

MACARIO CO YU KANG	}	INTER PARTES CASE NO. 14-2003-00051
	}	
Petitioner,	}	Petition for Cancellation:
	}	
-versus-	}	Registration No. 28199
	}	Date Filed: May 22, 1980
	}	Trademark: "DUNLOP"
BTR INDUSTRIES LIMITED	}	
Respondent-Registrant-Assignee.	}	
x-----x		Decision No. 2004-12

D E C I S I O N

This pertains to the verified Petition for Cancellation of the registration of the trademark "DUNLOP" under Registration No. 28199 issued *May 22, 1980* in the name of "DUNLOP HOLDING LIMITED" who later on assigned the same in favor of BTR INDUSTRIES LIMITED with address at Carlisle Place, London SW1P 1BX England represented in the Philippines by its resident agent, Poblador Azada & Bucoy with office at the 21st Floor, Chatham House, 116 V.A. Rufino corner Valero Streets, Salcedo Village, Makati City.

Petitioner is MACARIO CO YU KANG, Filipino with business address at No. 260 2nd Street, Grace Park, Caloocan City.

The grounds for the Petition for Cancellation are that Respondent-Registrant-Assignee has abandoned its trademark registration No. 28199 for the mark "DUNLOP".

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

- "1. Petitioner is the true and lawful owner of the mark "DUNLOP WITH THE LETTER D DESIGN" for use on socks, having adopted, used and popularized the same earlier than the Respondent-Registrant-Assignee. Petitioner had registered the "DUNLOP WITH THE LETTER D DESIGN" for use on socks with the Philippine Patent Office under Registration No. SR-4987 as early as September 26, 1980. A certified true copy of Certificate of Registration No. SR-4987 is hereto attached as Annex "A" and made an integral part hereof;
- "2. Likewise, Petitioner has filed with this Honorable Intellectual Property Office, Application Serial No. 4-1999-08496 for the registration of the mark "DUNLOP" for use on stockings, thighs, leggings, footcover, anklet stockings, short stockings, knee high stockings, stay up stockings, and panty hose, and Application Serial No. 4-2000-00536 for the registration of the mark "DUNLOP WITH THE LETTER D DESIGN" for use on socks. Certified true copies of the aforesaid applications are hereto attached as Annexes "B" and "C" and made an integral parts hereof;
- "3. Petitioner first used the mark "DUNLOP WITH THE LETTER D DESIGN" for socks on January 17, 1979;
- "4. Petitioner has continued up to the present the use of the mark "DUNLOP WITH THE LETTER D DESIGN" on socks, and he has extended the use of the mark "DUNLOP" on stockings, thighs, leggings, footcover, anklet

stockings, short stockings, knee high stockings, stay up stockings, and panty hose;

- “5. The trademarks ”DUNLOP WITH THE LETTER D DESIGN” have earned a nationwide reputation and nationwide following;
- “6. Petitioner’s mark have acquired trough time, in the minds of the purchasing public, a good reputation and high quality image;
- “7. Since its registration on May 22, 1980, neither the original registrant nor Respondent-Registrant-Assignee has used in the Philippines, without justifiable reason, the mark “DUNLOP” for goods enumerated in Registration Certificate No. 28199. In addition, Respondent-Registrant-Assignee has not filed the petition for renewal of subject registration;
- “8. In fact and in law, Respondent-Registrant-Assignee has abandoned the mark “DUNLOP” registered under Registration No. 28199;
- “9. The mark “DUNLOP” registered under Registration No. 28199 is identical and/or confusingly similar to Petitioner’s mark “DUNLOP” and ”DUNLOP WITH THE LETTER D DESIGN”.

The only issue in this case is whether or not *MACARIO CO YU KANG*, the Petitioner has been using the trademark “DUNLOP” in the Philippines for goods falling under class 25.

Pursuant to existing procedures, after the Petition was filed, a Notice to Answer was sent by this Office to the Respondent-Registrant-Assignee’s duly appointed agent and attorney which was received last September 5, 2003.

On December 4, 2003, Petitioner through counsel filed a Motion to Declare Respondent-Registrant-Assignee in Default for failure to file the Answer to the petition for cancellation which motion was *GRANTED* under ORDER No. 2004-16 dated 20 January 2004.

Pursuant to the Order of Default, Petitioner presented Exhibits “A” to “L” inclusive of sub-markings.

As shown by the evidence, Petitioner has registered the mark ”DUNLOP with the Letter D DESIGN” with the Philippine Patent Office, now the Intellectual Property Office on September 20, 1980 under Registration No. SR-4987 for the goods “socks” class 25 (Exhibit “D”).

The previous actual use of the Petitioner of the trademark ”DUNLOP with the Letter D DESIGN” is amply supported by Delivery Receipts, (Exhibits “F” to “F-23”) and Sales Invoices (Exhibits “F-24” to “F-39”).

Another proof that the Petitioner is actually using his trademark above-mentioned is the fact that “*LINA CO*” the sister of the herein Petitioner who was authorized to use the said trademark using her business name “WINFAIR ENTERPRISES” which was registered with the appropriate Government agencies since 1984 was allotted store spaces by various shopping malls where to display, offer for sale, and sell DUNLOP socks and stocking (Exhibits “G” to “G-9”).

The previous registration and use of the trademark ”DUNLOP with the Letter D DESIGN” by the Petitioner was not disputed by the Respondent-Registrant-Assignee by any counter evidence since it was declared IN DEFAULT. Lamentably, Respondent-Registrant-Assignee has not adduced an iota of proof that tit is using the trademark “DUNLOP” in the Philippines.

Deserving attention at this point is the fact that the Certificate of Registration No. 28199 issued on May 22, 1980 in the name Respondent-Registrant-Assignee which was issued under Republic Act No. 166, as amended is valid for a period of twenty (20) years or up to *May 22, 2000*. As shown by the evidence submitted by the Petitioner, Respondent-Registrant-Assignee had not filed any petition for renewal of Registration No. 28199. Accordingly, said Certificate of Registration has already expired.

WHEREFORE premises considered, this case is DISMISSED for being *moot and academic*.

Let the file wrapper of trademark DUNLOP 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 with a copy furnished the Bureau of Trademarks for information and to update its record.

SO ORDERED.

Makati City, 29 July 2004.

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