

MRS. GIULIANA CAMERINO,  
Petitioner,

INTER PARTES CASE NO. 1841  
Pet. For Cancellation:

- versus-

Regn. No.5484  
Date Issued: April 23, 1981  
Trademark: "R with Buckle Device"

ROBERTO YAP,  
Respondent-Registrant.  
X-----X

DECISION NO. 97-23

### DECISION

This is a Petition for Cancellation of trademark "R with Buckle Device" used on sportswear, pants, jeans under Certificate of Registration No. 5484, issued on April 23, 1981 in the name of Roberto Yap, hereinafter referred to as Respondent-Registrant, a Filipino citizen and residing at 2720 Figueroa Street, Pasay City,

Petitioner Guiliana Camerino Nee Coen, known and trading as Roberta di Camerino, is an Italian citizen with principal address at Castelo 6123, Venice, Italy.

Petitioner raised the following grounds in this Petition:

- "1. That the registration of the trademark "R with Buckle Device" by Respondent-Registrant was obtained fraudulently;
- "2. That the registration is contrary to the provision of Section 4(d), Chapter 11-A of R.A. 166, as amended; and
- "3. That cancellation is authorized by other provision of R.A. 166, as amended."

To sustain these grounds, Petitioner relied on the following facts:

- "1. Trademark "R with Buckle Device" of Respondent-Registrant is a flagrant and veritable imitation of Petitioner's trademark "R with Buckle Device" as likely to cause and has caused confusion, mistake or deception to the buying public as to the source of goods;
- "2. Petitioner's trademark has acquired the reputation of high quality products;
- "3. The registration of Respondent-Registrant's trademark "R with Buckle Device" was procured by means of false or fraudulent representations or declarations;
- "4. The use and adoption by Respondent-Registrant of trademark "R with Buckle Device" as his trademark has falsely suggested a connection with the existing business of petitioner with that of Respondent-Registrant and therefore, constitute fraud and/or intent to defraud petitioner."

On May 31, 1984, a Notice to Answer was sent to the Respondent Registrant by registered mail with Return Card No. 3633.

On July 05, 1984, Petitioner moved to declare Respondent-Registrant in default for failure to file his Answer within the reglementary period.

Subsequently, the Bureau issued Order No. 84-240 dated July 11, 1984 declaring Respondent-Registrant in default for failure to file an Answer pursuant to Sec. 1, Rule 18 of the Revised Rules of Court and Rule 169 (d) of the Rules of Practice in Trademark Cases.

On July 23, 1984, Respondent-Registrant opposed the Motion to Declare in Default contending that the Notice to Answer has not yet been received and on August 01, 1984 the same party moved to lift the order of default which this Office granted under Order No. 84-435 dated 28 November 1984.

Correspondingly, after extension of time to file answer was granted, Respondent filed her answer with counterclaim. Petitioner formally offered Exhs. "A" to "D" as evidence which was admitted by this Office.

The case was thereafter set for the presentation by Respondent's evidence on September 24, 1985 but Respondent nor his Counsel failed to appear. Hence, the same was reset to October 21, 1985 but Respondent and his Counsel again failed to appear.

Thereafter, for failure to attend the scheduled hearings, Respondent-Registrant was deemed to have waived his right to present evidence and the case was deemed submitted for decision under Order No. 86-90 dated 17 March 1986.

On May 22, 1986, Petitioner submitted her Memorandum. From hereon to date, no action has been taken by the Bureau in the above-entitled case. Verification was subsequently made and it was found out that the records of this case have been lost when the Bureau transferred from Midland Building to its present location and was not listed in the inventory of cases.

Hence, the Petitioner filed a petition for reconstitution of the records dated July 05, 1994 which the Bureau granted on July 20, 1994 in Order No. 94-519.

The issues to be resolved are as follows:

1. Whether or not Respondent-Registrant's trademark "R with Buckle Device" is confusingly similar with that of Petitioner.
2. Which of the contending parties has acquired priority of registration and goodwill over the mark "R with Device" to the exclusion of the use/ registration of the same by all others.

