

EMINENCE S.A.,  
Opposer,

INTER PARTES CASE NO. 3272

-versus

OPPOSITION TO:

Application Serial No.:52840  
Filed: December 13, 1983  
Applicant: Fairland Knitcraft  
Co., Inc.  
Trademark: EMINENCE  
Used On: T-shirts, polos, jackets,  
pants and shorts

FAIRLAND KNITCRAFT  
Respondent-Applicant.

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DECISION NO. 90-7 (TM)  
February 20, 1990

### DECISION

On October 28, 1988, Eminence S.A. filed an unverified Notice of Opposition against the registration of the trademark "EMINENCE" used on T-shirts, polos, jackets, pants and shorts applied for by Fairland Knitcraft Co., Inc. on December 13, 1983 under Application Serial No. 52840, published on Page 92, Volume I, No. 7 of the BPTTT Official Gazette issue of September 27, 1988 and was released for circulation on September 30, 1988.

Opposer is a foreign company organized and existing under the laws of France, doing business at 38 Rue Florian, 30013 Nimes, France; while Respondent-Applicant is a domestic corporation organized under the laws of the Philippines, with business address at 1260 Juan Luna Street, Tondo, Manila, Philippines.

The grounds alleged in the verified Notice of Opposition submitted on December 27, 1988 are:

"1. Opposer is the owner of the trademark EMINENCE covering a wide range of goods falling, among others, under International Philippine Classes 1 to 34. Such ownership subsists up to date and has never been abandoned.

2. Opposer's ownership of the trademark EMINENCE, as used on various goods, most notably on clothing and underclothing, is evidenced by certificates of registrations which it obtained from, and applications for registrations which it filed with, government offices in many countries, notably European countries, the United States of America, Japan, South and Central American countries, African and Middle Eastern countries.

3. The trademark EMINENCE applied for by herein respondent-applicant is identical to Opposer's trademark, and its registration will run counter to Section 4(d) of Republic Act No. 166, as amended.

4. The trademark EMINENCE is a world famous mark and deserves protection as such pursuant to the Convention of Paris for the Protection of Industrial Property (Lisbon version) to which the Philippines became a signatory since 1968.

5. The applicant's act of appropriating the trademark EMINENCE for its use and benefit, to the extent of claiming ownership over the same, constitutes a blatant and reprehensible act of trademark piracy, which is violative of the Philippine government's long standing policy against counterfeiting."

On January 11, 1989, Respondent-Applicant was notified about this opposition and was required to file its Answer thereto within fifteen (15) days from receipt of said notice. For failure to file its Answer within the prescribed period despite receipt of the above-stated notice on January 17, 1969, Respondent-Applicant was declared in default in Order No. 89-147 dated February 2-2, 1969 and Opposer was allowed in said Order to present its evidence ex-parte.

Opposer, after a few extensions, presented its documentary evidence on August 28, 1989 consisting of Exhibits "A" to "L-3", inclusive, which were all admitted in evidence, in open court, for the offeror.

Since the trademark "EMINENCE" commonly claimed by the parties are identical, the issue to be resolved is whether or not Respondent-Applicant could register the contested mark in the light of Section 4(d) of Republic Act No. 166, as amended, the pertinent portions of which provides:

"SEC. 4. Registration of trade-marks, x x x on the principal register. - x x x  
The owner of a trademark x x x used to distinguish his goods x x x from the goods 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 trade-name registered in the Philippines or a mark or trade-name 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;" (Underscoring supplied)

Opposer proved its ownership and prior adoption and use of the mark "EMINENCE" by presenting its French Registration No. 271612 (Exh. "E") indicating therein that the mark has been applied for on March 23, 1937; that thereafter up to the present Opposer has registered the mark "EMINENCE" under Registration No. 1238645 (Exh. "B-1"), Registration No. 1161906 (Exh. "C-1") Registration No. 1141080 (Exh. "F-1"), Registration No. 475528 (Exh. "F-3"), and Registration No. 45973 issued on April 28, 1960 (Exh. "F-4") and, more particularly, the following registrations for the mark "EMINENCE".(Exhs. "F-4"/ Annex "E-10");

Registration No. 404,351 (Seine) issued July 5, 1950

Registration No. 404, 352 (Seine) issued July 5, 1950

Registration No. 1830 (Nimes) issued April 5, 1955

Opposer has also registered its mark "EMINENCE" with the World Intellectual Property Organization (WIPO), Geneva (Exh. "F-2"), in Singapore (Exh. "17"), in Hong Kong (Exh. "I", in Japan (Exh. "J-J-1"), in the United States of America (Exh. "K" and "K-1") and in almost all of the countries of the world (Exhs. "A", pp. 2 and 3), and therefore has already attained the attributes of a world famous and internationally known mark.

The records show that Respondent-Applicant's mark (file wrapper) is identical to the mark owned by the Opposer (Exhs. "L" to "L-3"). Respondent's alleged first use of the mark is only on January 15, 1976 (Respondent's trademark application), while Opposer filed its application therefore in its home country on March 23, 1937 (Exh. "E").

Overwhelming are the exhibits presented to prove Opposer's ownership, use and registration in its favor, of the mark "EMINENCE" while Respondent-Applicant did not bother any

more to follow up, much less defend its claim over subject mark in this case. Thus, he was declared in default as stated above.

Both France, the home country of Opposer, and the Philippines are, of judicial notice, members of the Convention of the Union of Paris for the Protection of Industrial Property where the member-countries thereof each undertakes to protect marks or tradenames in all the countries of the Union without the obligation of filing or registration, whether or not they form part of a tradename (Articles 6bis and 8 of the Paris Convention in relation to Section 37 of Republic Act 166, as amended).

The registration of the mark "EMINENCE" in Application Serial No. 52840 filed by the Respondent-Applicant, in the light of the foregoing circumstances, is proscribed under Section 4(d) of Republic Act No. 166, as amended.

WHEREFORE, this Notice of Opposition is SUSTAINED. Accordingly, Application Serial No. 52840 is REJECTED.

Let the records of the case be forwarded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO  
Director