

HENRY N. KAWSON,
Opposer

IPC NO. 14-2005-00103
Opposition to:

-versus-

Appl'n Serial No.: 04-2004-001243
Date Filed: 11 February 2004
Trademark: "YOUNG'S TOWN"

FISHWEALTH CANNING CORP.
Respondent-Applicant

x-----x

Decision No. 2006-01

DECISION

This is an opposition to the registration of the mark "YOUNG'S TOWN" for sardines and mackerel in Class 29 bearing Serial No. 4-2004-001243 filed on February 11, 2004 by Fishwealth Canning Corporation with address at No. 629-631 Elcano St., Binondo, Manila, which application was published for opposition in the Intellectual Property Office (IPO) Electronic Gazette and officially released for circulation on July 28, 2005.

The herein Opposer is "HENRY N. KAWSON" with address at 27-D City Plaza Tower, 439 Plaza del Conde, Binondo, Manila.

The grounds for Opposition to the registration of the mark are as follows:

- "1. The registration of Respondent-Applicant's mark "YOUNG'S TOWN" will violate the Opposer's rights and interest over its "YOUNG'S TOWN" trademark.
- "2. The registration of Respondent-Applicant's mark is contrary to the provisions of the Intellectual Property Code or Republic Act No. 8293.

Opposer relied on the following facts to support his opposition:

- "1. Opposer had on 03 September 2003 filed an Application for Trademark Registration of "YOUNG'S TOWN" under Application Serial No. 4-2003-0008131 with the Intellectual Property Office (IPO) in accordance with the provisions of the Intellectual Property Code or Republic Act No. 8293.
- "2. The Trademark Application was filed pursuant to Sections 122 and 124 of the aforesaid code.
- "3. Opposer intends to use "YOUNG'S TOWN" trademark which he had applied for before the expiry of the period of three (3) years from the date the trademark application was filed on or before 03 September 2006.
- "4. Opposer will comply with the filing of the declaration of actual use (D.A.U.) on or before 03 September 2006 consistent with Section 124.2 of the Intellectual Property Code.
- "5. The opposition to the intended registration of "YOUNG'S TOWN" mark applied for by herein Respondent-Applicant is consistent with the clear provisions of Section 123.1 of Republic Act No. 8293 since Opposer has earlier first filed his trademark application ahead of Respondent-Applicant ad because the latter filed its application only last 11 February 2004 for the same goods under Class 29.
- "6. The Intellectual Property Code follows the first-to-file rule.

- “7. Clearly, Respondent-Applicant cannot legally register its mark “YOUNG’S TOWN” applied for since it is identical with a mark with an earlier filing date for the same goods.
- “8. The Opposer invokes his right to oppose Respondent-Applicant’s application herein under Section 2: Trademarks, Article 15, Paragraph 5 of the TRIPS Agreement (1994) which affords an opportunity for the registration of a trademark to be opposed.”

On November 23, 2005, Respondent-Applicant “FISHWEALTH CANNING CORPORATION”, through counsel, filed its Answer to the verified notice of opposition, stating therein the following:

- “1. The instant Notice of Opposition is barred by two (2) prior Decisions rendered by this Honorable Office in two (2) cases between the same parties;
- “2. Respondent-Applicant’s application Serial No. 4-2004-001243 conforms with, and does not violate the Intellectual Property Code of the Philippines.

To be taken into consideration in this particular case is that it is governed by Summary Rules pursuant to Office Order No. 79, Series of 2005 which took effect on September 1, 2005.

During the preliminary conference in the above-entitled case held on December 6, 2005 pursuant to Rule 2, Section 14 and Subsections 14.2 and 14.3 of Office Order No. 79, both parties were present with their respective counsel and were asked the following questions:

- a. “Can the parties settle this case amicably?” The parties answered “NO”.
- b. “Would the parties submit this case for mediation?” The parties likewise answered “NO”.
- c. On the third (3rd) question propounded to the parties. “What is the ultimate issue to be resolved in this particular case? The parties agreed that the only issue to be resolved in this case is the same issue raised and resolved in the two (2) prior cases decided by this Honorable Office involving the same parties.

With the three (3) questions answered by both parties, the preliminary conference was officially terminated, thereby the parties were required to submit their respective position papers within ten (10) days therefrom. After which, the case will be considered submitted for DECISION. Both parties filed their respective position papers on 05 December 2005.

