and reputation of Opposer. This is sustained by the fact that Respondent wishes to obtain registration of the same trademark on the same related products, i.e. shoes, which Opposer is reputedly known to be an owner and manufacturer of.

Thus, by allowing registration of the trademark for the applicant would result in deception and confusion in the mind of the buying public upon the mistaken notion that the two trademarks ("Eastside" and "Eastside and Device) are one and the same and originated from the senior user which is the opposer in the case at bar:

In *Converse Rubber Corp., vs. Universal Rubber Products. Inc.*, (14 SCRA 154), viz:

"The determinative factor in ascertaining whether or not marks are confusingly similar to each other is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether use of such mark would likely cause confusion or mistake on the part of the buying public. The risk of damage is not limited to a possible confusion of goods but also includes confusion of reputation if the public could reasonably assume that the goods of the parties originated from the same source.

On this score, the Bureau will not and cannot allow registration (Serial No. 71682) of the trademark "Eastland" for shoes under the name of the Respondent-Applicant. Additionally, failure to submit evidence on her behalf further strengthen our belief that Respondent had nothing to

offer in evidence but to take advantage of the published trademark of the herein Opposer through the use of the same.

WHEREFORE, premises considered, the herein Notice of opposition is, as it is hereby, SUSTAINED. Accordingly, Application Serial No. 71682 filed by Ms. Denise Dee Tan on 24 April 1990 for the trademark cigarettes 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 with a copy to be furnished the Trademark Examining Division to update its record.

SO ORDERED.

Makati City, September, 1997.

EMMA C. FRANCISCO
Director