As to the issue of confusing similarity, the Philippine Patent Office in its Decision No. 85-52 rendered in Inter Partes Case No. 1568 (Exhibit "B") opined, thus;

"x x x

It has been consistently held that the question of infringement of a trademark is to be determined by the test of dominancy. Similarity in size, form and/or color, while relevant, is not conclusive. If the competing trademark contains the main or essential dominant features of another, and confusion and deception are likely to result, infringement is not necessary; nor is it necessary that the infringing labels should suggest an effort to imitate (C. Mielman Brewing Co. vs. Independent Brewing Co., 191 F. 489, 495, citing Eagle White Lead Co. vs. Plough [cc], 180 Fed. 579).

Having these views in mind, I am constrained to hold that Opposer's mark and that of Respondent-Applicant are confusingly similar. As stated earlier, the Opposer's mark and that of Respondent have substantially the same appearance, same sound, same color background and above all, contain the same "R" logo with buckle design and these similarities create a likelihood of confusion. Although there exist some difference in the marks, such differences are not striking enough to overcome the similarity in their dominant feature. xxx" (Underscoring provided)

It should be borne in mind that the above-cited decision involves the same parties with respect to the same mark as in this instant case. Thus, we find no cogent reason to depart from this ruling.

Further, confusing similarity of Respondent-Registrant's trademark to herein Petitioner is a clear contravention of Section 4(d) of our Trademark Law which provides as follows:

“Section 4. *Registration of trademarks, tradenames and service marks on the principal register.* – There is hereby established a register of trademarks, tradenames and service marks which shall be known as the principal register. The owner of a trademark, tradename and service mark use to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same in the principal register, unless it:

x x x

(d) Consist of or comprises a mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename 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.”

Having established the confusing similarity between the two marks, the remaining issue to be resolved is which of the contending parties has the priority of registration and goodwill over the mark “R with Buckle Device”.

As shown by the records of the above-entitled case, the trademark “R with Buckle Device” has been registered by Petitioner in many countries, thus:

1. Italy, Trademark Certificate of Registration No. 256501 issued on December 30, 1971, March 2, 1972 (Exhibit “C”)
2. U.S.A., Trademark Certificate of Registration No. 988163 issued on July 16, 1974 (Exhibit “D”)
3. Japan, Trademark Certificate of Registration No. 1561821 issued on January 23, 1983 (Exhibit “E”)
4. Japan, Trademark Certificate of Registration No. 1246583 issued on January 27, 1977 (Exhibit “F”)
5. Japan, Trademark Certificate of Registration No. 1082727 for footwear issued on August 19, 1974.
6. Australia, Trademark Certificate of Registration No. A298, 690 for footwear issued on July 19, 1976 (Exhibit “I”)
7. Australia, Trademark Certificate of Registration No. A298, 688 issued on July 19, 1976 (Exh. “J”)

Exhs. "C" to "J" will clearly show that the Petitioner was able to prove beyond any scintilla of doubt that she had prior and continuous use of the trademark "R with Buckle Device" in many countries throughout the world as early as December 3, 1971 in contrast to the uncorroborated claim by Respondent-Registrant that he first used the mark in 1978.

Needless to state, the non-appearance of the Respondent-Registrant in the scheduled hearings, September 24, 1985 and October 21, 1985, which prompted Petitioner to move for the

waiver of Respondent-Registrant to present evidence is a clear indication that said party has lost interest in this case as he did not even move for the reconsideration of Order No. 86-90 dated March 17, 1986 declaring him to have waived his right to present evidence and submitting this case for decision. Thus, this may be interpreted as an abandonment of Certificate of Registration No. 5484 for the mark "R with Buckle Device" used on sportswear, pants and jeans.

Moreover, a review of the records of subject registration reveals that registrant has not filed the required affidavit of use for the 5th and 10th, anniversaries which were due on April 23, 1986 to April 23, 1987 and April 23, 1991 to April 23, 1992 respectively hence, such registration should be cancelled in accordance with Section 12 of the Trademark Law.

WHEREFORE, this Petition is hereby GRANTED. Consequently, Certificate of Registration No. SR. 5484 issued to Respondent-Registrant Robert Yap is hereby CANCELLED.

Let the records of this case be forwarded to the Patent, Trademark Registry and EDP Division for appropriate action in accordance with this Decision with a copy to be furnished the Trademark Examining Division for information and to update its records.

SO ORDERED.

Makati City, November 03, 1997.

EMMA C. FRANCISCO  
Director