

G2000 (APPAREL) LTD.	}	IPC No. 4271
<i>Petitioner,</i>	}	Petition for Cancellation:
	}	Reg. No. 59138
	}	Issued: September 5, 1994
-versus-	}	
	}	Trademark: "G2000"
	}	
ROMEO CHONG	}	
<i>Respondent-Registrant,</i>	}	
x-----x	}	Decision No. 2006 – 68

DECISION

This is a proceeding that G2000 (Apparel) Ltd. (*Petitioner*) instituted against Romeo Chong (*Respondent*) for the cancellation of the registration of the mark G2000 in his favor.

Petitioner G2000 (Apparel) Ltd. is a corporation duly organized and existing under the laws of Hong Kong with principal address at Penthouse, Wyler Centre II, 200 Tai Lin Pai Road, Kwai Chung, New Territories, Hong Kong. Respondent Romeo Chong, on the other hand, is the registered owner of trademark G2000 under Certificate of Registration No. 59138 issued on 5 September 1994 covering goods such as T-shirts, sandals, polos, polo shirts, shorts, pants, jeans, jackets, briefs, blouses, socks, and tie sides falling under Class 25.

On 4 October 1996, Petitioner commenced the above-entitled cancellation proceeding through the filing of its Verified Petition for Cancellation (*Verified Petition*) before the Bureau of Legal Affairs (*Bureau*), Intellectual Property Office (*Office*). This cancellation proceeding was docketed as Inter Partes Case No. 4271. In its Verified Petition, Petitioner alleged that it will be damaged by Respondent's registration. Consequently, it seeks cancellation of the subject registration. Specifically, Petitioner pointed out the grounds for cancellation, viz.:

"1. Petitioner is the first use and true owner of the trademark G2000 used on goods in Class 25, having first used the said trademark since 1985 in Hong Kong and since 1989 in the Philippines. Registrant's trademark G2000 for goods in Class 25 so resembles Petitioner's trademark G2000 for identical goods as to be likely, when applied to or used in connection with the goods of registrant, to cause confusion, mistake and deception on the part of the purchasing public."

"2. The registration of the trademark G2000 in the name of the registrant violates Section 37 of Republic Act No. 166, as amended, Section 6bis and other provisions of the Paris Convention for the Protection of Industrial Property and Article 16 of the Agreement on Trade-Related Aspects of Intellectual Property Rights to which the Philippines and Hong Kong are parties."

"3. The registration and use by Registrant of the trademark G2000 will diminish the distinctiveness and dilute the goodwill of petitioner's trademark G2000, which is an arbitrary trademark for goods in Class 25."

"4. Registrant adopted the trademark G2000 on identical 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 petitioner, which has been identified in the trade and by the relevant sector of the public as the source of goods bearing the trademark G2000."

“5. The registration of registrant’s trademark G2000 is based on the fraudulent misrepresentation that he is the true owner and first user of the trademark, which was copied from petitioner’s G2000 trademark.”

“6. Registrant’s infringing use of the trademark G2000 is not lawful use of the trademark in commerce and does not lead to valid trademark pre-emption.”

“7. The registration of the trademark G2000 in the name of the registrant is contrary to Section 37 of the Trademark Law under which tradename of nationals of member countries of the international convention relating to marks or tradename, like the Paris Convention, shall be protected in the Philippines without the obligation of filing or registration whether or not they form part of marks.”

A Notice to Answer was duly served upon Respondent. The record shows Respondent’s receipt, through its counsel, on 18 November 1996. For failing to file and serve its Answer or any motion, manifestation, or other paper within the prescribed reglementary period, the Bureau issued Order No. 97-243 declaring Respondent *in default*, and accordingly, setting the case for *ex-parte* presentation of Petitioner’s evidence. The dispositive portion of this Order reads, viz.:

IN VIEW THEREOF, Respondent-Applicant [*Registrant*] is, as he is, hereby declared in Default. Consequently, this case is set for the *ex-parte* presentation of Petitioner’s [*Petitioner’s*] evidence on June 3, 1997 at 2pm.

