

FREDCO MANUFACTURING
CORPORATION

Petitioner,
- versus -

PRESIDENT AND FELLOWS,
OR HARVARD COLLEGE
(HARVARD UNIVERSITY),
Respondent-Applicant

x-----x

IPC 14-2005-00105

Opposition to:
TM Application No. 56561
(Filing Date: March 25, 2002)

TM: "Harvard VERITAS
"Shield" Symbol
Decision No. 06-157

DECISION

This pertains to a Petition for Cancellation on 10 August 2005 by herein Petitioners, Fredo Manufacturing Corporation docketed as Inter Partes Case No. 14-2005-00094 against the registration of the trademark "HARVARD VERITAS "SHIELD" SYMBOL" bearing Registration No. 56561 on 25 November 1993 for decals, tote bags, serving trays, sweatshirts, t-shirt, hats and flying discs under class/es 16, 18, 21, 25 and 28 to herein Respondent-Registrant, PRESIDENT AND FELLOWS OF HARVARD COLLEGE (HARVARD UNIVERSITY).

Petitioner is a corporation duly organized and existing under the laws of the Philippines with principal place of business at 656 Padre Rada St., cor. Juan Luna, Tondo Manila, Philippines.

Respondent-Registrant on the other hand is the President and fellows of Harvard College (Harvard University), a corporation organized and existing under the laws of the State of Massachusetts, United States of America, having its principal place of business at 17 Quincy St., Cambridge, Massachusetts, United States of America.

The relevant facts and grounds of this Petition are culled from the records, as follows:

1. Respondent fraudulently obtained the registration of the trademark "HARVARD VERITAS "SHIELD" SYMBOL" on 25 November 1993 under Trademark Registration Number 5656.
2. The mark "HARVARD" for t-shirts, polo shirts, briefs, jackets and slacks was first used in the Philippines by Petitioner's processor-in-interest. New York Garments Manufacturing & Export Co. Inc., on 02 January 1982, who filed an application for trademark registration with the then BPTT (now IPO) on 24 January 1985 for the mark "HARVARD" for goods under class 25.
3. The said application matured into a registration to the Principal Register and was issued a Certificate of Registration on 12 December 1988, which was later assigned to Romeo Chuateco, a family member of the family-owned, New York Garments Manufacturing & Export Co. Inc., with twenty (20) years term, subject to renewal at the end of the term.
4. In the years that followed, Petitioner's predecessor-in-interest spent considerable amount in advertisement and promotion of the mark "HARVARD" thereby establishing goodwill on the "HARVARD" mark. Its aggressive promotion and continuous use of the same flourished the business making it a household name.
5. On 25 November 1993, Respondent fraudulently obtained and was granted Philippine Trademark Registration No. 56561 for HARVARD VERITAS "SHIELD"

SYMBOL for goods and services in classes 16, 18, 21, 25, and 28 of the NICE International Classification of Goods and Services.

6. At the time of the issuance, Petitioner has a trademark registration for the mark "HARVARD" for goods under class 25.
7. On 09 November 1995, Petitioner Fredo Manufacturing Corp. was formed and registered with the Securities and Exchange Commission. Since then, it handed the marketing and promotion of the mark "HARVARD" and the manufacture of its clothing articles.
8. To maintain and expand the goodwill of its mark, Petitioner launched an aggressive marketing and promotion campaign, spending considerable amount in print and media advertising and billboards by using celebrity endorsers.
9. It expanded its marketing channels in various department stores gaining reputation for high quality clothing at reasonable prices, targeting the young working class.
10. To keep up with the modern trends in marketing Petitioner creating a website in the internet to promote "HARVARD" clothing line.
11. Petitioner is the rightful owner and the prior user of the mark "HARVARD" in the Philippines. 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, Petitioner's predecessor-in-interest by inadvertence failed to file the affidavit of use/non-use for 5th Anniversary resulting to cancellation on 30 July 1998. However, the right to the mark "HARVARD" still remains with the Petitioner.
12. Respondent has no right to the mark "HARVARD" for Class 25. Its trademark registration 56561 is based on Home registration for the mark "Harvard Veritas Shield" for the class 25 among others issued on 25 November 1993. Under RA 166, the law under which the registration was obtained, no registration shall be issued on a mark already registered in the Philippines or currently used in the Philippines.
13. When the Respondent's registration was issued on 25 November 1993, Petitioner's registration was still in existence. It was only on 30 July 1998 or 5 years after Respondent's registration was issued that Petitioner's registration was cancelled.
14. Respondent's existing Philippine trademark registration are based on Home registration and not on use. The right to a mark is based on use. Adoption or registration alone does not confer any right to the mark. Respondent's mark has no commercial use in the Philippines whereas Petitioner has been using the mark since 02 January 1982 earlier than the dates of the home registration of Respondent's mark.

