

JEANJER, LTD.,  
Petitioner/ Opposer,

INTER PARTES CASE NO. 2040

PETITION FOR CANCELLATION

Cert. of Regn. No. SR-7076  
Issued : October 5, 1985  
Registrant : Eduardo Sy  
Trademark : JEANJER  
Used on : T-Shirts, polos, polo  
shirts, pants, jeans,  
shorts, sandos and socks

- versus -

- and -

INTER PARTES CASE NO. 3086

OPPOSITION TO:

Application Serial No. 56736  
Filed : June 27, 1985  
Applicant : Eduardo Sy  
Trademark : JEANJER  
Used on : T-shirts, polos, polo  
shirts, pants, jeans,  
shorts, sandos and  
socks

EDUARDO SY,  
Respondent-Registrant/  
Applicant

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DECISION NO. 89-101 (TM)  
December 15, 1989

### DECISION

This is a consolidation of two (2) cases, namely:

- (1) A Petition for Cancellation (Inter Partes Case No. 2040) filed by Jeanjer, Ltd. on January 23, 1987 for cancellation of Certificate of Registration No. SR-7076 from the Supplemental Register of the trademark "JEANJER" used on jeans, T-shirts, polos, polo shirts, pants, jeans, shorts, sandos and socks issued to Eduardo Sy on October 25, 1985; and
- (2) A Notice of Opposition (Inter Partes Case No. 3086) likewise filed by Jeanjer, Ltd. on June 2, 1988 against the registration of the trademark "JEANJER" used on T-shirts, polos, polo shirts, pants, jeans, shorts, sandos and socks applied for by Eduardo Sy on June 27, 1985 under Application Serial No. 56736 published on Page 94, Volume I, No. 3 of the BPTTT Official Gazette dated and released for circulation on May 23, 1988.

The grounds alleged in the Petition (Inter Partes Case No. 2040) are:

- (1) That the registration of the trademark "JEANJER" for jeans, T-shirts, polo shirts, etc. under Class 25 is contrary to the provisions of Section 4 (d), Chapter II-A, and Section 37, paragraph 6 of Republic Act No. 166, as amended, in relation to Art. 8 (a) of the Treaty of Paris;
- (2) That Petitioner is the owner of the trademark "JEANJER" used on jeans for men, women and children in Class 25 since November 15, 1979 as shown by U.S. Registration Nos. 1,308,130 and 1,340, 867 issued on December 4, 1984 and June 11, 1985, respectively;
- (3) That Petitioner is likewise the owner of trademark "JEANJER, LTD.", having used the same as its corporate name since its incorporation on September 6, 1985;
- (4) That under the Treaty of Paris for the Protection of Industrial Property which took effect in the Philippines on September 27, 1965: "Tradenames shall be protected in all the countries of the Union even without the obligation of filing or registration" (Art. 8-a), which is implemented by Sec. 37, par. 6 of our Trademark Law.
- (5) That, in view of the illegal use and registration by Respondent-Registrant of Petitioner's tradename in connection with goods under Class 25, the same causes confusion and mistake, and deceive unscrupulous dealer into believing that the goods of the Respondent-Registrant originated from the Petitioner to the damage and injury of the latter and the buying public.

The grounds alleged in the Notice of Opposition (Inter Partes Case No. 3086) are:

- (1) The Opposer is the originator, adopter, and registered owner of the trademark and/or tradename "JEANJER"
- (2) The Opposer is the owner of the trademark "JEANJER" used on garments specifically jeans, pants, denims for men. Women and children in Class 25 since November 15, 1979 as shown by U.S. Registration Nos. 1,308,130 and 1,340, 867 issued on December 4, 1984 and June 11, 1985, respectively;
- (3) The Opposer likewise the owner of the tradename "JEANJER, LTD.", having used the same as its corporate name since its incorporation on September 6, 1965;
- (4) Under the Treaty of Paris for the Protection of Industrial Property which took effect in the Philippines on September 27, 1965, the said tradename "JEANJER, LTD." is protected by said Treaty;
- (5) The application for registration of the work mark "JEANJER" by Respondent-Applicant for goods under Class 25 – garments – would indeed cause confusion or mistake as to the source or origin of the goods in view of the confusing similarity between the trademark applied for and that belonging to Opposer's.

In its Answer to the Petition for Cancellation filed on March 9, 1987, Respondent-Registrant denied the material allegations therein and made the following special and/or affirmative defenses:

- "(5) That Petitioner has no cause of action against the Respondent since its alleged Tradename has not been registered in its name in the Philippines, not well-known in the Philippines, much less being used by Petitioner in commerce in the Philippines.
- (6) That the Respondent has used the Trademark in question under Certificate of Registration No. SR-7076 on its products and spent considerable amount of money through and by means of various advertisements and promotions.

(7) That Petitioner has no valid and existing registration in the Philippines and, for not being the lawful owner of the Trademark in question, Petitioner will not suffer any prejudice or damage whatsoever by its registration in the name of Respondent.”

