

DELIAS BRAND LLC
Opposer,
- versus -

IPC 14-2004-00092

Opposition to:
TM Application No. 4-2002-001946
(Filing Date: 07 March 2002)

NELSON CHAN
Respondent-Applicant.
x-----x

TM: "DELIAS WITH THE
REPRESENTATION OF A SIX PETAL
FLOWER AFTER THE LETTER S"

Decision No. 2007-25

DECISION

This pertains to the VERIFIED NOTICE OF OPPOSITION filed by Delias Brand LLC to the application for registration of the trademark DELIAS WITH THE REPRESENTATION OF A SIX PETAL FLOWER THE LETTER S for goods under class 25, filed on March 7, 2002 under Serial No. 4-2002-001946 filed by Nelson Chan and was published on page 133 of Volume VII, No. 2 issue of the Official Gazette, released for circulation on June 7, 2004.

Opposer Delias Brand LLC, a limited liability company organized under the laws of State of Delaware., with principal office at 435 Hudson Street, New York, New York, while Nelson Chan is a Filipino with business address at Unit 1318 Franco corner Moriones Street, Tondo, Manila.

The grounds for the Opposition to the registration of the trademark are as follows:

1. Opposer is the first user and the true owner of the trademark and trade name "DELIAS", in the Philippines and in other countries worldwide, which it has been using on casual apparel, cosmetics and accessories for young women (specifically as a trademark for goods in Classes 3, 9, 14, 16, 18, 24, 25 and as a service mark in Classes 35 and 42) long before Applicant appropriated and used it for identical or related goods. Applicant's trademark Delias (with the Representation of a Six Petal Flower after the letter S), for identical or related goods so resembles Opposer's identical trademark and trade name "DELIAS" for casual apparel, cosmetics, accessories and other goods and services, that likely, when applied to or used in connection with the goods of Applicant, to cause confusion, mistake and deception on the part of the purchasing public.
2. The registration of the trademark "Delias" (with Representation of a Six Petal Flower after the letter S) in the name of the Applicant will violate Section 123.1 (e) and (f) of the Intellectual Property Code, Article 6bis of the Paris Convention for the Protection of Industrial Property and Article 16 of the Agreement of Trade Related Aspects of Intellectual Property Rights, to which the Philippines and the United States of America are parties.
3. The registration and use by Applicant of the trademark "DELIAS" (with the representation of a Six Petal Flower after the letter S) will diminish the distinctiveness and dilute the goodwill of Opposer's trademark and trade name "DELIAS", which has earned international renown as a trademarks for goods in classes 3, 9, 14, 16, 18, 24 and 25, and which is a well-known trademark and trade name, within the meaning of treaties on industrial and intellectual property rights and the previous of Intellectual Property Code, including Section 123.1 (e) and (f) and Section 147.2

4. Applicant adopted the trademark "DELIAS" (with the Representation of a Six Petal Flower after the letter S) on identical or related goods with the obvious intention of misleading the public into believing that his goods bearing the trademark originate from, or are licensed or sponsored by Opposer, which has been identified in the trade and by consumers as the source of goods bearing the trademark and trade name "DELIAS".
5. The approval of Applicant trademark "DELIAS" (with Representation of a Six Petal Flower after the letter S) is based on the fraudulent misrepresentation that he is the true owner and first user of the trademark.
6. The registration of the trademark "DELIAS" (with Representation of a Six Petal Flower after the letter S) in the name of the Applicant is contrary to international treaties and conventions to which the Philippines and the United States of America adhere, and other provisions of the Intellectual Property Code, including Section 165, which protect Opposer's trademark and trade name "DELIAS" without the obligation of filing or registration against any subsequent use by others in a manner that is likely to mislead the public.

On December 15, 2004, a Notice to Answer was sent to the Respondent-Applicant and after an extension, Respondent-Applicant timely submitted its Answer.

On 11 October 2005, this Office issued a NOTICE TO COMPLY WITH OFFICE ORDER NO. 79, series of 2005 (Amendments to the Regulations on Inter Partes Proceedings), prescribing therein the summary rules which took effect on September 1, 2005. In the aforementioned notice, both parties were required to submit the originals of all their evidence and two (2) duplicate copies within thirty days from receipt thereof.

Record show that both parties failed to comply with the aforementioned notice.

The Opposer, thru Order 2005-1021 was granted an extension of time to submit its compliance to Office Order No. 79, however, they filed another Motion for Extension of Time dated 15 December 2005 which was denied by the then Hearing Officer thru Order 2006-60, the dispositive portion of which reads, to wit:

"WHEREFORE, Opposer's Motion for Extension of Time to Submit Evidence is DENIED".