Respondent-Registrant in its Answer dated 21 June 2006 admitted the allegation in the Petition only as regards the corporate existence of the Petitioner and the issuance of Philippine Trademark Registration No. 56561 for the subject mark HARVARD VERITAS "SHIELD" SYMBOL, issued on 25 November 1993 in its behalf for goods in classes 16, 18, 21, 25 & 28 namely, decals, tote bags, serving trays, sweatshirts, t-shirts, hats and flying discs. All other allegations in the said Petition are denied for being an erroneous conclusion or devoid of bases in law and in fact.

The following statements are the special and affirmative defenses set forth in the Answer of Respondent-Registrant, to wit:

1. At the outset, it must be stated that an administrative complaint (“compliant”) entitled, “President and Fellows of Harvard College vs. Fredo Manufacturing Corp. for trademark infringement and/or unfair competition with damages was filed with the IPO on 20 April 2004. A certified copy of the compliant is attached as Annex “C”.
2. 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 and is well-known throughout the world. Attached as Annex “A” of the compliant is a copy of its Charter.
3. It is the owner of the well-known name and mark HARVARD and is the proprietor of numerous trademark registration in countries worldwide, including the Philippines. Attached as Annex “B” of the compliance is a list of countries where the mark name HARVARD is filed and/or registered in various classes such as 9, 16, 18, 20, 21, 24, 25, 26, 28, 35, 36, 40, 41, 42 and 44 of the NICE International Classification of Goods and Services.
4. It first used the name and mark HARVARD with the word College as early as 1638 and used the same in commerce as early as 1638 and used the same in commerce as early as 1872. Attached as Annexes “C, D, E, F and G” of the compliant, respectively, are certified copies of (a) US Trademark (TM) Registration No. 2,498,203 for Harvard College in class 41 of the NICE International Classification; (b) US TM Reg. No. 2,119,339 for HARVARD in class 25; (c) US TM reg. No. 2,101,295 for HARVARD VARITAS AND SHIELD DESIGN in class 25; (d) US Trademark Registration No. 1,602,960 for HARVARD VERITAS SHIELD SYMBOL in class 41 and (e) US Trademark Registration No. 1,608,533 for HARVARD in class 41.
5. Its well-known name and mark HARVARD have been rated as one of the most famous brands in the world and valued at between 750 million and 1 billion US dollars. Attached as Annex “H” of the compliant is a copy of the article “Most Valuable Brands” published in October 1997 issue of the Financial World.
6. It promotes uses and advertises its name HARVARD through various publications, service and products in foreign countries, including the Philippines. Attached as Annexes “D-D3” are some of its local advertisements in the Philippine Daily Inquirer (PDI) for its various merchandise for sale in class 25.
7. In the Philippines, it is the owner of the valid and existing certificates of trademark registration such as, (a) Philippine Trademark (TM) Registration No. 56561 for HARVARD VERITAS “SHIELD” DESIGN issued on November 25,1998 for goods and services in classes 16,18, 21, 25 and 28 of the NICE International Classification; (b) Philippine TM Registration No. 57526 for HARVARD VERITAS “SHIELD” SYMBOL issued on March 24, 1994 for services in class 41 and (d) Philippine TM Registration No.66677 for HARVARD GRAPHICS for goods in class 9 issued on December 8, 1998. Attached as Annexes “I, J, K and L” of the complaint are certified copies of certificates of registration of the aforementioned trademarks.
8. The required affidavits of use for the subject mark were filed by Respondent-Registrant with IPO as shown by Annexes “A” and “B” demonstrates use of the mark in the Philippines for goods and classes 16, 18, 21, 25, 28.
9. It as also the owner of the Philippine trademark application for HARVARD MEDICAL INTERNATIONAL & SHIELD DESIGN with Serial No. 4-2003-04090

for services in Classes 41 and 44 filed on May 7, 2003, attached as Annex "M" of the compliant.

