

HERBERT GMBH,)	INTER PARTES CASE NO. 3442
Petitioner,)	
)	PETITION FOR CANCELLATION:
)	
)	Cert. of Regn. No. 31606
)	Issued : March 21, 1979
)	Registrant : Standox Chemical
- versus -)	Corporation &
)	Logo
)	Trademark : NEC
)	Used on : Paints, lacquer,
)	thinner
)	
STANDOX CHEMICAL)	<u>DECISION NO. 91-2 (TM)</u>
CORPORATION,)	
Respondent-Registrant.)	January 30, 1991
x-----x)	

DECISION

This is a Petition for Cancellation of the Certificate of Registration No. 31606 for the trademark STANDOX CHEMICAL CORPORATION AND LOGO, issued on 23 February 1983 in the name of STANDOX CHEMICAL CORPORATION (herein Respondent-Registrant).

Petitioner, Herbert GMBH, is a corporation organized and existing under the laws of Germany with principal place of business at Christbush 25, 5600 Wuppertal, West Germany, while Respondent-Registrant is a corporation organized under the laws of the Philippines with business address at First Avenue, Bo. Bagumbayan, Taguig, Metro Manila.

The controversy started when the Petitioner filed an application for the registration of its trademark HERBERTS STANDOX and DESIGN under Serial No. 59587. The Examiner-in-Charge of the Petitioner's application cited the registration of Respondent-Registrant's tradename STANDOX CHEMICAL CORPORATION AND LOGO as a bar to tradename registration of the former. Petitioner filed its response to the Examiner's objection, claiming that no confusing similarity exists between the two marks. Pending resolution of the issue on confusing similarity before the Examiner-in-Charge, Petitioner took an inconsistent stand in filing a Petition for Cancellation of the cited mark, thereby necessarily relying on the existence of confusing similarity as a basis for the claim that it is or will be damaged by the registration of the subject cited mark. In its Petition, petitioner relied on the following grounds:

- (a) abandonment of the trademark STANDOX CHEMICAL CORPORATION and logo, by the Respondent-Registrant
- (b) failure of Respondent-Registrant to file the required Affidavit of use or non-use under Sec. 12 of RA 166, as amended.

A Notice to Answer within the fifteen (15) days reglementary period was then served to the Respondent-Applicant to which it did not comply. Thus, Respondent-Applicant was declared in default and Petitioner allowed to present its evidence ex-parte pursuant to Order No. 89-796.

To support its claim of abandonment of the tradename STANDOX CHEMICAL CORPORATION and LOGO, Petitioner submitted as evidence certified copies of the Board Resolution, stockholders' Resolution and Affidavit of Publication on Notice of Dissolution of the voluntary dissolution of Standox Chemical Corporation filed before the securities and Exchange Commission (SEC) on 3 January 1985 (Exhibits "I", "J", "K", and "L"). Petitioner further claims

that it made checkings on the principal place of business of respondent-registrant at First Avenue, Barrio Bagumbayan, Taguig, Metro Mania, confirming the actual shutdown of the office and/or factory (p. 7, Petitioners Memorandum). On the matter of non-filing of the required Affidavit of use/non-use, Petitioner submitted as evidence a certification issued by Atty. Estrellita C. Beltran, Chief of the Patent, Trademark Registry and EDP Division of this Office, certifying the fact that Respondent-Registrant failed to file the fifth anniversary Affidavit of use/non-use (exhibit "M"). Lastly, Petitioner presented as evidence a waiver document (Exhibit "H") executed by the Respondent-Registrant on 31 July 1989 in favor of Petitioner. Said waiver document contains a quit claim on the Petitioner's registration, appropriation, and utilization of the name STANDOX.

We grant the Petition.

Abandonment is one of the grounds for cancellation provided in Sec.17 of RA 166, as amended. By abandonment, "(t)here must be not only non-user, but also intent and to give up use of the tradename permanently" (p.4, Black's Law Dictionary, Fifth Ed., quoting Neva-Wet Corporation of Amenta v. Never Wet processing Corporation, 277 N.Y. 163, 13 N.E. 2d 755, 761). And considering that intent is a design, a state of the mind, or a mental attitude (p. 727, supra.), it presupposes the existence of the beholder. In the case before us, Respondent-Registrant was effectively dissolved and ceased to exist on 31 December, 1984 by virtue of its own resolutions and notice of dissolution filed with the Securities and Exchange Commission (exhibits "I", "J", "K", and "L"). However, we are not prepared to give credence on the waiver or quitclaim (exhibit "H") purportedly executed by the Respondent-Registrant in favor of the Petitioner. The document readily shows that it was executed only on 31 July 1989 through its chairman Mr. Bonifacio Que Pe. One wonders how an Officer could bind a Corporation which ceased to exist three years ago.

Anent the issue on the filing of Affidavit of use, we take notice of the fact that Respondent-Registrant failed to file the required Affidavit of use or non-use within one year following its fifth anniversary from issuance of the certificate of registration. Sec. 12 of RA 166, as amended, provides that ---

"(e)ach certificate of registration shall remain in force for twenty years: *Provided*, That registrations under the provisions of this Act shall be cancelled by the Director, unless within one year following the fifth, tenth and fifteenth anniversaries of the date of issue of the certificate of registration, the registrant shall file in the Patent Office an affidavit showing that the mark or trade-name is still in use or showing that its non-use is due to special circumstances which excuse such non-use and is not due to any intention to abandon the same, and pay the required fee."

In connection with Sec. 17 (e) of RA 166, as amended, we are constrained to cancel the subject registration.

WHEREFORE, Certificate of Registration No. 31606 for the tradename STANDOX CHEMICAL CORPORATION AND LOGO issued in the name of Respondent-Registrant, is hereby declared CANCELLED.

SO ORDERED.

IGNACIO S. SAPALO
Director