

FRED PERRY SPORTSWEAR LTD.,
Petitioners,

INTER PARTES CASE NO. 1929

PETITION FOR CANCELLATION

Cert. of Regn. No. SR-4378
Issued : November 29, 1979
Registrant : Chan Artie
Trademark : JOHN PERRY
Used on : T-shirts, polos,
jackets

- versus -

CHAN ARTIE,
Respondent-Registrant.

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DECISION NO. 88-19 (TM)
March 24, 1989

DECISION

This Petition was filed on April 23, 1985 by Fred Perry Sportswear Ltd. for the cancellation of Certificate of Registration No. SR-4378 bearing the trademark "JOHN PERRY" used on T-shirts, polos and jackets issued to Chan Artie on November 29, 1979.

Petitioner is a foreign corporation duly organized under and by virtue of the laws of England, with offices located at No. 2300 Delmar Boulevard, Saint Louis, Missouri 63166, United States of America, while Respondent-Registrant is a Filipino citizen, with address at No. 1170 Padre Algue Street, Tondo, Manila, Philippines.

The grounds for cancellation alleged in the Petition are as follows:

"a) That the registration is contrary to the provisions of Section 4(c) of Republic Act 166, as amended;

b) That the registration is contrary to the provisions of Section 4(d) of Republic Act 166, as amended;

c) That the registration is contrary to the provision of Section 37 of Republic Act 166, as amended;

d) That the registration is contrary to the Memorandum dated November 20, 1980 made by the Minister of Trade;

e) That the registration is contrary to the provisions of Executive Order No. 913 by the President of the Republic of the Philippines; and

f) That when the said registration was still being applied for, the Philippine Patent Office has issued Paper No. 3 dated November 12, 1979 holding that the trademark John Perry being applied for is confusingly similar to the Petitioner's 'FRED PERRY'."

The facts relied upon in support of the Petition are:

"a) The trademark 'JOHN PERRY' of the respondent-registrant is a flagrant and veritable imitation of Petitioner's 'FRED PERRY' as to be likely to cause confusion, mistake or deception to the purchaser as to the goods themselves or as to the source of the goods;

b) The trademark 'FRED PERRY' has been used in the Philippines long prior to the alleged use and registration of the trademark 'JOHN PERRY' of the Respondent-Registrant and the herein Petitioner has acquired an immense goodwill in the Philippines and its goods have acquired the reputation of high quality products by the purchasing public;

c) The Philippine Patent Office has consistently upheld the rights of the Petitioner over the trademark 'FRED PERRY' as held in the cases of Fred Perry vs. Nylex Industrial Corporation (IPC 1539); Fred Perry vs. Rosalina Gaw (IPC 1446) and Fred Perry vs. Victor Yap (IPC 884)."

On May 3, 1985, this Office sent by registered mail with return card to Respondent-Registrant a Notice of the filing of the herein Petition enclosing a copy thereof requiring him to file his Answer within fifteen (15) days after receipt of the Notice. Petitioner filed on September 3, 1985 a Motion to declare Respondent-Registrant in default. And on September 17, 1985, Petitioner filed another Motion praying that the law firm of Messrs. Poblador, Azada & Associates be deputized to serve an Alias Notice to Answer to Respondent. Per Office Order No. 85-316 dated September 24, 1986, the Motion to declare Respondent-Registrant in default was denied but the Motion to deputize was granted.

On December 3, 1985, Petitioner filed an Ex-Parte Motion for authority to serve the Notice to Answer by publication in view of the failure of Messrs. Poblador, Adana & Associates to carry out personal service on Respondent, which Motion was granted. No Answer having been filed after the lapse of fifteen (15) days from the date of last publication, this Office on Motion by Petitioner declared Respondent in default.

On March 5 and April 11, 1985. Petitioner presented its evidence and subsequently submitted its written Formal Offer of Evidence on August 25, 1986 consisting of the following exhibits:

Exhibits "A" to "A-2" –

Power of Attorney executed by Petitioner, Fred Perry Sportswear, Ltd. signed by John H. Hornickel, Secretary, appointing the law firm, Poblador, Azada & Associates, to act as its agents or attorneys in this case, and the signature of K. R. Kasperski, Notary Public, to show that the firm is duly authorized to represent Petitioner.

Exhibits "A-3" to "A-4" –

Certification of the Country Clerk of the County of Henrico and as such the Clerk of the Circuit Court thereof certifying that K. R. Kasperski is a Notary Public at the time the Power of Attorney was acknowledged before him and the signature of Margaret B. Baker, Clerk of Court, Circuit Court of Henrico County to establish the fact that the Power of Attorney was duly executed by Petitioner.

Exhibits "A-5" to "A-10" –

Certificate of the Secretary of the Commonwealth of Virginia that Margaret Be Baker was and is the Clerk for the Circuit Court of Henrico County, Virginia, and the signature of Laurie Naismith; certification of the Department of State of Virginia signed by Annie Re Maddux, authentication officer of the Department of State for John C. Whitehead, and the signature of Annie R. Maddux; certificate of authentication by the Philippine Consulate signed by Vice-Consul Reginald A. Velasco and the signature of the Vice-Consul, all to show that Exhibit "A" has been properly authenticated in accordance with law.