As stated by Opposer in his Verification and Certification attached to, and which from part of the Verified Notice of Opposition, there is between the parties, Inter Partes Case No. 14-2004-00134 which was decided by this Office in favor of herein Respondent-Applicant and against the Opposer, although the latter appealed the adverse decision against him to the Director General. In addition, there is Intellectual Property Violation (IPV) Case No. 10-2004-00002 between the same parties which was decided by this Honorable Office in favor of the herein Respondent-Applicant, although the Opposer appealed the adverse decision against him to the Director General.

In Inter Partes Case No. 14-2004-00134, which involved the same parties and the same trademark YOUNG’S TOWN, the main issue resolved by this Office was “*WHO BETWEEN THE OPPOSER (herein Respondent-Applicant) AND RESPONDENT-APPLICANT (herein Opposer) IS THE RIGHTFUL OWNER OF THE TRADEMARK “YOUNG’S TOWN” used on sardines and mackerel and therefore, entitled to its registration.* In its Decision No. 2005-11 dated 9 June 2005 rendered in the above mentioned case now marked as Exhibit “1”, this Office held that the herein

Respondent-Applicant is the rightful owner of the trademark "YOUNG'S TOWN" and therefore, entitled to its registration. Accordingly, the Notice of Opposition filed by Fishwealth Canning Corporation was sustained and Appln. Serial No. 4-2003-008131 for the registration of the mark YOUNGS TOWN on sardines and mackerel filed by Respondent-Applicant (Henry Kawson), who was the Oppositor in the instant case was rejected.

Likewise, in Intellectual Property Violation Case No. 10-2004-00002, also between the same parties, the crux of the controversy lies in the determination of the ownership of the mark "YOUNG'S TOWN" and the circumstances surrounding the filing by Opposer of his Application Serial No. 4-2003-008131 for the registration of the trademark YOUNG'S TOWN, upon which Opposer relies in support of the instant Notice of Opposition. In its Decision No. 2005-01 dated 23 June 2005 now marked in this case as Exhibit "2", this Office found that herein Respondent-Applicant is the owner of the trademark "YOUNG'S TOWN" and that Opposer, by applying for registration of the identical mark in his name, was guilty of falsely and fraudulently representing himself to be the owner of the said mark.

It is therefore, crystal clear and without iota of doubt that the instant Notice of Opposition is barred by the above mentioned decisions marked as Exhibits "1" and "2".

Opposer invokes the first-to-file rule claiming that he was the first to file the application for registration of the trademark YOUNG'S TOWN on September 3, 2003 ahead of herein Opposer-Applicant and the "the Intellectual Property Code follows the first to file rule." As fully discussed in Decision No. 2005-01 dated 23 June 2005 issued in Intellectual Property Violation Case No. 10-2004-00002, although Opposer was first-to-file his application of the mark "YOUNG'S TOWN" under the Intellectual Property Code, such fact alone does not automatically entitle him to the registration of the mark applied for as the applicant should still competently establish his entitlement to the mark applied for by showing compliance to the requirements for registrability of the mark which is, that he should use the mark within three years from dated of filing, otherwise the application shall be refused or if already registered, be removed from the register. Moreover, Opposer's application must not be in derogation of Respondent-Applicant's previously acquired and existing rights to the trademark "YOUNG'S TOWN" as decided by this Office earlier.

Finally, Opposer cannot invoke the First to File Rule of the Intellectual Property Code against the Respondent-Applicant as the same; law likewise provides that:

"Section 236. Preservation of Existing Rights. – Nothing herein shall adversely affect the rights on the enforcement of rights in patents, utility models, industrial designs, marks and works, acquired in good faith prior to the effective date of this Act."

Considering that herein Respondent-Applicant was found by this Office to be the rightful owner of the trademark YOUNG'S TOWN used on sardines and mackerel as it has acquired its rights to the trademark in good faith prior to the effectivity of the Intellectual Property Code, hence, its existing right was to be preserved.

WHEREFORE, with all the foregoing, the Notice of Opposition is, as it is hereby DENIED, for lack of merit. Consequently, Application Serial No. 4-2004-001243 for the mark "YOUNG'S TOWN" filed on February 11, 2004 by FISHWEALTH CANNING CORPORATION is hereby GIVEN DUE COURSE.

Let the filewrapper of YOUNG'S TOWN 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, 20 January 2006.

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