On 16 June 1999, Petitioner formally offered its evidence consisting of the affidavit of its witness and supporting documentary evidence. On 24 June 1999, however, Respondent filed a Motion to Lift Order Of Default/Annual Proceedings, and on 2 July 1999, Petitioner filed its Opposition. The Bureau issued Order No. 2000-38 setting aside its previous Order, declaring Respondent *In Default*. The dispositive portion of Order No. 2000-38 reads, viz.:

IN VIEW THEREOF, Respondent-Registrant’s Motion To Lift Order of Default is, as it is hereby, GRANTED and his Answer is hereby ADMITTED. Accordingly, herein Respondent-Registrant [*Registrant’s*] *locus standi* is restored without prejudice to the proceedings already taken. Petitioner is hereby ordered to furnish Respondent-Registrant of its Witness’ Affidavit for him to be able to file his Cross-Written Interrogatories within 30 days from receipt thereof.

In his Answer, the Respondent specifically denied the salient allegations of the Petition. It remarked that Petitioner’s alleged grounds for cancellation are unfounded. The salient portions of Respondent’s Answer are stated below, viz.:

“On the grounds for cancellation of the registration:

“2. Regarding paragraph 1:

- a) The clause referring to the date of first use in Hong Kong is DENIED for lack of information;
- b) The clause regarding the date of first use in the Philippines since 1989 is ADMITTED.
- c) The clause referring to confusion or mistake is admitted with the qualification that being the first user of the mark in the Philippines, the goods sold by the petitioner is the one that will cause confusion, mistake or deception on the part of the purchasing public.

3. Paragraph 2 is DENIED for being a self-serving interpretation of a question of law and is further subject to the affirmative defenses hereunder discussed.

4. Paragraphs 4, 5, and 6 are DENIED for being self-serving conclusion of law, the truth being discussed above on paragraph 2c and subject to the discussion in the affirmative defense.”

For failing, however, to comply with our Order No. 2000-38 directing, among others, Petitioner to furnish Respondent the affidavit of its witness, the Bureau issued Order No. 2000-584 striking out the affidavit of Petitioner’s witness. The dispositive portion of Order No. 2000-584 reads, viz.:

IN VIEW THEREOF, Petitioner’s Witness Affidavit [*the affidavit of Petitioner’s Witness*] is hereby STRICKEN OUT for failure to comply with the said Order No. 2000-38.

Let this case be set for continuance of the proceedings on 19 December 2000 at 2:30 pm with warning that no motion for postponement on the part of either parties [*party*] shall be entertained.

On 25 September 2001, Petitioner filed a Manifestation and Motion praying that Respondent be declared to have waived its right to oppose or object to petitioner’s evidence and to present his own evidence; that Petitioner be granted reasonable time to file its memorandum; and that the case be declared submitted for decision based on Petitioner’s uncontroverted evidence on record. On 1 October 2001, Respondent filed a Counter Manifestation pointing out that Petitioner’s Manifestation and Motion should be denied. Resolving the foregoing, the Bureau issued Order No. 2001-635 denying Petitioner’s Manifestation and Motion. The dispositive portion of this Order reads, viz.:

WHEREFORE, premises considered, Petitioner is hereby directed to furnish Respondent-Registrant [a] copy of its Formal Offer of evidence within 20 days from receipt hereof informing this Office of Respondent-Registrant’s proof of receipt thereto. Likewise, Respondent-Registrant is given 30 days from receipt thereto within which to file its comment and/or objection. Failure to file said comment and/or objection within the allotted time will mean a waiver on its part.

On 13 November 2001, Respondent filed its objection to Petitioner’s Formal Offer of Evidence. And on 22 November 2001, Petitioner filed its Reply. On 25 June 2003, the Bureau issued Order No. 2003-247 admitting, Petitioner’s Formal Offer and taking note of Respondent’s objections.

