

ROBERTO Y. GABIREL, in his capacity as Administrator of the testate estate of Crisanta Y. Gabriel,	}	INTER PARTES CASE NO. 4197
	}	
Opposer,	}	Petition for Cancellation of:
	}	
	}	Regn. No. : 61382
	}	Date issued : 08-07-95
-versus-	}	Trademark : "C.Y. GABRIEL"
	}	Used for : bleaching soap
	}	
LORENZO B. ALMORADIE,	}	Decision No. : 2000-14
Respondent-Applicant.	}	
x-----x		

DECISION

On 15 August 1995, Roberto Y. Gabriel, a Filipino citizen, in his capacity as Administrator of the Estate of Crisanta Y. Gabriel, filed a verified Petition for Cancellation of Registration No. 61382 for the trademark "C.Y. Gabriel" used on bleaching soap falling under Class 3 if the International Classification of goods, which registration was issued on 07 August 1995 to Lorenzo B. Almoradie with address at No. 12-Romarosa Townhomes, Luzon Avenue, Balara, Quezon City.

Preceding the filing of the instant petition for cancellation, a petition for declaration of interference was filed on 18 July 1995 involving the same parties and issues.

Hence, on motion of Petitioner, this case was consolidated under IPC No. 4197 with the petition for cancellation as the main cause of action.

Petitioner premised this cancellation proceeding into two (2) main grounds:

"1. The Certificate of Registration no. 61382 was obtained fraudulently and contrary to Section four, Chapter II, R.A. 166, as amended; and

"2. The said Certificate of Registration was issued in gross violation of Section 4(a), Chapter II-A of R.A. 166, as amended, i.e. the questioned registered trademark consists of deceptive matter and falsely suggest a lawful connection with the decent Crisanta Y. Gabriel or C.Y. Gabriel, for brevity or to her Testate Estate (institution)."

The antecedent facts that petitioner relied upon were summarized as follows:

"1. Respondent was married to the deceased Crisanta Y. Gabriel (or C.Y. Gabriel) but whose marriage was later pronounced by the Higher Court to be a BIGAMOUS MARRIAGE;

"2. A party who acted in bad faith is disqualified to inherit, by testate or intestate succession from the innocent spouse (Art.43, FPC). A subsequent marriage contracted during the lifetime of the first marriage is illegal and void from the performance and no judicial decree is necessary to establish its invalidity;

"3. Respondent also became the facto Administrator of the Estate Crisanta Y. Gabriel upon her death on 25 January 1989 and became its first court declared administrator. Part of the estate of C.Y. Gabriel was her single proprietorship business, the C.Y. Gabriel

Commercial, which manufactures, sells and distributes various C.Y. Gabriel soaps, including soaps bearing the mark 'CYG' monogram registered in the Philippines under Regn. No. 29968, and issued on September 29, 1981;

"4. Respondent's prior use of the tradename C.Y. Gabriel was initially done in his capacity as the then legal husband of the deceased C.Y. Gabriel and as the first administrator of her estate and not in his personal capacity;

"5. When respondent's previous marital relationship with C.Y. Gabriel was declared to be illegal or bigamous, coupled with his ouster as administrator of the estate by the court, his right to use the trademark C.Y. Gabriel had legally ceased;

"6. In the respondent's label on its small box container presented to the market, it contains, on several sides of its box, and on one side of the soap itself, petitioner's patented 'c.Y.g.' monogram which is a clear violation of the trademark law;

"7. Respondent's Certificate of Registration No. 61382 should be outrightly cancelled in view of the factual circumstances."

On 27 September 1995, Respondent-Registrant filed his Answer denying the material allegations in the petition for cancellation and posited some technicalities in the petition as his special and affirmative defenses.

The contending parties failed to arrive at an amicable settlement during the pre-trial conference, and so, trial on the merits ensued.

Shunning away alleged technicalities relied upon by Respondent-Registrant for the dismissal of this case, this Office resolves to decide this case on its merit in view of the relevancy and materiality of the issue involved.

The focal issue here is whether or not Respondent-Registrant violated Section 17 (c) of R.A. 166, as amended i.e. "That the registration was obtained fraudulently or contrary to the provisions of section four, chapter II, hereof", in causing the registration of the mark "C.Y. Gabriel" bleaching soap.