10. In 1989, Respondent-Registrant 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 trademark for various goods and services in Classes 16, 24, 25, and 41. It has not authorized or licensed any person to use its well-known name and mark HARVARD in connection with any goods or services in the Philippines.
11. Through its international trademark watch program, Respondent-Registrant discovered in March 2003 Petitioner's website www.harvard-usa.com advertising and promoting the brand name HARVARD USA and adopting the well-known name HARVARD without the former's consent. Attached as Annex "N" of the compliant is a copy of the internet printout of Petitioner's profile, which is also Exhibit G-13 of the petition.
12. The flash intro page or the main page of petitioner's website shows a logo bearing the mark HARVARD JEANS USA (the sign R with a circle or registered marks) and the words "Established 1936" and "Cambridge, Massachusetts" with an oblong device. Attached as Annex "O" of the compliant is a copy of the internet printout of the main page or Exhibit G-14 of the petition and a cleanser copy as Annex "E".
13. The brief history, of the brand HARVARD JEANS USA failed to explain Petitioner's reference to or use of the words "Established in 1936", "Cambridge Massachusetts" "USA" and most importantly, the name HARVARD for its brand name and logo. Petitioner claims that it opened different stores in Metro Manila and in the provinces for its clothing with brand name HARVARD JEANS USA. Attached as Annex "P" of the complaint and Exhibit G-15 of the petition is a copy of the internet printout of the brief history of the brand name HARVARD JEANS USA.
14. On May 23, 2003, Respondent-Registrant's attorney's sent a cease and desist letter to Petitioner by personal delivery informing its unauthorized use of the well-known name and mark HARVARD, the legal consequences thereof and, the possibility of entering into a licensing agreement with Respondent-Registrant to legitimize Petitioner's use of the well-known name and mark HARVARD. Attached as Annex "X" of the complaint is a copy of Petitioner's reply dated June 2, 2003.
15. On July 28, 2003, Respondent-Registrant attorneys sent its second cease and desist letter to Petitioner, advising the latter of the cancelled trademark registration for HARVARD, as well as, the trademark application for HARVARD & DESIGN and HARVARD JEANS CO. HJCO and reiterating its provisions advice on a licensing agreement. Attached as Annex "Z" of the compliant is a copy of said letter.
16. Petitioner's adoption and use of the name HARVARD on its articles of clothing despite repeated and justified demands to cease or to legitimize its use of the name HARVARD is a blatant disregard of Respondent-Registrant's clear and prior right the more than 350 year old that is its corporate name and trademark with an established goodwill and reputation worldwide.
17. The Petitioner'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.