Exhibits "B" to "B-2" –

Xerox copy of the trademark registration signed by Marlin Mullet, Joint Secretary of Fred Perry Sportswear, Ltd., indicating therein the different trademark registration numbers of Fred Perry Sportswear, Ltd., marks and goods embraced by each registration sworn to before Notary Public Sophia Junz; and the signature of Marlin Mullet and Notary Public Sophia Junz to show that Fred Perry Sportswear, Ltd. is the owner of several trademark registrations of goods standing in the United Kingdom.

Exhibits "B-3" and "B-4" –

Certification of the State of Missouri that Sophia Junz was and is a Notary Public, and the signature of Roy Blunt, Secretary of State, to show that Exhibit "B" has been duly identified in accordance with the rules.

Exhibits "B-511 and "B-6" –

Certificate of authentication by the Philippine Consulate signed by Stephen V. David, Vice-Consul, and his signature to show that Exhibit "B" has been properly authenticated in accordance with law.

Exhibits "C" to "C-5" –

Brochures of Fred Perry Sportswear, Ltd., advertising and depicting sports apparel, such as clothes, T-shirts, shoes, pants for the years 1985 and 1986; Fred Perry Export Price List effective as of September 1, 1985 to show extensive worldwide advertisement of Fred Perry products.

Exhibits "D" to "D-3" –

Xerox copy of Certificate of Registration No. 11189 showing Fred Perry Sportswear, Ltd. has registered the trademark in the Principal Register of the Philippine Patent Office and the date of its registration which is July 2, 1964; the statement of first actual use in Great Britain and Northern Ireland in the year 1952, and in the Philippines – December 3, 1962 – to show priority of registration and use.

Exhibit "D-4" –

Certificate issued by the Philippine Patent Office to the effect that Certificate of Registration No. 11189 as presented herein as Exhibits "D", "D-1", "D-2" and "D-3" is a true copy from the records of said Office to show that Certificate of Registration No. 11189 as presented is a true copy from the records of said Office.

Exhibits "E" to "E-4" –

Certified true copy of the trademark application filed with the Philippine Patent Office by Fred Perry Sportswear, Ltd. with Serial No. 43470 filed by Walter Henry Nurse, Managing Director; Laurel Wreath Device; trademark application showing the date filed and serial number; certification by Robert Anthony Duff Urquhart, Notary Public, as to the genuineness of the signature of 'W. H. Nurse'; authentication made by the Philippine Embassy in London duly signed by Alice Palacios, Consul, to show that trademark Application Serial No. 43470 was really filed with the Philippine Patent Office; that trademark Application Serial No. 43470

was duly executed by the authorized representative of Petitioner; and that the document has been authenticated in accordance with law.

Exhibit "E-5" –

Letter addressed to the Director of Patents dated December 12, 1980 regarding the application duly signed by Godofredo L. Tuaño to show the reason for the filing of the application.

Exhibits "E-6" and "E-7" –

Certification signed by Purita S. Campilla, Acting Chief, Application, Issuance and Documentation Division and attested by Eduardo R. Joson; signature of Purita S. Campilla and Eduardo R. Joson, to show that Application Serial No. 43470 as presented is a true copy from the records of the Philippine Patent Office.

Exhibits "F" and "F-1" –

U. K. Certificate of Registration No. 991254 for the trademark "FRED PERRY & LAUREL WREATH DESIGN" registered on April 28, 1972.

Exhibits "G" and "G-1" –

U. K. Certificate of Registration No. 875071 for the trademark "FRED PERRY" registered on February 1, 1965.

The foregoing evidence establishes the ownership and prior use of the trademark "FRED PERRY" in the United Kingdom (Exhs. "F" to "F-1"; and "G" to "G-1") and in other foreign countries (Exhs. "B" to "B-2" and "C" to "C-5"), while Respondent's claim of "first use" of his trademark "JOHN PERRY" was only on September 1, 1976 and was allowed registration merely in the Supplemental Register. Petitioner was also first in the use in commerce of the word "PERRY" in the Philippines, though identifying itself only as owner of the mark "LAUREL WREATH DESIGN".

The issue at bar is whether the trademark "JOHN PERRY" registered by Respondent-Registrant is confusingly similar with the "FRED PERRY" trademark of Petitioner.

It was found out however from the records of the case that:

- (a) Respondent-Registrant's business office had already closed shop (Order No. 85-380);
- (b) Respondent-Registrant did not or failed to file his Answer to the Notice of Opposition up to this date despite Notices done by registered mail, by personal service (Order No. 85-380), and by publication (Order No. 86-46);
- (c) Respondent-Registrant has been declared in default in Office Order No. 86-46 dated February 11, 1986; and, most importantly,
- (d) Respondent-Registrant did not or failed to file its Affidavit of Use after the fifth year and within the sixth year of its registration as required by the rules.

In view hereof, the contested trademark "JOHN PERRY", for all intents and purposes, is now considered and is hereby declared ABANDONED by Respondent-Registrant.

WHEREFORE, there being nothing more to oppose, this case is hereby DISMISSED for having become moot. Certificate of Registration No. SR-4378 for the mark "JOHN PERRY"

issued on November 29, 1979 to herein Respondent-Registrant is hereby ordered CANCELLED from the Trademark Registry of the Office.

Let the records of this case be transmitted to the Application, Publication and Documentation Division for appropriate action in accordance herewith.

SO ORDERED.

IGNACIO S. SAPALO
Director