

ROMEO CHAUATECO.

IPC NO. 14-2009-00098

Opposer,
-versus-

Opposition to:
Appln. Serial No. 4-2007-001414
Filing Date: 12 February 2007
Trademark: HARVARD

PRESIDENT AND FELLOWS OF HARVARD
COLLEGE,

Respondent-Applicant.

x-----x

Decision No. 2011- 59

DECISION

ROMEO CHUATECO ("Opposer") filed on 27 March 2009 an opposition to Trademark Application Serial No. 4-2007-001414. The application, filed by PRESIDENT AND FELLOWS OF HARVARD COLLEGE ("Respondent-Applicant"), covers the mark "HARVARD" for use on "blazers, hats, sweatshirts, sweatpants, t-shirts, gloves, pants, shorts, blouses, shoes, socks, shorts, night gowns, jackets, ties, slippers, booties, bathing suits, scarves, raincoats, belts, camisoles, underwear" under Class 25 of the International Classification of Goods.

The Opposer alleges the following:

"1. The respondent applicant's mark "HARVARD" is identical with the mark of the opposer which was first used in the Philippines by the Opposer in 1982, more than 27 years before the filing of the respondent's trademark application.

"2. The adoption of the 'HARVARD' mark for goods under class 25 is an act designed to ride in the goodwill established by the Opposer on the 'HARVARD' mark for goods under class 25 in the Philippines and to compete unfairly with the Opposer.

"3. The Opposer has a prior valid and existing trademark registration and not abandoned as well as prior valid and existing trademark application for the 'HARVARD' marks for goods under class 25. Hence, Opposer should be protected against any subsequent attempt to register a confusingly similar or identical mark on the basis of Section 123.1 (d) of R.A. 8293, which states to wit:

"4. The Opposer is the owner of the 'HARVARD' trademark for goods under class 25 as found by the Bureau of Legal Affairs in IPC Case No. 14-2005-0094 entitled 'Fredco Manufacturing Corporation vs. President and Fellows Harvard College (Harvard University)

"The Opposer will rely on the following facts in support of the Opposition:

"1. Opposer is the true and lawful owner of the mark 'HARVARD' for t-shirts, Polo shirts, sandos, briefs, pants, jackets, and slacks under Class 25 having adopted, used, popularized and registered the same in the Philippines earlier than the Respondent-applicant.

"2. Opposer through its predecessor-in-interest, New York Garments Manufacturing & Export Co., Inc. first used the mark 'HARVARD' for goods under class 25 on 2 January 1982. (see attached EXHIBIT A)

"3. Opposer through its predecessor-in-interest, New York Manufacturing & Export Co., filed an application for trademark registration with the then BPTTT (Now IPO) on 24 January 1985 for the mark 'HARVARD' for goods under class 25.

"6. (sic) The said application matured into a registration in the Principal Register and was issued a Trademark Certificate of Registration No. 42348 on 12 December 1988 and in the Supplemental Register on 20 September 1985 (see Attached EXHIBIT B & C)

"7. The said registration was later assigned to the Oppressor, Romeo Chuateco, a family member of the family-owned, New York Garments Manufacturing & Export Co. Inc.

"8. Believing that their mark was registered for a term of twenty (20) years there being no other requirements except for its renewal after the end of the term, Opposer's predecessor-in-interest focused and concentrated all its effort in marketing and promoting the mark 'HARVARD' for clothing. (see attached EXHIBIT D)

"9. In the years that followed, it has spent considerable amount in advertisement and promotion of the mark 'HARVARD' thereby earning a nationwide reputation and following. Through its aggressive promotion and continuous use of the 'HARVARD' mark, the business flourished and the mark 'HARVARD' acquired through time in the minds of the purchasing public, a good reputation and high quality-image. (see attached EXHIBIT E)

"10. On October 3, 1991 or more than nine (9) years after Opposer's predecessor-in-interest registered the same mark with the then BPTTT on December 12, 1988, respondent-applicant in bad faith and with prior knowledge on the existence and reputation of Opposer's 'HARVARD' mark of goods under class 25 filed a trademark application with the then BPTTT for 'HARVARD VE RI TAS 'SHIELD SYMBOL' for goods under class 25 which is identical, if not similar, with Petitioner's 'HARVARD' mark.

"11. On 25 November 1993 or more than twelve (12) years after Opposer's predecessor-in-interest adopted and started using the mark 'HARVARD' on January 2, 1982 and almost five (5) years after Opposer's predecessor-in-interest registered the same mark with the then BPTTT on December 12, 1988, respondent-applicant fraudulently obtained and was granted Philippine Trademark Registration No. 56561 for the identical/similar mark 'HARVARD VERITAS 'SHIELD' DESIGN' for goods under Class 25. (see attached EXHIBIT F)

"12. When respondent-applicant filed its application and until it was issued a registration, Opposer has a valid and existing registration for the mark 'HARVARD' for goods under class 25 and was used in commerce and not abandoned.