18. Petitioner's subsequent use of the trade name HARVARD as a brand name in a manufacture of clothing violates Section 165os RA 8293.
19. HARVARD is a well-known name and respected mark. Petitioner's adoption and use of the HARVARD name in bad faith cannot give rise to valid trademark rights since the name HARVARD has already been appropriated by Respondent-Registrant, as its name and mark.
20. Petitioner's mark should not have been registered in the first place being contrary to Sections 4(a) and 37(e) of RA 166, which prohibited the registration of the mark that they may disparage and falsely suggest a connection with persons or Institution, such as the Harvard University.
21. Trademark application for Harvard Jeans USA, Harvard (world), Harvard and Design filed by Chuaticos and New York Garments Manufacturing & Export Company, Inc., which application have been abandoned and/or refuse falsely suggested a connection with a HARVARD Institution, contrary to Section 123/1 of the Intellectual Property Code.
22. Respondent-Registrant is likewise entitled to protection of its name and mark by virtue of Article 6bis of the Paris Convention as well as Sectin123.1 (e& f) of RA 8293.
23. Petitioner's unauthorized commerce of the well-known name and mark HARVARD, a registered mark in the Philippines, which name also forms a dominant part of the registered mark HARVARD VERITAS SHIELD constitutes trademark infringement under Section 155of RA 8293.
24. Petitioner's unauthorized use thereof services to mislead and to deceive the public into believing that its goods are sanctioned or sponsored by Respondent-Registrant. The use by Petitioner of words "USA", "Cambridge Massachusetts", and "Established in 1936" on the logo on its webpage and labels (Exhibits E-E92 and G13) is a deliberate attempt to deceive the public into believing that it is affiliated or connected with the plaintiff and to ride on the reputation and goodwill of the name of the Respondent-Registrant which has its principal place of business actually located in Cambridge, Massachusetts, USA and established in 1636.
26. Petitioner does not have any affiliation with HARVARD UNIVERSITY, with Cambridge, Massachusetts, or with the United States of America (USA) where HARVARD UNIVERSITY is situated. Neither was Petitioner established in 1936.
27. Petitioner's use of the mark HARVARD was made in bad faith and was designed to ride in the immense popularity and goodwill of the Respondent-Registrants name and mark HARVARD. Such constitute unfair competition under section 168 of RA 8293.
28. Petitioner's use of the, the words "Registered Trademark "Cambridge , Massachusetts", and "USA" in its exhibits also constitute unfair trade practice under sec. 169 of the Intellectual Property Code.
29. Out of the many available names, symbols and ideas, Petitioner chose the well-known name and mark HARVARD for its articles of clothing, knowing very well that the name HARVARD belongs to the celebrated institution of learning, HARVARD UNIVERSITY, at no time has petitioner denied its knowledge of

Respondent-Registrant's existence. Hence, Petitioner's use of the name and mark HARVARD without consent is an absolute act of gross evident bad faith.

30. The alleged use of the name and mark HARVARD by Petitioner and/or through its predecessor-in-interest since 1982 or 1985 does not vest any or prior or valid right to the well-known name and mark HARVARD which belongs to Respondent-Registrant for over 350 years now, hence, it has no cause of action against herein Respondent-Registrant.
31. Lastly, the equitable principle of laches, estoppel, and acquiescence may apply in this case. Petitioner allowed Respondent-Registrant's trademark registration and use of the HARVARD VERITAS SHIELD SYMBOL to continue for more than ten (10) years without any petition for cancellation having been filed.

Petitioner submitted the following documentary evidence, to wit:

Exhibit No. (Attached to the Petition)	Description
"A"	Certificate of Copyright Registration issued by The National Library
"B" to "B-3"	Trademark Certification of Registration No. 42348 registered on December 12, 1988 for the trademark HARVARD
"C" to "C-1"	Certification of Registration (Supplemental Register) No. 7040 for the trademark HARVARD bearing registration date of September 20, 1985
"D" to "D-240"	Concessionaires Sales Report
"E" to "E-92"	Harvard labels and other promotional materials
"F" to "F-2"	Certificate true copy of Certificate of Registration No. 56561 for the trademark HARVARD VE RI TAS "SHIELD" SYMBOL registration on November 25, 1993
"F-3" to "F-5"	Certified true copy of Certificate of Registration No. 57526 for the trademark HARVARD VE RI TAS SHIELD SYMBOL registered on March 24, 1994
"F-6" to "F-8"	Certificate true copy of Certificate of Registration No. 56539 for the trademark HARVARD registered on November 25, 1993
"F-9" to "F-11"	Certified true copy of Certificate of Registration No. 66677 for the trademark HARVARD GRAPHICS registered on December 8, 1998
"F-12" to "F-16"	Certified true copy of Trademark Application bearing Serial No. 4-2003-004090 filed on May 7, 2003 for the trademark HARVARD MEDICAL INTERNATIONAL AND SHIELD DESIGN"
"G"	Certified true copy of SEC Registration No. AS095-

011274 issued to FREDCO manufacturing Corp. on November 10, 1995

- "G-1" to "G-12" Certified true copy of the Articles of Incorporation of FREDCO Manufacturing Corp.
- "G-13" to "G-15" Computer printout of the company profile of FREDCO Manufacturing Corp. and the brief history of Harvard jeans with website address <http://www.harvard-usa.com/history.html>
- "G-16" to "G-105" Notice of Credit Claim
- "G-106" to "G-115" Copies of checks paid to the order of Harvard
- "H" to "H-8" Advertising and promotional materials

