

PEPSICO, INC.,  
Petitioner,

INTER PARTES CASE NO. 1684

PETITION FOR CANCELLATION

- versus

Cert. of Regn. No. SR-3474

Issued : August 4, 1978

Registrant : Allstate Merchandizing  
Corporation

Trademark : WILSON

Used on : Caps, travel bags, casual  
wear for men, ladies and children

ALLSTATE MERCHANDIZING  
CORPORATION,

Respondent-Registrant.

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DECISION NO. 88-60 (TM)

August 3, 1988

### DECISION

This is a petition filed by Pepsico, Inc. for the cancellation of Certificate of Registration No. SR-3474 issued to Allstate Merchandizing Corporation for the trademark "WILSON" used on caps, travel bags, casual wear for men, ladies and children.

Petitioner is a foreign corporation organized and existing under the laws of the State of Delaware, U.S.A. with business address at No. 700 Anderson Hill Road, Purchase, New York, 10577, U.S.A., while Respondent-Registrant is a domestic corporation organized and existing under Philippine laws and holding office at Room 608, Artex Building, No. 435 Juan Luna Street, Manila, Philippines.

Having in its favor prior registrations of the mark "WILSON", petitioner alleges that:

"1. Respondent-registrant was not entitled to register the mark WILSON at the time of its application for registration thereof.

2. Registration of the mark WILSON in the name of the registrant has caused and will cause great irreparable injury and damage to the petitioner within the meaning of Sec. 19-A of R.A. 16, as amended."

Records show that on August 24, 1973, Petitioner filed an application in this Bureau for the registration of the trademark "WILSON" used on golf clubs, balls, bags and other sporting goods. The same mark which was registered in the U.S.A. under Certificate of Registration No. 788107 on April 13, 1965 was allowed by use on May 25, 1976 when Certificate of Registration No. 23150 was issued to Petitioner.

On June 18, Petitioner also sought for the registration of the same mark "WILSON" used on caps, jackets, shorts, track pants, skirts and other athletic clothing, which mark was already registered in the U.S.A on September 28, 1965 under Certificate of Registration No. 796780. Said mark was allowed registration in the Philippines on December 1, 1967 under Certificate of Registration No. 24482.

On October 28, 1977, Respondent-registrant filed its application for the registration in the Supplemental Register of the same mark "WILSON" used on caps, travel bag, casual wear for men, ladies and children, stating therein July 1, 1976 as the date of first use. Certificate of Registration No. SR-3474 was issued to Respondent-Registrant on August 4, 1978.

This Petition was filed on October 5, 1982 and Notice to File Answer was sent to Respondent-Registrant. Notice to File Answer was sent to Respondent-Registrant on October 26, 1982 but was returned unserved. An alias notice was issued on December 22, 1982 upon motion by Petitioner to a new address which was likewise returned unserved. It was only on November 3, 1983 that the second alias notice was successfully served to Petitioner through the Sheriff's Office of Manila. For failure to file the required answer within the reglementary period, Respondent-Registrant was declared in default on January 18, 1984. Consequently, Petitioner was allowed to present ex-parte the following exhibits admitted as evidence, to wit:

Exhibits "A", "A-1" to "A-4"

Authentic Sworn Statement of Mr. Lawrence F. Dickie, Assistant Secretary of the Petitioner, Pepsi Co, Inc.

Exhibit "B", "B-1" and "B-2"

Catalogue of PepsiCo Products bearing the trademark "WILSON" consisting of 113 pages, among which products are bags, clothings, caps and other wearing apparel (pp. 28 and 29) to show the goods produced by Petitioner on which the trademark "WILSON" used.

Exhibit "C", "C-1" and "C-2"

Certificate of Registration No. 23150 issued by the Philippine Patent Office in the name of Petitioner for the trademark "WILSON" used on a long list of sporting goods to show that Petitioner is the registered owner of the trademark "WILSON" in the Philippines as used on the goods enumerated therein.

Exhibit "D", "D-1" and "D-2-a"

Certificate of Registration No. 24482 issued by the Philippine Patent Office in the name of the Petitioner for the mark "WILSON" used on different kinds of athletic clothings to show that Petitioner is the registered owner of the mark "WILSON" in the Philippines used on exactly the same goods which Respondent uses its mark on.

Exhibits "E", "E-1" and "E-1-b"

Certificate of Registration No. SR-3434 issued by the Philippine Patent Office in the name of Respondent for the trademark "WILSON", subject of the herein cancellation proceedings to show the confusing similarity of the mark "WILSON" registered in the name of Respondent-Registrant to that of the identical mark "WILSON" registered in the name of Petitioner.

Established is the fact that Petitioner is the owner and prior user of the trademark "WILSON" in contest. When Respondent-Registrant filed for registration of its mark in the Supplemental Register on October 28, 1982, the very same mark was already registered by Petitioner and used on goods classified under Classes 23 and 40 (the goods of Respondent-Registrant should have been classified under these classes instead of Classes 18 and 25). Notwithstanding, registration was allowed and Certificate No. SR-3474 was issued to Respondent-Registrant. This was not proper.

Section 19-A and 4(d) of Republic Act No. 166, as amended, provide that:

"SEC 19-A. In addition to the principal register, the Director shall keep another register to be called the Supplemental register. All marks and trade-names capable of distinguishing applicant's goods or services and not registrable on the principal register

herein provided, except those declared to be unregistrable under paragraphs (a), (b), (c), and (d) of Section 4 of this Act x x x may be registered on the supplemental register x x x." (Underscoring ours)

"SEC. 4. x x x The owner of a trademark, trade-name or service-mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register, unless it:

(d) Consists of or compromises a mark or trade-name which so resembles a mark or trade-name registered in the Philippines or a mark or trade-name 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 deceive, purchasers;" (Underscoring ours)

WHEREFORE, premises considered, this petition for cancellation is sustained and Certificate of Registration No. SR-3474 issued to Respondent-Registrant is hereby ordered CANCELLED.

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

SO ORDERED.

IGNACIO S. SAPALO  
Director