"13. On 09 November 1995, Fredco Manufacturing Corp., was formed and registered with the Securities and Exchange Commission. Since then, Opposer have it handle the marketing and promotion of the mark 'HARVARD' and the manufacture of the clothing articles under the 'HARVARD' mark. (see attached EXHIBIT G & H).

"14. Believing that the mark was registered for a term of twenty (20) years there being no other requirements except for its renewal after the end of the term, by inadvertence Opposer failed to file the affidavit to use/non-use for 5th Anniversary resulting to the cancellation of its registration on 30 July 1998.

"15. Opposer learned only of the cancellation when Respondent-Applicant demanded that they stopped using the mark.

"16. Opposer filed a Petition for Cancellation for Respondent-applicant's trademark registration of 'HARVARD VE RI TAS 'SHIELD' SYMBOL' for class 25 goods before the Bureau of Legal Affairs, Intellectual Property Office.

“17. In its ‘Decision’ of December 22, 2006, a certified true copy of which is hereto attached as EXHIBIT I, the Bureau of Legal Affairs (‘BLA’) of the Intellectual Property Office ruled in favor of petitioner Fredco Manufacturing Corporation, finding as follows:

x x x

“18. On appeal, the Office of the Director General reversed and set aside the decision of the Bureau of Legal Affairs. The decision of the Director General was affirmed by the Court of Appeals. The case is now pending before the Supreme Court.

“19. After the Bureau of Legal Affairs promulgated its decision, Opposer filed its application for the ‘HARVARD’ mark on January 19, 2007 or almost a month before the respondent-applicant filed its trademark application for the ‘HARVARD’ mark.

“20. Opposer’s trademark application was allowed and published in the E-Gazette on February 29, 2008 but was opposed by the respondent-applicant.

“21. Meanwhile, respondent-applicant trademark application for the ‘HARVARD’ mark for goods under Class 25 was allowed and was published in the E-Gazette despite the existing prior applicant of the Opposer. Hence, this instant Opposition.”

The Respondent-Applicant filed its Answer on 17 August 2009 refuting the material allegations of the Opposer. The Respondent-Applicant alleges, among other things, the following:

“26. Respondent-applicant President and Fellows of Harvard College (Harvard University) was established in 1636 and is over 350 years old. It is a highly regarded institution of higher learning in the United States of America and is well-known throughout the world.

“27. It is the owner of the more than 350 year old well-known name and mark HARVARD and is the proprietor of numerous trademark registration for HARVARD in countries worldwide, including the Philippines, for various classes xxx.

“28. The name and mark HARVARD was first used in connection with the word College as early as 1638 and in commerce as early as 1872.

“29. It promotes, uses, and advertises its name HARVARD through various publications, services, and products in foreign countries, including the Philippines.

“30. In the Philippines, Respondent-applicant is the owner of the valid and existing certificates of trademark registrations x x x

“31. Respondent-applicant’s well-known name and mark HARVARD have been rated as one of the most famous brands in the world and valued between 750 million and 1 billion U.S. dollars in the article ‘Most Valuable Brands’ published in October 1997 issue of the Financial World.

“32. In 1989, Respondent-applicant established the HARVARD Trademark Licensing Program, operated by the Office for Technology and Trademark licensing, to oversee and manage the worldwide licensing of the HARVARD name and trademarks for various goods and services in classes 16, 18, 21, 24, 25 and 41.

“33. Respondent-applicant has not, however, authorized or licensed Romeo Chuateco or Fredco Manufacturing Corp. to use the name or mark HARVARD on any of

his goods or services, or to continue filing trademark applications for the name and mark HARVARD in the Philippines.

“34. The Opposer’s act of illegally appropriating and using the well-known name HARVARD violates the treaty obligations of the Philippines under Art. 8 of the Paris Convention for the Protection of Industrial Property, x x x

“35. Opposer’s adoption and use of the trade name HARVARD as a brand name in connection with the word ‘Cambridge, Massachusetts’ and ‘USA’ in the articles of clothing it manufactures and the labels likewise violates Section 165 of R.A. 8293 xxx

“36. HARVARD is a well-known name and respected mark. Opposer’s adoption and use of the HARVARD name in bad faith as shown below cannot give rise to valid trademark rights since the name HARVARD has already been appropriated by another entity xxx

“37. The mark Harvard, which was the subject of cancelled Philippine Trademark Registration No. 42348, should not even have been registered by Opposer’s predecessor-in-interest in the first place since its previous registration was obtained contrary to sections 4 (a) and 3 (e) of R.A. 166, which prohibited the registration of a mark that may be disparage and falsely suggest a connection with persons or institutions, such as the Harvard University.