Respondent-Registrant alleged in his Affidavit Exh "2" that:

"xxx

"7. I know that I was the first to adopt and use the trademark 'C.Y. Gabriel' bleaching soap and according to the Trademark Law, I can use the name of a living or dead person provided it does not disparage nor falsely suggest a connection with other persons, living or dead. Crisanta Y. Gabriel is a dead person who spent the major part of her life or 27 years of her life with me as my wife. The use of C.Y. Gabriel as a trademark for bleaching beauty soap is a fair tribute and no one can say that my use of C.Y. GABRIEL BLEACHING SOAP disparages nor falsely suggest a connection with her or bring into contempt or disrepute."

xxx"

The above quoted conclusion of herein Respondent-Registrant has no basis in fact and in law. Respondent conveniently for got that before any person or entity can adopt, use and appropriate a mark for himself, the same should not be appropriated by another.

Thus, under Secs. "2-A", "4", "4-a" and "4-d" of the Trademark Law, R.A. 166, as amended, which was the law in force and effect when the cause of Petitioner's action cropped up, it said that:

"Section 2-A. Ownership of trade-marks, trade-names and service marks; how acquired. – Anyone who lawfully produces or deals in merchandise of any kind or who engages in any lawful business or who renders any lawful service in commerce, by actual use thereof in manufacture or trade, in business, and in service rendered, may appropriate to his exclusive use a trade-mark, a trade-name, or a service-mark not so appropriated by another, to distinguish his merchandise, business or service from the merchandise, business or services of others. The ownership or possession of a trade-mark, trade-name, or a service-mark heretofore or hereafter appropriated, as in this section provided, shall be recognized and protected in the same manner and to the same extent as are other property rights known to the law. (Underscoring provided)

"xxx

"Section 4. Registration of trade-marks, trade-names and service-marks on the principal register. There is hereby established a register of trade-marks, trade-names and service-marks which shall be known as the principal register. The owner of trade-mark, trade-name or service-mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same o the principal register, unless it:

"(a) Consists of or comprises immoral, deceptive or scandalous matter, or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions beliefs, or national symbols, or bring them into contempt or disrepute;

"(b) xxx

"(c) xxx

"(d) Consists of or comprises 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; or

xxx

(Underscoring supplied)

As the evidentiary facts bear out, the monogram trademark "c.Y.g." for beauty soap (Class 3) was registered under Certificate no. 29968 on 29 September 1981 with Crisanta Y. Gabriel as owner and with a claim of first use on 17 October 1977 (Exhs. "E", "13").

Likewise, as shown by the evidence, the name C.Y. Gabriel Commercial was registered as a business name of Crisanta Y. Gabriel (Exhs. B, B-1, 11 & 12) and being used by her in her

invoices for the sale of her beauty soap using her registered mark "cYg" and mark as Exhs. "F" to "F-4" "F-6" "F-7".

On the other hand, the trademark "C.Y. Gabriel" bleaching soap (Class 3) was registered under Certificate No. 61382 on 07 August 1995 with Lorenzo E. Almoradie as owner and with a claim of first use on 25 January 1989 (Exhs. "H", "4").

For a better appreciation of the issue, it is necessary to make a comparative analysis of Petitioner's mark "cYg" on beauty soap and Respondent's "C.Y. Gabriel" bleaching soap.

As to their respective appearances, the following are noteworthy. Except for the inclusion of the words "wonder" soap in Petitioner's label, which was later dropped off as it was declared belonging to another (see *Gabriel-Almoradie v. Court of Appeals* [229 SCRA 15-34] in contrast to the "bleaching" soap for respondent-registrant (Exhs. "1", "3")., confusing similarity and a slight variation in color backdrop an overwhelming dissimilarity and disassociation, the labels bearing the "c.Y.g." and "C.Y. Gabriel" are identical in all respect in their overall presentation.

Not to infer the least, the mere mention of the monogram-trademark "c.Y.g.", an abbreviated initial of Crisanta Y. Gabriel which was owned by her along side the mark "C.Y. Gabriel" which was admitted by herein Respondent in his Affidavit to be the name of Crisanta Y. Gabriel, her alleged wife for 27 years, would leave a lasting impression that they are identical, interchangeable or interconnected.

Thus, the inevitable conclusion is that, the person who can be attributed as the owner of the marks "c.Y.g." and "C.Y. Gabriel" is the one bearing the name Crisanta Y. Gabriel. Since she is already dead, the marks "c.Y.g." and "C.Y. Gabriel" should form part of her Estate.