Exhibit No. (Attached to the Affidavit of Richard Teco)

Description

- "A" to "A-13" Copies of consignment Liquidation
- "B" Award Notice No. 9307-090099 covering the period of July 1, 1993 to July 30, 1994 issued to AHS Burton Marketing Corp.
- "C" Certification issued to FREDCO Manufacturing Corporation by EVER Plaza Inc. with Mr. James Ong as Consignor Head
- "D" Contact of Lease entered into by The Landmark Corporation (lessor) and FREDCO Manufacturing Corp. (lessee)
- "E" Concessionaire Agreement between Plaza Marcela and FREDCO Manufacturing Corp.
- "F" Store Concessionaire Contact No. R-MGC-2001-033
- "G" Addendum to Notice of Lease dated July 6, 2001 issued to FREDCO Manufacturing Corp. by Robinsons, Inc.
- "H" An article entitled "Harvard Jeans Concert ngayong Sabado" posted in the Kabayan, September 8, 2001 issue
- "H-1"and "H-2" Advertising material posted in the Manila Bulletin
- "I" Leasing Terms and Conditions Form with No. 02-1140 dated 11 December 2002
- "J" to "J-4" Award Notice issued by Shoemart, Inc. to FREDCO Manufacturing Corp.;

- “K” Concessionaire Agreement entered into by Robinsons Department Store and FREDCO Manufacturing Corp. bearing Contact No. 2003090000002 dated September 9 2003
- “L” Concessionaire Agreement (Renewal) between Sta. Lucia East Department Store and FREDCO Manufacturing Corp. bearing date of December 12, 2003
- “M” to “M-1” Concessionaire’s Support Agreement between Materrco, Incorporated and FREDCO Manufacturing Corp.
- “N” Notice of Agreement No.006290
- “O” Renewal Notice dated 12 September 2005 issued by Isetann Department Store, Inc. to FREDCO Manufacturing Corp.

Respondent, on the other hand, submitted the following documentary evidence, to wit:

Exhibit No.	Description
“1-1a” (Annex A of Answer)	Certified copy of the 5 th year affidavit of use
“2” (annex B of Answer)	Certified copy of the 10 th year affidavit of use
“3-3ee” (Annex C of the Answer)	Compliant entitled, “President and Fellows of Harvard College vs. Fredco Manufacturing Corp., (“Compliant”)
“4-4oo”	Charter of the President and fellows of Harvard College (Annex of the Compliant)
“5-5r	List of worldwide trademark registration for the various Harvard marks (Annex B of the Compliant)
“6-6a”	Certified true copy of U.S Trademark Registration No. 2, 4 98,203 (Annex C of the Compliant)
“7-7a”	Certified true copy of U.S. Trademark Registration No. 2,199,339 (Annex D of the Compliant)
“8-8b”	Certified true copy of U.S. Trademark Registration No. 2, 101,295 (Annex E of the Compliant)
“9-9a”	Certified true copy of U.S. Trademark Registration No. 1,602,960 (Annex F of the Compliant)
“10-10a”	Certified true copy of U.S. Trademark Registration No. 1,608,533 (Annex G of the Compliant)

- “11-11d” Copy of the Article “Most Valuable Brands”
(Annex H of the complaint)
- “12-12b” Certified true copy of Philippine Trademark
Registration No. 565614 (Annex I of the
Compliant)
- “13-13b” Certified true copy of Philippine Trademark
Registration No. 57526 (Annex J of the
Compliant)
- “14-14b” Certified true copy of Philippine Trademark
Registration No. 56539 (Annex K of the
Compliant)
- “15-15b” Certified true copy of Philippine Trademark
Registration No. 66677 (Annex L of the
Compliant)
- “16-16d” Certified true copy of Philippine Trademark
Application No. 4-2003-004090 (Annex M of the
Compliant)
- “17” Company Profile of Fredco Manufacturing
Corp.,
- “18” Intro page of the Fredco website (Annex O of
the Compliant)
- “19” Brief history of the Harvard Jeans USA (Annex
P of the Compliant)
- “20-20L” SEC Registration No. AS095-011274 for
Fredco Manufacturing Corporation (Annex Q of
the Compliant)
- “21” List of Stores
(Annex R of the Compliant)
- “22” Photo of the Harvard Jeans Clothes
(Annex S of the Compliant)
- “23-24” Local celebrity profile
(Annex T and U of the Compliant)
- “25-25a” Photo of billboard advertisements
(Annex V-V1 of the Compliant)
- “26-26a” Letter dated May 22, 2003 to Fredco
Manufacturing Corp., (Annex W of the
Compliant)
- “27” Letter from Atty. Isidro Escano dated June 23,
2003 (Annex X of the Compliant)
- “28-28C” Certified true copy of Philippine Trademark