On 16 February 2004, Petitioner filed a Manifestation and Motion praying that Respondent be declared to have waived its right to present further evidence; that both parties be granted 30 days to file a memorandum; and that after filing of the memorandum or after the expiration to file the same, the case be considered submitted for decision. On 5 March 2004, Respondent filed an Opposition praying, among others, that the Petitioner’s Manifestation and Motion be denied. On 16 March 2004, the Petitioner filed a reply. Resolving the foregoing, the Bureau issued Order No. 2005-265 granting Petitioner’s Manifestation and Motion. The dispositive portion of this Order reads, viz.:

WHEREFORE, premises considered, Respondent-Registrant is hereby declared to have waived his right to present further evidence. Accordingly, the parties are hereby ordered to file their respective memoranda, attaching thereto draft decisions, within 30 days from receipt hereof. After the lapse of the said period, with or without the parties having filed the said pleadings, the case is deemed submitted for decision.

On 31 May 2005, Respondent filed a Motion for Reconsideration praying that the Bureau's Order No. 2005-265 be set aside and a new order be issued recalling its witness Mr. Ricky Molo. On 6 June 2005, Petitioner filed a Manifestation praying that Respondent's Motion for Reconsideration be denied for lack of merit and that our Order No. 2005-265 be affirmed. Resolving the foregoing, the Bureau issued Resolution No. 2005-07 denying Respondent's Motion for Reconsideration. The dispositive portion of this Resolution reads, viz.:

WHEREFORE, Respondent's Motion for Reconsideration is denied for lack of merit, and consequently, this Bureau's Order No. 2005-265 is affirmed in its entirety. Accordingly, the parties are directed to file their respective memoranda, attaching to them draft decisions within 30 days from receipt of this Resolution. After the lapse of this period, with or without the prescribed pleading having been filed, this Bureau shall consider the case submitted for decision.

The entire evidence for the Petitioner is stated below. Noticeably, Mr. Peter Ho's Affidavit-Testimony is not among them. This is because Order No. 2000-584 had stricken it out from the record for Petitioner's failure to comply with Order No. 2000-38. It is, therefore, an error that Order No. 2003-247 admitted Mr. Peter Ho's Affidavit-Testimony.

Description	Marking
1. Photocopies of sample advertisements consisting of 25 pages for petitioner's clothing and apparel in Class 25 bearing the trademark G2000	Exhibits 2; 2-A to 2-X
2. Sample catalogs consisting of 147 pages prepared by independent retailers for sale directly to consumers which clearly indicates petitioner's goods in Class 25 and bearing the trademark G2000	Exhibits 3; 3-A to 3-PPPPPP
3. Sample catalogs and advertisements consisting of 4 pages where G2000 clothing and apparel are distributed and sold by numerous small independent retailers in the Philippines	Exhibits 4 to 4-A to 4-C
4. Advertising and promotional materials for petitioner's products circulated throughout the worldwide including the Philippines consisting of 3 pages	Exhibits 5; 5-A to 5-B
5. Sample commercial invoices showing sales of petitioner's products in the Philippines consisting of 5 pages	Exhibits 6; 6-A to 6-D
6. Details of petitioner's existing trademark registrations in Class 25 consisting of 136 pages	Exhibits 7; 7-A to 7-EEEEEE
7. Photocopies showing by petitioner to promote its world-renowned trademark G2000 consisting of 4 pages	Exhibits 8; 8-A to 8-C

On the other hand, the entire evidence for the Respondent consists of Ms. Glenda Galito's Affidavit inclusive of supporting documents identified and attached to it and the file wrapper containing original copies of its Registration Certificate No. 59198 and other supporting papers. In our Resolution No. 2005-07, the Bureau affirmed its Order No. 2005-265 declaring Respondent to have waived his right the right to resent further other evidence.

In this cancellation proceeding, noticeably Petitioner and Respondent both claim ownership over the trademark G2000. The Petitioner contended that it is the true owner and first

user of the trademark G2000 having first used such mark in 1985 in Hong Kong and in 1989 in the Philippines. The Respondent, for its part, argued that it is the owner of the trademark G2000 having first used it in 1987 in the Philippines. This is the main issue.

The Petitioner, however, pointed out the confusing similarity between the parties' trademarks. The Respondent, on the other hand, did not deny it. In fact, Respondent affirmed Petitioner's theory of confusing similarity of their respective trademarks. Albeit not an offshoot of the main issue, it presents itself as another equally important issue.