Thereafter, a Motion and Manifestation was files by the Opposer on 25 January 2006 praying that the exhibit and affidavits that they are presenting be admitted. On 20 February 2006, this Office issued Order 2006-280, the dispositive portion of which reads, viz:

"WHEREFORE, Opposer's Motion and Manifestation is a prohibited pleading and not allowed under the summary rules. Accordingly the same cannot be given due course. Consequently, the Opposition and the supporting documents attached thereto shall constitute the entire evidence for the Opposer subject to applicable Rules".

The Respondent-Applicant on the other hand filed its Manifestation and Motion on 05 December 2005 and prayed for an extension of time to file its evidence up to January 16, 2006. Order 2005-1143 dated 12 December 2005, however, partially granted the extension, the dispositive portion of which reads, to wit:

"WHEREFORE, Respondent-Applicant is given a non-extendible period of thirty (30) days from 8 December 2005 or until 7 January 2006 within which to submit all his evidences".

As per record, Respondent filed its Compliance with Office Order No. 79 on 11 January 2006, which is two (2) days late from the deadline provided in Order 2005-1143.

Considering that both parties failed to file their evidence on time, they are both deemed to have waived their right to submit their evidences as mandated by Order No. 79. Hence, the opposition and answer, and the supporting documents respectively attached thereto shall constitute the entire evidence respectively for the Opposer and respondent.

The evidence attached by the Opposer in its Verified Opposition consists of the following:

1. Original copy of a Certificate of Authentication issued by The Foreign Service of the Philippine certifying James Bizzarri as the Special Deputy Secretary of State of New York at the time he affixed his signature on the annexed certificate.
2. Original copy of a Certification that Karen V. Murphy was Clerk of the Country of Nassau in the state of New York signed by James Bizarri.
3. Original Special Power of Attorney issued in Favor of Sycip, Salazar, Hernandez & Gatmaitan.
4. Xerox copies of Owner Trademark Report by Country consisting of Exhibits "A" with annexes "A-1" to 5".

The Respondent on its part has no attachment in its Answer.

On 2 January 2006, this Office issued a Notice of preliminary Conference scheduled on 16 February 2006. As per the minutes of the hearing, only the counsel for the Respondent-Applicant was present, and for the failure of the Opposer to appear, the preliminary conference was terminated and the Opposer was deemed to have waived its right to submit its position paper. Thereafter, the case was submitted for decision.

The only issue to be resolved in this case is whether or not the Respondent-Applicant is entitled to the trademark Delias with representation of a six petal flower after the letter S.

The Opposer failed to establish any property rights against the Respondent-Applicant's application for the trademark Delias. Order No. 2006-60 denying Opposer's Motion for Extension of Time to submit its evidences and Order 2006-280 (rendering the motion and manifestation a prohibited pleading) has in effect rendered the allegations contained in the Verified Opposition as baseless. Secondly, the Exhibits attached to the Verified Opposition marked as Exhibits "A" with annexes "A-1 to 5" are unauthenticated and mere Xerox copies which are not admissible in evidence. Section 7 and Subsection 7.1 of Office Order No. 79 provides as follows:

"Section 7. Filing of Petition or Opposition-

7.1 The petition or opposition, together with the affidavits of witnesses and originals of the documents and other requirements, shall be filed with the Bureau, provided, that in case of public documents, certified copies shall be allowed in lieu of the originals.xxx

Moreover, Rule 130, sec. 3 of the Rules of Court provides:

"Rule 130, Sec. 3. Original document must be produced; exceptions. – When the subject of inquiry is the contents of a document, no evidence shall be admissible other than the original document itself, except in the following cases:

- (a) When the original has been lost or destroyed, or cannot be produced in court, without bad faith on the part of the offeror;

- (b) When the Original is in the custody or under the control of the party against whom the evidence is offered, and the latter fails to produce it after reasonable notice;
- (c) When the original consist of numerous accounts of other documents which cannot be examined in court without great of time and the fact sought to be established from them is only the general result of the whole; and
- (d) When the original is a public record in the custody of a public officer or recorded in a public office”.

It is also noted and taken into consideration that the Opposer has no such local registration secured for the trademark Delias, neither have they applied for the registration of the same. What is evident in this case is application 4-2002-01946 filed by herein Respondent for the contested trademark, hence, this Bureau finds no justifiable reason to warrant denial of due course to such application.

WHEREFORE, premises considered, the Notice of Opposition is hereby DENIED. Consequently, application serial no. 4-2002-001946 filed by Respondent-Applicant Nelson Chan on 7 March 2002 for the registration of the mark DELIAS WITH THE REPRESENTATION OF A SIX PETAL FLOWER AFTER THE LETTER S under class 25 is hereby GIVEN DUE COURSE.

Let the filewrappers of DELIAS, subject matter f this case be forwarded to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Makati City, February 28, 2007

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office