

APPENDAGEZ, INC.,
Petitioner,

INTER PARTES CASE NO. 967

PETITION FOR CANCELLATION

- versus -

Cert. of Regn. No. SR-2338
Issued : December 16, 1975
Registrant : Lily Tanlo Sy Chua
Trademark : "FADED GLORY"
Used on : Jeans, pants and shirts

LILY TANLO SY CHUA,
Respondent-Registrant.
x-----x

SY CHIN
Opposer,

INTER PARTES CASE NO. 1031

OPPOSITION TO:

- versus -

Appln. Serial No. 28742
Filed : November 10, 1975
Applicant : Appendagez, Inc.
Trademark : "FADED GLORY BY APPENDAGEZ"
Used on : Men's and women's pants, shirts and Jackets

APPENDAGEZ, INC.,
Respondent-Applicant.
x-----x

SY CHIN,
Opposer,

INTER PARTES CASE NO. 1034

OPPOSITION TO:

- versus -

Appln. Serial No. 28740
Filed : November 10, 1975
Applicant : Appendagez, Inc.
Trademark : "FADED GLORY"
Used on : Men's and women's pants, shirts, etc.

APPENDAGEZ, INC.,
Respondent-Applicant.
x-----x

APPENDAGEZ, INC.,
Opposer,

INTER PARTES CASE NO. 1058

OPPOSITION TO:

- versus -

Appln. Serial No. 29376
Filed : February 25, 1976
Applicant : Lily Tanlo Sy Chua
Trademark : "FADED GLORY"
Used on : Jeans, pants and shirts

LILY TANLO SY CHUA,
Respondent-Applicant.
x-----x

DECISION NO. 88-18 (TM)

March 7, 1988

DECISION

Involved are the following cases:

Inter Partes Case No. 967 - Petition for Cancellation filed on April 14, 1976 by Appendagez, Inc. against Certificate of Registration No. SR-2338 issued on December 16, 1975 in favor of Lily Tanlo Sy Chua for the registration of the trademark "FADED GLORY" used on jeans, pants and shirts;

Inter Partes Case No. 1031 - Opposition filed on November 18, 1976 by Sy Chin against Application Serial No. 28742 filed by Appendagez, Inc. on November 10, 1975 for the registration of the trademark "FADED GLORY BY APPENDAGEZ" used on men's and women's pants, shirts and jackets;

Inter Partes Case No. 1034 - Opposition filed on November 18, 1976 by Sy Chin against Application Serial No. 28740 filed by Appendagez, Inc. on November 10, 1975 for the registration of the trademark "FADED GLORY" used on men's and women's pants, shirts, jackets, skirts and hats; and

Inter Partes Case No. 1058 – Opposition filed on June 3, 1977 by Appendagez, Inc. against Application Serial No. 29376 filed by Lily Tanlo Sy Chua on February 25, 1976 for the registration of the trademark "FADED GLORY" used on Jeans, pants and shirts.

Considering that the parties and the subject matter are the same in these four (4) cases, it was deemed proper and expedient to consolidate the same and as such heard jointly by one Hearing Officer.

The basic issue in these cases boils down to: Which of the two (2) parties - Appendagez, Inc. and Sy Chin, "assignee of Lily Tanlo Sy Chua" - would be entitled to the registration of the trademark "FADED GLORY" used on men's and women's pants, shirts, jackets, skirts and hats in Class 40?

On November 23, 1977, Appendagez, Inc. presented its evidence consisting of:

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| Exhibits "A" | - | Specimen labels of "FADED GLORY" submitted by Appendagez, Inc. and Lily Tanlo Sy Chua in support of their respective applications for the registration of the trademark "FADED GLORY". |
| Exhibit "C" | - | Photocopy of U.S. Registration No. 992,894 issued on September 10, 1974 to Appendagez, Inc. for "FADED GLORY" used on men's, women's pants, shirts, jackets, skirts and hats. |
| Exhibit "D" | - | Photocopy of U.S. Registration No. 992,895 likewise issued to Appendagez, Inc. on September 10, 1974 for "FADED GLORY BY APPENDAGEZ" used on men's, women's pants, shirts, jackets, skirts and hats. |
| Exhibit "E" | - | Photocopy of Trademark Application Serial No. SR-3144 (based on local use) filed with the Philippine Patent Office by Lily Tanlo Sy Chua on December 5, 1975 alleging January 8 1970 as the date of first use in the Philippines of the mark "FADED GLORY" used on jeans, pants and shirts. |

Exhibit "F" - Photocopy of Certificate of Registration of Business Name No. 217854 issued on March 14, 1972 by the Bureau of Commerce (now Bureau of Domestic Trade) in the name of Lily Tanlo Sy Chua.