The main issue involves a question of ownership of the trademark G2000. As earlier noted, Petitioner claimed ownership over the trademark G2000 alleging first use in 1985 in Hong Kong and in 1989 in the Philippines. To prove its claim, Petitioner demonstrated adoption and use of the subject trademark for articles of clothing by actively promoting and selling in Hong Kong and in international markets since 1985 and by obtaining and securing registration of the subject trademark in various countries. In doing so, it presented and offered as evidence photocopies of advertisements, promotional materials, sales invoices, and several trademark registration certificates.

For its part, Respondent contended that it is true owner of the trademark G2000. To prove its contention, it pointed out to certain calendar dates indicated in its trademark registration certificate, namely, the date of first use on 4 January 1987 in the Philippines, the filing date on 4 April 1988, and the date of registration on 5 September 1994. It emphasized as well prior and continuous use in trade of the subject mark on its products in the Philippines. In doing so, it presented and offered as evidence the testimony of its witness including supporting particulars identified and attached to it.

The governing laws at the time of Respondent's registration of the subject trademark apply to this cancellation proceeding. These pertain to the pertinent provisions of Republic Act No. 166, as amended, or the old Trademark Law, and the Convention for the Protection of Industrial Property, or the Paris Convention.

To be registrable, the old trademark law requires, among others, that the applicant must be the owner of the trademarks, trade names, or service marks and that these trademarks, trade names, or service marks must have been actually used in commerce in the Philippines for a period of not less than two months before the filing of their applications for registration. The full text of Section 2, R.A. 166, as amended, states, viz.:

What are registrable. – Trademarks, trade names and service marks owned by persons, corporations, partnerships or associations domiciled in the Philippines and by persons, corporations, partnership or associations domiciled in any foreign country may be registered in accordance with the provisions of this Act: Provided, That said trademarks, trade names or service marks are actually in use in commerce and services not less than two months in the Philippines before the time the applications for registration are filed: And provided, further, That the country of which the applicant for registration is a citizen grants by law substantially similar privileges to citizens of the Philippines, and such fact is officially certified, with a certified true copy of the foreign law translated into the English language, by the government of the foreign country to the Government of the Republic of the Philippines.

And to acquire ownership of trademarks, trade names, or service marks, their proprietors must actually use them in their lawful trade or business. Worth nothing, it is necessary that these trademarks, trade names, or service marks must not have been appropriated by anyone else. The full text of Section 2-A, R.A. 166, as amended, states, viz.:

Ownership of trademarks, 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 the service rendered, may appropriate to his exclusive use a trademark, 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 trademark, trade name, 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 this law.

Constructing the foregoing provisions of the old trademark law, the High Court noted that adoption alone of trademarks or trade names is not sufficient to confer ownership nor is it sufficient to give exclusive right over them. Making advertisements, issuing circulars, or giving out price lists cannot be considered as actual use unless the goods and services themselves upon which the trademark or trade name is used are sold in the market. It pointed out that trademark is a creation of use. In another case, the High Court pointed out that adoption and use must be in commerce and in the Philippines and not elsewhere. It emphasized that the use of the trademark or trade name must be in the country because foreign use creates no trademark right following the nationality principle upon which our trademark law rests.

And recognizing that adoption and use are essential ingredients in the acquisition of trademark or trade name right, the High Court remarked that it belongs to the one who first used and gave it value. Similarly, it concluded in another case that the person establishing prior adoption and use of trademarks or trade names acquires ownership over them in reference to goods or other related articles upon which they are used.

The Paris Convention is another equally important legal precept. Under the doctrine of incorporation, the Paris Convention is considered part of the law of the land. No less than our fundamental law mandates our commitment to it. Having adopted the doctrine of incorporation in our Constitution, the Paris Convention became part of our law. The Philippine Government, through its Senate, became a signatory to the Convention on 10 May 1965, and our adherence became effective on 27 September 1965.