Respondent adopted the same special and affirmative defenses in his Answer to the Notice of Opposition filed against the registration of subject mark in his name.

These two (2) cases, on joint motion of their respective counsels, were consolidated in Order No. 88-236 dated July 8, 1988.

Petitioner/ Opposer, after this parties failed to settle their case amicably during the pre-trial conferences, started presenting its evidence on September 11, 1987 and completed its presentation on October 14, 1987. Having waived its right to cross-examine Petitioner’s witness at the hearing of January 20, 1988, Petitioner submitted its Formal Offer of Evidence on February 1, 1988 consisting of Exhibits “A” to “S”, inclusive. Said exhibits were admitted in evidence for the Petitioner in Order No. 88-86 dated March 24, 1988.

For successive failures to appear to the scheduled hearings set on July 29, 1988; August 12 and September 6, 1988, Respondent-Registrant/Applicant was declared as in default in Order No. 89-621 dated August 8, 1989 and since Petitioner/Opposer has already rested its case, the same was submitted for decision.’

The main issue to be resolved is: Who between the parties is the prior adopter, user and owner of the trademark and tradename “JEANJER”; and the second issue is whether or not Respondent-Registrant/Applicant is entitled to the registration of the trademark “JEANJER” pursuant to the Philippine Trademark Laws.

Petitioner/Opposer presented ample proofs: that it applied for the registration of its corporate and tradename “JEANJER, LTD.” with the Department of State of New York on September 23, 1985 (Exhs. “A-1”, “A-2” and “A-3”) which it has continuously used since its incorporation on September 6, 1965 (Annex ‘C’) and should therefore be entitled to protection under Article 8 (a) of the Treaty of Paris and Section 37 paragraph 6 of the Philippine Trademark Law; that it registered the trademark “JEANJER-JEANS” with the United States Patent and Trademark Office under Registration No. 1,308,130 on December 4, 1984 indicating therein that its first use in commerce was in November 15, 1979 (Exh. “I”) and also the trademark “JEANJER SPORTSWEAR and a car design” with the same U.S. Patent and Trademark Office under Registration No. 1,340,867 issued on June 11, 1985 (Exh. “J”); that it registered the mark “JEANJER” in France on November 18, 1986 (Exhs. “B-1”); in Switzerland on September 19, 1985 (Exhs. “C” and “C-1”); in the Dominican Republic on January 30, 1986 (Exhs. “D” and “G”); in Italy on September 19, 1985 (Exh. “E”); in the Republic of Paraguay on June 3, 1986 (Exh. “F”); has registration in 19 other countries (Exh. “D-1”, pp. 1 and 2), and pending applications in 43 more countries (Exh. “0-2”, pp. 1 to 5).

Petitioner/Opposer also presented proofs of its “JEANJER” labels as actually used on its goods (Exhs. “P-1” and “P-2”), a Sales Invoice of one pant at the E.S. Commercial, Claro M. Recto Avenue, Sampaloc, Manila (Exh. “Q”), a full page warning in a newspaper (Philippine Daily Inquirer) against infringers of the “JEANJER” trademark by the Opposer (Exh. “R”), and a list of establishments, with their addresses, where denim jeans bearing the “JEANJER” mark are sold (Exh. “S”).

Petitioner/Opposer submitted proofs that it already filed its application (Serial No. 58051) on December 26, 1985 for the registration of its “JEANJER-JEANS” mark in the Philippines (Exh. “H”), with such application (Exhs. “K”, “L”, “M”, “N” and “O”).

From the foregoing exhibits, Petitioner/Opposer has sufficiently proved that it is the prior user and owner of the mark “JEANJER” and expanded its use and registration of said mark to

almost all, if not all, commercial centers of the world. The use of Petitioner/ Opposer of the word "JEANJER" as its corporate and tradename has also been clearly established.

On the other hand, when it was his turn to present his evidence, Respondent failed to appear. Although technically it was not correct for the Hearing Officer to declare him "as in default" in Order No. 89-621 dated August 8, 1989 (supra), yet his failure to appear and to present his evidence in effect deprived the other party to cross-examine him on the factual allegations contained in his application, particularly his claim of use in commerce in the Philippines. For this inaction of his, Respondent is deemed to have abandoned both his registration in the Supplemental Register, which is devoid of the benefit of any presumption as to its validity, and his application for the subject mark.

WHEREFORE, the Petition for Cancellation (Inter Partes Case No. 2040) and the Notice of Opposition (Inter Partes Case No. 3086) are both GRANTED. Accordingly, Certificate of Registration No. SR-7076 is ordered CANCELLED from the Supplemental Registry, and Application Serial No. 56736 is REJECTED.

Let the records of these cases be forwarded to the Patent/Trademark Registry & EDP Division (Inter Partes Case No. 2040), and the Application, Issuance & Publication Division (Inter Partes Case No. 3086) for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO  
Director