

PROCTER & GAMBLE PHILIPPINES, INC.,

Opposer,

- versus -

HENKEL KOMMANDITGESELLSCHAFT AUF AKTIEN,
Respondent-Applicant.

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INTER PARTES CASE NO. 3304

OPPOSITION TO:

Application Serial No.: 61887
Filed: June 11, 1987
Applicant: Henkel Kommanditgesellschaft auf Aktien
Trademark: PERLA
Used On: Starch for laundry

DECISION NO. 90-20 (TM)
April 2, 1990

DECISION

This is an opposition filed on December 26, 1988 by Opposer, Procter & Gamble Philippines, Inc., to the trademark application of Respondent-Applicant, Henkel Kommanditgesellschaft auf Aktien, with Serial No. 61887 filed on June 11, 1987 and published on Page 16, Vol. I, No. 9 of the BPTTT Official Gazette dated November 29, 1988 for the trademark "PERLA" used on starch for laundry use, classified under Class 3.

Opposer is a corporation duly organized and existing under the laws of the Philippines with principal office located at 777 Solid Bank Building, Paseo de Roxas, Makati, Metro Manila, while Respondent-Applicant is a foreign corporation with business address at Henkelstr 67, D-4000 Dusseldorf-Holthausen, Federal Republic of Germany.

The grounds of the opposition are as follows:

1. Opposer is the owner of the trademark "PERLA" for laundry soap in Class 4 (now Class 3);
2. The trademark "PERLA" applied for by Respondent-Applicant is identical to Opposer's "PERLA" trademark;
3. Opposer has, since its adoption, continuously applied the trademark "PERLA" to its products, package and containers of said products and the labels affixed to said packages and containers. Consequently, the trademark "PERLA" has come to be and is now popularly known throughout the Philippines such that Opposer product bearing the mark "PERLA" has become identified as coming from Opposer;
4. The tremendous goodwill established by the mark "PERLA" nurtured through its long use, the superior quality of its products and public assistance is an invaluable asset of the Opposer which must be protected from trademark poachers; and
5. Opposer believes that the registration of the trademark subject of this application will cause great and irreparable damage and injury to it.

On January 10, 1989, Respondent-Applicant received, together with a copy of the Notice of Opposition, a notice requiring it to file its Answer within fifteen (15) days from receipt of said notice.

On January 23, 1989, Respondent-Applicant filed an urgent motion requesting for a 30-day extension from January 21, 1989 within which to file its Answer. Said motion was granted under Order No. 89-104 issued on February 10, 1989.

The 30-day extension has lapsed yet no Answer was filed by Respondent-Applicant. As a result, on April 27, 1989, Opposer filed a motion to declare Respondent-Applicant in default, which was granted in Order No.89-304 dated May 5, 1989. Accordingly, Opposer was allowed to present its evidence ex parte.

On June 1, 1989, Opposer formally offered its evidence consisting of Exhibits "A" to "H", inclusive, and the same was admitted by the Office in open court. Nine days thereafter, Opposer filed its Memorandum and the case was deemed submitted for decision.

To be resolved in this case is the question of whether or not Respondent-Applicant's application for registration of its trademark "PERLA" be given due course. The Office finds in the negative.

In the first place, Opposer is the registered owner and proprietor of the trademark "PERLA" for laundry soap in Class 3 by virtue of its original Certificate of Registration No. R-676 issued on November 12, 1969 (Annex "B") and its renewal application filed on March 15, 1988 (Annex "C").

Secondly, Opposer is the first user of the trademark "PERLA" in the Philippines, having used it in this country since May 14, 1925 (Annex "A-2" and since then used the mark extensively and continuously up to the present (Annexes "E", "F" and "C").

Further, the respective marks of the parties are identical and used in connection with the same class of goods. Consequently, to allow registration of Respondent-Applicant's mark would result in confusion or mistake or deception or purchasers as to the goods themselves and/ or as to their origin, causing irreparable injury to Opposer.

Respondent-Applicant's mark is not registrable as per Section 4 (d), Republic Act 166, as amended.

WHEREFORE, premises considered, this Opposition is hereby SUSTAINED and Respondent-Applicant's Application Serial No. 61887 for the registration of the trademark "PERLA" in its name is REJECTED.

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

SO ORDERED.

IGNACIO S. SAPALO
Director