In summary, the Paris Convention is a multilateral treaty that seeks to protect industrial property consisting of patents, utility models, industrial designs, trademarks, service marks, trade names and indications of source or appellations of origin, and at the same time aims to repress unfair competition. Under its Article 6bis, the Convention confers protection to well-known trademarks. The text of its pertinent provisions, States, viz.:

(1) The countries of the Union undertake, either administratively if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well-known in that country as being already the mark or a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of registration shall be allowed for seeking the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be sought.

(3) No time limit shall be fixed for seeking the cancellation or the prohibition of the use of marks registered or used in bad faith.

Interpreting the foregoing provisions, the High Court remarked that each country of the Union undertakes to refuse or to cancel the registration and to prohibit the use of a trademark that constitutes a reproduction, imitation, or translation of a well-known mark used for identical or similar goods. It noted that it is a self-executing provision and does not require legislative enactment to give it effect in the member country.

The Bureau will perforce decide this cancellation proceeding on the bases of these legal precepts. Neither the Intellectual Property Code nor the TRIPS Agreement finds applicability.

At the outset, we noted that Petitioner alleged prior adoption and use in Hong Kong as early as 1985 and in the Philippines in 1989. In proving them, it presented photocopies of documents such as advertisements, promotional materials, sales invoices, and several registration certificates from different countries. These documents albeit photocopies are nevertheless competent to show Petitioner's actual use of the trademark or trade name G2000. This does not violate the best evidence rule. As Petitioner has correctly pointed out, the best evidence rule admits of several exceptions, and among them, when the original consist of numerous accounts or other documents, which cannot be examined without great loss of time, and the fact to be established from them is only the general result of the whole.

As earlier remarked, Petitioner's documentary evidence will show when it adopted and actually began the use of the trademark or tradename G2000 or a strikingly similar, if not, identical trademark or trade name. Examining the registration certificates, it demonstrated that the earliest registration for the subject trademark was in the year 1985 for goods under Class 25 in Singapore. In Hong Kong and Macau, it showed that Petitioner obtained its trademark registrations in 1987 for goods under Class 25. In Republic of Korea, it filed it secured its trademark registration in 1988 for goods under Class 45. In other countries such as Bahrain (1995), Netherlands (1995), Cambodia (1995), Iran (1995), Jordan (1995), Lao People's Democratic Republic (1995), Portugal (1995), China (1992, 1993, 1996), Saudi Arabia (1996), Vietnam (1992), and Turkey (1996), it acquired its trademark registrations from the years 1992 to 1996 for goods under Classes 3, 8, 12, 14, 16, 18, 25, 35, 42, and 45. In its sales catalogs and promotional materials, they showed that the earliest date of advertising of its goods outside the Philippines was in 1990 and in the Philippines in 1989. The earliest date of actual sale was in Hong Kong in 1985 and in the Philippines in 1989. It appeared that export sales were made to Taiwan, Singapore, Malaysia, and United Arab Emirates from the years 1990 to 1995. From the foregoing, it clearly appears that Petitioner's adoption and use started in Hong Kong in 1985 and in the Philippines in 1989.

Respondent, for its part, did not contest that Petitioner's first use in the Philippines was in 1989. This in fact, Respondent categorically admitted in its Answer to highlight that its use in the Philippines was earlier than Petitioner's use. As shown in its trademark certificate, Respondent's first use in the Philippines was on 4 January 1987. Noticeably, even the date of its filing, which was on 4 April 1988, is earlier than Petitioner's first use in the Philippines. From the foregoing, it clearly appears that Respondent's adoption and use in the Philippines began in 1987.

These disquisitions plainly show that Respondent is the true and rightful owner of the subject trademark. Having first adopted and used the trademark G2000 in the country, Respondent met the essential requisites in acquiring the right of ownership over it. As earlier noted, trademark is a creation of use, and as such, belongs to the one who first used and gave it value in the Philippines and not elsewhere.

The Paris Convention, concededly, confers protection to well-known trademarks. But to be entitled to such protection, it is necessary to establish that the subject trademark is well known. In the language of the High Court, the trademark to be protected must be well-known in the country where protection is sought. The power to determine whether a trademark is well known, the High Court explained, lies in the competent authority of the country of registration or of use. This competent authority would be either the registering authority, if it has the power to decide this, or the courts of the country in question, if the issue comes before a court.