	Registration No. 42348 (Annex Y of the Compliant)
“29-29a”	Letter dated July 28, 2003 (Annex Z of the Compliant)
“30”	Newspaper advertisement from Harvard dated June 1, 2006
“31”	Newspaper advertisement from Harvard dated June 2, 2006
“32”	Newspaper advertisement from Harvard dated June 3, 2006
“33”	Newspaper advertisement from Harvard dated June 4, 2006
“34”	Main intropage for Harvard Jeans USA with “Cambridge, Massachusetts, Established in 1936”
“35-35g”	Authenticate affidavit of Mr. Enrique Calixto Director of the Trademark Program, President and Fellows of Harvard College
“35h-35n”	Old affidavit of Joyce Brinton, former Director of the Office of Trademarks Licensing, Harvard University
“36-36tt”	Certified true copies of foreign trademark registrations for the HARVARD marks
“37-37p”	Certified true copy of the Philippine Trademark Registration for HARVARD
“38-38j”	Certified copy of the Consent Judgment in the Civil Action No. 99CV12489RC2 entitled, “President and Fellows of Harvard College vs. Michael Rhys d/b/a UST-Pro and Michael Douglas d/b/a Web Productions
“39-39yy”	Certified copy of proceedings in the Motion for Preliminary Injunction hearing
“40-40ff”	Certified true copies of the internet print ads, containing information on Harvard University
“41-41g”	Certified copy of the U.S news report Showing Harvard University ranking among the top university
“42-42h”	Certified copy of the U.S news report showing Harvard University ranking among the top universities
43-43g”	Certified copy of the U.S news report

	showing Harvard University ranking among the top universities
“44-44d”	Certified copy of the U.S news report showing Harvard University ranking among the top universities
“45-45f”	Certified copy of the U.S news report showing Harvard University ranking among the top universities
“46-46f”	Certified copy of the U.S news report showing Harvard University ranking among the top universities
“47-47G”	Certified copy of the U.S news report showing Harvard University ranking among the top universities
“48-48g”	Certified copy of the U.S news report showing Harvard University ranking among the top universities
“49-49d”	Certified copy of the U.S news report showing Harvard University ranking among the top universities
“50-50e”	Certified copy of the U.S news report showing Harvard University ranking among the top universities
“51-51f”	Certified copy of the U.S news report showing Harvard University ranking among the top universities
“52-52zz”	Certified copy of the U.S news report showing Harvard University ranking among the top universities
“53-53d”	Certified copies of the special report on best colleges
“54-54q”	Certified copies of the special report on best colleges
“55-55v”	Certified copies of the special report on best colleges
“56-56zz”	Certified copy of the Foreign Activities Chart of Harvard
“57-57zz”	Certified copy of the Foreign Activities Chart of Harvard
“58-58d”	Certified true copy of the Harvard Alumni Director

“59-59pp”	Certified true copy of the Harvard Human Rights report in the Philippines
“60”	Certified true copy of Harvard report on innovations in numerous countries
“60-60b”	Certified true copy of Harvard report on innovations in numerous countries
“60-60s”	Certified true copy of the Harvard Business Review report
“60-60x”	Certified true copy of the article “Most Valuable Brands”
“60Y-60gg”	Certified true copy of the article “Most Valuable Brands”
“61-61a”	Notarized affidavit of Ma. Jasmin R. Blancaflor
“61-b-61-e”	Copies of the Harvard advertisement in the Philippine Daily Inquirer June 1-4, 2006

During the Preliminary Conference, parties tried to thresh out their dispute to settle amicably. Unfortunately, they cannot meet into mutual terms and conditions. Thus, this conference was terminated with the main issue presented before this Office to resolve-

WHETHER OR NOT PETITIONER IS THE PRIOR ADOPTER AND USER OF THE MARK “HARVARD” IN HE PHILIPPINES FOR GOODS UNDER CLASS 25 TO WARRANT CANCELLATION OF RESPONDENT-REGISTRANT’S REGISTRATION OVER THE MARK HARVARD VE RITAS “SHIELD” SYMBOL.