This Bureau observed the deliberate attempt of herein Respondent to impress upon us that C.Y. Gabriel Commercial owned by her late wife Crisanta Y. Gabriel, had not used her name "C.Y. Gabriel" as a trademark but only as a tradename and even went to the extent of defining and pointing out the difference between a trademark and a tradename. However, the evidence on record establish otherwise.

The testimony of Mr. Adolfo M. Puno, who testified that he was a Salesman-Driver of Crisanta Y. Gabriel form 1973 to 1975 and whose testimony was duly marked as Exh. "N" and duly identified by him and subjected to cross-examination, proved to all and sundry that Petitioner has indeed used the "C.Y. Gabriel" as trademark when he testified that "C.Y. Gabriel" is one of the trademarks being used by Crisanta Y. Gabriel and even identified the label marked by Respondent-Registrant as Exh. "1". Excerpts of his testimony during the cross-examination by Atty. Jocelyn C. Cruz, Counsel for Respondent-Registrant, were as follows:

"Q :You mentioned here in your affidavit that you sell soap products of C.Y. Gabriel Commercial. Can you tell us what in particular are these products?

"A : C.Y. Gabriel Wonder, C.Y. Gabriel Medicated, C.Y. Gabriel Special and C.Y. Gabriel Bleaching Soap.

"Q : All in all, how many kinds of soap products were you selling?

"A :Around four (4) C.Y. Gabriel Wonder, C.Y. Gabriel Kayumanggi, C.Y. Gabriel Dahlia, C.Y. Gabriel Excel all and C.Y. Gabriel Medicated

"Q : You mentioned just a while ago the word tatak. What do you Mean by tatak?

"A : C.Y. Gabriel and special soap.

"Q : Are you referring to the tatak that this soap you were selling were made, C.Y. Gabriel, C.Y. Gabriel or the soap itself has the mark C.Y. Gabriel?

"A : Yes. The soap has the mark C.Y. Gabriel.

"Q : How about the other soap that you mentioned Kayumanggi, Dahlia and Excel all. Does it have the name C.Y. Gabriel?

"A : Yes.

"Q : During the time, can you tell us who was managing C.Y. Gabriel Commercial?

"A : Crisanta Y. Gabriel.

x x x

"Q : As a salesman you are familiar with the packing of the soap that you distribute. While ago you were showing to us packaging?

"A : This one (shown) this is the soap we were selling.

"ATTY. CRUZ: And witness handing out to the lawyer a box container with a mark C.Y. Gabriel Wonder Special which would request to be marked as our Exhibit "1" your honor.

"HEARING OFFICER : Mark as requested.

"ATTY. CRUZ : You said when you handled this soap to me that this was the soap you are selling before. Can you tell us what year you were selling this product?

"A : We were selling this soap in 1972.

"Q : Where did you get this soap?

"A : In the old store where they have stocks.

"Q : Particularly this soap, with what store did you get?

"A : In San Leonardo, Nueva Ecija.

"Q : Can you recall from what store?

"A : It is a drug store in San Leonardo, Nueva Ecija.

"Q : You pointed a while ago to the log "CYG" which also appears in this Exhibit "1". Can you recall since when C.Y. Gabriel Commercial used this logo CYG?

"A : When I started working for C.Y. Gabriel that logo was already there and the name C.Y. Gabriel."

(TSN; August 26, 1997, pp. 6-8; 34-37)

With these, Petitioner was able to show by clear and convincing evidence that it was not only using the monogram "cYg" but also the name "C.Y. Gabriel" as a trademark of Crisanta Y. Gabriel. In fact, a cursory reading of the quoted cross-examination would disclose that "C.Y. Gabriel" was already being used by Petitioner way back 1972 when she was still alive, which is prior to the date of first use on January 25, 1989 (Exh. "2") of herein Respondent-Registrant for his bleaching soap bearing "C.Y. Gabriel".

Therefore, the deceased CRISANTA Y. GABRIEL who was the owner/proprietor of the business name C.Y. GABRIEL COMMERCIAL and the registered trademark "cYg" which is now a part of her Estate and who has likewise used the name "C.Y. Gabriel" as a trademark for her beauty soaps, has all the legal right to use and appropriate her name, whether it be her full name or any other moniker to which she was known in her business. Absolutely, no person or entity may use her name either as a trademark or as a tradename without her consent or without the consent of her Estate, if such use would be in conflict with her registered trademark or her business interest which is now part of her Estate.