In the landmark case of *La Chemise Lacoste, S.A. v. Fernandez*, the High Court had the opportunity to explain the protection conferred under the Paris Convention as implemented by the Villafuerte and Ongpin Memoranda. Under Article 6bis of the Paris Convention, it declared that the Minister of Trade and Industry was the competent authority to determine whether a trademark is well-known in the country. The High Court upheld the validity of the foregoing memoranda.

In the Villafuerte Memorandum, the Minister of Trade instructed the Director of Patents to reject all pending applications for Philippine registration of signature and other world-famous trademarks of applications other than their original owners or users. The Minister enumerated several internationally known trademarks and ordered the Director of Patents to require Philippine registrants of such marks to surrender their certificates of registration. The full text of the Villafuerte Memorandum is reproduced below, viz.:

Pursuant to the Paris Convention for the Protection of Industrial Property to which the Philippines is a signatory, you are hereby directed to reject all pending applications for Philippine registration of signature and other world-famous trademarks by applicants other than its original owners or users.

The conflicting claims over internationally known trademarks involve such name brands as Lacoste, Jordache, Vanderbilt, Sasson, Fila, Pierre Cardin, Gucci, Christian Dior, Oscar de la Renta, Calvin Klein, Givenchy, Ralph Lauren, Geoffrey Beene, Lanvin and Ted Lapidus.

It is further directed that, in cases where warranted, Philippine registrants of such trademarks should be asked to surrender their certificates of registration, if any, to avoid suits for damages and other legal action by the trademarks foreign or local owners or original users.

You are also required to submit to the undersigned a progress report on the matter.

For immediate compliance.

In the Ongpin Memorandum, the Minister of Trade and Industry did not enumerate well-known trademarks but laid the guidelines for the Director of Patents to observe in determining whether a trademark is entitled to protection as a well-known mark in the Philippines under Article 6bis of the Paris Convention. The full text of the Ongpin Memorandum is reproduced below, viz.:

Pursuant to Executive Order No. 913 dated 7 October 1983 which strengthens the rule-making and adjudicatory powers of the Minister of Trade and Industry and provides inter alia, that such rule-making and adjudicatory powers should be revitalized in order that the Minister of Trade and Industry can . . . apply more swift and effective solutions and remedies to old and new problems . . . such as infringement of internationally-known trade names and trademarks . . . and in view of the decision of the Intermediate Appellate Court in the case of *LA CHEMISE LACOSTE, S.A., versus RAM SADWHANI* [AC-G.R. SP NO. 13359 (17) June 1983] which affirms the validity of the MEMORANDUM of then Minister Luis R. Villafuerte dated 20 November 1980 confirming our obligations under the PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY to which the Republic of the Philippines is a signatory, you are hereby directed to implement measures necessary to effect compliance with our obligations under said Convention in general, and, more specifically, to honor our commitment under Section 6bis 57 thereof, as follows:

1. Whether the trademark under consideration is well-known in the Philippines or is a mark already belonging to a person entitled to the benefits of the CONVENTION, this should be established, pursuant to Philippine Patent Office procedures in inter partes and ex-parte cases, according to any of the following criteria or any combination thereof:

(a) a declaration by the Minister of Trade and Industry that the trademark being considered is already well-known in the Philippines such that permission for its use by other than its original owner will constitute a reproduction, imitation, translation or other infringement;

(b) that the trademark is used in commerce internationally, supported by proof that goods bearing the trademark are sold on an international scale, advertisements, the establishment of factories, sales offices, distributorships, and the like, in different countries, including volume or other measure of international trade and commerce;

(c) that the trademark is duly registered in the industrial property office(s) of another country or countries, taking into consideration the date of such registration;

(d) that the trademark has long been established and obtained goodwill and international consumer recognition as belonging to one owner or source;

(e) that the trademark actually belongs to a party claiming ownership and has the right under the provisions of the aforestated PARIS CONVENTION.

