JEANNE LANVIN,

Opposer,

INTER PARTES CASE NO. 1659

**OPPOSITION TO:** 

Application Serial No. 35237

Filed Applicant

: May 11, 1978 : Horacio R. Cebrero, Jr.

Trademark

: JL CEBRERO

Used on

: T-shirts, pants, blouses,

jeans, shorts and jackets

HORACIO R. CEBRERO Respondent-Applicant.

- versus -

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DECISION NO. 89-36(TM) June 20, 1988

## **DECISION**

On May 11, 1978, Horacio R. Cebrero, Jr., a Filipino businessman, filed an application for registration in the Principal Register of the trademark "JL CEBRERO" for use on T-shirts, pants, blouses, jeans, shorts and jackets.

On December 13, 1982, an Opposition to the registration of the above-mentioned trademark was filed by Jeanne Lanvin, a foreign corporation organized and existing under the laws of France, on the grounds, among others, that the subject mark is primarily merely a surname and, therefore, unregistrable under Section 4(e) of Republic Act 166, as amended, and that the subject mark is confusingly similar with Opposer's trademark "DOUBLE TRIPLE L". On January 20, 1983, Respondent filed its Answer to the Opposition, denying specifically all the material allegations therein.

On April 23, 1984, Opposer filed a Motion to Remand Respondent's application to the Principal Examiner for further examination on the same grounds of confusing similarity and unregistrability under Section 4(e) of Republic Act 166, as amended. On May 9, 1984, Respondent filed an Opposition to the said Motion to Remand on the grounds that the "mark should not be dissected", and that Respondent's mark is not violative of the said Section 4(e). On May 23, 1984, Opposer filed a Reply to the said Opposition to Motion to Remand, stating, among others, that "though marks are to be considered in their entireties, their dominant features could convey impressions to the buying public which could ultimately cause the likelihood of confusion, mistake and deception". On June 6, 1984, Respondent filed a Rejoinder to Opposer's Reply, stating, among others, that "trademark JL CEBRERO is a composite or technical mark; hence, it has dominant features to obviate the likelihood of confusion on the part of the buying public".

However, on June 19, 1986, the parties, through their counsel, submitted a Compromise Agreement duly signed by them, the contents of which are hereunder reproduced:

"X X X

- 2. In the spirit of mutual goodwill and to avoid inconvenience attendant to litigation, the parties hereto have agreed to submit this Compromise Agreement under the following terms and conditions, to wit:
  - a) Opposer will no longer prosecute the instant case and agrees to the issuance of a trademark certificate of registration in favor of respondent-applicant as the latter has agreed to comply with the undertaking stated hereunder;

- b) In consideration of the foregoing, respondent-applicant obliges himself to always use the letters JL with the surname CEBRERO in all of his labels considering that his main interest and concern is the perpetuation of said surname;
- Respondent-applicant will likewise see to it that the lone presentation of the letters JL with the surname CEBRERO at the outside portion of the goods covered thereby would be entirely different from the Opposer's Double Triple L logo;

hence, it will always consist of, as it presently does, a sailboat with the letters JL inscribed in the sails thereof, provided that the letters JL shall be presented in the same manner that such letters appear in respondent-applicant's trademark 'JL CEBRERO' as shown by copies of the tag/label 'JL CEBRERO' hereto attached as Annex 'A', provided further that whenever the sailboat device shall be used by the respondent-applicant upon his goods, such goods will always be accompanied by the tag/label bearing the 'JL CEBRERO' trademark as above-cited;

- d) In the event that said respondent-applicant fails to observe or comply with the foregoing or make subsequent changes in the presentation of the letters JL in order to conform the same with the Double Triple L logo, giving rise to confusing similarity thereto, then outright cancellation of the respondent-applicant's trademark certificate of registration shall be ordered by this Honorable Office at the instance of Opposer herein;
- e) On the other hand, should Opposer file anew a case against respondentapplicant despite the latter's compliance with the foregoing undertaking, then respondent-applicant shall have the right to file a damage suit in a regular court against the Opposer;
- 2. This Compromise Agreement has been voluntarily entered into by the parties and not by reason of mistake, fraud, violence, intimidation or undue influence;
- 3. This Compromise Agreement shall be final and executory upon submission of the same to this Honorable Office.

Finding the said Compromise Agreement to be in order and not contrary to law or rules of this Bureau, the same is APPROVED. The parties are enjoined to observe strictly the provisions thereof.

WHEREFORE, this Opposition is DISMISSED for being moot and academic. Respondent's application for registration of the trademark "JL CEBRERO" (Serial 140. 35237) is given due course.

Let the records of this case be remanded to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO Director