

ROSALINA GAW, <i>Petitioner,</i>	}	INTER PARTES CASE NO. 3225
	}	Petition for Cancellation:
	}	
	}	TM Registration. No.: 37623
-versus-	}	Issued : 08-31-1987
	}	Trademark : "GRAND SLAM"
	}	For : Clothing (Class 25)
MUNSINGWEAR, INC. <i>Respondent-Registrant.</i>	}	
	}	Decision No. 200-29
x-----x		

DECISION

This pertains to the Petition for Cancellation filed by ROSALINA GAW, of legal age and with address at c/o Alberto tan, 645-A Tomas Mapua Street, Sta. Cruz, Manila, against the registration of the trademark "GRAND SLAM" for goods under Class 25, bearing TM Registration No. 37623, issued on 31 August 1987 in the name of MUNSINGWEAR, INC., a corporation organized and existing under the laws of the State of Delaware, U.S.A., with principal business address at 8000 West 78<sup>th</sup> Street, Suite 400, Minneapolis, Minnesota 55439, U.S.A.

Petitioner filed the instant Petition for Cancellation with the Bureau of Patents, Trademarks and Technology Transfer (BPTTT) on 05 September on 05 September 1988 1994, based on the following grounds:

- "1. That the registration of the trademark GRAND SLAM for clothing under Class 25 is contrary to the provision of Section 4(d) Chapter II of republic Act No. 166, as amended.
- "2. That petitioner has adopted and used the said trademark since long prior to the respondent-registrant.
- "3. That petitioner likewise had registrations on the mark GRAND SLAM as per Registration No. 2119 issued on February 10, 1975 and another Registration No. 18042 issued on December 18, 1972, but unfortunately she failed to file the required affidavits of use on both registrations due to inadvertence and heavy pressure of work. Xerox copies of said registrations are herewith attached and marked as Annexes "A" and "B", respectively.
- "4. That despite said failure to comply with the filing of affidavits she did not actually abandon the same and had continuously used in actual trade and commerce in the Philippines her said mark GRAND SLAM.
- "5. That because of said non-filing of said affidavits of use, she filed anew an application in the Principal Register, Serial No. 59326 now pending before this Honorable Office.

To support the Petition for Cancellation, Petitioner relied upon the following facts, among others:

- "1. That at least long prior to respondent's alleged date of first use, petitioner had been using the mark GRAND SLAM in actual local

trade and commerce for which reason the registrations Annexes “A” and “B” were issued to her.

- “2. Respondent had never used said mark in actual local trade and commerce thru its own for which reason it could not claim bona fide use and ownership in the Philippines.
- “3. That it is obvious that the mark GRAND SLAM as used by the parties are confusingly similar and that when concurrently used on their goods and other related goods will damage petitioner and the goodwill built up in her well known mark.”

The Notice to Answer, dated 10 October 1988, was sent to and received by Respondent-Registrant’s counsel on 11 October 1988. On 25 November 1988, Respondent-Registrant filed its Answer, specifically denying all the averments in the Petition for Cancellation and alleging that it is the owner of the trademark GRAND SLAM, which it has been using since the early 1950’s. Respondent-Registrant, as the owner of the subject trademark, has registered the same not only in the Philippines but also in various countries around the world for goods under Class 25. Respondent-Registrant, likewise, alleged that it is Petitioner who has illegally appropriated the subject trademark, which Respondent-Registrant has popularized worldwide.

The issues having been joined, the case was set for Pre-Trial and for failure of the parties to reach an amicable settlement, the case proceeded to trial on the merits where the parties presented their respective oral and documentary evidence.