The trademark registration subject of this instant petition for cancellation was filed issued under the old Trademark Law (R.A. 166, as amended). Thus this Office shall resolve the case under said law in order not to adversely affect rights acquired prior to the effectivity of the new Intellectual Property Code or R.A. 8293.

Anent thereto, it is important to lay down the following applicable provisions of the old Trademark Law (RA 166, as amended), to wit:

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

- (a) That the registered mark or trade-name becomes the common descriptive name of an article or substance on which the patent has expired;
- (b) That it has been abandoned;
- (c) That the registration was obtained fraudulently or contrary to the provisions of section four, Chapter II hereof; x x x x x” (emphasis supplied.)

“Sec. 4. *Registration of trademark, trade names and service marks on the principal register.*- x x x The owner of a trademark , trade name or service mark used to distinguish his goods, business or services from the goods, business or service of others shall have a right to register the same on the Principal Register, unless it:

(d) Consist of or comprises a mark or a 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 used in connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers". x x x x

The element of prior use and adoption of the subject mark or the registration thereof in the Philippines with goods which may likely cause confusion or mistake or to deceive purchasers could validly warrant the cancellation of a registered trademark. Thus, if Petitioner substantially proves these elements, then legally, it can claim exclusive ownership over the HARVARD mark to the exclusion of third parties, including the Respondent-Registrant. Short of it, this petition shall be dismissed in favor of the latter.

The best evidence to determine prior adoption and use is the date of its first use, first application and first registration in the Philippines. Comparing the relevant dates, it is obvious that Petitioner first used and adopted the mark HARVARD for goods under class 25.

Factual evidentiary matters show that Petitioner through its predecessor-in-interest, New York Garments Manufacturing & Export Co. Inc. First used the mark HARVARD for goods under class 25 on 02 January 1982 and 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.

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. This was later assigned to Romeo Chuateco, of the New York Garments Manufacturing & Export Co. Inc.

With a mark of twenty (20) year term and without any requirements except for its renewal after the end of the term, Petitioner failed to file the affidavit of use/non-use for 5th Anniversary which resulted to the cancellation of its registration on 30 July 1998.

Respondent, on the other hand, filed a trademark application on 03 October 1991, with the then BPTTT for HARVARD VERITAS 'SHIELD' SYMBOL which was given due course and was issued Philippine Trademark Registration No. 56561 on 25 November 1993.

Based on the foregoing, this Bureau have come to the inescapable conclusion that herein Petitioner is the prior adopter and user of the mark "HARVARD" for Class 25 in the Philippines.

Respondent filed its application with the then BPTTT for HARVARD VERITAS 'SHIELD' SYMBOL for goods under class 25 on 03 October 1991 or more than nine (9) years after Petitioner adopted and started using the mark HARVARD on 02 January 1982 and almost three (3) years after Petitioner registered the same mark with the then BPTTT on 12 December 1988.

The grant of Philippine Trademark Registration No. 56561 to Respondent for the identical/similar mark HARVARD VERITAS 'SHEILD' DESIGN for goods Class 25 on 25 November 1993 is actually, more than twelve (12) years after Petitioner adopted starting using the mark "HARVARD" on 02 January 1982 and almost five (5) years after Petitioner registered the same mark.

The attention of this Bureau is also called to the fact that when Respondent filed its application until it was issued a registration, Petitioner has valid and existing HARVARD mark registration which was used in commerce and not abandoned. Thus, Respondent's registration is contrary to the afore-quoted provision of Section 4, RA 166, as amended.

Clearly, no registration shall be issued on a mark already registered in the Philippines or currently being used in the Philippines. In the instant case, Petitioner's registration was valid and in existence when Respondent's registration was issued on 25 November 1993. It was only five years thereafter that Petitioner's registration was cancelled.

