

HARUTA SEIKA KABUSHIKI KAISHA
(HARUTA SHOE MFG. CO., LTD.),
Petitioner/Opposer,

INTER PARTES CASE NO. 3010

OPPOSITION TO:

Application Serial No. 55523
Filed : January 25, 1985
Applicant : Carina T. Ong
Trademark : PENNY ROAD
Used on : Shoes, sandals, T-shirts,
pants, blouses and socks
-and-

- versus -

INTER PARTES CASE NO. 3051

CANCELLATION OF:

Cert. of Regn. No. SR-6894
Issued : April 12, 1985
Registrant : Carina T. Ong
Trademark : PENNY ROAD
Used on : Shoes, sandals, T-shirts,
pants, blouses and socks

CARINA T. ONG,
Respondent-Applicant/
Registrant.
x-----x

DECISION NO. 89-17 (TM)
March 7, 1989

DECISION

This is a consolidation of two cases, to wit:

1. Inter Partes Case No. 3010, an opposition filed by Haruta Seika Kabushiki Kaisha (Haruta Shoe Mfg. Co., Ltd.) against the registration of the trademark "PENNY ROAD" for shoes, sandals, T-shirts, pants, blouses and socks applied for on January 25, 1985 by Carina T. Ong under the Application Serial No. 55523 published on Page 220, No. 10, Volume 82, March 10, 1986 issue of the Official Gazette, officially releases for circulation on October 29, 1987; and
2. Inter Partes Case No. 3051, a cancellation case wherein Haruta Seika Kabushiki Kaisha (Haruta Mfg. Co., Ltd.) sought by the cancellation of Certificate of Registration No. SR-6894 bearing the trademark "PENNY ROAD" issued on April 12, 1985 in the name of Carina T. Ong.

Opposer/Petitioner in both cases is a foreign corporation duly organized and existing under the laws of Japan, domiciled at 8-8 Senju, Miyamoto-cho, Adachi-ku, Tokyo, Japan, while Respondent in both cases is a Filipino citizen doing business at c/o Jolly Shoes, Ground Floor, Yellow Avenue, Farmers Plaza, Cubao, Quezon City, Philippines.

The grounds alleged in the Notice of Opposition are:

"1. Applicant`s trademark PENNY ROAD is confusingly similar to the trademark PENNY ROAD owned by the opposer which is used in respect of shoes and not abandoned, as to be likely, when applied to or used with the goods of the applicant to cause confusion or mistake or to deceive purchasers thereof;

2. The Registration of PENNY ROAD in the name of Carina T. Ong will cause great and irreparable injury and damage to opposer within the meaning of Section 8 of Republic Act 166, as amended"

The grounds alleged in the Petition for Cancellation are:

- (1) THE REGISTRANT WAS NOT ENTITLED TO REGISTER THE MARK PENNY ROAD AT THE TIME OF HIS APPLICATION FOR REGISTRATION THEREOF;
- (2) THE REGISTRATION IS PROSCRIBED BY SEC. 4 (d) OF REPUBLIC ACT NO. 166, AS AMENDED."

In both cases, Respondent filed its Answers on time and so dates were set for the holding of their respective pre-trial conferences.

No amicable settlement of the cases was arrived at. Hearings on the merits of both cases followed.

On February 10, 1989, Opposer by counsel filed a motion "to withdraw its Opposition to the application for registration of Respondents-Applicant of the trademark "PENNY ROAD" and its Petition for Cancellation of Certificates of Registration No. SR-6849 for the same trademark because it is no longer interested in pursuing the same". Attached thereto is a photocopy of the letter dated January 10, 1989 of the Opposer to its counsel instructing them not to proceed further with Inter Partes Cases Nos. 3010 and 3051.

WHEREFORE, premises considered, Inter Partes Cases Nos. 3010 (Opposition) and 3051 (Cancellation) are DISMISSED. Accordingly, Application Serial No. 55523 should be given due course and the status of Certificate of Registration No. SR-6894 shall remain undisturbed until otherwise so ordered.

Let the records of these cases be forwarded to the Application, Issuance and Publication Division (Inter Partes Case No. 3010) and to the Patent/Trademark Registry & EDP Division (Inter Partes Case No. 3051) for appropriate actions in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director