Admitted as evidence for the Petitioner are Exhibits “A” to “L” inclusive of sub-markings, consisting of: (a) Trademark Registration 18042 dated 18 December 1972 for the trademark GRAND SLAM with Penguin or the letter “m” device, for goods under Class 25, issued in the name of Petitioner, which was later canceled for failure to file the required Affidavit of Use; (b) Trademark Registration No. SR-2119 dated 10 February 1975 for the trademark GRANDSLAM with Penguin device, for goods under Class 25, which was later cancelled for failure to file the required Affidavit of Use; (c) Mayor’s Permit (dated 31 December 1989) of Lawton Garment Manufacturing Co., which manufactures and sells GRAND SLAM clothing and of which Petitioner is a partner; (d) Sales Invoices 10751 to 10800 dated 02 June 1983 representing sales of GRAND SLAM clothing for said period; (e) BPTTT Decision No. 87-40 dated 30 January 1987, in Inter Partes Case No. 1160 entitled “Munsingwear, Inc. vs. G & T Garment Factory” (the letter being the predecessor in interest of Lawton Garment Manufacturing Co.), whereby the BPTTT dismissed the Petition for Cancellation for being moot and academic since the certificate of registration subject thereof, Certificate of Registration No. SR-2119, was already cancelled for failure of the registrant to file the required Affidavit of Use for the fifth anniversary, pursuant to Sec. 12 of R.A. 166; (f) BPTTT Decision No. 87-47 dated 05 August 1987, in an interference case between Munsingwear, Inc. as Junior Party-Applicant and Rosalina Gaw as Senior Party-Registrant, whereby the BPTTT dismissed said proceedings for being moot and academic since the certificate of registration subject thereof, Certificate of Registration No. 10842, was already cancelled for failure of the registrant to file the required Affidavit of Use for the tenth anniversary, pursuant to Sec. 12 of R.A. 166. Thus, Application Serial No. 35354 of Munsingwear, Inc. for the trademark GRAND SLAM was given due course and matured to Certificate of Registration No. 37623, which is subject of the instant Petition for Cancellation; (g) Transcripts of Stenographic Notes dated 24 May 1989, 03 August 1989, 23 January 1990, and 06 July 1990; and (h) Inter-Office Memo dated 10 December 1970 from Mr. Alberto Tan to the Supervisor of the Design Section of G & T Garment Factory, “to show that the words GRAND SLAM was conceived because of the basketball championships of several tournaments of games, for which said winners referred to their achievement in basketball as GRAND SLAM”.

Admitted as evidence for the Respondent-Registrant are Exhibits “1” to “3” inclusive of sub-markings, consisting of: (a) the Affidavit of Roger Y. Meyer, Executive Vice-President and manager of Munsingwear, Inc., dated 29 March 1993; (b) list of the certificates of

registration/applications for registration of the trademark GRAND SLAM from different countries worldwide; and (c) Certificates of Registration/Applications for Registration of the trademark GRAND SLAM issued to/applied for by Respondent-Registrant in eighty six (86) countries worldwide from Albania to Zimbabwe.

The issues to be resolved in this particular case are:

- (a) Whether or not there exists a confusing similarity between the Petitioner's and Respondent-Registrant's trademark GRAND SLAM; and
- (b) Who between the Petitioner and the Respondent-Registrant is the prior user entitled to protection under the Trademark Law.

Considering that Certificate of Registration No. 37623 subject of the instant petition for cancellation was issued under the old Trademark Law (R.A. 166, as amended), this Office shall resolve the case under said law so as not to adversely affect rights already acquired prior to the effectivity of the new Intellectual Property Code (R.A. 8293).

The applicable provision of the Trademark Law, Section 4(d) provides:

“Sec. 4. *Registration of trademarks, trade-names and service-marks on the principal register* – xxx 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:

x x x

“(d) Consists of or comprises a mark or trade-name which so resembles a mark of 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 or used in connection with the goods, business or service of the applicant, to cause confusion or mistake or to deceive purchasers.”

