

GIORDANO LIMITED,
Petitioner,

INTER PARTES CASE NO. 3391

PETITION FOR CANCELLATION

- versus -

Cert. of Regn. No.: 33666
Issued: September 3, 1984
Registrant: Fashion World Garments
Mfg. Corp.
Trademark: FROG & REPRESENTATION
Used on: T-shirts, polos, briefs, socks
and sandos

FASHION WORLD GARMENTS
MFG. CORP.,
Respondent-Registrant.
x-----x

DECISION NO. 90-30 (TM)
July 25, 1990

DECISION

Giordano Limited filed on June 1, 1989 a Petition seeking for the cancellation of Certificate of Registration No. 33666 for the trademark "FROG & REPRESENTATION" used on the following goods, to wit: T-shirts, polos, briefs, socks and sandos in International Class 25 issued on September 3, 1984 in the name of Fashion World Garments Mfg. Corp.

Petitioner is a foreign entity, incorporated as a limited company under the companies ordinance of Hong Kong with principal place of business at Tin on Industrial Building, Nos. 777-779 Cheung Sha lean Road, 11th Floor, Kowloon, Hong Kong, while Respondent-Registrant is a domestic corporation with business address at 92 Engineering Road, Araneta Village, Malabon, Metro Manila.

The grounds alleged in the Petition are as follows:

- "a) That respondent-registrant was not .entitled to register the mark 'FROG & REPRESENTATION' at the time of its application for registration thereof;
- b) That the registration was obtained fraudulently or contrary to the provisions of Sec. 4(d), Chapter II-of Republic Act No. 166, as amended; and
- c) That cancellation is authorized by other provisions of Republic Act No. 166, as amended."

On July 20, 1989, a Notice to Answer was sent to Respondent-Registrant by registered mail with return card No. 489. For failure to file its Answer, and upon Motion of the Petitioner, Respondent-Registrant was declared in default (Order No. 861 dated October 27, 1989). Accordingly, Petitioner was allowed to present its evidence ex parte.

The issues to be resolved are the following:

1. Whether or not the trademark of Respondent-Registrant is confusingly similar with that of the Petitioner; and
2. Whether or not Petitioner has acquired priority of registration and goodwill over the mark "FROG DEVICE" to the exclusion of use/registration of the same by all others.

On October 10, 1980, the mark "FROG REPRESENTATION" was registered under Part A in Hong Kong (Exh. "B-26-6") as appearing in the Certificate of Registration No. 621 of 1981 (Exh. "B-26").

The above mark was likewise registered in Iran (Exhs. "B-33" and "B-35").

Certificate of Registration No. 26755 issued in the Republic of Iraq (Exh. "B-37").

The mark "GIORDANO AND FROG DEVICE" was likewise registered in Japan, and in other countries as shown in the evidence submitted (Exh. "B", inclusive).

Based on the evidence submitted, the Respondent-Registrant's trademark "FROG & REPRESENTATION" is confusingly similar with the Petitioner's mark as both marks contain a frog device. The Registrant-Respondent's mark although accompanied by the word "frog" is exactly the same meaning with the frog representation. Under Philippine jurisprudence, colorable imitation implies similarity; however, this does not mean such a similitude as amounts to identity. One test given is that if the form, marks, contents, words or other special arrangement or general appearance of the words of the alleged infringer's device are such as would be likely to mislead persons in the ordinary course of purchasing the genuine articles, then the similarity is such as entitles the injured party to equitable production.

It is, therefore, not necessary that the matter sought to be protected be literally copied. Difference or variations or similarity in the details of one device or article of those of another are not the legally accepted tests whether an action based on confusing similarity exists. It is sufficient that the substantial and distinctive part of the main or essential or dominant features of one mark is copied or imitated in another (Co Tiong Sa vs. Director of Patents, 95 Phil. 1).

Respondent-Registrant's trademark "FROG & REPRESENTATION" was granted only on September 3, 1984 with date of application July 20, 1981 (Exh. "E-1").

On the other hand, Petitioner's trademark "FROG DEVICE" was registered in Hong Kong on October 10, 1980 under Certificate of Registration No. 621 of 1981 (Exhs. "B-26-b" and "B-26").

On the basis of the evidence presented, the herein Petitioner has established that it owns the mark "FROG DEVICE" through prior and continuous use of the same and in many countries in the world to merit protection as a well-known mark.

The herein Respondent-Registrant was declared in default (Order No, 89-861 dated October 27, 1989) and the non-filing of the Answer and Motion to lift the Order of Default despite notice is indicative of its lack of interest in its application; thus, he is deemed to have abandoned the same.

WHEREFORE, the Petition is GRANTED. Consequently, Certificate of Registration No. 33666 issued to Respondent-Registrant is hereby CANCELLED.

Let the records of this case be remanded to the Patent/Trademark Registry and EDP-Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director