

ESPRIT INTERNATIONAL)	INTER PARTES CASE NO. 3541
Opposer,)	
)	OPPOSITION TO:
)	
)	Application Serial No. 45124
)	Filed : June 9, 1981
)	Applicant : Eduardo Sy
- versus -)	Trademark : ESPRIT
)	Used on : T-shirts, jeans,
)	jackets, socks,
)	briefs, polo,
)	blouses, and
)	shirts
)	
)	<u>DECISION NO. 92-16 (TM)</u>
EDUARDO SY,)	
Respondent-Applicant.)	August 3, 1992
x-----x)	

DECISION

On May 31, 1990, ESPRIT INTERNATIONAL, a limited partnership organized and existing under the laws of California, U.S.A., domiciled in the U.S.A., with offices at 900 Minnesota Street, San Francisco, California, U.S.A. filed its Verified Notice of Opposition (Inter Partes Case No. 3541) to Application Serial No. 45124 for the trademark "ESPRIT" used on t-shirts, jeans, jackets, socks, briefs, polos, blouses and skirts, Class 25, which application was filed on June 19, 1981 by Eduardo Sy, a Filipino citizen, with address at 251 Roosevelt Avenue, Quezon City, which was published on page 21, Vol. II, No. 12, December 29, 1989 issue of the Bureau of Patents, Trademarks and Technology Transfer Official Gazette, which was officially released for circulation to the public on February 6, 1990.

Opposer stated as basis for its opposition is, The Registration of the mark "ESPRIT" in the name of Respondent-Applicant is proscribed under Section 4 (d) of R.A. No. 166 as amended.

Opposer relies on the following facts to support its opposition:

1. Opposer is the registered owner of the trademark "ESPRIT" used in respect of women's wearing apparel, namely blouses, knit tops, halters, t-shirts, smock tops, sweaters, jackets, pants and skirts; and men's wearing apparel, namely, t-shirts and pants, etc. in jurisdictions all over the world, including but not limited to Anguilla, Barbados, Bermuda, People's Republic of China, Fiji, Finland, West Germany, Gibraltar, Great Britain, Greece, Guyana, Hongkong, Kenya, Nicaragua, Peru, Singapore, Sweden, Switzerland, Turkey,, United States and Virgin Islands;
2. Opposer has applied for the registration of the trademark "ESPRIT" with the Philippines Patent Office (Bureau of Patents, Trademarks and Technology Transfer and was assigned Serial No. 60448 and said application is still pending with said office up to this date;
3. Respondent-Applicant's mark "ESPRIT" is similar in all respects, except for a lack of a break in its "S", to opposer's mark and since both marks are for

goods under the same class, the likelihood of confusion and of interchanging one for the other is absolute;

4. Opposer's mark "ESPRIT" is a world-famous mark associated with products of the highest quality;

5. Opposer, being a resident of a country signatory to the Convention of Paris for the Protection of Industrial Property, of which the Philippines is also a signatory, deserves protection pursuant to said convention;

6. Registration of "ESPRIT" in the name of Eduardo Sy will cause great and irreparable injury and damage to opposer.

The main issue to be resolved is whether or not the use of the trademark "ESPRIT" on Respondent-Applicant's goods would likely cause confusion, mistake or deception upon purchasers as to the source or origin thereof.

Our Trademark Law, particularly Section 4(d) thereof, provides as follows:

"Sec. 4. Registration of trademark, tradenames and service marks on the Principal Register. – There is hereby established a register of trademarks, tradenames and service marks which shall be known as the principal register. the owner of a trademark, tradename or service mark used to distinguish his goods,, business or service from the goods, business or services of others shall have the right to register the same on the Principal Register unless it:

x x x

(d) Consists of or comprises a mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers".

On June 8, 1990, Notice to Answer the Verified and Authenticated Opposition was sent to Respondent-Applicant, mailed with Return Card, however the said Notice to Answer was Returned to Sender.

On February 26, 1991, another Notice to Answer was sent to Respondent-Applicant through his Counsel Atty. William C. Limquico, requiring Respondent-Applicant to filed his Answer within fifteen (15) days after receipt of the Notice, however, after the expiration of the fifteen (15) days period, yet no Answer has been filed, hence, Respondent-Applicant has been declared as in Default (Order No. 91-398) dated May 7, 1991.

Pursuant to the Order of Default, Opposer presented its evidence ex-parte consisting of Exhibits "A" to "B-2" and their corresponding submarkings.

The evidence show that Respondent-Applicant's trademark "ESPRIT" is identical to the Opposer's trademark "ESPRIT LOGO" which was registered with this Bureau under Reg. No. 45262 dated June 23, 1989 (Exhibit "A") as both marks contained the word, "ESPRIT" and that the goods covered by the competing marks fall under the same class 25. Hence, there is factual basis to hold that Respondent-Applicant's trademark is confusingly similar with the opposer's trademark.

WHEREFORE, the Opposition is, as it is, hereby GRANTED. Accordingly, Application Serial No. 45124 for the trademark "ESPRIT" filed on June 9, 1981 by Eduardo Sy 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 the same furnished the Trademark Examining Division for information and to update its records.

SO ORDERED.

IGNACIO S. SAPALO
Director