

SEHWANI, INCORPORATED  
Opposer,

INTER PARTES CASE NO. 3273

OPPOSITION TO:

- versus -

Application Serial No. 52840  
Filed : December 13, 1983  
Applicant : Fairland Knitcraft  
Co., Inc.  
Used on : T-shirts, polos, jackets,  
briefs, jeans, pants and  
shorts

FAIRLAND KNITCRAFT CO., INC.  
Respondent-Applicant.

x-----x

DECISION NO. 90-48 (TM)  
December 27, 1990

### DECISION

On October 28, 1988, SEHWANI INCORPORATED, a corporation duly organized and existing under and by virtue of the laws of the Philippines, with Principal Office address at 157 Saint Jude Street, Oranbo Drive, Pasig, Metro Manila, filed its verified Notice of Opposition (Inter Partes Case No. 3273) to Application Serial No. 52840 for the Trademark "EMINENCE" used on T-shirts, polos, jackets, briefs, jeans, pants and shorts falling under class 25 which application was filed on December 13, 1983 FAIRLAND KNITCRAFT CO. INC. of Tondo, Manila which was published in the Bureau of Patents, Trademarks and Technology Transfer Official Gazette, Vol. 1, No. 7 , Page 92, which was released for publication on September 30, 1988.

The grounds of the opposition are as follows:

1. The Trademark "EMINENCE" of respondent-applicant is confusingly similar, is not identical to the trademark "EMINENCE & REP. OF A MAN DEVICE" and copyrighted intellectual creation "EMINENCE" of herein opposer, which it had much earlier adopted and used in Commerce in the Philippines being used for the same or related goods under the official classification of goods of the Bureau of Patents, Trademarks and Technology Transfer has become publicly known and for which it has existing trademark applications and certificate of copyright registration;

2. The opposer has spent much for the advertisement and promotion of the aforementioned trademarks nationwide and its business will be clearly damaged and will suffer irreparable injury;

3. The word "EMINENCE" is the predominant feature of the trademark of respondent-applicant which so resembles the trademarks "EMINENCE & REP. OF A MAN DEVICE" previously registered with the Bureau of Patents, Trademarks and Technology Transfer or previously used in the Philippines and not let the application to be cancelled but only failed to file the affidavit of use and the intellectual creation "EMINENCE" duly copyrighted with the National Library, Department of Education and Culture by Opposer, as to be likely, when applied to or used in connection with the goods of respondent-applicant, to cause confusion, mistake or to deceive purchasers or consumers. (Sec. 4(e), R.A. No. 166 as amended).

4. More especially the public and the patronizers of the Opposer's products are deceived into buying respondent-applicant's goods or under the impression and mistaken

belief that respondent's goods are identical with or come from the same source as opposer's products or that respondent is as affiliate or licensee of opposer, which it is not.

On January 11, 1989, Respondent-Applicant was notified about this opposition and was required to file its Answer thereto within fifteen (15) days from receipt of said notice.

For failure to file an Answer, and upon Opposer's Motion, respondent-Applicant was declared in default in Order No. 89-351 dated Mar. 23, 1989 and accordingly, Opposer was allowed in said order to present its evidence ex-parte.

Admitted as Opposer's evidence were Exhibits "A" to "E" inclusive.

Since the trademarks "EMINENCE" commonly claimed by the parties are identical, the issue to be resolved is whether or not Respondent-Applicant could register the contested mark "EMINENCE" in the light of Sec. 4(d) of R.A. 166 as amended, the pertinent portions of which provides:

"SEC. 4 Registration of Trademarks xxx on Principal register xxx The owner of the trademark xxx used to distinguish his goods xxx from the goods of others shall have the right to register the same on the principal register, unless it

(d) Consists of or compress 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 to deceive purchasers."

An examination of the Respondent-Applicant's Trademark "EMINENCE" discloses that it is identical with the trademark of the herein Opposer.

As shown by the evidence submitted, Respondent-Applicant's date of first use as stated in its Application Serial No. 52840 is January 15, 1976 while the Opposer's date of first use as shown in its Trademark Registration No. 26299 for the mark "EMINENCE & REP. OF A MAN DEVICE" dated December 29, 1978 (Exhibit "A-1") is June 3, 1975 for the goods garments particularly underwear such as pants, jeans, t-shirts, jackets under class 25. Same mark was likewise registered by the herein Opposer in the Supplemental Register bearing Regn. No. SR-3440 dated July 12, 1978 for the goods underwear particularly panties, bra, briefs, brassieres falling under class 25 and this is shown in Exhibit "B-1".

From the foregoing, there is no doubt that Opposer has already appropriated the Trademark "EMINENCE & REP. OF A MAN DEVICE" Before that of the Respondent-Applicant.

On the basis of the evidence submitted, opposer has shown concrete and convincing proofs that ownership of the mark "EMINENCE & REP. OF A MAN DEVICE" belongs to it and clearly established that Respondent-Applicant's application for the registration of the mark "EMINENCE" in its name is in violation of the law particularly Section 4(d) of R.A. No. 166 as amended.

It must be pointed out that the Supreme Court has accordingly ruled that the right to exclusive use of a trademark grows out of its actual use (CIA General, de Tobacos V. Alhambra Cigar & Cigarette Mfg. Co., 38 Phil. 485) and does not depend upon the registration thereof. Likewise, the Supreme Court also ruled that, if a party proves that he has used Trademark for a length of time sufficient that it is use by another would injure him and deceive the public, he does not have to prove that the same has been registered (Ubedia V. Zialcita, 13 Phil. 11).

The herein Respondent-Applicant was declared in default (Order No. 89-351) dated May 23, 1989 and the non-filing of the Answer and Motion to lift the Order of default despite notice is indicative of its lack of interest in its application; thus it is deemed to have abandoned the same.

WHEREFORE, the Opposition is SUSTAINED. Application Serial No. 52840 filed by FAIRLAND KNITCRAFT CO., INC. is DENIED.

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

SO ORDERED

IGNACIO S. SAPALO  
Director