But the fact that Petitioner's registration was deemed cancelled due to the non filing of the affidavit of Use negates Respondent's registration to an identical/similar mark, as inferred from Sec. 16 of R.A. 166, as amended, to wit:

"Sec. 16. Effect of failure to renew registration. – Mere failure renew any registration shall not affect the right of the registrant to apply for and obtain anew registration under the provisions of this Act, nor shall such failure entitle any other person to register a mark or trade-name unless he is entitled thereto in accordance with the provisions of this Act." (Emphasis Supplied.)

Moreover, Respondent-Registrant's existing Philippine trademark registrations are based on Home registration and not on use. The right to a mark is based on use. Adoption or registration alone does not confer any right to the mark. Respondent's mark has no commercial use in the Philippines whereas Petitioner has been using the mark continuously up to the present as evidence by concessionaires sales report (Exhibits "G-16" to "G-105") and check paid to the order of Harvard (Exhibits "G-106" to "G-115") which were presented by the Petitioner to show actual commercial use. Consequently, Petitioner has the right to own and possess the exclusive title to and interest in the mark "HARVARD" pursuant to the discussion.

The registration of Respondent-Registrant's subject mark contravenes the provisions of Section 4 (d) of Republic Act No. 166, as amended and Section 123 (d) of R.A. 8293 because it is identical, if not similar, to Petitioner's trademark HARVARD for goods under Class 25, which has been previously used in commerce and registered in the Philippines, and not abandoned, as to be likely, when applied to or used in connection with the goods of Respondent, to cause confusion, mistake and deception on the part of the purchasing public.

Moreover, Respondent failed to prove its entitlement to the mark in controversy. Its heavy reliance to its United States and Philippines registration to disprove Petitioner's prior use and adoption, failed to convince this Office. While it is true that Respondent's United States registration precedes over Petitioner's registration in the Philippines is devoid of merit. The United States is not the Philippines. Registration in the United States is not registration in the Philippines. The law of trademark rest upon the doctrine of nationality or territoriality. Accordingly, Respondent's United States trademark registration would not of itself afford protection for the use by Petitioner in the Philippines of the same trademark for the same or different products. (Sterling Product International, Inc. vs. Farbenfabriken Bayer Aktiengesellschaft, 27 SCRA 1226).

Furthermore, Respondent's Philippine registration lacks legal anchor. Its registration was issued based on home registration and not on actual use in commerce. It merely creates a prima facie presumption of validity of registration, not ownership. Registration does not perfect a trademark right. (Unno Commercial Enterprises, Inc. vs. General Miling Corporation, 120 SCRA 811). It is the actual use in commerce which gives birth of the right of ownership over a trademark. For trademark is a creation of use. Adoption alone of a trademark would not give exclusive right thereof for adoption is not use. (Sterling Products International, Inc. vs. Farbenfabriken Bayer Aktiengesellschaft, 27 SCRA 1225).

Finally, this Office finds Respondent's call for protection granted by Article 8 of the Paris Convention inapplicable (Opposer's Memorandum, paragraph 32 -36, pages 8-9) as it pertains to the protection of trade names. It does not refer to the protection of trademark. Hence, the invocation of the protective mantle of Article 8 is out of place.

WHEREFORE, premises considered, the Petition for Cancellation is hereby GRANTED. Consequently, Trademark Registration Number 56561 for the trademark "HARVARD VERITAS 'SHIELD' SYMBOL" issued on November 25, 1993 to PRESIDENT AND FELLOWS OF HARVARD COLLEGE (HARVARD UNIVERSITY) should be CANCELLED only with respect to goods falling under Class 25. On the other hand, considering that the goods of Respondent-Registrant falling under hand, considering that the goods of Respondent-Registrant falling under Classes 16, 81, 21 and 28 are not confusingly similar with the Petitioner's goods, the Respondent-Registrant has acquired vested right over the same and therefore, should not be cancelled.

Let the filewrapper of the Trademark Registration No. 56561 issued on November 25, 1993 for the trademark "HARVARD VERITAS 'SHIELD' SYMBOL", subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademark (BOT) for appropriate action.

SO ORDERED.

Makati City, 22 December 2006

ESTELLITA BELTRAN-ABELLARDO
Director, Bureau of Legal Affairs
Intellectual Property Office