“38. In the same manner, the current trademark applications for Harvard Jeans HJCO and Harvard & Design filed by Romeo Chuateco and which are the subject of oppositions falsely suggest a connection with the HARVARD institution, hence, their registration will be contrary to Section 123.1 (a) of R.A. 8293, which provides that: xxx

“39. Respondent-applicant is likewise entitled to protect its well-known name and mark virtue of the treaty obligations of the Philippines under Article 6 bis of the Paris Convention as well as Section 123.1 (e & f) of R.A. 8293, which state as follows:

xxx

“42. Opposer’s unauthorized use of the name HARVARD for its articles of clothing serves to mislead and to deceive the public into believing that its goods are sanctioned or sponsored by the Respondent-applicant, which is located in ‘Cambridge, Massachusetts’ on the logo appearing on its labels is a deliberate attempt to deceive the public into believing that it is affiliated or connected with Respondent-applicant, and to ride on the reputation and goodwill of the name HARVARD. xxx

“44. Out of the many available names, symbols and ideas, Opposer chose the well-known name and mark HARVARD for its articles and clothings, knowing very well that the name HARVARD belongs to the celebrated institution of learning, HARVARD UNIVERSITY. Opposer has not denied its knowledge of Respondent-applicant’s existence. Hence, Opposer’s adoption and use of the name and mark HARVARD without Respondent-applicant’s consent is an absolute act of gross and evident bad faith.

x x x

The preliminary conference was conducted and terminated on 19 October 2009. On 03 February 2010, the Hearing Officer issued Order No. 2010-233 which states:

“In view of the petition pending before the Supreme Court involving the issue of ownership of the mark ‘HARVARD’ in the Philippines for goods under Class 25 and upon request of Opposer without objection on the part of Respondent-Applicant, the filing of

position paper by the parties is hereby deferred until the rendition of a decision in the said Petition for Review on Certiorari before the Supreme Court”.

Should the Respondent-Applicant be allowed to register the mark HARVARD?

There is no dispute that the Respondent-Applicant’s mark is identical to the Opposer’s and that both marks are used on similar and closely related goods. Hence, the competing marks are confusingly similar and therefore cannot co-exist. What is disputed is the ownership and the right to register and use the mark HARVARD.

In this regard, the Intellectual Property Office of the Philippines through the Decision of the Director General in Appeal No. 14-07-09 (IPC No. 14-2005-00094, entitled President and Fellows of Harvard College (Harvard University) v. Fredco Manufacturing Corporation) has resolved the aforementioned issues in favor of the Respondent-Applicant. The Director General’s decision was affirmed by the Court of Appeals in CA-G.R. SP No. 103394, promulgated on 24 October 2008. The Supreme Court in G.R. No. 18517 sustained the decisions of the Director General. The High Court concurred with the findings of the Director General, to wit:

“‘Harvard’ is a well-known name and mark not only in the United States but also internationally, including the Philippines. The mark ‘Harvard’ is rated as one of the most famous marks in the world. It has been registered in at least 50 countries. It has been used and promoted extensively in numerous publications worldwide. It has established a considerable goodwill worldwide since the founding of Harvard University more than 350 years ago. It is easily recognizable as the tradename and mark Harvard University of Cambridge, Massachusetts, U.S.A. internationally known in the world. As such, even before Harvard University applied for registration of the mark ‘Harvard’ in the Philippines, the mark was already protected under article 6 bis and article 8 of the Paris Convention. Again, even without applying the Paris Convention, Harvard University can invoke Section 4 (a) of R.A. No. 166 which prohibits the registration of a mark ‘which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs xxx’ . “

Succinctly, the Court also held in its decision that there are two (2) compelling reasons why Fredco’s case fails:

First, Fredco’s registration of the mark ‘Harvard’ and its identification of origin as Cambridge, Massachusetts’ falsely suggest that Fredco or its goods are connected with Harvard University, which uses the same mark ‘Harvard’ and is also located in Cambridge, Massachusetts. This can easily be gleaned from the following oblong logo of Fredco that it attaches to its clothing line:

xxx

“Fredco’s use of the mark ‘Harvard’ coupled with its claimed origin in Cambridge, Massachusetts, obviously suggest a false connection with Harvard University. On this ground alone, Fredco’s registration of the mark Harvard should have been disallowed.

Indisputably, Fredco does not have affiliation or connection with Harvard University, or even with Cambridge, Massachusetts. Fredco or its predecessor New York Garments was not established in 1936, or in the U.S.A. as indicated by Fredco in its oblong logo. xxx”

Accordingly, as the owner of the mark HARVARD, the Respondent-Applicant has all the right to register the mark. Conversely, not being the owner of the mark, the Opposer has no right to register it and claim the use thereof, much less prevent the Respondent-Appellant from doing so.

WHEREFORE, premises considered, the instant opposition case is hereby DISMISSED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO OREDERED.

Taguig City, 14 July 2011