

VAN DOREN RUBBER CO., INC.,
Opposer,

INTER PARTES CASE NO. 3394

OPPOSITION TO:

- versus -

Application Serial No.: 40786
Filed: February 29, 1980
Applicant: Tony Ong King
Trademark: VAN
Used On: Clothing

AB ASTRA,

Respondent-Applicant.

x-----x

DECISION NO. 90-28 (TM)
July 24, 1990

DECISION

On June 30, 1989, Van Doren Rubber Co., Inc., a foreign corporation organized under the laws of the United States of America, filed a Verified Notice of Opposition (Inter Partes Case No. 3394) to Application Serial No. 40786 for the trademark "VAN" used on T-shirts, skirts, blouses, pants, jeans, jackets, hankies, shorts, dresses, socks, skirts and nighties (Class 25), which application was filed on February 29, 1980 by Tony Ong King, a Filipino citizen doing business under the style "Clothman International" at 966 Soler Street, Manila, and published in the Office Gazette dated April 28, 1989.

Opposer stated as basis for its opposition the following:

"1. The Opposer is the owner of the trade name and trademark 'VANS' covered by the U. S. Certificates of Registration Nos. 1,267,262; 1,267,100; 1,269,202; 1,301,871; 1,269,201; and 1,353,939. The said 'name' and 'mark' is a pure creation of Opposer, it is known all over the United States and throughout the world including the Philippines and that as a result of Opposer's continuous and extensive use of the said 'name' and 'mark', it has developed and now has a distinctive and secondary meaning to the public and has come to mean and does mean, indicate and stand for products of Opposer to the trade and the general public throughout the world and in the Philippines. The registration of the trademark of applicant would not only violate Opposer's rights and interests in its trade name and trademark but would also tend to mislead the public in view of the fact that the two marks are virtually identical.

2. The trade name and trademark VANS which Opposer has created and adopted is known in the Philippines and throughout the world. It is apparent that applicant had prior knowledge thereof and deliberately designed its mark to be confusingly similar to Opposer's mark in order to take advantage of Opposer's fame, reputation and goodwill, which Opposer has established at tremendous costs.

3. Article 8 of the Convention of Paris for the Protection of Industrial Property of which both the United States and the Philippines are member countries provides that a trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark."

For failure to file an Answer, and upon Opposer's Motion, Respondent-Applicant was declared in default. Accordingly, Opposer was allowed to present its evidence ex parte (Order No. 89-646 dated August 17, 1989). Admitted as Opposer's evidence were Exhibits "A" to "L", inclusive.

An examination of Respondent-Applicant's trademark "VAN" discloses that it is identical with the trade name and trademark of the Opposer.

As shown by the evidence submitted, Respondent-Applicant's date of first use as stated in his trademark Application Serial No. 40786 is June 2, 1978, while the Opposer's date of first use as shown in Home Registration No. 1,353,939 issued on August. 13, 1985 by the U. S. Patent and Trademark Office (Exh. "H-1") is "2-0-1967" (Exh. "H-2") for the goods wearing apparel, namely, sport shirts, T-shirts, hats, short, jogging skirts, socks, swimsuits and shoes in Class 25.

From the foregoing, there is no doubt that Opposer has already appropriated the trade name "VAN" and the trademark "VANS" before that of Respondent-Applicant.

On the basis of the evidence submitted, Opposer has shown concrete and convincing proofs that ownership of the mark "VAN" belongs to it and clearly established that Respondent-Applicant's application for the registration of the mark "VAN" in his name is in violation of Section 4(d) of Republic Act No. 166, as amended.

The non-filing of the requisite Answer to the Notice of Opposition nor any motion to lift the Order of Default despite notice is indicative of Respondent-Applicant's lack of interest in his application; thus, he is deemed to have abandoned the same.

It must be pointed out that the mark "VAN" is a trade name of the herein Opposer whose country of origin is a member of the Convention of Paris for which the Philippines is also a signatory. Under the said Convention, each country of the Union undertakes at the request of an interested party to prohibit the use of a trademark which constitutes a reproduction, imitation or translation of a mark already belonging to a person entitled to the benefits of the Convention and use for identical or similar goods. Article 8 of the said Convention provides that a trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.

WHEREFORE, premises considered, the herein Notice of Opposition is hereby SUSTAINED. Accordingly, Application Serial No. 40786 for the mark "VAN" in favor of the herein Respondent-Applicant is hereby REJECTED.

Let the records of this case be remanded to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director