

KIRKBI A/S and  
LEGO OVERSEAS A/S,  
Opposer,

INTER PARTES CASE NO. 3004

OPPOSITION TO:

- versus -

Application Serial No. 50698  
Filed : March 22, 1983  
Applicant : Paramount Vinyl  
Products Corp.  
Trademark : LEGO  
Used on : shoes and sandal

PARAMOUNT VINYL PRODUCTS CORP.,  
Respondent-Applicant.

x-----x

DECISION NO. 89-43 (TM)  
July 10, 1989

### DECISION

This is an opposition filed against the applications of Paramount Vinyl Product's Corp. of the trademark "LEGO" under Serial No. 50693 for shoes and sandals in Class 25 instituted by Kirkbi A/S and Legal Overseas A/S on March 22, 1983.

Opposers herein are corporations organized and existing under the laws of Denmark with principal business address at DK 7190 Billund, Denmark, whereas Respondent-Applicant is also a corporation duly organized and registered under the laws of the Philippines with business address at No. 56 G. de Jesus Street, Caloocan City, Philippines.

The records reveal that the Opposer Kirkibi A/S is the duly registered owner of the trademark "LEGO" under Registration No. 52478 issued by this Office on August 18, 1983 for toys under Class 28, while Respondent-Applicant filed an application for registration of the same trademark on March 22, 1983 under Serial No. 50698 for shoes and sandals under Class 25.

Opposers alleged the following grounds in its opposition:

1. The trademark "LEGO" of respondent-applicant is similar to Opposer's trademark and/or tradename "LEGO" x x x to such an extent that they may be mistaken by the unwary public as related to the products manufactured and sold by Opposers;
2. Opposer's trademark and/or trade-name "LEGO" has been previously registered with the Philippine Patent Office and is being presently used;
3. Opposers' trademark and/or trade-name "LEGO" is well-known throughout the world and in the Philippines and said mark and/or tradename has become distinctive of Opposers' goods and business;
4. The mark "LEGO" has been used and is presently used and adopted by Opposers in overseas trade as its tradename and/or businesses name; and
5. Opposers' mark and/or tradename "LEGO" had long been established and obtained general international consumer recognition, as belonging to one owner or origin, the opposers herein."

On February 29, 1988, Respondent—Applicant was served with a Notice to Answer the Notice of Opposition within fifteen (15) days from receipt thereof. When Respondent-Applicant failed to file an Answer or responsive pleading within the prescribed period, the Respondent, on motion of the Opposer, was declared in default.

On February 5, 1989, Opposers' counsel presented evidences ex-parte and the case was submitted for decision. These are (1) Certificate of Registration No. 32478 issued by the Bureau to the Opposer on August 18, 1983 for toys; (2) specimens of labels actually used on its products together with the advertisement in local publications (Exhs.-"A-30" to "A-34"), and (3) certified copies of several registrations of the mark in sixteen (16) countries.

The issue in this case is whether or not the application for the trademark "LEGO" under Serial No. 50093 for shoes and sandals should be given due course.

As gleaned from the evidences presented by the Opposers, there is substantial proof of continuous use of the trademark "LEGO" not only in the Philippines but also in more than 100 other parts of the world (Exhs. "A-1" to "A-16"). The opposition should be given due course.

Failure of Respondent-Applicant to file an Answer to the Opposition and his subsequent failure to file a motion to set aside the Order of Default indicates lack of interest on the part of Respondent-Applicant in establishing and protecting whatever rights he has over the trademark "LEGO" is rejected.

WHEREFORE, the Opposition is hereby given due course. Accordingly, Application Serial No. 50693 for the trademark "LEGO" is rejected.

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

SO ORDERED.

IGNACIO S. SAPALO  
Director