Finally, knowing of the existence of another registered trademark "cYg" and registered business name "C.Y. Gabriel Commercial", both owned by Crisanta Y. Gabriel and that Crisanta Y. Gabriel was using the mark "C.Y. Gabriel", as discussed above, at the time of his alleged first use, and subsequently, the filing of his own application for registration of the mark "C.Y. Gabriel", which he admitted as the name of her alleged wife for 27 years, Respondent-Registrant could not assert that he was the one who first adopted and used the mark "C.Y. Gabriel".

Respondent-Registrant also alleged that there are dissimilarities in letters, sounds, and appearance between his mark "C.Y. Gabriel" and Petitioner's "cYg".

We do not countenance this scheme. In a line of decision, the Supreme Court emphasized that the test in determining confusing similarity is not simply to take their words and compare the spelling and pronunciation of said words. Rather it is to consider the two marks in their entirety, as they appear in the respective labels, in relation to the goods to which they are attached (Mead Johnson & Co. vs. N.V. Dorf, Ltd., [7 SCRA 286; Mead Johnson & Co., v. Director of Patents, et. al. [17 SCRA 128-129]]).

As discussed hereinabove, there is nothing that leaves to the imagination of unwary purchasers that the labels bearing the marks "cYg" and "C.Y. Gabriel" are not identical to or associated with, or under licensed by one over the other because they have practically the same label presentation and the same color scheme.

Hence, by allowing the mark "C.Y. Gabriel" bleaching soap of herein Respondent-Registrant and Petitioner's "cYg" beauty soap being sold by C.Y. Gabriel Commercial to co-exist in the market, there is a likelihood that the reputation and goodwill generated by C.Y. Gabriel Commercial in the sale of beauty soap with the mark "cYg", which is now part of the Estate of Crisanta Y. Gabriel will be diminished and tarnished because of the confusing similarity it had vis-à-vis the mark "C.Y. Gabriel" on bleaching soap being sold by Respondent.

This is where the significance of Section 17 (c) in relation to 4 (d) supra comes in. it said, inter alia, to viz:

"Section 17. Grounds for Cancellation. – Any person, who believes that he is or will be damaged by the registration of a mark of trade-name, may, upon the payment of the prescribed fee, apply to cancel said registration upon any of the following grounds:

(a) xxx

(b) xxx

(c) That the registration was obtained fraudulently or contrary to the provisions of section four, Chapter II hereof;

xxx”

As can be gleaned from the above quoted legal provisions, the party who will be damaged by the adoption or use of a similar mark is legally bound to call for a cancellation or striking out of a registered mark before this Office.

Ironically, the Estate of deceased Crisanta Y. Gabriel, or more particularly the business name “C.Y. Gabriel Commercial” would suffer damages through loss of goodwill and diminution of reputation if the mark “C.Y. Gabriel” bleaching soap of Respondent-Registrant were to be allowed to proliferate in the market.

To preempt this, a petition for cancellation of the registered trademark “C.Y. Gabriel” bleaching soap is found to be in order.

Respondent-Registrant’s objective of perpetuating the memory of his wife, which is noble as it may seem, by the use of the mark “C.Y. Gabriel” bleaching soap does not hold a grain of salt considering that the law itself proscribed him from appropriating the mark.

Neither do we buy Respondent-Registrant’s proposition that the use of his wife’s name will not bring her in contempt or disrepute.

If the intention of herein Respondent-Registrant is pure, he could have secured the approval of his wife Crisanta Y. Gabriel during her lifetime. Why did he wait for his wife’s demise before he used and even registered the name of “C.Y. Gabriel” as his trademark? The logical conclusion is, if her wife is still living, she will not permit her alleged husband to compete and confuse the buying public by using her name “C.Y. Gabriel” for bleaching soap when her own business, C.Y. Gabriel Commercial, is using the trademarks “cYg” and “C.Y. Gabriel” on her beauty soaps,

Respondent-Registrant was likewise of the view that there could be no similarity between the “C.Y. Gabriel Commercial” as a trade-name and the “C.Y. Gabriel” as a trademark. By citing jurisprudence, he went on to define trademark as referring “to a word, name, symbol, emblem, sign or device or any combination thereof adopted and uses by merchant to identify, and distinguish from others, his goods or commerce.” He added that: “(trademarks) must be affixed to the goods while a tradename is descriptive of the manufacturer or dealer himself as much as his own name is and frequently includes the name of the place where the business is located.”

