

BATA INDUSTRIES, LIMITED,
Opposer,

INTER PARTES CASE NO. 1926

-versus

Opposition to:

Application Serial No.:46455
Filed: October 16, 1981
Applicant: Manuel P. Samson
Trademark: TABATA
Used On: Shoes, slippers, sandals,
t-shirts, blouses, bra, pants, polo
shirts, jackets, belts and wallets

MANUEL P. SAMSON,
Respondent-Applicant.

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DECISION NO. 90-1 (TM)
February 8, 1990

DECISION

On April 8, 1985, Bata Industries, Limited filed an unverified Notice of Opposition against the registration of the trademark "TABATA" used on shoes, slipper, sandals, t-shirts, blouses, bra, pants, polo shirts, jackets belts and wallets applied for by Manuel P. Samson on October 16, 1981 in Application Serial No. 46455 published on Page 40, Volume 80, No. 42 of the Supplement to the Official Gazette dated October 15, 1984, which was released for circulation on March 6, 1985.

Opposer is a foreign corporation of Canada, while Respondent-Applicant is a Filipino citizen with business address at Doña Betang Subdivision, Santolan Pasig, Metro Manila, Philippines.

The grounds alleged in the verified Notice of Opposition later filed on June 4, 1985 are:

"1. The trademark 'TABATA' of respondent-applicant is identical and/or confusingly similar to the trademark 'BATA' of herein opposer, which it had much earlier adopted and used, and is being used worldwide and has become internationally famous and for which it has existing registration worldwide;

2. The word 'BATA' which is identical and/or confusingly similar to respondent-applicant's mark is the predominant feature of the opposer's trade name and is entitled to protection under the terms of the trade mark law and the Paris Convention. x x x

3. The word 'BATA' used by the opposer as a trademark and as a tradename is internationally well-known under the provisions of Executive Order No. 913 and the unauthorized adoption and use of any identical and/or confusingly similar trademark or tradename is considered as an act amounting to economic sabotage;

4. The respondent-applicant is not entitled to the registration of the mark 'TABATA' and/or has had no bona fide commercial use thereof before his application for its registration.

On June 11, 1985, Respondent-Applicant was notified about this opposition and was required to file its Answer thereto within fifteen (15) days from receipt of the notice.

In its Answer seasonably filed on August 8, 1985, Respondent-Applicant denied the material allegations made therein and alleged the following affirmative and/or special defenses:

"5. That opposer has no valid legal cause of action against respondent-applicant;

6. That opposer is not licensed to do business in the Philippines; it is not actually doing business in the Philippines; it is not the duly registered owner of the trademark 'BATA' in the Philippines as said trademark ('BATA') is registered in the name of New Olympian Rubber Products Co., Inc. Consequently, opposer has no legal capacity and personality to file, much less prosecute, the above Notice of Opposition;

7. That respondent-applicant's trademark 'TABATA' is distinctly different from the trademark 'BATA';

8. That the above Notice of Opposition was filed out of time;

9. That the filing of the application for registration of the trademark 'TABATA' by respondent-applicant conforms with and is in all respects in accordance with the provisions of the Trademark Law and the Revised Rules of Practice in Trademark Cases;

10. That under the principle of estoppel and/or laches, opposer is now estopped to question the use as well as the ownership of the trademark 'TABATA' by respondent-applicant."

The issues joined, the pre-trial conference was scheduled to September 17, 1985. For failure of the parties to settle the case amicably, the pre-trial stage was terminated on the same date.

After several resetting, Opposer submitted on August 26, 1986 the Affidavit of its first witness, Arturo Cerola, with voluminous annexes.

It took quite a time for Respondent-Applicant's counsel to submit its cross-written interrogatories relative to the Affidavit of Opposer's witness. Said cross-written interrogatories was transmitted to the Bureau on February 4, 1987.

The Bureau did not receive the Answer of Opposer's witness to the aforecited cross-written interrogatories for more than two years (February 4, 1987-June 30, 1989) so the case was dismissed motu proprio in Order No. 89-439 dated June 30, 1989.

Said Order was, however, reconsidered and set aside in Order No. 89-553 dated July 25, 1989. The case was thus set for hearing to August 28, 1989 for the reception of Opposer's evidence.

Again Opposer's counsel failed to appear at the hearings scheduled for August 28, September 28, and November 24, 1989, which prompted Respondent's counsel to file a Motion to Dismiss herein case on December 8, 1989.

On January 25, 1990, Opposer by counsel filed a Motion to withdraw herein opposition because Opposer "has lost interest in further prosecuting the above entitled case".

WHEREFORE, this Notice of Opposition is DISMISSED. Accordingly, Application Serial No. 46455 seeking for the registration of the trademark "TABATA" in the name of Respondent is given due course.

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

SO ORDERED.

IGNACIO S. SAPALO
Director