

BAYERISCHE MOTOREN WERKE,
AKTIENGESELLSCHAFT,
Opposer,

INTER PARTES CASE NO. 3535

OPPOSITION TO:

Application Serial No. 66778
Filed: January 27, 1989
Applicant: Ho Jang Industries
Trademark: "HOU CHIEN" & Device
Used on: Pump

- versus -

HO JANG INDUSTRIES, CO. LTD.,
Respondent-Applicant.

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DECISION NO. 90-43 (TM)

November 14, 1990

DECISION

On June 6, 1990, Bayerische Motoren werke, Aktiengesellschaft, a joint stock company organized and existing under the laws of the Federal Republic of Germany and doing business at 130 Petuedring, 8000 Munich 40, Federal Republic of Germany, filed its verified Notice of Opposition (Inter Partes Case No. 3535) to Application Serial No. 66778 for the trademark "HOU CHIEN & DEVICE" used on pump, which application was filed on January 27, 1989 by HO JANG INDUSTRIES CO. LTD. of PING TUNG, Taiwan, China which was published in the Official Gazette of the Bureau of Patents, Trademarks and Technology Transfer Volume 11, No. 12, released for circulation on February 6, 1990.

The following were the grounds stated in the opposition:

- 1) The registration of the captioned trademark is contrary to the provisions of Sec. 4(d) Chapter 11 of R.A. No. 166, as amended;
- 2) Opposer is the owner of the trademark "BMW & DEVICE and BMW LOGO" duly registered with the then Philippine Patent Office (now Bureau of Patents, Trademarks and Technology Transfer) under Certificates of Registration No. R-3338 and 16398 issued on May 17, 1984 and April 7, 1971, respectively;
- 3) The BMW & DEVICE and BMW Logo are well known or world famous marks and the registration of respondent-applicant's "HOU CHIEN & DEVICE" mark will constitute a violation of article 6bis of the Convention of Paris for the protection of Industrial property in conjunction with the Memoranda of the then Minister of Trade dated November 28, 1980 and October 25, 1983;
- 4) The registration of the captioned mark will cause confusion or mistake or will deceive purchasers in view of the fact that it is confusingly similar to and in a colorable imitation of the opposer's mark "BMW & DEVICE and BMW LOGO".

Opposer relied on the following facts to support its opposition:

- a) Long before the alleged date of first use of the respondent-applicant on September 12, 1987 of the trademark "HOU CHIEN & DEVICE" herein opposer has adopted, used and registered the trademark "BMW & DEVICE" in Germany on December 10, 1917 and internationally registered under no.

173813 (7th January 1954). The said trademark was thereafter used and registered in several countries of the world including the Philippines.

- b) Opposer is likewise the registered owner of the trademark "BMW LOGO" in Germany and other foreign countries, covering, T-shirts, lighters, umbrellas and sunglasses.
- c) BMW & DEVICE and BMW LOGO are widely promoted and featured in advertisements and by virtue of their long continuous and extensive use and various registrations in several countries of the world, these marks have gained international fame and acceptance.
- d) By virtue of the use; Opposer of its aforesaid marks in international commerce, the sale of its products depicting its said marks on an international scale, opposer's products have acquired immense popularity and goodwill and placed the said marks in the rank or category of internationally famous marks.
- e) The registration of respondent-applicant's trademark "HOU CHIEN & DEVICE" (consisting of the BMW device and/or BMW Logo) which is identical and/or obviously a colorable imitation of opposer's well-known BMW & Device and/or BMW Logo will be violative of the memoranda of the then Minister of Trade dated November 20, 1980 and October 25, 1983, which prohibits the registration of world famous marks by applications other than their true owners.
- f) The business reputation established and acquired by opposer through the years of continuous and exclusive use of its BMW & DEVICE and BMW Logo is likely to be seriously jeopardized and impaired. Consequently, opposer will continuously suffer damages due to the dilution of the value of its mark and loss of prestige.
- g) Further, respondent-applicant's adoption and use of its trademark is not a mere coincidence but is a result of a deliberate and well calculated scheme to take advantage of the popularity and goodwill of opposer's aforesaid marks.
- h) Finally, the adoption and use of respondent-applicant of the BMW DEVICE and BMW LOGO without the authorization or consent of the opposer will likely influence purchasers to believe that the goods sold are those of the opposer or sponsored or connected with the opposer and/or a licensee of opposer thereby defrauding and damaging the public in general and the opposer in particular.

Respondent-Applicant through counsel filed a Manifestation and Motion stating that it received a Telex from Respondent-Applicant's Taiwanese Counsel that it is no longer interested in pursuing its trademark Application Serial No. 66778 subject of this Inter Partes Case No. 3535 and is, therefore voluntarily withdrawing said application for the mark "HOU CHIEN & DEVICE" which was relayed to the Director of this Bureau on October 16, 1990 upon the filing of the Manifestation and Motion (See Annex "A").

WHEREFORE, Application Serial No. 66778 for the trademark "HOU CHIEN & DEVICE" is hereby declared voluntarily ABANDONED. Accordingly, this Opposition Case is DISMISSED for being moot and academic.

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

SO ORDERED.

IGNACIO S. SAPALO
Director