

JEEP EAGLE CORPORATION,  
Opposer,

INTER PARTES CASE NO. 3521  
Opposition to:

-versus-

Serial No.64667  
Date Filed: May 13, 1988.  
Trademark: "EAGLE"

ERNESTO A. GABULAT  
Respondent-Applicant.

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DECISION NO. 97-08

### DECISION

This is an Opposition filed by Jeep Eagle Corporation of the City of Highland Park, Michigan, U.S.A. in the matter of the application for registration of the mark "EAGLE" with Serial No. 64667 filed on May 13, 1988 in the name of Ernesto A. Gabuat, Filipino citizen doing business under the name and style EAG Intertrade Corp., with business address at 2<sup>nd</sup> Floor, DEL-BEN Bldg., 1090 Pasong Tamo Street cor. Ponce Street, Makati City.

The grounds for Opposition are as follows:

- "1. Opposer is the owner of the trademark EAGLE which is used for motor vehicles under International Class 12. The mark EAGLE is used and registered internationally to identify goods manufactured or licensed by the Opposer;
- "2. The trademark EAGLE which Opposer has created, adopted and used is well-known, having acquired international recognition and goodwill for its quality products bearing said mark;
- "3. On May 13, 1988, Respondent-Applicant filed with the Patent Office application for registration of the mark EAGLE for utility vehicles under Application Serial No. 64667 and said application was duly published in the Official Gazette;
- "4. Respondent-Applicant's goods and those of the Opposer and/or its licensees/distributor belong to the same class of goods; such that, use of the trademark EAGLE in connection with Applicant's goods may cause confusion or mistake or deceive purchasers as to source or origin of said goods to such an extent that they may be mistaken by the unwary public as being products originating from the Opposer or its licensees/distributors, to the damage and prejudice of the latter.
- "5. The Respondent-Applicant's mark EAGLE is identical to the trademark of Opposer which is used and registered for vehicles in foreign countries members of the Paris Convention and which trademark of Opposer is entitled to protection in the Philippines under the provisions of the Paris Convention.
- "6. Applicant's use of the mark EAGLE for vehicle will also damage Opposer since said mark EAGLE is a part of the tradename of the Opposer Jeep Eagle Corporation which tradename is also protected in the Philippines under the provision of the Paris Convention.
- "7. Opposer would be damaged by the registration of the Respondent's mark EAGLE because said registration may prevent Opposer's registration of the mark EAGLE and use of the same mark by the latter's licensees in the Philippines. Loss of the ability of the Opposer to market in the Philippines its EAGLE products which have acquired excellent

reputation and goodwill in the other countries of the world would irreparably injure Opposer.

"8. The long use of and the large amounts spent by Opposer in popularizing its trademark EAGLE has generated immense goodwill for said trademark EAGLE which has become a strong and distinctive mark of Opposer.

"9. The use and adoption by Respondent-Applicant of the trademark EAGLE which is confusingly identical with Opposer's trademark may tend falsely to suggest connection with the business of the Opposer and therefore constitute fraud upon the purchasing public."

Immediately upon receipt of Opposer's verified Notice of Opposition, this Office sent to Respondent-Applicant a Notice to Answer requiring him to answer the Notice of Opposition which Respondent has not received. Thereafter, an Alias Notice to Answer was sent to Respondent which was received by his representative on January 24, 1991.

On June 03, 1991, this Bureau issued Order No. 91-487 declaring Respondent-Applicant in default for failure to file his answer within the reglementary period despite several notices. Consequently, the herein Opposer was allowed to present its evidence ex-parte on various occasions. On 11 March 1992, Opposer filed its Formal Offer of Evidence, and thereafter, on April 02, 1992, Opposer submitted its Memorandum.

The issue to be resolved in this case is:

Whether or not the use and adoption of the trademark "EAGLE" at the same time by the opposing parties would cause confusion and fraud to the general public by reason of confusing similarity in the identity of the aforementioned trademark.

Opposer's mark "EAGLE" bears the same words and the same pronunciation vis-a-vis that of applicant's. The appearance of eagle's head and horizontal lines in Applicant's mark are not highly distinctive to impress upon the public perception of dissimilarity in mark and variance in origin (Exhibit "B-1"- and "D-3").

Moreover Opposer's mark is being used on motor vehicles and other goods in International Classes 7, 9, 11, 12 and 37 (Exhibit "C", "C-2") while that of Respondents on utility vehicles, both of which are related goods.

In *Esso Standard Eastern, Inc. vs. Court of Appeals* 116 SCRA 336, the Supreme Court defined "related goods", thus:

x x x

"Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their forms, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores..."

Having established that the mark "EAGLE" is being used for related products, there would clearly be confusing similarity that would lead to confusion and deception of the purchasing public if the herein Respondent will be allowed to appropriate and use the same mark in the Philippines for utility vehicles without authority from the herein Opposer.

WHEREFORE, the Notice of Opposition is hereby SUSTAINED. Accordingly, Application Serial No. 64667 for the trademark "EAGLE" for utility vehicles filed by herein Respondent-applicant 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 and let a copy of this decision be furnished the Trademark Examining Division for information and to update its record.

SO ORDERED.

Makati City, November 10, 1997

EMMA C. FRANCISCO  
Director