

BENJAMIN T. GONZALES  
Junior Party-Applicant

INTER PARTES CASE NOS. 3254

INTERFERENCE BETWEEN:

Application Serial No.: 60236  
Filed: October 23, 1986  
Applicant: Santiago P. Enriquez  
Trademark: DIGMAN HALO-HALO  
Used On: Restaurant and refreshment

- versus -

- and -

Application Serial No.: 60244  
Filed: October 24, 1986  
Applicant: Benjamin T. Gonzales  
Trademark: DIGMAN  
Used On: Halo-halo and home-  
made siopao

SANTIAGO F. ENRIQUEZ  
Senior Party-Applicant.

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DECISION NO. 90-27 (TM)  
July 6, 1990

#### DECISION

This is an interference case declared pursuant to Rules 179 and 180 of the Rules of Practice in Trademark Cases between Trademark Application Serial No. 60236 filed on October 23, 1986 by herein Senior Party-Applicant Santiago F. Enriquez for the service mark "DIGMAN HALO-HALO" used on "restaurant and refreshment parlor" and Trademark Application Serial No. 60244 filed on October 24, 1986 by herein Junior Party-Applicant Benjamin T. Gonzales for the mark "DIGMAN" used on halo-halo and home-made siopao.

The Junior Party-Applicant is a Filipino with business address at Digman, Bacoar, Cavite under the style "Digman Halo-Halo", while the Senior Party-Applicant is likewise a Filipino citizen doing business under the style "Digman Halo-Halo" at 5050 P. Burgos, Makati, Metro Manila and residing at 245 El Grande Avenue, B.F. Homes, Las Piñas, Metro Manila.

This Bureau declared an interference between the contending applicants purposely to determine who has the priority of use and adoption of the contested mark in the market.

The declaration of interference was premised on the fact that the application of the Junior Party-Applicant, though filed later, alleged an earlier date of use of the mark in commerce (January 1, 1975) than that of the Senior Party-Applicant whose first use of the mark is July 29, 1984.

Accordingly, a Notice of Interference was sent to both parties, through registered mail, requiring them to file within a period of forty (40) days from receipt thereof a motion to dissolve and other motions of similar character.

On December 15, 1988, the Senior Party-Applicant filed a motion to dissolve asking for the dissolution of the interference and for the declaration of the application for registration of Benjamin T. Gonzales as contrary to the provision of subsection (e) of Section 4, Chapter II-A of

Republic Act No. 166, as amended, and that applicant Benjamina T. Gonzales is not entitled to an exclusive appropriation of the word "DIGMAN".

On June 22, 1989, the Junior Party-Applicant filed a motion to dissolve interference on some of the following substantive valid grounds:

1. That Junior Party-Applicant started using the mark "DIGMAN" since January 1, 1975 and up to the present and has no intention whatsoever to abandon its use on halo-halo.
2. That the Senior Party-Applicant filed his application dated October 23, 1986 with alleged first use thereof on July 29, 1984 which is much later than the first filing date and first use of the Junior-Party Applicant.
3. That Senior Party-Applicant has no better nor superior right to use the mark "DIGMAN".
4. That Junior Party-Applicant having used the mark "DIGMAN" for fifteen years to date (1989) although a name of a place in Cavite, has already acquired a secondary meaning.
5. That the application of the Senior Party-Applicant be denied.

This Bureau on the motions to dissolve filed by the parties and that the issue of priority of adoption and use of the marks in controversy could not be determined without the presentation by the parties of their respective evidence, on July 6, 1989, sent a Notice of Pre-Trial Conference on both parties to have the case proceed to trial.

On the basis of the admitted evidence presented, Junior Party-Applicant has been using the mark "DIGMAN" in the Philippines since January 1, 1975 (Exhs. "A" and "A-1") as shown in Certificate of Registration No. SR-3658 issued on December 12, 1978 in the name of the Junior Party-Applicant and the trademark application (Exh. "B") she filed dated October 24, 1986 containing the same date of first use, January 1, 1975.

On the other hand, Senior Party-Applicant alleged date of first use of the mark in commerce is July 29, 1984 as alleged and stated in the application he filed covered by the acknowledgment receipt issued by the Bureau of Patents, Trademarks and Technology Transfer (Exh. "2-a").

In addition to the documentary evidence presented, it has been admitted by the witness for the Senior Party-Applicant in the name of Ms. Gloria Carascal, that she knew Junior Party-Applicant Benjamina T. Gonzales owning a sari-sari store since 1972 selling canned goods and drinks and in 1976 selling halo-halo using the mark "DIGMAN". Mr. Enriquez likewise admitted that he only started using the mark "DIGMAN Halo-Halo" in 1984.

Under such circumstances, the Senior Party-Applicant having used the mark "DIGMAN" only in the year 1984 which is much later than the date of first use of the Junior Party-Applicant which is 1975, the Junior Party-Applicant would be the prior user of the mark "DIGMAN." and, therefore, entitled to register the same under her name.

WHEREFORE, premises considered, Application Serial No. 60244 filed on October 24, 1986 by Junior Party-Applicant is hereby given due course. Accordingly, Application Serial No. 60236 filed on October 23, 1986 by the Senior Party-Applicant is hereby ordered REJECTED.

Let the records of this case be remanded to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO  
Director