Appendagez, Inc. made its formal offer of evidence on January 31, 1978.

On June 5, 1978, Respondent presented as witnesses Messrs. Dominador Santos, Jr. and Eduardo Villanueva. Thereafter, no development took place until this Office on June 28, 1982 sent letters to the parties to signify their interest in prosecuting these cases. No reply thereto was received by this Office. Finally, at the hearing on June 26, 1986, counsel of record of Lily Tanlo Sy Chua (Atty. Florencio Z. Sioson) manifested in open court that he had withdrawn as her counsel way back on October 24, 1980. On July 17, 1986, Petitioner's counsel (Messrs. Belo, Abiera, San Jose and Pagunsan) likewise withdrew as counsel of Appendagez, Inc.

This Office is therefore constrained to consider the aforestated Exhibits "A" to "F" of Petitioner and the testimony of Respondent's witnesses, Messrs. Santos and Villanueva.

Taken into consideration likewise are applications in the Principal Register identified as Serial No. 28740 filed by Appendagez, Inc. on November 10, 1975 for "FADED GLORY" for men's and women's pants, shirts, jackets, skirts and hats based on U.S. Registration No. 992,894 issued on September 10, 1974; and Serial No. 28742 for "FADED GLORY BY APPENDAGEZ" for the same goods and based on U.S. Registration No. 992,895 issued on September 10, 1974. Certified copies of the U. S. registrations mentioned above were filed by Appendagez, Inc. and are part of the records of this Bureau. Both United States registrations indicate that the trademarks "FADED GLORY" and "FADED GLORY BY APPENDAGEZ" were adopted and used by Appendagez, Inc. on October 18, 1973.

On the other hand, Lily Tanlo Sy Chua had filed for registration in the Supplemental Register an application Serial No. SR-3144 on December 5, 1975 claiming date of first use in the Philippines on January 8, 1970. The corresponding Certificate of Registration No. SR-2338 was issued eleven (11) days after it was filed, i.e., December 16, 1975. Lily Tanlo Sy Chua also filed on January 25, 1976 an application for registration in the Principal Register for trademark "FADED GLORY" under Serial No. 29376 for pants and shirts likewise claiming January 20, 1970 as the date of first use. On June 21, 1976, however, Lily Tanlo Sy Chua submitted a Sworn Statement requesting for a change in such date of first use, i.e., January 8, 1970 to March 10, 1973. However, Registration Certificate No. SR-2338 lapsed for non-filing of the tenth anniversary affidavit of use.

The foregoing, particularly the inconsistency in the date of first use claimed by Lily Tanlo Sy Chua in Application Serial No. SR-3144, which was January 8, 1970, and the date of first use in Application Serial No. 29376 which was March 10, 1973; and the Business Name Registration (Exh. "F") obtained by Lily Tanlo Sy Chua on March 14, 1972, which was subsequent to the date of first use January 8, 1970 claimed in Application Serial No. SR-3144 proves fatal to Respondent since these are indicative of the incredulity of the claim of Lily Tanlo Sy Chua as to the date of first use of the marks. On the other hand, on the basis of the certificates of registration in the United States Appendagez, Inc. is considered as proving by preponderance of evidence its exclusive right to the use of the trademarks "FADED GLORY" and "FADED GLORY BY APPENDAGEZ" for men's and women's pants, jackets, shirts and hats.

WHEREFORE, the Opposition filed by Sy Chin to the application for registration of the trademark "FADED GLORY", Serial No. 28742, filed by Appendagez, Inc. (Inter Partes Case No. 1031), and to Application Serial No. 28740 also filed by Appendagez, Inc. (Inter Partes Case No. 1034) are hereby DISMISSED therefore the certificates for registration in respect thereof should issue; and the Opposition filed by Appendagez, Inc. against Application Serial No. 29376 (Inter

Partes Case No. 1058) is hereby given due course, while the Petition for Cancellation filed likewise by Appendagez, Inc. against Certificate of Registration No.SR-2338 (Inter Partes Case No. 967) is hereby DISMISSED for having become academic.

Let the records of these cases be remanded to the trademark Examining Division and the Application, Publication and Documentation Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director