In the instant case, the trademarks of the Petitioner and the Respondent-Registrant are not only similar but are identical. Both parties use the word GRAND SLAM in exactly the same writing style and configuration. The Penguin and “m” devices, which are used by the parties in conjunction with the word GRAND SLAM, are the same in appearance and pictorial presentation. The trademarks used by both parties are exactly alike such that it can reasonably be concluded that one party copied the trademark of the other. It is quite impossible for two people to come up with exactly the same word mark, with exactly the same devices, without one first having seen the trademark of the other. In the face of such identity, not only in the word mark used but also in the combination of devices, the question as to likelihood of confusion becomes academic, especially when the parties use the same mark for the same goods. *Res ipsa loquitur*. The only issue that remains to be resolved is: who between the two parties is the prior user of the trademark and therefore entitled to protection?

As per the evidence presented, Petitioner admits having seen the mark GRAND SLAM prior to her application for registration thereof, to wit:

“Q: But how did you come to know of this mark here, did you or where did you get it?

x x x

A: We see and look at the magazines. And when we saw this trademark, I have it registered.”

*(Testimony of Rosalina Gaw, TSN dated 06 July 1990, pp. 26, 29)*

In the face of the foregoing admission, the 10 December 1970 Inter-Office Memo from Mr. Alberto Tan to the Supervisor of the Design Section, which was submitted as evidence by the Petitioner on 16 December 1991 to show that the trademark GRAND SLAM was allegedly conceived because basketball champions referred to their achievement in basketball as GRAND SLAM, is obviously a belated attempt to cover-up the fact that it was not Petitioner who coined and originated the subject trademark. The documentary evidence is self-serving and baseless as Petitioner did not even present independent evidence that G & T Garment Factory had a design section much less a design supervisor.

On the other hand, it was in the 1950's Respondent-Registrant first used the trademark GRAND SLAM in the United States for various goods. As early as 19 June 1956, Respondent-Registrant secured for the United States Patent Office Trademark Certificate of Registration No. 629, 148 for the trademark GRANS SLAM for goods under Class 36. Thereafter, on 29 July 1969 and 14 August 1979 respectively, the United States Patent Office also issued to the Respondent-Registrant Certificates of Registration Nos. 873,862 (Class 39) and 1,418,434 (Class 25). Respondent-Registrant has also applied for/secured registrations for the trademark GRAND SLAM for various goods in about eighty-six (86) countries worldwide, from Albania to Zimbabwe, including Philippines. Prior to 1971, when Petitioner first applied for registration of the trademark GRAND SLAM in the Philippines, Respondent already obtained registrations for said trademark in Canada (Reg. No. 119,303; 02 September 1960), Botswana (Reg. No. 3,907; 06 January 1962), and Mexico (Reg. no. 156,362; 04 March 1970).

Thus, it is clear from the foregoing that between the Petitioner and the Respondent-Registrant, the former has sufficiently proven that it is the originator, owner and prior user of the trademark GRAND SLAM and is therefore entitled to protection from infringement thereof.

WHEREFORE, premises considered, the Petition for Cancellation is hereby DENIED. Consequently, TM Certificate of Registration bearing Serial No. 37623 for the mark “GRAND SLAM” issued in the name of MUNSINGWEAR, INC. on 31 August 1987 is hereby AFFIRMED. Nevertheless, for failure of the Respondent-Registrant to file the required Affidavit of Use on the tenth (10<sup>th</sup>) year anniversary, pursuant to Section 12 of R.A. 166, Certificate of Registration Serial No. 37623 for the mark “GRAND SLAM” issued in the name of MUNSINGWEAR, INC. on 31 August 1987 is hereby CANCELLED.

Let the filewrapper of trademark GRAND SLAM subject matter of this case be forwarded to the Administrative, Financial Human Resource Development Service Bureau (AFHRDSB) for appropriate action in accordance with this Decision and a copy furnished the Bureau of Trademarks (BOT) for information and update of its records.

SO ORDERED.

Makati City, 04 December 2002.

EDWIN DANILO A. DATING  
Assistant Director / Officer-in-Charge  
Bureau of Legal Affairs