There is no dispute about this. While we take cognizance of this difference, Respondent-Registrant failed to prove that the use of an identical trademark and trade-name “C.Y. Gabriel” and “C.Y. Gabriel Commercial” dealing on bleaching soap and sale of beauty soap products by two different persons would not result to confusion as to the source of origin of the products bearing such trademark and tradename were to be used simultaneously in the market.

The following principles cited in Converse Rubber Corporation v. Universal Rubber Products, Inc. (147 SCRA 154-166) bears remembering, to viz:

“A corporation is entitled to the cancellation of a mark that is confusingly similar to its corporate name. Appropriation by another of the dominant part of a corporate name is an infringement.”

xxx

“The similarity in general appearance of respondent’s trademark and that of petitioner would evidently create a likelihood among the purchasing public. But even assuming, arquendo, that the trademark sought to be registered by respondent is distinctively dissimilar from those of the petitioner, the likelihood of confusion would still subsists, not on the purchaser’s perception of the goods but on the origins thereof. By appropriating the word ‘CONVERSE’, respondent’s products are likely to be mistaken as having been produces by petitioner. The risk of damage is not limited to a possible confusion of goods but also includes confusion of a reputation if the public could reasonably assume that the goods of the parties originated from the same source. xxx” (Underscoring provided).

Therefore, contrary to the claim of Respondent-Registrant, there is confusing similarity between a trademark and a tradename especially if they deal on the same products or the same line of business.

As regards Respondent allegations that Roberto Y. Gabriel was doing business under his name and not through the estate of descendant C.Y. Gabriel as evidenced by DTI-NCR business registration dated 24 February 1992 (Exh. “15”), and BFAD License to Operate dated 02 April 1993 (Exh. “16”), this Bureau is precluded to resolve these pieces of evidence as it is not within its authority to decide on matter pertaining to business name registration and BFAD licenses which are within province of DTI-NCR and BFAD.

Besides, it did not escape the attention of this Office that at the time herein Respondent-Registrant adopted and used the trademark C.Y. Gabriel as his own on January 25, 1989 he was also appointed by the Court as the first Administrator of the Estate of Crisanta Y. Gabriel, yet he did not register C.Y. Gabriel in favor of the Estate but under his own name.

More elaborately, Respondent-Registrant’s declaration in his trademark application (Exh. “9”) that he was the first to use and adopt the subject mark “C.Y. Gabriel” bleaching soap is indicative that he was acting independently on his own and is not continuing or expanding his wife’s business.

This puts Respondent-Registrant in estoppel, hence, he is now precluded from assailing the validity of Petitioner’s act when himself had taken a semblance of validity on it through a similar action.

Moreover, as appearing on record, the Petitioner in this case is, Roberto Y. Gabriel, in his capacity as Administrator of the testate estate of Crisanta Y. Gabriel, not Roberto Y. Gabriel himself.

Finally, this Bureau would like to emphasize at this point, that one of the issues being litigated in this case is, who between the Respondent, Lorenzo B. Almoradie or the Estate of Crisanta Y. Gabriel is entitled to the registration of “C.Y. Gabriel” for bleaching soap. Consequently, the issue of Roberto Gabriel doing business under the name C.Y. Gabriel Commercial is immaterial since he is not claiming that the “C.Y. Gabriel” trademark is his own. What he is claiming is, “that the ‘C.Y. Gabriel’ trademark is part of the Estate of C.Y. Gabriel.” This is further bolstered by the fact that he filed instant Petition for Cancellation in his capacity as Administrator of the Estate of C.Y. Gabriel, an indication that he is claiming “C.Y. Gabriel” trademark as part of the Testate of Crisanta Y. Gabriel.

WHEREFORE, premises considered, the Petition for Cancellation GRANTED. Consequently, Certificate of Registration No. 61382 issued on 07 August 1995 is hereby ordered CANCELLED.

Let the filewrapper subject matter of this case be forwarded to the Administrative, Financial and Human Resource Development Services Bureau for appropriate action in

accordance with this Decision with a copy thereof furnished the Bureau of Trademarks for information and update of its record.

SO ORDERED.

Makati City, September 19, 2000.

ESTRELLITA BELTRAN-ABELARDO
Director