2. The word trademark, as used in this MEMORANDUM, shall include tradenames, service marks, logos, signs, emblems, insignia or other similar devices used for identification and recognition by consumers.

3. The Philippine Patent Office shall refuse all applications for, or cancel the registration of, trademarks which constitute a reproduction, translation or imitation of a trademark owned by a person, natural or corporate, who is a citizen of a country signatory to the PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

4. The Philippine Patent Office shall give due course to the Opposition in cases already or hereafter filed against the registration of trademarks entitled to protection of Section 6 bis of said PARIS CONVENTION as outlined above, by remanding applications filed by one not entitled to such protection for final disallowance by the Examination Division.

5. All pending applications for Philippine registration of signature and other world-famous trademarks filed by applicants other than their original owners or users shall be rejected forthwith. Where such applicants have already obtained registration contrary to the abovementioned PARIS CONVENTION and/or Philippine Law, they shall be directed to surrender their Certificates of Registration to the Philippine Patent Office for immediate cancellation proceedings.

Petitioner should show that its trademark or trade name G2000 is already a well known trademark or trade name at the time of Respondent's application for registration of its trademark G2000. Its evidence should satisfactorily demonstrate that it is either mentioned as a signature or a world famous mark in the Villafuerte Memorandum or that it met the criteria set for a well known mark in the Ongpin Memorandum.

Noticeably, Petitioner's trademark or trade name G2000 does not fall under the enumeration of signature and other world famous mark in the Villafuerte Memorandum. Not

having been mentioned as a signature or a world famous mark in the subject memorandum, Petitioner's claim of worldwide recognition finds no support under the Paris Convention.

Neither did Petitioner's evidence adequately show that it met any criterion in the Ongpin Memorandum. The Minister of Trade and Industry did not declare that the Petitioner's trademark or trade name G2000 was a signature or world famous mark or name. Concededly, Petitioner had commercial transactions outside its principal office in Hong Kong, but its only admissible and credible evidence were its sales transactions in the Philippines in the year 1989. But even assuming *arguendo* that evidentiary value can be given to its export sales data, it could demonstrate that its export commercial transactions other than in the Philippines began in the year 1990. Noticeably, Petitioner's export sales were limited to very few countries. It, therefore, cannot be considered as engaged in commercial transaction in an international scale. Even Petitioner's advertisements and promotional materials only showed that the earliest advertising and sales promotions date was in the year 1990 in countries other than the Philippines and in the year 1989 in the Philippines. Interestingly, Petitioner's earliest registration was in Singapore in the year 1985. In Hong Kong, it only obtained its registration in the year 1987. Notably, Petitioner has not met even a single criterion under the Ongpin Memorandum. Not having established its entitlement to protection as a well known mark under the subject memorandum, Petitioner cannot claim the benefits of the Paris Convention.

In summary, the foregoing circumstances militate against Petitioner's claim that its trademark or trade name G2000 is a well known mark at the time of Respondent's application for registration of its trademark G2000. Plainly, Petitioner's trademark or trade name is not a well known mark and therefore is not entitled to the benefits of the Paris Convention. Neither did it meet the essential requirements of adoption and use in the Philippines under R.A. 166, as amended. Consequently, the Bureau upholds the validity of the Respondent's trademark registration over the trademark G2000 and declares Respondent as its true and rightful owner.

Equally important, as earlier noted, is the issue of confusing similarity. In evaluating the similarity between Respondent's registered mark G2000 and Petitioner's trademark or trade name G2000, it requires us to examine their appearance, sound, connotation, and commercial impression. Taking note of the striking similarity of their marks and the competing nature of their goods, we declare that a state of confusing similarity exists. Even the parties admitted that their marks are confusingly similar as applied to their respective products.

WHEREFORE, premises considered, the Petition for Cancellation is hereby, DENIED. Consequently, the validity of Registration No. 59138 for the mark "G2000" issued in the name of ROMEO CHONG, on 5 September 1994 is hereby AFFIRMED.

Let the filewrapper of the mark G2000 subject matter of this case be forwarded to the Bureau of Trademarks for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, 27 July 2006.

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