

INTER PARTES CASE NO. 1980
Petition for Cancellation:

H.D. LEE COMPANY, INC.,
Petitioner

Cert. of Reg. No. SR-4712
Issue : May 16, 1980
Registrant : Tee Liong Chai

Trademark : CALIFORNIA
LEE

- versus -

Used on : jackets, jeans,
shoes, etc.

TEE LIONG CHAIN,
Respondent-Registrant.
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DECISION NO. 88-45 (TM)
July 12, 1988

DECISION

This is a Petition for Cancellation of Certificate of Registration No. S.R.-4712 issued on May 16, 1980 in favor of the herein Respondent, Tee Liong Chai, for the trademark CALIFORNIA LEE used on jackets, jeans, shoes, belts, bags, socks, etc.

Petitioner, H.D. Lee Company, Inc., is a Delaware corporation with address at 9001 West 67th Street, Merriam, Kansas, U.S.A. while Respondent is a Filipino citizen doing business at 535 Rizal Avenue, Manila

The issue in this case, i.e. whether or not the subject registration is cancellable in accordance with Section 4 (d) of R.A. 166, as amended, has been settled in favor of the herein Petitioner in the Decision (Decision No. 85-88 TM, December 13, 1985) of Inter Partes Case No. 1818 - an Opposition filed by H.D. Lee Company, Inc., against the registration in the Principal Register of the same trademark, California Lee, of the herein Respondent. The Director of Patents ruled:

"All the foregoing in mind, and borne out by evidence adduced by the Opposer, it is includible for the Office to hold that the dominant feature of the contending trademarks is the word "LEE". It may not be amiss to state at this juncture that the trademarks of the Opposer has become popular and had already established a valuable goodwill not only in the Philippines but also all over the world (Exhs. "F-1", "F-7" to "F-66", incl.; "F-74", "F-75" and "F-98" to "F-101", inc.). Thus, it is not farfetched for this Office to surmise that if the contending trademarks are allowed to co-exist, ordinary or unwary purchasers will be misled into believing that the goods or products under such marks come from the same source or origin to the prejudice Opposer's products. In fact, as shown by the adduced evidence, Opposer and its authorized Philippine license are incurring expenses due to the proliferation of fake "LEE" jeans and other garments (Exhs. "F-80" to "F-93", incl.)."

x x x

"WHEREFORE, all the foregoing premises considered, this Office believes that, Opposer has successfully made out its case. Hence, the Opposition is, as it is hereby GRANTED. Accordingly, Application Serial No. 40145 filed on December 6, 1979 by the herein Respondent-Applicant, Tee Liong Chai, is, as it is hereby REJECTED for being contrary to the provisions, of Sec. 4 (d) and (c) of Republic Act 166, as amended."

Moreover, records show that Certificate of Registration No. S.R.-4712 is deemed cancelled by operation of law for Respondent failed to file the 5th Anniversary Affidavit of use/non-use pursuant to Section 12 of R.A. 166, as amended which reads:

“Sec. 12. Duration. - Each certificate of registration shall remain in force for twenty years; Provided, That registrations under the provision of this Act shall be cancelled by the Director, unless, one year following the fifth, tenth and fifteenth anniversaries of the date of issue of the certificate of registration, the registrant shall file in the Patent Office an affidavit showing that the mark or tradename is still in use or showing that its non-use is due to special circumstances which excuse such non-use and is not due to any intention to abandon the same, and pay the required fee.”

WHEREFORE, premises considered, this Bureau GRANTS the herein Petition for Cancellation and order Certificate of Registration No. S.R.-4712 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